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Greenberg Traurig LLP
2450 Colorado Avenue
Suite 400E
Santa Monica, CA 90404

(For Patent Owner)

MAILED
APR 10 2006
REEXAM UNIT

Peng Chen
Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130

(For Third Party Requester)

In re Zyon International, Inc.
Reexamination Proceeding
Control No.: 90/007,813
Filed: November 23, 2005
For: U.S. Patent No. 6,805,837

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the March 3, 2006 patent owner petition entitled PETITION UNDER 37 CFR 1.182.

The petition fee of $ 400.00 (37 CFR 1.17(f)) is being charged to Deposit Account No. 50-2638 as authorized in the patent owner petition.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. A request for *ex parte* reexamination of U.S. Patent No. 6,805,837 (the '837 patent) was filed on November 23, 2005 and assigned control number 90/007,813 (the '813 ex *parte* reexamination proceeding).

2. Reexamination was ordered for the '813 *ex parte* reexamination proceeding on December 21, 2005.

3. On December 30, 2005, patent owner filed a timely paper entitled STATEMENT BY PATENT OWNER UNDER 37 CFR 1.530.

5. On February 22, 2006, the third party requester filed a timely paper entitled REQUESTOR'S (sic, REQUESTER'S) REPLY TO PATENT OWNER'S STATEMENT.

6. On March 1, 2006, pending litigation between patent owner and third party requester was stayed by the District Court. [1]

7. On March 3, 2006, patent owner filed the present petition.

8. Also on March 3, 2006, patent owner also filed a petition under 37 CFR 1.183 seeking a waiver of 37 CFR 1.181(f) such that a petition under 37 CFR 1.181 could be filed to contest the propriety of the December 21, 2005 order granting reexamination on the grounds that the order constituted an *ultra vires* action. That petition is being addressed by a separate decision being issued on even date.

9. There has been no further action on the '813 *ex parte* reexamination proceeding.

DECISION

35 U.S.C. § 304 provides:

> "If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed."

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

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

37 CFR 1.530(b) provides:

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

37 CFR 1.535 provides:

> "A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the ex parte reexamination requester will be considered."

---

[1] See *Zyon International, Inc. v. Acon Laboratories, Inc. et al,* No. CV 05-8692 (C.D. CA Mar. 1, 2006) (order denying motion to dismiss civil action, and granting stay of the action pending reexamination of the '837 patent) The Court granted the stay based on findings that - the present reexamination proceeding will simplify the issues in the litigation, extensive discovery has not occurred, a trial date has not been set, and plaintiff (patent owner) will not be unduly prejudiced if the Court waits for a determination by the Office before proceeding with the action.

MPEP § 2246(I) provides, in pertinent part:

> "A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, 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)."
>
> "When a petition under 37 CFR 1.181 is filed to vacate an reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, 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."

Relief Requested by Patent Owner

In the present petition, patent owner requests that the December 30, 2005 "Statement by Patent Owner Under 37 CFR 1.530" be construed as a timely filed 37 CFR 1.181 petition pursuant to MPEP § 2246(I). At page 2 of the petition, patent owner argues that the December 21, 2005 patent owner submission was well within the time limit for filing a petition under 37 CFR 1.181. [2] Patent owner further argues at page 2 of the petition that the December 21, 2005 paper is, in essence, a petition to vacate the reexamination order that was not filed in proper petition format. To demonstrate that the December 30, 2005 paper was such a petition, patent owner relies on the last sentence on page 2 of the December 30, 2005 paper, which states: "The reexamination order should be reversed."

Findings and Analysis

A review of the December 30, 2005 paper filed by patent owner shows that it was styled as a patent owner's statement under 37 CFR 1.530, and not as a petition for relief from an order granting reexamination that was regarded as being an *ultra vires* action. In the December 30, 2005 paper, patent owner argued that the examiner erred in ordering reexamination. An argument of that sort is not inconsistent with the content of a patent owner's statement under 37 CFR 1.530 because it is, in fact, "a statement on the new question of patentability" as provided for by the regulation, and by 35 U.S.C. 304, second sentence. Thus, it is far from clear that the December 30, 2005 constituted a petition of the sort contemplated in MPEP § 2246(I). It appears that the December 30, 2005 paper is in fact what it purports to be, - a patent owner's statement under 37 CFR 1.530 presenting an argument for patentability, and not a petition under 37 CFR 1.181. Had patent owner desired to file a petition under 37 CFR 1.181 in accordance with the practice discussed in MPEP § 2246(I) with respect an order granting reexamination that is alleged to consist an *ultra vires* action, patent owner could have simply done so.

In addition, the record of the '813 *ex parte* reexamination proceeding shows that pursuant to 37 CFR 1.535, the third party requester filed a timely reply to the patent owner's December 30, 2005 paper. To now construe the December 30, 2005 paper as a petition to vacate the order for reexamination as being an *ultra vires* action would potentially prejudice the third party requester. Patent owner has not established that the third party requester would have replied

[2] 37 CFR 1.181(f) provides for a limit of two months from the action being challenged, for filing a petition under 37 CFR 1.181.

to a 37 CFR 1.181 petition in the same manner as the third party requester replied to the patent owner's statement, since there are consequences attendant to the granting of such petition that do not attach to the mere filing of a patent owner's statement. Further, as set forth in MPEP § 2246(I), a third party submission in opposition to a patent owner petition under 37 CFR 1.181 that alleges that a reexamination order was an *ultra vires* action must be filed within two weeks of the filing of service of the petition on the third party requester. Therefore, treating the December 30, 2005 patent owner paper as a petition in the manner requested by patent owner would raise an issue of timeliness of the third party requester's February 22, 2006 paper if it were to be construed as a submission in opposition to a patent owner *ultra vires* petition, rather than as a 37 CFR 1.535 reply to a 37 CFR 1.530 patent owner's statement. Therefore, if the December 30, 2005 patent owner paper were treated as a 37 CFR 1.181 petition as requested, it would be necessary to set a period of time in which the third party requester could file a reply thereto. It would also require additional time to consider the 37 CFR 1.181 petition and any submission in opposition thereto filed by the third party, as well as to promulgate a decision on the 37 CFR 1.181 petition. Granting the relief requested by patent owner would unduly delay the '813 *ex parte* reexamination proceeding, and thereby run counter to the provisions of 35 U.S.C. § 305 that reexamination in the Office must be conducted with special dispatch. Such a result is particularly undesirable here, because there is litigation regarding the '837 patent, and that litigation has been stayed by the District Court to await the result of the reexamination proceeding. See note 1, *supra*.

In addition to the time delay pointed out in the prior paragraph, it is noted that, in this instance, the patent owner will not be prejudiced by the failure to grant the requested relief, since even if the presently requested relief is not granted, patent owner may pursue the issue raised in the December 30, 2005 patent owner's statement on appeal (if the examiner rejects claims based upon an issue that patent owner believes to be *ultra vires* in this *ex parte* reexamination proceeding). The refusal to grant the relief requested in the present patent owner petition will not prevent patent owner from obtaining a speedy resolution (in accordance with the statutory requirement for special dispatch) of the issue raised in the patent owner's statement. Inasmuch as there is stayed litigation involving the '837 patent, any examiner's action which sets a shortened statutory period for the filing of a patent owner response thereto will set a one-month (or thirty day, which ever is longer) shortened statutory period for reply in accordance with the provisions of MPEP § 2286(I). Patent owner need only respond promptly to the examiner's actions. It is also observed that even if the requested relief were granted, such would not guarantee that the resulting 37 CFR 1.181 petition would be granted.

CONCLUSION

1. The patent owner petition requesting that the patent owner's statement under 37 CFR 1.530 filed on December 30, 2005 be treated as a petition under 37 CFR 1.181 is <u>dismissed</u>.

2. Jurisdiction over the '813 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit, and to Art Unit 3993, for immediate action in accordance with 37 CFR 1.550 and MPEP §§ 2258 - 2263 .

3. **Any Office action in which a shortened statutory period for filing a response thereto is set, will set a shortened statutory period of 1 month or 30 days, whichever is longer.**

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

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

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April 5, 2006

4-6-06
C:\Kiva\Kenpet6\UV\7813-1.182 consider Owner Statement as UV Petition.doc

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12531 High Bluff Drive
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(For Third Party Requester)

In re Zyon International, Inc.
Reexamination Proceeding
Control No.: 90/007,813
Filed: November 23, 2005
For: U.S. Patent No. 6,805,837

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the March 3, 2006 patent owner petition entitled PETITION UNDER 37 CFR 1.183. The petition fee of $ 400.00 (37 CFR 1.17(f)) is being charged to Deposit Account No. 50-2638 as authorized in the patent owner petitions.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. A request for *ex parte* reexamination of U.S. Patent No. 6,805,837 (the '837 patent) was filed on November 23, 2005 and assigned control number 90/007,813 (the '813 ex *parte* reexamination proceeding).

2. Reexamination was ordered for the '813 *ex parte* reexamination proceeding on December 21, 2005.

3. On December 30, 2005, patent owner filed a timely paper entitled STATEMENT BY PATENT OWNER UNDER 37 CFR 1.530.

5. On February 22, 2006, the third party requester filed a timely paper entitled REQUESTOR'S (sic, REQUESTER'S) REPLY TO PATENT OWNER'S STATEMENT.

6. On March 1, 2006, pending litigation between patent owner and third party requester was stayed by the District Court. [1]

7. On March 3, 2006, patent owner filed the present petition.

8. Also on March 3, 2006, patent owner filed a petition under 37 CFR 1.182 seeking to have the December 30, 2005 patent owner paper construed as be a petition under 37 CFR 1.181 seeking review of the order granting reexamination as being an *ultra vires* action because it was not based on a new question of patentability. That petition is being addressed by a separate decision being issued on even date.

9. There has been no further action on the '813 *ex parte* reexamination proceeding.

DECISION

35 U.S.C. § 304 provides:

> "If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed."

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

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

37 CFR 1.530(b) provides:

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

37 CFR 1.535 provides:

> "A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the ex parte reexamination requester will be considered."

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[1] See *Zyon International, Inc. v. Acon Laboratories, Inc. et al,* No. CV 05-8692 (C.D. CA Mar. 1, 2006) (order denying motion to dismiss civil action, and granting stay of the action pending reexamination of the '837 patent) The Court granted the stay based on findings that - the present reexamination proceeding will simplify the issues in the litigation, extensive discovery has not occurred, a trial date has not been set, and plaintiff (patent owner) will not be unduly prejudiced if the Court waits for a determination by the Office before proceeding with the action.

MPEP § 2246(I) provides, in pertinent part:

> "A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, 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)."
>
> "When a petition under 37 CFR 1.181 is filed to vacate an reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, 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."

Relief Requested by Patent Owner

In the present petition, patent owner requests that a the provisions of 37 CFR 1.181(f) be waived to permit patent owner to file a petition under 37 CFR 1.181 seeking to vacate the order granting reexamination on the grounds that the order constitutes an *ultra vires* action because the request for reexamination does not set forth a new question of patentability. [2] Patent owner argues at page 2 of the petition that because the March 3, 2006 paper is, in essence, a petition to vacate the reexamination order that was not filed in proper petition format, the interests of justice would be served by granting the requested relief so that the patent owner can now file a proper petition.

Findings and Analysis

A review of the December 30, 2005 paper filed by patent owner shows that it was styled as a patent owner's statement under 37 CFR 1.530, and not as a petition. In the present petition, patent owner requests relief that is premised on the assumption that, although the December 30, 2005 patent owner paper was not in fact a petition, the paper addresses an issue that is advanced via a petition, rather than by a patent owner's statement. In the patent owner's statement, patent owner argued that the examiner erred in ordering reexamination. An argument of that sort is a not inconsistent with the content of a patent owner's statement under 37 CFR 1.530, because it is, in fact, "a statement on the new question of patentability" as provided for by the regulation, and by 35 U.S.C. 304, second sentence. The December 30, 2005 paper is in fact what it purports to be, a patent owner's statement under 37 CFR 1.530 presenting an argument for patentability, and the patent owner may obtain relief via that avenue when the examiner considers the content of the patent owner's statement during the examination stage of the proceeding.

In the present instance, the patent owner has not established that justice would be served by permitting patent owner to now file a petition under 37 CFR 1.181 in accordance with the practice in MPEP § 2246(I), in addition to the filed statement directed to the same issue. The record of the '813 *ex parte* reexamination proceeding shows that pursuant to 37 CFR 1.535, the third party requester filed a timely reply to the patent owner's December 30, 2005 paper. To permit patent owner to now file an untimely petition after the third party has set forth

[2] 37 CFR 1.181(f) provides for a limit of two months from the action being challenged, for time limit for filing a petition under 37 CFR 1.181. Therefore, patent owner cannot presently file the desired 37 CFR 1.181 petition.

arguments in the 37 CFR 1.535 reply to the December 30, 2005 patent owner's statement would allow patent owner a benefit not contemplated by the statute, which does not permit any patent owner submission in response to a reply filed under 37 CFR 1.535 prior to the examination stage. The next step contemplated by the statute is the issuance of a firat Office action by the examiner, without any prior further input from parties.

Further, if patent owner were now permitted to file a 37 CFR 1.181 petition to vacate the reexamination order as constituting an *ultra vires* action, the practice set forth in MPEP § 2246(I) would require that the Office grant additional time to the third party requester in order to file a submission in opposition to that petition. Consideration of the 37 CFR 1.181 petition and any third party submission in opposition thereto would require that additional time be taken, which would substantially delay *ex parte* examination in the event that the petition were not granted. Any unnecessary delay at this point in the '813 *ex parte* reexamination proceeding would run counter to the provisions of 35 U.S.C. § 305 that reexamination in the Office must be conducted with special dispatch. Such a result is particularly undesirable here, because there is litigation regarding the '837 patent, and that litigation has been stayed by the District Court. See note 1, *supra*.

In addition to the undesirable time delay pointed out in the prior paragraph, it is to be noted that the extraordinary relief of waiving a rule will not normally be considered if the rules provide an alternative avenue for obtaining the relief sought - *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, even though the presently requested relief is not granted, patent owner may pursue the issue raised in the December 30, 2005 patent owner's statement on appeal (if the examiner rejects claims based upon an issue that patent owner believes to be *ultra vires* in this *ex parte* reexamination proceeding). Thus, there is an alternative avenue which patent owner may pursue, and the failure to grant relief by way of the present petition does not run counter to the interests of justice in this proceeding. Patent owner will not be prevented from obtaining a speedy resolution (in accordance with the statutory requirement for special dispatch) of the issue raised in the patent owner's statement. Inasmuch as there is stayed litigation involving the '837 patent, any examiner's action which sets a shortened statutory period for the filing of a patent owner response thereto will set a one-month (or thirty day, which ever is longer) shortened statutory period for reply in accordance with the provisions of MPEP § 2286(I). Patent owner need only respond promptly to the examiner's actions. It is also observed that even if the requested relief were granted, such would not guarantee that the resulting 37 CFR 1.181 petition would be granted.

CONCLUSION

1. The patent owner petition requesting waiver of 37 CFR 1.181(f) to permit patent owner to now file a petition under 37 CFR 1.181 (to vacate the order granting reexamination) is dismissed.

2. Jurisdiction over the '813 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit and Art Unit 3993 for immediate action in accordance with 37 CFR 1.550 and MPEP §§ 2258 - 2263 .

3. **Any Office action in which a shortened statutory period for filing a response thereto is set, will set a shortened statutory period of 1 month or 30 days, whichever is longer.**

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

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

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April 5, 2006

4-6-06
C:\Kiva\Kenpet6\UV\7813-1.183 suspend 1.181(f) to allow late filing of UV Petition.doc

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Charles Berman
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Santa Monica, CA 90404

For Patent Owner

MAILED

APR 18 2007

CENTRAL REEXAMINATION UNIT

Peng Chen
Morrison & Forrester LLP
12535 High Bluff Drive, Suite 100
San Diego, CA 92130

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,813
Filed: November 28, 2005
For: US Patent No. 6,805,837

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

This is a decision on the petition filed April 6, 2007 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing an Appeal Brief which is due on April 8, 2007.

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

The petition is granted for one (1) 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 filed December 8, 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 the after final amendment filed December 5, 2006 was not considered until February 7, 2007. A Notice of Appeal was filed December 8, 2006 and an interview was held for March 22, 2007; however, there has not been a response to the amendment file March 26, 2007. An extension of time until May 8, 2007 is requested to facilitate the completion of the Appeal Brief.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. In the interest of providing Patent Owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for one (1) month is granted. It should be noted, second or subsequent requests for extensions of time will be granted only in extraordinary situations. (MPEP 2265)

Conclusion

1. The Patent Owner's petition for extension of time of one month in which to file an Appeal Brief is **granted**.

2. The Patent Owner's Appeal Brief is due May 8, 2007.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

Deborah Jones

for Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,813	11/23/2005	6805837	549102801300	4405

33717 7590 07/11/2007

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA, CA 90404

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/11/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

7/11/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PENG CHEN

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE, SUITE 100

SAN DIEGO, CA 92130

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007813

PATENT NO. 6,805,837

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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CENTRAL REEXAMINATION UNIT

Charles Berman
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2450 Colorado Avenue, Suite 400E
Santa Monica, California 90404

(For Patent Owner)

Peng Chen
Morrison & Foerster, LLP
12535 High Bluff Drive, Suite 100
San Diego, California 92310

(For 3rd Party Requester)

In re: Barry M. Tydings	: DECISION ON PETITION
Reexamination Proceeding	: TO CONTINUE
Control No.: 90/007,813	: *EX PARTE*
Filed: November 23, 2005	: REEXAMINATION
For: U.S. Patent No.: 6,805,837	: PROCEEDINGS

This is a decision on the June 26, 2007 patent owner petition, denominated "PETITION FOR ENTRY OF SUPPLEMENTAL AMENDMENT AND SECOND SUPPLEMENTAL DECLARATION OF BARRY M. TYDINGS." The petition is being taken as a petition under 37 CFR 1.182 for continued prosecution in the reexamination proceeding.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. DA 50-2638. A further waiver fee of $400 set forth in 37 CFR 1.17(f) for waiver of 37 CFR 1.52 pursuant to 37 CFR 1.183 has been charged to Deposit account No. DA 50-2638.

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

REVIEW OF SALIENT FACTS

1) U.S. Patent No. 6,805,837 (the '837 patent) issued on September 30, 2004.

2) A request for *ex parte* reexamination of United States Patent No. 6,805,837 (the '837 patent) was filed by a third party requester on November 23, 2005, and assigned control number 90/007,813 (the '813 reexamination proceeding).

3) An Order granting reexamination in the '813 reexamination proceeding was mailed on December 21, 2005.

4) Patent owner filed a statement under 37 CFR 1.530 on December 30, 2005.

5) Requester filed a reply under 37 CFR 1.535 on February 22, 2006.

6) On May 10, 2006, a first non-final Office action was mailed, rejecting all 30 claims of the '837 patent on the grounds of non-statutory obviousness-type double patenting over claims 1-6 of U.S. Patent No. 6,379,620.

7) On June 12, 2006, patent owner filed a response traversing the rejection, in which no claims were amended.

8) On August 10, 2006, a final Office action (final rejection) was mailed, repeating the rejection of claims 1-30 on the same grounds as had been set forth in the May 10, 2006 non-final Office action.

9) On September 8, 2006, patent owner filed a response after final rejection in which no claims were amended, and further argument was presented traversing the rejection of record.

10) On September 19, 2006, the examiner conducted a personal interview with patent owner's representatives.

11) On September 20, 2006 patent owner filed a record of the September 19 interview, as required under 37 CFR 1.560(b).

12) On November 9, 2006, an advisory Office action was mailed, in which the examiner stated that the arguments were considered, but the rejection of record would be maintained as to finally rejected claims 1-30. The period for response to the final rejection was extended to run 4 months from the mailing date of the final rejection.

13) On December 5, 2006, patent owner filed a response after final rejection, [1] including an amendment which proposed amendments to claims 1, 9, 14, 16, 18, and 27-30.

14) On December 8, 2006, the patent owner timely filed [2] a Notice of Appeal.

15) On February 7, 2007, an advisory Office action was mailed, in which the examiner stated that the proposed amendments to the claims submitted on December 5, 2006, would not be entered as they raised new issues by altering the scope of the claims. The advisory letter informed patent owner that for purposes of appeal, claims 1-30 remained under rejection.

16) On March 26, 2007, patent owner filed a response after final rejection, including an amendment which proposed amending claims 1, 14, and 18 and cancelling claims 9-13, 15,

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[1] This paper was submitted to the Office by EFS-Web; EFS-Web filing was not permitted at that time for reexamination.

[2] This paper was submitted to the Office by EFS-Web; EFS-Web filing was not permitted at that time for reexamination.

22, 24, and 27-30. A declaration of Barry Tydings in support of patentability was included in this submission.

17) Also on March 26, 2007, patent owner filed an interview summary, making of record an interview held on March 22, 2007. [3]

18) On April 17, 2007, patent owner filed a Supplemental Declaration of Barry Tydings to support the patentability of the claims.

19) On April 27, 2007, an advisory Office action was mailed, in which the examiner stated that the proposed amendments to the claims submitted on March 26, 2007, and the affidavit submitted April 17, 2007, would be entered. The advisory action further indicated that, for purposes of appeal, the remaining claims (1-8, 14, 16-21, 23, 25, and 26) stand rejected.

20) On May 2, 2007 patent owner filed a paper titled "Supplemental Amendment."

21) On May 7, 2007 patent owner submitted (i) a further supplemental amendment proposing cancellation of claim 20 and further changes to claim 18, and (ii) a second supplemental declaration of Barry Tydings.

22) On May 8, 2007, patent owner filed an appeal brief. [4]

23) On June 14, 2007, the Office issued a Notification of Non-Compliant Appeal Brief in Ex-Parte Reexamination setting a period of one month for correction.

24) Also on June 14, 2007, the examiner mailed an advisory action indicating that the Supplemental amendments of May 2nd and May 7th would not be entered, because they did not comply with the proper form for amendments in reexamination proceedings, and that the second supplemental declaration would not be entered for failure to comply with 37 CFR 41.33(d)(1).

25) On June 26, 2007, patent owner filed the instant petition under 37 CFR 1.182, (a) for entry of a corrected version of the May 2 and May 7, 2007 amendments submitted concurrently, and (b) for entry of the second supplemental affidavit of Barry M. Tydings originally submitted May 7, 2007.

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 Supplemental Amendment After Final received in the Office in proper format June 26, 2007, and the Second Supplemental Declaration

[3] No Examiner Interview Summary reflecting this interview is to be found in the IFW file for this proceeding.

[4] Extensions of time were granted on March 8th and April 18th, extending the time for filing the brief from February 8th to May 8, 2007.

of Barry M. Tydings received in the Office on May 7, 2007. [5]

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." [6] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, 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.

Based on the facts and circumstances of the present situation, it is found that Petitioner patent owner's presentation of an amendment and further evidence directed to the determination of patentability are deemed a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate; and as such, the granting of the present petition is consistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the Supplemental Amendment After Final and the Second Supplemental declaration of Barry M. Tydings received June 26, 2007. These papers will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the Amendment After Final,

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[5] Item 25 in the Review of Salient Facts.

[6] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

and all papers submitted as part of the appeal process. The Examiner will then issue an Office action treating these papers as patent owner responses received **after** a first Office action.

A review of the record reveals that reexamination proceeding papers titled "Amendment After Final" were submitted to the Office by EFS-Web on December 5, 2006. Also, papers titled "Notice of Appeal", "Request for Oral Hearing", and "Pre-Appeal Brief Request for Review" were submitted to the Office by EFS-Web on December 8, 2006. Reexamination proceeding papers, however, were not at that time 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. On July 10, 2007, in a telephone communication between the patent owner's representative Charles Berman and Pinchus M. Laufer of the Office, authorization was given to charge $ 400.00 to deposit account No. 50-2638, to provide the requisite fee for the present waiver of the rule. In view of the above, 37 CFR 1.52 is hereby waived to the extent that the aforementioned reexamination proceeding papers, submitted by EFS-Web on December 5 and 8, 2006, are now accepted as being properly submitted to the Office.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '7813 *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 August 10, 2006 final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The Supplemental Amendment After Final and the declaration of Barry M. Tydings received June 26, 2007, will be entered [7] by the Central Examination Unit, and will then be considered by the examiner. These papers (and all papers submitted relating to the appeal [8] process) will be treated as a response by patent owner received **after** a first Office action.

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[7] 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.

[8] Although the brief on appeal was held non-compliant, that determination was limited to its entry as a brief. Insofar as the proceeding is no longer in appeal status, any arguments and evidence submitted with the brief are entered in the record and are properly ripe for consideration by the examiner.

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

6) Telephone inquiries related to this decision should be directed to 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

July 10, 2007
C:\Kiva\Kenpet6\RCR\ 7813_RCR grant_KSR+Amdt+Aff+1.52 waiver.doc

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.
90/007,813	11/23/2005	6805837	549102801300	4405

33717 7590 09/28/2007

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA, CA 90404

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2007

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

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9/28/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PENG CHEN

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE, SUITE 100

SAN DIEGO, CA 92130

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007813

PATENT NO. 6,805,837

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)).

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Charles Berman
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404

For Patent Owner

Peng Chen
Morrison & Forrester LLP
12535 High Bluff Drive, Suite 100
San Diego, CA 92130

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,813
Filed: November 23, 2005
For: US Patent No. 6,805,8387

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

This is a decision on the petition filed September 21, 2007 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing a Notice of Appeal which is due on September 24, 2007.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a Notice of Appeal which is due on September 24, 2007. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The petition for extension of time states that a timely amendment in response to the July 24, 2007 final Office action was filed on September 6, 2007. The examiner mailed an Advisory Action on September 19, 2007 that was not viewable in PAIR until September 21, 2007. Substantial new grounds have now been raised for refusal to enter the September 6, 2007 amendment and, in order for Appellant to adequately consider the Advisory Action, a one-month extension of time is requested.

Analysis and Findings

On July 24, 2007, a Final rejection was sent to Patent Owner with a shortened statutory period for response set to expire one month therefrom.

On August 9, 2007, Patent Owner submitted a first response to the Final rejection.

On August 17, 2007, an Advisory action was sent to Patent Owner indicating the Declarations of Mr. Tydings and Mr. Hipple and the amendment to the specification, submitted on August 9, 2007, were entered but the amendments to the claims were not compliant with 37 CFR 1.530 (f) and (i) and were therefore not entered. The previous grounds of rejection were maintained for the reasons of record. The period for response was extended to run two months from the mailing date of the Final rejection.

On August 20, 2007, an Amendment was submitted that included a compliant amendment to the claims and presented new claim 31.

On August 31, 2007, an Advisory action was mailed to Patent Owner denying entry of the amendment to the claims because the amendments raised new issues, did not place the proceeding in better condition for appeal, and presented additional claims without canceling a corresponding number of finally rejected claims. The Advisory action indicated that the amendment failed to provide an explanation of the support in the disclosure of the patent for the changes made to the claims or the newly submitted claim. The previous grounds of rejection were maintained for the reasons of record. The period for response continued to run two months from the Final rejection.

On September 6, 2007, a second Response to Final Rejection was filed including the previously entered amendment to the specification and an amendment to the claims that now included new claims 31-34.

On September 19, 2007, an Advisory action was mailed to Patent Owner denying entry of the amendment adding new claims and, in addition to repeating the previous reasons for non-entry, indicated that the proposed amendment did not remove the issues for appeal or put a claim in obvious patentable condition. The previous grounds of rejection were maintained for the reasons of record. The period for response was held to run two months from the mailing date of the Final rejection.

On September 21, 2007, Patent Owner submitted a Petition for an Extension of Time concurrently with a Petition for Entry of Amendment. The Petition for Extension of Time states the additional time is necessary so that the case will be in the right status with the Petition for Entry of Amendment decided before the Notice of Appeal is filed.

On balance, it does not appear that the petition explains the "sufficient cause" for an extension of time. In the view of the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, no extension of time is deemed necessary. The Notice of Appeal is due on September 24, 2007.

Conclusion

1. The Patent Owner's petition for extension of time of one month in which to file an Appeal Brief is **dismissed**.

2. The Patent Owner's Notice of Appeal is due September 24, 2007.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

for Lissi M. Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Charles Berman
Greenberg Traurig, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, California 90404

(For Patent Owner)

Peng Chen
Morrison & Foerster, LLP
12535 High Bluff Drive, Suite 100
San Diego, California 92310

(For 3rd Party Requester)

In re: Barry M. Tydings	: DECISION ON PETITION
Reexamination Proceeding	: FOR ENTRY OF
Control No.: 90/007,813	: AMENDMENT
Filed: November 23, 2005	: FILED AFTER FINAL
For: U.S. Patent No.: 6,805,837	: REJECTION

This is a decision on the September 21, 2007 patent owner petition, denominated "PETITION UNDER 37 CFR 1.182 FOR ENTRY OF AMENDMENT."

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. DA 50-2638.

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

DECISION ON PETITION UNDER 37 CFR 1.182

A review of the file history reveals that continued reexamination was granted to the patent owner in a decision mailed July 11, 2007; a final Office action was issued by the Examiner of record on July 24, 2007; an amendment was filed on August 9 2007; the examiner issued an advisory action on August 17, 2007; patent owner filed a second response to the final Office action on August 20, 2007; the examiner issued a further advisory action on August 31, 2007; the patent owner file a third response to the final Office action on September 6, 2007; and the Examiner issued a third advisory action on September 19, 2007 which informed patent owner that the September 6 amendment would not be entered.

In the present petition, filed under 37 CFR 1.182, it is requested that the Office enter the amendment dated September 6, 2007.

37 CFR § 1.182 states:

> **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). (***Emphasis added***)

Entry of amendments after final action is governed by 37 CFR 1.116. Accordingly, 37 CFR 1.182, which is limited to questions not specifically provided for, does not apply. In addition, any challenge of the non-entry is effected by petition under 37 CFR 1.181 to the CRU Director, and such is not under the jurisdiction of the Office of Patent Legal Administration.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed

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

3) 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

October 1, 2007
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Charles Berman
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Santa Monica, CA 90404

For Patent Owner

MAILED

NOV 21 2007

CENTRAL REEXAMINATION UNIT

Peng Chen
Morrison & Forrester LLP
12535 High Bluff Drive, Suite 100
San Diego, CA 92130

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,813
Filed: November 23, 2005
For: US Patent No. 6,805,837

DECISION DISMISSING
PETITION FOR
ENTRY OF AMENDMENT
[37 CFR 1.181]

This is a decision on the petition filed October 8, 2007 to request entry of the amendment to the specification and claims submitted on September 6, 2007.

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

The petition is dismissed for the reasons set forth below.

The Patent Owner petitions for the entry of the amendment filed September 6, 2007. The amendment was in response to the Final Office Action mailed July 24, 2007 and included amendments to the specification and claims. Patent Owner states the arguments to support entry are set out in the amendment and requests these arguments be considered part of this petition.

Review of Facts

On July 24, 2007, a Final rejection was sent to Patent Owner with a shortened statutory period for response set to expire one month therefrom.

On August 9, 2007, Patent Owner submitted a first response to the Final rejection.

On August 17, 2007, an Advisory action was sent to Patent Owner indicating the Declarations of Mr. Tydings and Mr. Hipple and the amendment to the specification, submitted on August 9, 2007, were entered but the amendments to the claims were not compliant with 37 CFR 1.530 (f) and (i) and were therefore not entered. The previous grounds of rejection were maintained for the reasons of record. The period for response was extended to run two months from the mailing date of the Final rejection.

On August 20, 2007, an Amendment was submitted that included a compliant amendment to the claims and presented new claim 31.

On August 31, 2007, an Advisory action was mailed to Patent Owner denying entry of the amendment to the claims because the amendments raised new issues, did not place the proceeding in better condition for appeal, and presented additional claims without canceling a corresponding number of finally rejected claims. The Advisory action indicated that the amendment failed to provide an explanation of the support in the disclosure of the patent for the changes made to the claims or the newly submitted claim. The previous grounds of rejection were maintained for the reasons of record. The period for response continued to run two months from the Final rejection.

On September 6, 2007, a second Response to Final Rejection was filed including the previously entered amendment to the specification and an amendment to the claims that now included new claims 31-34.

On September 19, 2007, an Advisory action was mailed to Patent Owner denying entry of the amendment adding new claims and, in addition to repeating the previous reasons for non-entry, indicated that the proposed amendment did not remove the issues for appeal or put a claim in obvious patentable condition. The previous grounds of rejection were maintained for the reasons of record. The period for response was held to run two months from the mailing date of the Final rejection.

On September 21, 2007, Patent Owner submitted a Petition for an Extension of Time concurrently with a Petition for Entry of Amendment. The Petition for Extension of Time states the additional time is necessary so that the case will be in the right status with the Petition for Entry of Amendment decided before the Notice of Appeal is filed.

On September 24, 2007, Patent Owner filed a Notice of Appeal.

On October 8,2007, Patent Owner filed this petition requesting entry of the after-final amendment.

Analysis and Findings

A review of the salient facts reveals the Examiner has entered the amendment to the specification and has appropriately denied entry of the after-final amendment to the claims. Patent Owner has provided no compelling showing the examiner has abused his discretion. Since the issuance of this decision is within days of the due date of the Appeal Brief, Patent Owner is given 30 (thirty) days from the mailing of this decision to submit the Appeal Brief.

Conclusion

1. The Patent Owner's petition for entry of the after-final amendment is **dismissed**.

2. The Patent Owner's Notice of Appeal is due December 21, 2007.

3. Response may be submitted as follows:

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

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

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

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

/Lissi M. Marquis /
Lissi M. Marquis,
Director,
Central Reexamination Unit

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Greenberg Traurig LLP
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(For Patent Owner)

Peng Chen
Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130

(For Third Party Requester)

MAILED
APR 10 2006
REEXAM UNIT

In re Zyon International, Inc.
Reexamination Proceeding
Control No.: 90/007,820
Filed: November 23, 2005
For: U.S. Patent No. 6,805,838

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the March 3, 2006 patent owner petition entitled PETITION UNDER 37 CFR 1.182.

The petition fee of $ 400.00 (37 CFR 1.17(f)) is being charged to Deposit Account No. 50-2638 as authorized in the patent owner petition.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. A request for *ex parte* reexamination of U.S. Patent No. 6,805,838 (the '838 patent) was filed on November 23, 2005 and assigned control number 90/007,820 (the '820 ex *parte* reexamination proceeding).

2. Reexamination was ordered for the '820 *ex parte* reexamination proceeding on December 21, 2005.

3. On December 30, 2005, patent owner filed a timely paper entitled STATEMENT BY PATENT OWNER UNDER 37 CFR 1.530.

5. On February 22, 2006, the third party requester filed a timely paper entitled REQUESTOR'S (sic, REQUESTER'S) REPLY TO PATENT OWNER'S STATEMENT.

6. On March 1, 2006, pending litigation between patent owner and third party requester was stayed by the District Court. [1]

7. On March 3, 2006, patent owner filed the present petition.

8. Also on March 3, 2006, patent owner also filed a petition under 37 CFR 1.183 seeking a waiver of 37 CFR 1.181(f) such that a petition under 37 CFR 1.181 could be filed to contest the propriety of the December 21, 2005 order granting reexamination on the grounds that the order constituted an *ultra vires* action. That petition is being addressed by a separate decision being issued on even date.

9. There has been no further action on the '820 *ex parte* reexamination proceeding.

DECISION

35 U.S.C. § 304 provides:

> "If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed."

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

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

37 CFR 1.530(b) provides:

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

37 CFR 1.535 provides:

> "A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the ex parte reexamination requester will be considered."

---

[1] See *Zyon International, Inc. v. Acon Laboratories, Inc. et al,* No. CV 05-8692 (C.D. CA Mar. 1, 2006) (order denying motion to dismiss civil action, and granting stay of the action pending reexamination of the '838 patent) The Court granted the stay based on findings that - the present reexamination proceeding will simplify the issues in the litigation, extensive discovery has not occurred, a trial date has not been set, and plaintiff (patent owner) will not be unduly prejudiced if the Court waits for a determination by the Office before proceeding with the action.

MPEP § 2246(I) provides, in pertinent part:

> "A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, 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)."
>
> "When a petition under 37 CFR 1.181 is filed to vacate an reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, 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."

Relief Requested by Patent Owner

In the present petition, patent owner requests that the December 30, 2005 "Statement by Patent Owner Under 37 CFR 1.530" be construed as a timely filed 37 CFR 1.181 petition pursuant to MPEP § 2246(I). At page 2 of the petition, patent owner argues that the December 21, 2005 patent owner submission was well within the time limit for filing a petition under 37 CFR 1.181. [2] Patent owner further argues at page 2 of the petition that the December 21, 2005 paper is, in essence, a petition to vacate the reexamination order that was not filed in proper petition format. To demonstrate that the December 30, 2005 paper was such a petition, patent owner relies on the last sentence on page 2 of the December 30, 2005 paper, which states: "The reexamination order should be reversed."

Findings and Analysis

A review of the December 30, 2005 paper filed by patent owner shows that it was styled as a patent owner's statement under 37 CFR 1.530, and not as a petition for relief from an order granting reexamination that was regarded as being an *ultra vires* action. In the December 30, 2005 paper, patent owner argued that the examiner erred in ordering reexamination. An argument of that sort is not inconsistent with the content of a patent owner's statement under 37 CFR 1.530 because it is, in fact, "a statement on the new question of patentability" as provided for by the regulation, and by 35 U.S.C. 304, second sentence. Thus, it is far from clear that the December 30, 2005 constituted a petition of the sort contemplated in MPEP § 2246(I). It appears that the December 30, 2005 paper is in fact what it purports to be, - a patent owner's statement under 37 CFR 1.530 presenting an argument for patentability, and not a petition under 37 CFR 1.181. Had patent owner desired to file a petition under 37 CFR 1.181 in accordance with the practice discussed in MPEP § 2246(I) with respect an order granting reexamination that is alleged to consist an *ultra vires* action, patent owner could have simply done so.

In addition, the record of the '820 *ex parte* reexamination proceeding shows that pursuant to 37 CFR 1.535, the third party requester filed a timely reply to the patent owner's December 30, 2005 paper. To now construe the December 30, 2005 paper as a petition to vacate the order for reexamination as being an *ultra vires* action would potentially prejudice the third party requester. Patent owner has not established that the third party requester would have replied

[2] 37 CFR 1.181(f) provides for a limit of two months from the action being challenged, for filing a petition under 37 CFR 1.181.

to a 37 CFR 1.181 petition in the same manner as the third party requester replied to the patent owner's statement, since there are consequences attendant to the granting of such petition that do not attach to the mere filing of a patent owner's statement. Further, as set forth in MPEP § 2246(I), a third party submission in opposition to a patent owner petition under 37 CFR 1.181 that alleges that a reexamination order was an *ultra vires* action must be filed within two weeks of the filing of service of the petition on the third party requester. Therefore, treating the December 30, 2005 patent owner paper as a petition in the manner requested by patent owner would raise an issue of timeliness of the third party requester's February 22, 2006 paper if it were to be construed as a submission in opposition to a patent owner *ultra vires* petition, rather than as a 37 CFR 1.535 reply to a 37 CFR 1.530 patent owner's statement. Therefore, if the December 30, 2005 patent owner paper were treated as a 37 CFR 1.181 petition as requested, it would be necessary to set a period of time in which the third party requester could file a reply thereto. It would also require additional time to consider the 37 CFR 1.181 petition and any submission in opposition thereto filed by the third party, as well as to promulgate a decision on the 37 CFR 1.181 petition. Granting the relief requested by patent owner would unduly delay the '820 *ex parte* reexamination proceeding, and thereby run counter to the provisions of 35 U.S.C. § 305 that reexamination in the Office must be conducted with special dispatch. Such a result is particularly undesirable here, because there is litigation regarding the '838 patent, and that litigation has been stayed by the District Court to await the result of the reexamination proceeding. See note 1, *supra.*

In addition to the time delay pointed out in the prior paragraph, it is noted that, in this instance, the patent owner will not be prejudiced by the failure to grant the requested relief, since even if the presently requested relief is not granted, patent owner may pursue the issue raised in the December 30, 2005 patent owner's statement on appeal (if the examiner rejects claims based upon an issue that patent owner believes to be *ultra vires* in this *ex parte* reexamination proceeding). The refusal to grant the relief requested in the present patent owner petition will not prevent patent owner from obtaining a speedy resolution (in accordance with the statutory requirement for special dispatch) of the issue raised in the patent owner's statement. Inasmuch as there is stayed litigation involving the '838 patent, any examiner's action which sets a shortened statutory period for the filing of a patent owner response thereto will set a one-month (or thirty day, which ever is longer) shortened statutory period for reply in accordance with the provisions of MPEP § 2286(I). Patent owner need only respond promptly to the examiner's actions. It is also observed that even if the requested relief were granted, such would not guarantee that the resulting 37 CFR 1.181 petition would be granted.

CONCLUSION

1. The patent owner petition requesting that the patent owner's statement under 37 CFR 1.530 filed on December 30, 2005 be treated as a petition under 37 CFR 1.181 is dismissed.

2. Jurisdiction over the '820 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit, and to Art Unit 3993, for immediate action in accordance with 37 CFR 1.550 and MPEP §§ 2258 - 2263 .

3. **Any Office action in which a shortened statutory period for filing a response thereto is set, will set a shortened statutory period of 1 month or 30 days, whichever is longer.**

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

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

sm
April 10, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Suite 400E
Santa Monica, CA 90404

(For Patent Owner)

Peng Chen
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12531 High Bluff Drive
Suite 100
San Diego, CA 92130

(For Third Party Requester)

MAILED
APR 10 2006
REEXAM UNIT

In re Zyon International, Inc.
Reexamination Proceeding
Control No.: 90/007,820
Filed: November 23, 2005
For: U.S. Patent No. 6,805,838

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the March 3, 2006 patent owner petition entitled PETITION UNDER 37 CFR 1.183. The petition fee of $ 400.00 (37 CFR 1.17(f)) is being charged to Deposit Account No. 50-2638 as authorized in the patent owner petitions.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. A request for *ex parte* reexamination of U.S. Patent No. 6,805,838 (the '838 patent) was filed on November 23, 2005 and assigned control number 90/007,820 (the '820 ex *parte* reexamination proceeding).

2. Reexamination was ordered for the '820 *ex parte* reexamination proceeding on December 21, 2005.

3. On December 30, 2005, patent owner filed a timely paper entitled STATEMENT BY PATENT OWNER UNDER 37 CFR 1.530.

5. On February 22, 2006, the third party requester filed a timely paper entitled REQUESTOR'S (sic, REQUESTER'S) REPLY TO PATENT OWNER'S STATEMENT.

6. On March 1, 2006, pending litigation between patent owner and third party requester was stayed by the District Court. [1]

7. On March 3, 2006, patent owner filed the present petition.

8. Also on March 3, 2006, patent owner filed a petition under 37 CFR 1.182 seeking to have the December 30, 2005 patent owner paper construed as be a petition under 37 CFR 1.181 seeking review of the order granting reexamination as being an *ultra vires* action because it was not based on a new question of patentability. That petition is being addressed by a separate decision being issued on even date.

9. There has been no further action on the '820 *ex parte* reexamination proceeding.

DECISION

35 U.S.C. § 304 provides:

> "If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed."

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

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

37 CFR 1.530(b) provides:

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

37 CFR 1.535 provides:

> "A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the ex parte reexamination requester will be considered."

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[1] See *Zyon International, Inc. v. Acon Laboratories, Inc. et al,* No. CV 05-8692 (C.D. CA Mar. 1, 2006) (order denying motion to dismiss civil action, and granting stay of the action pending reexamination of the '838 patent) The Court granted the stay based on findings that - the present reexamination proceeding will simplify the issues in the litigation, extensive discovery has not occurred, a trial date has not been set, and plaintiff (patent owner) will not be unduly prejudiced if the Court waits for a determination by the Office before proceeding with the action.

MPEP § 2246(I) provides, in pertinent part:

> "A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, 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:
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> ...
>
> (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)."
>
> "When a petition under 37 CFR 1.181 is filed to vacate an reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, 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."

Relief Requested by Patent Owner

In the present petition, patent owner requests that a the provisions of 37 CFR 1.181(f) be waived to permit patent owner to file a petition under 37 CFR 1.181 seeking to vacate the order granting reexamination on the grounds that the order constitutes an *ultra vires* action because the request for reexamination does not set forth a new question of patentability. [2] Patent owner argues at page 2 of the petition that because the March 3, 2006 paper is, in essence, a petition to vacate the reexamination order that was not filed in proper petition format, the interests of justice would be served by granting the requested relief so that the patent owner can now file a proper petition.

Findings and Analysis

A review of the December 30, 2005 paper filed by patent owner shows that it was styled as a patent owner's statement under 37 CFR 1.530, and not as a petition. In the present petition, patent owner requests relief that is premised on the assumption that, although the December 30, 2005 patent owner paper was not in fact a petition, the paper addresses an issue that is advanced via a petition, rather than by a patent owner's statement. In the patent owner's statement, patent owner argued that the examiner erred in ordering reexamination. An argument of that sort is a not inconsistent with the content of a patent owner's statement under 37 CFR 1.530, because it is, in fact, "a statement on the new question of patentability" as provided for by the regulation, and by 35 U.S.C. 304, second sentence. The December 30, 2005 paper is in fact what it purports to be, a patent owner's statement under 37 CFR 1.530 presenting an argument for patentability, and the patent owner may obtain relief via that avenue when the examiner considers the content of the patent owner's statement during the examination stage of the proceeding.

In the present instance, the patent owner has not established that justice would be served by permitting patent owner to now file a petition under 37 CFR 1.181 in accordance with the practice in MPEP § 2246(I), in addition to the filed statement directed to the same issue. The record of the '820 *ex parte* reexamination proceeding shows that pursuant to 37 CFR 1.535, the third party requester filed a timely reply to the patent owner's December 30, 2005 paper. To permit patent owner to now file an untimely petition after the third party has set forth

[2] 37 CFR 1.181(f) provides for a limit of two months from the action being challenged, for time limit for filing a petition under 37 CFR 1.181. Therefore, patent owner cannot presently file the desired 37 CFR 1.181 petition.

arguments in the 37 CFR 1.535 reply to the December 30, 2005 patent owner's statement would allow patent owner a benefit not contemplated by the statute, which does not permit any patent owner submission in response to a reply filed under 37 CFR 1.535 prior to the examination stage. The next step contemplated by the statute is the issuance of a firat Office action by the examiner, without any prior further input from parties.

Further, if patent owner were now permitted to file a 37 CFR 1.181 petition to vacate the reexamination order as constituting an *ultra vires* action, the practice set forth in MPEP § 2246(I) would require that the Office grant additional time to the third party requester in order to file a submission in opposition to that petition. Consideration of the 37 CFR 1.181 petition and any third party submission in opposition thereto would require that additional time be taken, which would substantially delay *ex parte* examination in the event that the petition were not granted. Any unnecessary delay at this point in the '820 *ex parte* reexamination proceeding would run counter to the provisions of 35 U.S.C. § 305 that reexamination in the Office must be conducted with special dispatch. Such a result is particularly undesirable here, because there is litigation regarding the '838 patent, and that litigation has been stayed by the District Court. See note 1, *supra.*

In addition to the undesirable time delay pointed out in the prior paragraph, it is to be noted that the extraordinary relief of waiving a rule will not normally be considered if the rules provide an alternative avenue for obtaining the relief sought - *Cantello v. Rasmussen,* 220 USPQ 664 (Comr. 1982). In this instance, even though the presently requested relief is not granted, patent owner may pursue the issue raised in the December 30, 2005 patent owner's statement on appeal (if the examiner rejects claims based upon an issue that patent owner believes to be *ultra vires* in this *ex parte* reexamination proceeding). Thus, there is an alternative avenue which patent owner may pursue, and the failure to grant relief by way of the present petition does not run counter to the interests of justice in this proceeding. Patent owner will not be prevented from obtaining a speedy resolution (in accordance with the statutory requirement for special dispatch) of the issue raised in the patent owner's statement. Inasmuch as there is stayed litigation involving the '838 patent, any examiner's action which sets a shortened statutory period for the filing of a patent owner response thereto will set a one-month (or thirty day, which ever is longer) shortened statutory period for reply in accordance with the provisions of MPEP § 2286(I). Patent owner need only respond promptly to the examiner's actions. It is also observed that even if the requested relief were granted, such would not guarantee that the resulting 37 CFR 1.181 petition would be granted.

CONCLUSION

1. The patent owner petition requesting waiver of 37 CFR 1.181(f) to permit patent owner to now file a petition under 37 CFR 1.181 (to vacate the order granting reexamination) is dismissed.

2. Jurisdiction over the '820 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit and Art Unit 3993 for immediate action in accordance with 37 CFR 1.550 and MPEP §§ 2258 - 2263 .

3. **Any Office action in which a shortened statutory period for filing a response thereto is set, will set a shortened statutory period of 1 month or 30 days, whichever is longer.**

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

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

sm
April 10, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Charles Berman
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2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404

For Patent Owner

MAILED

APR 18 2007

CENTRAL REEXAMINATION UNIT

Peng Chen
Morrison & Forrester LLP
12535 High Bluff Drive, Suite 100
San Diego, CA 92130

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,820
Filed: November 23, 2005
For: US Patent No. 6,805,838

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

This is a decision on the petition filed April 6, 2007 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing an Appeal Brief which is due on April 8, 2007.

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

The petition is granted for one (1) 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 filed December 8, 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 the after final amendment filed December 5, 2006 was not considered until February 7, 2007. A Notice of Appeal was filed December 8, 2006 and an interview was held on March 22; however, there has been no response to the amendment filed March 26, 2007. An extension of time until May 8, 2007 is requested to facilitate the completion of the Appeal Brief.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. In the interest of providing Patent Owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for one (1) month is granted. It should be noted, second or subsequent requests for extensions of time will be granted only in extraordinary situations. (MPEP 2265)

Conclusion

1. The Patent Owner's petition for extension of time of one month in which to file an Appeal Brief is **granted**.

2. The Patent Owner's Appeal Brief is due May 8, 2007.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

for Deborah Jones

Lissi M. Marquis,
Director,
Central Reexamination Unit

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.
90/007,820	11/23/2005	6805838	549102801200	7357

33717 7590 07/11/2007

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA, CA 90404

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/11/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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7/11/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PENG CHEN
MORRISON & FOERSTER LLP
12535 HIGH BLUFF DRIVE, SUITE 100
SAN DIEGO, CA 92130

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007820
PATENT NO. 6,805,838
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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(For Patent Owner)

MAILED

JUL 11 2007

CENTRAL REEXAMINATION UNIT

Peng Chen
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12535 High Bluff Drive, Suite 100
San Diego, California 92310

(For 3rd Party Requester)

In re: Barry M. Tydings
Reexamination Proceeding
Control No.: 90/007,820
Filed: November 23, 2005
For: U.S. Patent No.: 6,805,838

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the June 26, 2007 patent owner petition, denominated "PETITION FOR ENTRY OF SUPPLEMENTAL AMENDMENT AND SECOND SUPPLEMENTAL DECLARATION OF BARRY M. TYDINGS." The petition is being taken as a petition under 37 CFR 1.182 for continued prosecution in the reexamination proceeding.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. DA 50-2638. A further waiver fee of $400 set forth in 37 CFR 1.17(f) for waiver of 37 CFR 1.52 pursuant to 37 CFR 1.183 has been charged to Deposit account No. DA 50-2638.

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

REVIEW OF SALIENT FACTS

1) U.S. Patent No. 6,805,838 (the '838 patent) issued on September 30, 2004.

2) A request for *ex parte* reexamination of United States Patent No. 6,805,838 (the '838 patent) was filed by a third party requester on November 23, 2005, and assigned control number 90/007,820 (the '820 reexamination proceeding).

3) An Order granting reexamination in the '820 reexamination proceeding was mailed on

December 21, 2005.

4) Patent owner filed a statement under 37 CFR 1.530 on December 30, 2005.

5) Requester filed a reply under 37 CFR 1.535 on February 22, 2006.

6) On May 10, 2006, a first non-final Office action was mailed, rejecting all 23 claims of the '838 patent on the grounds of non-statutory obviousness-type double patenting over claims 1-6 of US Patent No. 6,379,620.

7) On June 12, 2006, patent owner filed a response traversing the rejection, in which no claims were amended.

8) On August 10, 2006, a final Office action (final rejection) was mailed, repeating the rejection of claims 1-23 on the same grounds as had been set forth in the May 10, 2006 non-final Office action.

9) On September 8, 2006, patent owner filed a response after final rejection in which no claims were amended, and further argument was presented traversing the rejection of record.

10) On September 19, 2006, the examiner conducted a personal interview with patent owner's representatives.

11) On September 20, 2006 patent owner filed a record of the September 19 interview as required under 37 CFR 1.560(b).

12) On November 9, 2006, an advisory Office action was mailed, in which the examiner stated that the arguments were considered, but the rejection of record would be maintained as to finally rejected claims 1-23. The period for response to the final rejection was extended to run 4 months from the mailing date of the final rejection.

13) On December 5, 2006, patent owner filed a response after final rejection[1] including an amendment which proposed amendments to claims 1, 2, and 4-7.

14) On December 8, 2006, the patent owner timely filed [2] a Notice of Appeal.

15) On February 7, 2007, an advisory Office action was mailed, in which the examiner stated that the proposed amendments to the claims submitted on December 5, 2006 would not be entered as they raised new issues by altering the scope of the claims. The advisory letter informed patent owner that for purposes of appeal, claims 1-23 remained under rejection.

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[1] This paper was submitted to the Office by EFS-Web; EFS-Web filing which was not permitted at that time for reexamination.

[2] This paper was submitted to the Office by EFS-Web; EFS-Web filing which was not permitted at that time for reexamination.

16) On March 26, 2007, patent owner filed a response after final rejection, including an amendment which proposed amending claim 2 and cancelling claims 1, 4, 6-12, 18, 20, 22, and 23.

17) Also on March 26, 2007, patent owner filed an interview summary, making of record an interview held on March 22, 2007. [3]

18) On April 17, 2007, patent owner filed a Supplemental Declaration of Barry Tydings to support the patentability of the claims.

19) On April 27, 2007, an advisory Office action was mailed, in which the examiner stated that the proposed amendments to the claims submitted on March 26, 2007, and the affidavit submitted April 17, 2007, would be entered. The advisory action further indicated that, for purposes of appeal, the remaining claims (2, 3, 5, 13-17, 19, and 21) stand rejected.

20) On May 2, 2007 patent owner filed a paper titled "Supplemental Amendment".

21) On May 8, 2007, patent owner filed an appeal brief[4].

22) On June 14, 2007, the Office issued a Notification of Non-Compliant Appeal Brief in Ex-Parte Reexamination setting a period of one month for correction.

23) Also, on June 14, 2007, the examiner mailed an advisory action indicating that the Supplemental amendment of May 2nd would not be entered because it did not comply with the proper form for amendments in reexamination proceedings.

24) On June 26, 2007, patent owner filed the instant petition under 37 CFR 1.182, (a) for entry of a corrected version of the May 2, 2007 amendment submitted concurrently, and (b) for entry of a concurrently filed second supplemental affidavit of Barry M. Tydings.

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 Supplemental Amendment After Final and the Second Supplemental Declaration of Barry M. Tydings received in the Office on June 26, 2007. [5]

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[3] No Examiner Interview Summary reflecting this interview is to be found in the IFW file for this proceeding.

[4] Extensions of time were granted on March 8th and April 18th extending the time for filing the brief from February 8th to May 8, 2007.

[5] Item 24 in the Review of Salient Facts.

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." [6] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, 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.

Based on the facts and circumstances of the present situation, it is found that Petitioner patent owner's presentation of an amendment and further evidence directed to the determination of patentability are deemed a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate; and as such, the granting of the present petition is consistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the Supplemental Amendment After Final and the Second Supplemental declaration of Barry M. Tydings received June 26, 2007. These papers will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the Amendment After Final, and all papers submitted as part of the appeal process. The Examiner will then issue an Office action <u>treating these papers as responses of patent owner received **after** a first Office action</u>.

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[6] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

A review of the record reveals that reexamination proceeding papers titled "Amendment After Final" were submitted to the Office by EFS-Web on December 5, 2006. Also, papers titled "Notice of Appeal", "Request for Oral Hearing", and "Pre-Appeal Brief Request for Review" were submitted to the Office by EFS-Web on December 8, 2006. Reexamination proceeding papers, however, were not at that time 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. On July 10, 2007, in a telephone communication between the patent owner's representative Charles Berman and Pinchus M. Laufer of the Office, authorization was given to charge $ 400.00 to deposit account No. 50-2638, to provide the requisite fee for the present waiver of the rule. In view of the above, 37 CFR 1.52 is hereby waived to the extent that the aforementioned reexamination proceeding papers, submitted by EFS-Web on December 5 and 8, 2006, are now accepted as being properly submitted to the Office.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '7820 *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 Office action mailed 10 August 2006 is withdrawn, and prosecution of the proceeding is reopened.

4) The Supplemental Amendment After Final and the declaration of Barry M. Tydings received June 26, 2007 will be entered[7] by the Central Examination Unit, and will then be considered by the examiner. These papers (and all papers submitted relating to the appeal [8] process) will be treated as a response by patent owner received **after** a first Office action.

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

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[7] 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.

[8] Although the brief on appeal was held non-compliant, that determination was limited to entry as a brief. Insofar as the proceeding is no longer in appeal status, any arguments and evidence submitted with the brief are entered in the record and are properly ripe for consideration by the examiner.

6) 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

July 10, 2007
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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
www.uspto.gov

Charles Berman
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404

For Patent Owner

Peng Chen
Morrison & Forrester LLP
12535 High Bluff Drive, Suite 100
San Diego, CA 92130

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,820
Filed: November 23, 2005
For: US Patent No. 6,805,838

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

This is a decision on the petition filed September 21, 2007 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing a Notice of Appeal which is due on September 24, 2007.

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

The petition is dismissed for the reasons set forth below.

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9/28/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PENG CHEN

MORRISON & FOERSTER LLP

12535 HIGH BLUFF DRIVE, SUITE 100

SAN DIEGO, CA 92130

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007820

PATENT NO. 6,805,838

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

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.
90/007,820	11/23/2005	6805838	549102801200	7357

33717 7590 09/28/2007

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA, CA 90404

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2007

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

Decision

The Patent Owner requests an extension of time in which to file a Notice of Appeal which is due on September 24, 2007. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The petition for extension of time states that a timely amendment in response to the July 24, 2007 final Office action was filed on September 6, 2007. The examiner mailed an Advisory Action on September 19, 2007 that was not viewable in PAIR until September 21, 2007. Substantial new grounds have now been raised for refusal to enter the September 6, 2007 amendment and, in order for Appellant to adequately consider the Advisory Action, a one-month extension of time is requested.

Analysis and Findings

On July 24, 2007, a Final rejection was sent to Patent Owner with a shortened statutory period for response set to expire one month therefrom.

On August 9, 2007, Patent Owner submitted a first response to the Final rejection.

On August 17, 2007, an Advisory action was sent to Patent Owner indicating the Declarations of Mr. Tydings and Mr. Hipple and the amendment to the specification, submitted on August 9, 2007, were entered but the amendments to the claims were not compliant with 37 CFR 1.530 (f) and (i) and were therefore not entered. The previous grounds of rejection were maintained for the reasons of record. The period for response was extended to run two months from the mailing date of the Final rejection.

On August 20, 2007, a document entitled "Supplemental Amendment after Final Rejection" was submitted.

On August 31, 2007, an Advisory action was mailed to Patent Owner denying entry of the amendment to the claims because the amendments raised new issues, did not place the proceeding in better condition for appeal, and presented additional claims without canceling a corresponding number of finally rejected claims. The Advisory action indicated that the amendment failed to provide an explanation of the support in the disclosure of the patent for the changes made to the claims or the newly submitted claim. The previous grounds of rejection were maintained for the reasons of record. It was also indicated that the amendment would be entered if filed in a separate paper containing only the proposed amendment to claim 2 (without new claim 24 or any other amendment to the claims). The period for response continued to run two months from the Final rejection.

On September 6, 2007, a second Response to Final Rejection was filed including the previously entered amendment to the specification and an amendment to the claims that now included new claims 24-27.

On September 19, 2007, an Advisory action was mailed to Patent Owner denying entry of the amendment adding new claims and, in addition to repeating the previous reasons for non-entry, indicated that the proposed amendment did not remove the issues for appeal or put a claim in obvious patentable condition. The previous grounds of rejection were maintained for the reasons of record. The period for response was held to run two months from the mailing date of the Final rejection.

On September 21, 2007, Patent Owner submitted a Petition for an Extension of Time concurrently with a Petition for Entry of Amendment. The Petition for Extension of Time states the additional time is necessary so that the case will be in the right status with the Petition for Entry of Amendment decided before the Notice of Appeal is filed.

On balance, it does not appear that the petition explains the "sufficient cause" for an extension of time. In the view of the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, no extension of time is deemed necessary. The Notice of Appeal is due on September 24, 2007.

Conclusion

1. The Patent Owner's petition for extension of time of one month in which to file an Appeal Brief is **dismissed**.

2. The Patent Owner's Notice of Appeal is due September 24, 2007.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

for Deborah Jones
Lissi M. Marquis,
Director,
Central Reexamination Unit

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COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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FAX RECEIVED
OCT 02 2007
CENTRAL REEXAMINATION UNIT

Charles Berman
Greenberg Traurig, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, California 90404

(For Patent Owner)

Peng Chen
Morrison & Foerster, LLP
12535 High Bluff Drive, Suite 100
San Diego, California 92310

(For 3rd Party Requester)

In re: Barry M. Tydings
Reexamination Proceeding
Control No.: 90/007,820
Filed: November 23, 2005
For: U.S. Patent No.: 6,805,838

: DECISION ON PETITION
: FOR ENTRY OF
: AMENDMENT
: FILED AFTER FINAL
: REJECTION

This is a decision on the September 21, 2007 patent owner petition, denominated "PETITION UNDER 37 CFR 1.182 FOR ENTRY OF AMENDMENT."

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. DA 50-2638.

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

DECISION ON PETITION UNDER 37 CFR 1.182

A review of the file history reveals that continued reexamination was granted to the patent owner in a decision mailed July 11, 2007; a final Office action was issued by the Examiner of record on July 24, 2007; an amendment was filed on August 9 2007; the examiner issued an advisory action on August 17, 2007; patent owner filed a second response to the final Office action on August 20, 2007; the examiner issued a further advisory action on August 31, 2007; the patent owner file a third response to the final Office action on September 6, 2007; and the Examiner issued a third advisory action on September 19, 2007 which informed patent owner that the September 6 amendment would not be entered.

In the present petition, filed under 37 CFR 1.182, it is requested that the Office enter the amendment dated September 6, 2007.

37 CFR § 1.182 states:

> **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). (***Emphasis added***)

Entry of amendments after final action is governed by 37 CFR 1.116. Accordingly, 37 CFR 1.182, which is limited to questions not specifically provided for, does not apply. In addition, any challenge of the non-entry is effected by petition under 37 CFR 1.181 to the CRU Director, and such is not under the jurisdiction of the Office of Patent Legal Administration.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed

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

3) 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

October 1, 2007
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2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404

For Patent Owner

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CENTRAL REEXAMINATION UNIT

Peng Chen
Morrison & Forrester LLP
12535 High Bluff Drive, Suite 100
San Diego, CA 92130

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,820
Filed: November 23, 2005
For: US Patent No. 6,805,838

DECISION DISMISSING
PETITION FOR
ENTRY OF AMENDMENT
[37 CFR 1.181]

This is a decision on the petition filed October 8, 2007 to request entry of the amendment to the specification and claims submitted September 6, 2007.

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

The petition is dismissed for the reasons set forth below.

The Patent Owner petitions for the entry of the amendment filed September 6, 2007. The amendment was in response to the Final Office Action mailed July 24, 2007 and included amendments to the specification and claims. Patent Owner

states the arguments to support entry are set out in the amendment and requests these arguments be considered part of this petition.

Review of Facts

On July 24, 2007, a Final rejection was sent to Patent Owner with a shortened statutory period for response set to expire one month therefrom.

On August 9, 2007, Patent Owner submitted a first response to the Final rejection.

On August 17, 2007, an Advisory action was sent to Patent Owner indicating the Declarations of Mr. Tydings and Mr. Hipple and the amendment to the specification, submitted on August 9, 2007, were entered but the amendments to the claims were not compliant with 37 CFR 1.530 (f) and (i) and were therefore not entered. The previous grounds of rejection were maintained for the reasons of record. The period for response was extended to run two months from the mailing date of the Final rejection.

On August 20, 2007, a document entitled "Supplemental Amendment after Final Rejection" was submitted.

On August 31, 2007, an Advisory action was mailed to Patent Owner denying entry of the amendment to the claims because the amendments raised new issues, did not place the proceeding in better condition for appeal, and presented additional claims without canceling a corresponding number of finally rejected claims. The Advisory action indicated that the amendment failed to provide an explanation of the support in the disclosure of the patent for the changes made to the claims or the newly submitted claim. The previous grounds of rejection were maintained for the reasons of record. It was also indicated that the amendment would be entered if filed in a separate paper containing only the proposed amendment to claim 2 (without new claim 24 or any other amendment to the claims). The period for response continued to run two months from the Final rejection.

On September 6, 2007, a second Response to Final Rejection was filed including the previously entered amendment to the specification and an amendment to the claims that now included new claims 24-27.

On September 19, 2007, an Advisory action was mailed to Patent Owner denying entry of the amendment adding new claims and, in addition to repeating the previous reasons for non-entry, indicated that the proposed amendment did not remove the issues for appeal or put a claim in obvious patentable condition. The previous grounds of rejection were maintained for the reasons of record. The period for response was held to run two months from the mailing date of the Final rejection.

On September 24, 2007, Patent Owner filed a Notice of Appeal.

On October 8, 2007, Patent Owner filed this petition requesting entry of the after-final amendment.

Analysis and Findings

A review of the salient facts reveals the Examiner has entered the amendment to the specification and has appropriately denied entry of the amendment to the claims. Patent Owner has provided no compelling showing the examiner has abused his discretion. Since the issuance of this decision is within days of the due date of the Appeal Brief, Patent Owner is given 30 (thirty) days from the date of mailing of this decision to submit the Appeal Brief.

Conclusion

1. The Patent Owner's petition for entry of the after-final amendment is **dismissed**.

2. The Patent Owner's Appeal Brief is due December 21, 2007.

3. Response may be submitted as follows:

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

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

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

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

/Lissi M. Marquis/
Lissi M. Marquis,
Director,
Central Reexamination Unit

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Peng Chen
Morrison & Foerster, LLP
12535 High Bluff Drive, Suite 100
San Diego, California 92310

(For 3rd Party Requester)

In re: Barry M. Tydings
Reexamination Proceeding
Control No.: 90/007,820
Filed: November 23, 2005
For: U.S. Patent No.: 6,805,838

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the petition entitled "REQUEST FOR RECONSIDERATION OF DECISION ON PETITION FOR ENTRY OF AMENDMENT" filed November 27, 2007. The petition requests review of the November 21, 2007 decision dismissing the petition under 37 CFR 1.181 filed October 8, 2007, to request entry of the amendment filed September 6, 2007.

The petition requests review at a higher level of authority than the previous decision rendered by the Director of the Central Reexamination Unit.

For the reasons set forth below, the petition under 37 CFR 1.181 is dismissed.

DECISION ON PETITION UNDER 37 CFR 1.181

A review of the file history reveals that continued reexamination was granted to the patent owner in a decision mailed July 11, 2007; a final Office action was issued by the Examiner of record on July 24, 2007; an amendment was filed on August 9 2007; the examiner issued an advisory action on August 17, 2007; patent owner filed a second response to the final Office action on August 20, 2007; the examiner issued a further advisory action on August 31, 2007; the patent owner file a third response to the final Office action on September 6, 2007; and the Examiner issued a third advisory action on September 19, 2007 which informed patent owner that the September 6 amendment would not be entered. Patent owner filed a petition for supervisory review on October 8, 2007 and the Director of the Central Reexamination Unit in a decision mailed November 21, 2007 dismissed the petition and did not grant the requested relief.

In the present petition, filed under 37 CFR 1.181, it is requested that the Office review the decision of November 21, 2007, and enter the amendment dated September 6, 2007. The petition essentially calls up for review patent owner's October 8, 2007 submissions.

Petitioner's position

Petitioner, patent owner, contends that the amendment is entitled to entry because there are no new issues raised by the amendment to claim 2 and the addition of new claims 24-27.

Specifically, patent owner states [1] that the issue of 35 U.S.C. 112 support for proposed claims has been "made repeatedly to the Examiners in writing and during two oral hearings." Petitioner argues further, that proposed claims 26-27 as presented in the September 6 amendment are "essentially similar" to claims 2 and 5 "as sought to be amended" on December 5, 2006, and thus these claims cannot be raising a new issue.[2] Patent owner also alleges "the exact wording of claims 26 and 27 were previously submitted in claims 2 and 3 which were entered, so it is impossible for the Examiner to state this is now a new issue."[3] Patent owner provides a copy of a proposed amendment after final submitted December 5, 2006 and the February 7, 2007 advisory action in an attempt to support this contention.

Petitioner states further that the claims should be entered "since the Applicant cancelled finally rejected claims 1, 4, 6-12, 18, 20-22, and is now seeking to add only claims 24-27." [4]

Background

On December 21, 2005, reexamination of claims 1-23, all claims of the '838 patent, was ordered in the '820 proceeding. The examination phase led to an Office action which issued on August 10, 2006 finally rejecting claims 1-23. Patent owner filed multiple proposed amendments after the final rejection. Of particular relevance is the December 6, 2006 amendment[5] which the Examiner refused entry stating "The proposed amendment would necessitate at least a new rejection under 35 U.S.C. 112 2nd paragraph.... The proposed amendment raises a new issue to at least the scope of the claims". [6]

Patent owner later filed an amendment on March 26, 2007 amending claim 2 and cancelling claims 1, 4, 6-12, 18, 20, 22, and 23. This amendment was entered. Patent owner continued to file amendments and when the examiner refused entry, patent owner petitioned for their entry. On July 11, 2007 the Office granted the petition for entry of the May 2, 2007 amendment as

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[1] "Petition under 37 CFR 1.181 For Entry of Amendment", October 8, 2007 at page 2
[2] "Petition under 37 CFR 1.181 For Entry of Amendment", October 8, 2007 at pages 3-4
[3] Petition under 37 CFR 1.181 For Entry of Amendment", October 8, 2007 at pages 5
[4] "Petition under 37 CFR 1.181 For Entry of Amendment Supplemental Statement". October 8, 2007 at page 2. This is clearly in error as claim 21 has never been cancelled, nor is it sought to be cancelled in the September 6 amendment which patent owner is requesting to be entered..
[5] The amendment proposed changes to claims 1, 2, and 4-7.
[6] Advisory Action mailed February 7, 2007.

provided in corrected format June 26, 2007, and referred the application to the examiner for further examination. The decision stated "No further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances." [7]

On July 24, 2007, the examiner issued a final rejection on the pending claims. [8] Patent owner followed with various proposed amendments under 37 CFR 1.116 that were refused entry by the Examiner.

Advisory action of September 19, 2007

On September 19, 2007, the examiner mailed an advisory action indicating that the amendment of September 6th would not be entered because the amendment raised new issues, did not materially simplify the issues on appeal and presented additional claims without cancelling a corresponding number of finally rejected claims. The examiner stated that "the addition of claims 24-27 would require consideration under 35 U.S.C. 112, 1st and 2nd paragraph as well as 35 U.S.C. 305" and further pointed out that since this is the third after final amendment submitted by the patent owner, MPEP 2272 directs that it only be considered to the extent it "removes issues from appeal or puts a claim in obvious patentable condition."

Analysis and Findings

1. 37 CFR 1.116(b)(3), which governs the admission of amendments touching on the merits after a final rejection, indicates that if patent owner makes "a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented" then the amendment may be entered. No such showing has been made in this proceeding.

2. Petitioner has not cancelled any finally rejected claims. That in and of itself is adequate grounds for the refusal to enter the amendment after final. The July 11, 2007 decision removed the finality of the previous Office action and instructed the examiner to issue an Office action treating the May 2, 2007 amendment after final, and all papers submitted in the appeal process, as patent owner responses received after a first Office action. The July 24, 2007 Office action rejected all of the pending claims (2, 3, 5, 13-17, 19 and 21), none of which are proposed to be cancelled in the September 6, 2007 amendment after final.

3. The issues of whether newly proposed claims 24-27 meet the provisions of 35 U.S.C. 112, 305 as well as the scope of these proposed claims has not been before the examiner and thus are new issues. Patent owner relies on the submission of a proposed amendment after final of December 6, 2006. The advisory actions specifically state that these claims [9] would not be entered because they raise issues of claim scope and of compliance with 35 U.S.C.112. Patent owner appears to

[7] "Decision on Petition to Continue mailed July 11, 2007 at page 5

[8] Claims 2, 3, 5, 13-17, 19, and 21.

[9] For the purpose of this decision we will assume that patent owner's representation that they are of identical scope is correct. In actuality, the examiner would be compelled to make even that determination if the ***claim language*** was not identical.

be confusing an advisory opinion explaining why the claim is not appropriate for consideration after final with an actual full determination. By refusing entry, the issue was not placed in front of the examiner and thus these issues have not been addressed.

4. Finally, as per MPEP 2272, consistent with the mandate of special dispatch in reexamination proceedings:

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

For at least the reasons set out above, the September 6, 2007 amendment under 37 CFR 1.116 is not entitled to entry.

CONCLUSION

1) The petition under 37 CFR 1.181 is dismissed.

2) Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-1100.

/Marian C. Knode/

Marian C. Knode
Director
Technology Center 1700
United States Patent & Trademark Office

December 19, 2007

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

Oblon, Spivak, McClelland, Maier & Neustadt, P.C. (For Patent Owner)
1940 Duke Street
Alexandria, VA 22314

MAILED

JUL 11 2006

CENTRAL REEXAMINATION UNIT

Gregory S. Rosenblatt (For 3rd Party Requester)
Wiggin and Dana LLP
One Century Tower, P.O. Box 1832
New Haven, CT 06508

Lawrence E. Laubscher Jr. (For 3rd Party Requester)
1160 Spa Road, Suite 2B
Annapolis, MD 21403

Reexam Control No.: 90/007,822
Filed : November 28, 2005
For U.S. Patent No. : 5,514,909

Reexam Control No.: 90/007,883
Filed : January 20, 2006
For U.S. Patent No. : 5,514,909

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).

Consideration of 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."

Reexamination in application control No. 90/007,822 was ordered in a decision mailed January 19, 2006. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,883 was ordered in a decision mailed March 8, 2006. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

As evidenced by the above facts, reexamination control No. 90/007,822 and reexamination control No. 90/007,883 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. 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 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

Reexamination Control Nos. 90/007,822 and 90/007,883 are hereby merged into a single proceeding. 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 Mark Reinhart, Special Programs Examiner, at telephone No. (571) 272-1611.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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FOR FIRST THIRD PARTY REQUESTER

Lawrence Laubscher, Jr.
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Annapolis, Maryland 21403

FOR SECOND THIRD PARTY REQUESTER

MAILED

OCT 18 2006

CENTRAL REEXAMINATION UNIT

In re Seigo Yamamoto et al.
Reexamination Proceeding
Control No. 90/007,822
Filed: November 28, 2005
For: U.S. Patent No. 5,514,909

In re Seigo Yamamoto et al.
Reexamination Proceeding
Control No. 90/007,883
Filed: January 20, 2006
For: U.S. Patent No. 5,514,909

In re Reissue Application of
Seigo Yamamoto et al.
Application No. 11/430,302
Filed: August 4, 2005
For: U.S. Patent No. 5,514,909

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. Patent No. 5,514,909 (the '909 patent) issued on May 7, 1996, with 11 claims.

2. A first request for reexamination, assigned Control No. 90/007,822 (the '7822 proceeding), was filed by a first third party requester on November 28, 2005.

3. Reexamination was ordered in the '7822 reexamination proceeding on January 19, 2006.

4. A second request for reexamination, assigned Control No. 90/007,883 (the '7883 proceeding), was filed by a second third party requester on January 20, 2006.

5. Reexamination was ordered in the '7883 reexamination proceeding on March 8, 2006.

6. An application for reissue, assigned application No. 11/430,302 (the '302 application) was filed by the patent owner on May 9, 2006.

7. On May 24, 2006, a notification of concurrent proceedings under 37 CFR1.565 was filed by the patent owner in the '7822 proceeding, informing the Office of the '7883 reexamination proceeding and of the '302 reissue application.

8. Also on May 24, 2006, a notification of concurrent proceedings under 37 CFR 1.565 was filed by the patent owner in the '7883 proceeding, informing the Office of the '7822 reexamination proceeding and of the '302 reissue application.

9. The filing of the '302 reissue application was announced in the *Official Gazette* on June 20, 2006.

10. On July 10, 2006, a decision merging the '7822 and '7883 reexamination proceedings was mailed by the Office.

11. On September 29, 2006 a non-final office action was mailed in the merged '7822 and the '7883 reexamination proceedings.

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. 11/430,302 and merged reexamination control Nos. 90/007,822 and 90/007,883 are currently pending. The order to reexamine has been mailed in both reexamination proceedings, 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 already merged reexamination proceedings will be merged in accordance with the decision set forth below.

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

Furthermore, in the event that a request for continued examination (RCE) is filed for the '302 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 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 files for merged reexamination control Nos. 90/007,822 and 90/007,883 shows:

   (a) Original patent claims 1-11 are present.

   (b) No amendments have been made.

   A review of reissue application No. 11/430,302 shows:

   (a) Original patent claims 1-11 are present.

   (b) A new claim numbered 12 was added.

   Accordingly, the claims are not identical in all the proceedings.

   An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all the proceedings, specifically, Application No. 11/430,302 and merged Control Numbers 90/007,822 and 90/007,883. 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, any claim which does not contain identical text in all the 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 previously merged reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the reissue application and the reexamination proceedings, and each action will be entered into each of the files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with three copies being filed for entry in the three files, with each of the three bearing a signature. Any such response must contain identifying data *for all of the cases*, i.e, the reissue application and the two reexamination proceedings. *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 merged reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate for both reexamination proceedings 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 as to the reissue application, while retaining the merged reexamination proceeding for Control Nos. 90/007,822 and 90/007,883. The reissue application will be held abandoned. The merged reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued for the merged reexamination proceeding in accordance with the last action of the Office, unless further action in the merged proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the merged 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 severance of the reissue application from the merged reexamination proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following such severance 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 as to the reissue application, while retaining the merged reexamination proceeding for Control Nos. 90/007,822 and 90/007,883, and continue examination as to the merged reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 11/430,302 and merged reexamination control Nos. 90/007,822 and 90/007,883 **are merged** into a single proceeding.

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

3. Jurisdiction over the merged reissue/reexamination proceeding is being transferred to Technology Center 2800 in which the reissue proceeding is assigned. The examiner assigned the merged reissue/reexamination proceeding is not to be one who was involved in any part of the examination of the '909 patent (e.g., by preparing/signing an action). See MPEP 2236.

4. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the housekeeping amendment to place the same amendments in 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 Karen Hastings, Legal Advisor, at (571) 272-7717.

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

kmh
17 October 2006

October 18, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner) – '7823

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NOV 29 2006

CENTRAL REEXAMINATION UNIT

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STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 New York Avenue, NW
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(For Third Party – '7518 Requester)

Mark J. Patterson
WADDEY & PATTERSON
1600 Division Street Suite 500
Nashville, TN 37203

(For Third Party – '7823 Requester)

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

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,518
Filed: April 22, 2005
For U.S. Patent No. 5,416,386

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,823
Filed: November 23, 2005
For U.S. Patent No. 5,416,386

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of reexamination control number 90/007,518 and the reexamination control number 90/007,823 pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,416,386 issued on May 16 1995.

2. The 90/007,518 reexamination proceeding was filed on April 22, 2005 by a third party requester.

3. The proceeding Order granting reexamination for control number 90/007,518 was mailed on July 6, 2005.

4. The 90/007,823 reexamination proceeding was filed November 23, 2005 by a third party requester.

5. The proceeding Order granting reexamination for control number 90/007,823 was mailed on January 25, 2006.

6. There are no amendments to either the control number 90/007,518 and 90/007,823 proceedings at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/007,518 and 90/007,823 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, there are no amendments at this time in either reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,518 and 90/007,823 are **merged**.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

Ole K. Nilssen 408 Caesar Drive Barrington IL 60010	(Patent Owner)
Virgil L. Beaston STERNE KESSLER GOLDSTEIN & FOX PLLC 1100 New York Avenue NW Washington, DC 20025-3934	(For Third Party Requester)
Mark J Patterson WADDEY & PATTERSON 1600 Division Street, Suite 500 Nashville TN 37203	(for Third Party Requester)
	DECISION GRANTING IN PART PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,518 Filed: April 22, 2005 For: US Patent No. 5,416,386	
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,823 Filed: November 23, 2005 For: US Patent No. 5,416,386	

This is a decision on the July 6, 2007, petition for "Petition for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed May 30, 2007, be extended by two months.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed May 30, 2007, which set a two month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on July 6, 2007, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is met by reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner notes the large number of rejections and other proceedings whose time for response is very close to the instant proceeding for which a response is required. A sufficient cause in the patent owner's petition is shown to justify a one-month extension of time.

The petition request is **Granted in Part**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated May 30, 2007 is **granted in part**.

2. The Patent Owner's response is due **August 30, 2007**.

3. Response may be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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OCT 05 2007

CENTRAL REEXAMINATION UNIT

Ole K. Nilssen
200 N. Harrison St., Suite 103
Algonquin IL 60102

(Patent Owner)

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue NW
Washington, DC 20025-3934

(For Requester)

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,480 and 90/007,930
Filed: March 25, 2005 and February 13, 2006
For: U.S. Patent No.: 5,233,270

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,983
Filed: March 24, 2006
For: U.S. Patent No.: 6,172,464

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,470
Filed: March 18, 2005
For: U.S. Patent No.: 4,857,806

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,864
Filed: January 4, 2006
For: U.S. Patent No.: 5,343,123

DECISION ON PETITION UNDER 37 CFR 1.182 REGARDING EXTENDED EXAMINER INTERVIEW

This is a decision on the September 26, 2007 patent owner petition filed in each of the above-identified proceedings to conduct an extended personal interview with the Examiner for the duration of five hours to discuss each of the above-identified proceedings.

The petition is before the Office of Patent Legal Administration for consideration of whether the request for an extended interview should be granted.

The petition is dismissed.

REVIEW OF SALIENT FACTS

1. On September 25, 2007, the patent owner contacted Examiner Escalante and requested a personal interview for the above-identified proceedings. The examiner granted the initial request and indicated that the duration of the interview would not exceed one hour.

2. The patent owner filed a petition on Sept. 26, 2007, in each of the above identified proceedings "to confirm that Owner is entitled to interview the Examiner for a duration of one hour per patent at issue, or a total of five (5) hours for the above five (5) captioned reexamination proceedings."

3. Payment of the petition fees required for each proceeding was completed on October 4, 2007, thus affecting entry of the petitions in each respective proceeding on this date.

4. The status of each proceeding is as follows:

(a) Control nos. 90/007,480 & 90/007,930 have been merged. A final office action was mailed July 3, 2007. An amendment in response to the final office action was filed Sept. 7, 2007.

(b) Control nos. 90/007,518 & 90/007,823 have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

(c) Control no. 90/007,983 received a non-final office action mailed on May 17, 2007. An amendment in response to the non-final office action was filed July 19, 2007.

(d) Control no. 90/007,470 received a final office action mailed June 29, 2007. An amendment in response to the final office action was filed Sept. 4, 2007, and a Notice of Appeal was filed Oct. 1, 2007.

(e) Control no. 90/007,864 received a non-final office action mailed May 29, 2007. An amendment in response to the non-final office action was filed July 2, 2007.

5. Each proceeding has received at least one office action and has had a response* filed therein by patent owner awaiting action.

6. Each proceeding has claims rejected on different grounds based on different prior art references.

DISCUSSION

Interviews in *ex parte* reexamination proceedings are governed by 37 CFR 1.560, which reads:

Interviews in *Ex Parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner 's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

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* It is noted that merged proceeding control no. 90/007,480 does not have a amendment filed therein, but has a petition awaiting decision to accept a late response.

As explained in MPEP 2281:

> In the case where the patent owner desires to initiate an interview, the patent owner should initially contact the examiner in charge of the proceeding to indicate what issues are sought to be discussed, and to determine if an interview will be granted. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview, and a copy of any proposed claims to be discussed, unless examiner waives this requirement. This provision will provide structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> The duration of the interview will not exceed one hour, unless the patent owner files a petition under 37 CFR 1.182 showing sufficient cause where more time is needed. In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied, to the extent such is deemed necessary. An hour of time in a structured planned interview should be sufficient to accomplish this, and in those rare instances where it is not, a patent owner may show cause to extend the time. During the interview, the examiner is always free to extend the duration of the interview to discuss issues that the examiner deems appropriate for (further) discussion. Such an extension of the duration of the interview is permitted at the examiner's sole discretion.
>
> Only one interview may be requested after an Office action and prior to filing the response to that action, absent a showing of good cause to conduct a second interview during this period.

DECISION

Interviews are ***permitted*** during reexamination proceedings and are granted at the discretion of the examiner if they are deemed to facilitate prosecution with special dispatch. Interviews may be requested after an Office action, prior to filing a response to that action, in order to define the claims over the applied prior art. As the interview must be conducted in a structured and planned manner, one hour of time should be sufficient to accomplish this.

The patent owner has requested that five different reexamination proceedings be discussed during one personal interview and that one hour be allotted to each proceeding to result in a personal interview with a duration of five hours.

Each of the proceedings is at a different stage of prosecution. Each of the proceedings has different prior art rejections applied against the claims, with a total of at least ten (10) different prior art references being at issue. Responses have already been filed in the proceedings and are awaiting action.

An extended interview in this case, which would raise numerous different issues, involve proceedings at various stage of prosecution, and be conducted over a lengthy period of time, would not be productive and would not facilitate the handling of these cases with special dispatch. The patent owner acknowledges in the petition that there are "a multitude of issues to be discussed" and that additional issues relating to priority particular to only two of the proceedings will be raised.

The goal of conducting a targeted, planned interview to define the claims over the prior art would not be accomplished by combining five different sets of claims and over ten different prior art references along with a variety of other issues in a single discussion. Moreover, none of these proceedings are at an appropriate stage of prosecution during which interviews are normally granted. Further, such a lengthy interview would not be an efficient use of Office resources and would not serve the public interest.

It is also noted that the petition states the patent owner is entitled to an interview in each proceeding and is entitled to one hour for each interview. Interviews are *permitted* at the discretion of the examiner; interviews are not entitlements. Further, the manual states that an interview *will not exceed one hour*. Interviews are not guaranteed to last one hour and may be held for less than one hour at the discretion of the examiner in the interest of expediting prosecution in an efficient manner.

The patent owner has not provided a sufficient showing of good cause as to why additional time, especially for a time period of five hours, in which to conduct an interview should be permitted in this situation. The petition states that patent owner's request is for reasons of efficiency, to conserve resources, and to lessen the amount of travel time. Economic and time considerations for the patent owner do not give rise to an adequate showing as there are other means of communication, including the telephone, available to the patent owner to interact with the examiner.

CONCLUSION

1. The petition requesting an extended personal examiner interview conducted at one time for all of the above identified proceedings is dismissed.

2. The patent owner is required to identify which one of the above proceedings will be the subject of the personal interview and indicate what issues are sought to be discussed so that the examiner can determine if an interview will be granted.

3. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview along with a copy of any proposed claims to be discussed unless the examiner waives this requirement.

4. The duration of the interview for an individual proceeding, if granted, will not exceed one hour.

5. The patent owner is reminded that merged proceedings require papers to be filed in each proceeding within the merged proceeding. In this case, patent owner filed a single petition in each of the merged proceedings, which is not in accordance with the guidelines set forth in the merger decision. The petition must be filed in each proceeding in the merged proceedings. In this instance, the Office has waived this procedure, but this is not to be construed as a waiver as to future filings. A paper must be filed in each proceeding within the merged proceedings going forward.

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

cdd
October 4, 2007

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OCT 17 2007

CENTRAL REEXAMINATION UNIT

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Virgil L. Bealson (For Third Party Requester)
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Nashville, TN 37203

In re Reexamination Proceeding :
Control No. 90/007,518 :
Filed: April 22, 2005 : DECISION GRANTING PETITION
U.S. Patent No. 5,416,386 : TO ACCEPT LATE PAPERS
: PROCEEDINGS BASED ON
: UNINTENTIONAL DELAY

In Re Reexamination Proceeding :
Control No. 90/007,823 :
Filed: November 23, 2005
U.S. Patent No. 5,416,386

This is a decision on the petition for entry of late papers based upon unintentional delay under 37 CFR § 1.137(b) filed by the patent owner on September 14, 2007.

The petition and the merged 90/007,518 - 90/007,823 *ex parte* reexamination proceeding (hereinafter "the merged proceeding") are before the Office of Patent Legal Administration (OPLA) for decision.

A review of the record shows that a non-final Office action was mailed in the merged proceeding on May 30, 2007, and a two-month shortened statutory period was set for filing a response thereto. A request for a two-month extension of time, together with the fee for the extension, was filed on July 6, 2007. The request for extension of time was granted on September 1, 2007, but for one month only. Accordingly, the merged proceeding was technically terminated for failure to file a timely response to the May 30, 2007 Office action. See 37 CFR 1.550(d).

37 CFR 1.137 provides, in part:

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

The present petition for entry of late papers was accompanied by, *inter alia*, the requisite response (filed on September 18, 2007, but including a 37 CFR 1.8 showing that the response was mailed on September 14, 2007, the same day that the present petition was filed by facsimile transmission), a $1,500.00 petition fee under 37 CFR 1.17(m), and a statement by patent owner that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. It is noted that a terminal disclaimer is not required. It is also noted that the petition was accompanied by a certificate of service on the each of the third party requesters.

The fee of $1,500 has been charged to counsel's credit card as requested in the present petition.

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3992 for further examination and consideration of the response filed on September 14, 2007, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Ovidio Escalante, in CRU (Technology Center) Art Unit 3992, who can be reached at (571)272-7537 or Mark Reinhart, Supervisory Patent Examiner for Art Unit 3992, who can be reached at (571) 272-1611.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-7743.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

mn
October 15, 2007

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OCT 17 2007

CENTRAL REEXAMINATION UNIT

Enclosure:* Petition filed October 9, 2007

In re Nilssen
Ex parte Reexamination Proceeding
Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

DECISION ON PETITION UNDER 37 CFR 1.182 & 37 CFR 1.183 REGARDING THIRD PARTY PARTICIPATION IN AND TRANSCRIPTION OR VIDEOTAPING OF EXAMINER INTERVIEW

This is a decision on the October 9, 2007 petition filed by the third party requester in the above-identified proceeding to (1) permit a representative of the third party requester to observe any and all examiner interviews; and/or (2) permit any and all examiner interviews to be transcribed or videotaped and be made part of the record for the proceeding.

The fee set forth in 37 CR 1.17(f) for a petition under 37 CFR 1.182 and 1.183 is $400. The petition fee for the above proceeding is being charged to the petitioner's deposit account No. 19-0036 as authorized by the petitioner on page 3 of the petition.

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

The petition is dismissed and returned to the third party requester. As the petition is not a proper submission, it has not been made part of the record in any of the above proceedings.

* The sole copy of the petition submitted to the Office is enclosed with the Decision in Control No. 90/007,470.

REVIEW OF SALIENT FACTS

1. Control no. 90/007,518 (the '7518 proceeding) & control no. 90/007,823 (the '7823 proceeding) have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

2. The period for active participation of the third party reexamination requester has ended in the '7518 & '7823 merged proceeding.

3. On October 9, 2007, the third party requester filed the present petition under 37 CFR 1.182 and 1.183.

DISCUSSION

Participation by third parties in an *ex parte* reexamination proceeding is governed by 37 CFR 1.550(g) and (h), which provide:

> (g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.
>
> (h) Submissions by third parties, filed after the date of the order for *ex parte* reexamination pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

Interviews permitted in reexamination proceedings are conducted in accordance with MPEP 2281, which states:

> "[O]nly *ex parte* interviews between the examiner and patent owner and/or the patent owner's representative are permitted. Requests by reexamination requesters to participate in or to attend interviews will not be granted."

The recordation of an interview in *ex parte* reexamination is set forth as follows, pursuant to MPEP 2281:

> "The examiner must complete an Interview Summary form PTOL-474 for each interview held where a matter of substance has been discussed (see MPEP § 713.04)....The original should be made of record in the reexamination file, and a copy should be mailed to any third party requester."
>
> "The general procedure for conducting interviews and recording same is described at MPEP § 713.01 - § 713.04...."
>
> "In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.... The requirement for a patent owner's statement of the interview cannot be waived by the examiner."

Pursuant to MPEP 713.04:

> "Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview.... If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials."

DECISION

1. Third party requester participation after the period permitted for active requester participation is not permitted.

The present petition of October 9, 2007, was filed after the period for active participation of the reexamination requester had ended. The present petition is not in compliance with the requirements of 37 CFR 1.510 or 1.535, nor does the present petition qualify as a prior art statement under 37 CFR 1.501. Accordingly, it is an improper submission under the above-quoted portions of 37 CFR 1.550. See *Syntex (USA) Inc. v. U.S. Patent and Trademark Office,* 11 USPQ 2d 1866, 1868-1869 (Fed. Cir. 1989).

As the present petition is not a proper submission, it will not be made of record in the reexamination file and is being <u>returned</u> to the third party requester. This decision will be made of record in the reexamination file. See also MPEP 2267.

2. Third party participation during interviews in *ex parte* proceedings is not permitted.

Petitioner has requested that the Office permit the third party to observe any and all examiner interviews and/or permit transcription or videotaping of any and all examiner

interviews in the above identified proceedings. Only *ex parte* interviews between the examiner and patent owner are permitted. Observation by third parties is not permitted. Pursuant to MPEP 2281, requests by reexamination requesters to participate in or to **attend** interviews will not be granted. The relief requested by petitioner with respect to transcription or videotaping would permit attendance by a third party in interviews, in addition to the examiner and the patent owner. Such attendance is not permitted.

It is also noted that the requested stenographer or videographer would be functioning as a representative of the third party requester to record the content of the interview. This third party intervention requested in the petition would not be justified, in view of the intent of the legislation and rules to make reexamination an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989)(third parties do not participate before the Office). Thus, the requested relief cannot be granted.

Moreover, the substance of the interview, as made of record in the proceeding file, is available to the public. The information generated by the procedures in MPEP 2281 and 713.04 provides the entirety of the substance of the interview to be made of record.[1] That record is available to the public and any forum that has an occasion to review the patent that was reexamined.

CONCLUSION

1. The petition requesting permission for a representative of the third party requester to observe and/or to transcribe or videotape any and all examiner interviews in the '7518 & '7823 merged proceeding is dismissed.

2. The petition is being returned to the requester and will not be entered in the above proceeding file.

3. Jurisdiction over the reexamination proceedings is being returned to the Central Reexamination Unit.

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[1] Pursuant to 37 CFR 1.2, "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

cdd

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,824	11/28/2005	6033542	102815-301	9293

22850 7590 07/03/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/03/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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7/3/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

GREGORY S. ROSENBLATT

WIGGIN AND DANA LLP

ONE CENTURY TOWER, P.O. BOX 1832

NEW HAVEN, CT 06508

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007824

PATENT NO. 6,033,542

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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Richard L. Treanor, Ph.D, Oblon Spivak, McClelland, Maier & Neustadt, P.C. 1940 Duke Street Alexandria, Virginia 22314	)))))	**FOR PATENT OWNER**

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JUL 0 3 2006

CENTRAL REEXAMINATION UNIT

Gregory S. Rosenblatt Wiggin and Dana, LLP One Century Tower P.O. Box 1832 New Haven, Connecticut 06508-1832	)))))	**FOR THIRD PARTY REQUESTER**

In re Seigo Yamamoto et al. Reexamination Proceeding Control No. 90/007,824 Filed: November 28, 2005 For: U.S. Patent No. 6,033,542	)))))	**DECISION RETURNING UNAUTHORIZED PAPER**

This is a decision on the June 14, 2006 third party requester paper entitled "PETITION IN OPPOSITION TO MERGER OF REISSUE APPLICATION AND CONCURRENT REEXAMINATION PROCEEDING."

The petition is returned as an improper paper. Consequently, there is no petition before the Office of Patent Legal Administration for decision and the paper has not been considered.

BACKGROUND

1. Patent No. 6,033,542 (the '542 patent) issued on March 7, 2000.

2. A request for reexamination, assigned Control No. 90/007,824 (the '7824 proceeding), was filed by the Third Party Requester on November 28, 2005.

3. Reexamination was ordered in the '7824 reexamination proceeding on January 20, 2006.

4. An application for reissue, assigned application No. 11/430,299, (the '299 application) was filed by the patent owner on May 9, 2006.

5. A Notification of concurrent proceedings under 37 CFR §1.565 was filed by the patent owner on May 24, 2006, informing the Office of the '299 reissue application.

6. On June 14, 2006, the third party requester filed the present petition paper, which is the subject of this decision

DISCUSSION

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).

DECISION

The present petition ***will not*** be decided on the merits, and it is being returned to the requester.

As noted, *supra*, the present request for reexamination of the '542 patent was filed on November 28, 2005, and reexamination was ordered on January 20, 2006. The record does not reveal that the patent owner filed a statement pursuant to 37 CFR 1.530, prior to third party requester's filing of the present petition on June 14, 2006. 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 expired, and no patent owner statement has been filed in the present

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, is not a reply to a patent owner's statement pursuant to 37 CFR §1.535, and 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.

In view of the above, the present petition does not have an entry right under the rules. Therefore, the present petition is will not be made of record in the reexamination file, and it is being returned to the third party requester ***without consideration of the substance of the petition***. The present decision will, however, be made of record in the reexamination file. See also MPEP 2267.

CONCLUSION

1. The paper filed by the third party requester June 14, 2006 is being returned to the third party requester with this decision as not having an entry right.

2. The third party requester petition is dismissed without consideration on the merits.

3. No copy of the petition papers will be maintained in the electronic Image File Wrapper for the proceeding, 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 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

July 3, 2006
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New Haven, CT 06508

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OCT 13 2006

CENTRAL REEXAMINATION UNIT

In re Reissue Application of Yamamoto et al
Application No. 11/430,299
Filed: May 9, 2006
For: U.S. Patent No. 6,033,542

In re Yamamoto et al
Reexamination Proceeding
Control No. 90/007,824
Filed: November 28, 2005
For: U.S. Patent No. 6,033,542

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. 6,033,542 (the '542 patent) was issued on March 7, 2000, with 5 claims.

2. A request for reexamination was filed by a third party requester on November 28, 2005, and was assigned control No. 90/007,824 (the '7824 proceeding).

3. Reexamination was ordered for the '7824 proceeding on January 20, 2006.

4. An application for reissue, assigned application No. 11/430,299 (the '299 application), was filed by the patent owner on May 9, 2006.

5. The filing of the '299 reissue application was announced in the *Official Gazette* on June 20, 2006.

6. A patent owner's statement under 37 CFR 1.530 was not received in the '7824 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. 11/430,299 and reexamination control No. 90/007,824 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 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. 90/007,824 shows the presence of the following live claims: original patent claims 1-5. A review of reissue application No. 11/430,299 shows that original patent claims 1-5, and a new claim numbered 6 has 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. 11/430,299 and Control Number 90/007,824. 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:

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

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

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

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, 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. Reissue application No. 11/430,299 and reexamination control No. 90/007,824 **<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 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 '542 patent (e.g., by preparing/signing an action). See MPEP 2236.

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

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

6. Telephone inquiries related to this decision should be directed to Samuel Broda, Legal Advisor, at (571) 272-7711.

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

ssb
10 October 2006

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CENTRAL REEXAMINATION UNIT

Birch, Stewart, Kolasch, and Birch
P.O. Box 747
Falls Church, VA 22040-0747

(For Patent Owner)

Kate H. Murashige
Morrison & Foerster, LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

(Courtesy Copy)

In re Quingbin Dong et al
Reexamination Proceeding
Control No. 90/007826
Filed: November 29, 2005
For: U.S. Patent 6,407,083

DECISION DISMISSING REQUEST FOR WITHDRAWAL OF ATTORNEY AS MOOT

This is a decision on the request under 37 CFR 1.36 for withdrawal, as attorney or agent, of Ms. Kate H. Mirashige, registration number 29,959, of Morrison & Foerster, LLP, for the above-identified reexamination proceeding.

This request is before the Office of Patent Legal Administration.

SUMMARY

For the reasons set forth below, the request under 37 CFR 1.36 for withdrawal of Ms. Kate H. Mirashige, of Morrison & Foerster, LLP, is **dismissed as moot**. Birch, Stewart, Kolasch, and Birch are the attorneys of record for the patent owner in the file of the '083 patent and in the '7826 reexamination proceeding. All future correspondence will be mailed to Birch, Stewart, Kolasch, and Birch, attorneys of record for the patent owner.

REVIEW OF THE FACTS

1. U.S. Patent 6,407,083 (the '083 patent) issued to Quingbin Dong et al on June 18, 2002. Office records reveal that the attorneys of record in the patented file are Birch, Stewart, Kolach, and Birch, whose address is P.O. Box 747, Falls Church, VA 22040-0747.

2. On November 29, 2005, a request for *ex parte* reexamination of the '083 patent was filed by Kate H. Mirashige, registration number 29,959, of Morrison & Foerster, LLP. The resulting reexamination proceeding was assigned control number 90/007,826 (the '7826 reexamination proceeding). While the transmittal form for the request indicated that the

request was filed by a third party requester, the first page of the request stated: "This request is filed on behalf of the patent owner, Wex Medical Instrumentation Company, Ltd." Office records fail to reveal that a change of power of attorney, naming Morrison & Foerster as attorneys of record for the patent owner, was ever received in the file of reexamination proceeding control number 90/007,826, or in the file of the '083 patent.

3. On January 19, 2006, an order granting the *ex parte* reexamination request was mailed for the '7826 reexamination proceeding.

4. On January 31, 2006, a request for withdrawal as attorney or agent and a change of correspondence address, was filed by Kate H. Mirashige, of Morrison & Foerster, LLP.

5. On March 20, 2006, an amendment by the patent owner was filed by the attorneys of record for the patent owner, - Birch, Stewart, Kolasch, and Birch, of Falls Church, Virginia.

6. On July 13, 2006, in a telephonic discussion with Legal Advisor Cynthia L. Nessler, Office of Patent Legal Administration, Ms. Kate H. Murashige of Morrison & Foerster verified that the original transmittal letter for the request for reexamination, filed on November 29, 2005, incorrectly stated that the request was made by the third party requester. Ms. Murashige also verified that the statement found on the first page of the request that accompanied the transmittal letter, also filed on November 29, 2005, stating "This request is filed on behalf of patent owner, Wex Medical Instrumentation Company, Ltd.", was the correct statement.

RELEVANT RULES AND PATENT EXAMINING PROCEDURES

37 CFR 1.32(b) states, in pertinent part:

> A power of attorney must:
> (1) Be in writing;
> (2) Name one or more representatives in compliance with (c) of this section;
> (3) Give the representative power to act on behalf of the principal; and
> (4) Be signed by the applicant for patent (§ 1.41(b)) or the assignee of the entire interest of the applicant.

37 CFR 1.33(c) states, in pertinent part (emphasis added):

> All notices, official letters, and other communications for the patent owner or owners **in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.32(b)) in the patent file** . . .

37 CFR 1.34 states (emphasis added):

> When a registered patent attorney or patent agent **acting in a representative capacity** appears in person **or signs a paper** in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall

> constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. **In filing such a paper, the registered patent attorney or patent agent must specify his or her registration number and name with his or her signature. Further proof of authority to act in a representative capacity may be required.**

37 CFR 1.510(f) states (emphasis added):

> If a request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party **or be acting in a representative capacity pursuant to § 1.34.**

MPEP 2213 states, in pertinent part:

> Where an attorney or agent files a request for an identified client (the requester), he or she may act under either a power of attorney from the client, or act in a representative capacity under 37 CFR 1.34, see 37 CFR 1.510(f). While the filing of the power of attorney is desirable, processing of the reexamination request will not be delayed due to its absence . . . All correspondence for a requester that is not the patent owner should be addressed to the representative of the requester, unless a specific indication is made to forward correspondence to another address. If the request is filed by a person on behalf of the patent owner, correspondence will be directed to the patent owner at the address as indicated in 37 CFR 1.33(c), regardless of the address of the person filing the request.

DECISION

Absent a change of power of attorney properly executed by the patent owner, the attorney that is of record in the patent file must be the attorney of record for the patent owner in the reexamination proceeding. All correspondence for the patent owner in a reexamination proceeding is mailed to the correspondence address of the attorney of record in the patented file. See 37 CFR 1.32(b) and 37 CFR 1.33(c).

In the present instance, the transmittal letter for the request for reexamination in the '7826 reexamination proceeding, filed by Morrison & Foerster, LLP, erroneously indicated that the request was made by a third party requester (see Item 6 of the Review of the Facts). For this reason, the Office mailed a copy of the order granting reexamination to Morrison & Foerster as attorneys for a third party requester, and another copy to Birch, Stewart, Kolasch, and Birch, who are the attorneys of record for the patent owner in the file of the '083 patent.

Morrison & Foerster, however, filed the request for reexamination on behalf of the patent owner, as stated on the first page of the request for reexamination (again see Item 6 of the Review of the Facts). Office records fail to reveal that a change of power of attorney, naming Morrison & Foerster as attorneys of record for the patent owner, was ever received in the file of reexamination proceeding control number 90/007,826 or in the file of the '083 patent (see Item 2 of the Review of the Facts). Because Ms. Kate H. Murashige specified her registration number,

29,959, and her name with her signature on the last page of the request (see item 2 of the Review of the Facts), Morrison & Foerster are determined to have filed the request for reexamination under 37 CFR 1.34, as acting on behalf of the patent owner in a representative capacity. See 37 CFR 1.510(f) and MPEP 2213.

Because Morrison & Foerster, LLP, were not the attorneys for a third party requester, they were not required to serve a copy of the request for reexamination on the attorneys for the patent owner, Birch, Stewart, Kolasch, and Birch.

CONCLUSION

1. Because Morrison & Foerster, LLP, are not the attorneys of record for the patent owner in the '7826 reexamination proceeding, the instant request for withdrawal as attorney or agent is dismissed as moot.

2. Birch, Stewart, Kolasch, and Birch are the attorneys of record for the patent owner in the file of the '083 patent and in the '7826 reexamination proceeding.

3. All future correspondence will be mailed to Birch, Stewart, Kolasch, and Birch, attorneys of record for the patent owner.

4. Neither the Office nor the patent owner will serve copies of communications filed or mailed with respect to the '7826 reexamination proceeding upon Morrison & Foerster, LLP, as this proceeding is in fact a patent owner requested proceeding.

5. Telephone inquiries relating to the '7826 reexamination proceeding can be directed to the primary examiner, Evelyn M. Huang, at (571) 272-0686.

6. Telephone inquiries relating to this decision can be directed to Cynthia L. Nessler, Legal Advisor, at (571) 272-7724.

7. Any comments with respect to this decision must be filed within ONE MONTH of the mailing date of the decision.

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

July 19, 2006

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MAILED
MAR 27 2006
REEXAM UNIT

In re The President and Fellows of
Harvard University *et al*
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent No. 6,410,516 B1

: DECISION ON PETITION TO
: VACATE ORDER GRANTING
: REEXAMINATION, AND
: ON PETITION TO STAY
: REEXAMINATION

This is a decision on the February 16, 2006 patent owner petition entitled "PETITION UNDER CFR 1.181 TO VACATE DECEMBER 12, 2005 ORDER GRANTING REEXAMINATION." reexamination proceeding. This is also a decision on the February 17, 2006 [1] patent owner request entitled "REQUEST FOR STAY OF REEXAMINATION UNDER 37 CFR 1.565(b) AND MPEP § 2286." Although captioned as a Request for Stay of Reexamination, the request to stay is being taken as a petition and will be referred to as a petition to stay the reexamination proceeding throughout this decision.

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

SUMMARY

A. The petition to vacate is dismissed for the reasons set forth below.

B. The petition to stay the reexamination proceeding is granted to the extent that there has been no action in the reexamination proceeding prior to the issuance of the instant decision, but is dismissed with respect to staying the 90/007,828 proceeding subsequent to the mailing date of this decision.

C. The December 12, 2005 order granting reexamination in the 90/007,828 proceeding remains intact.

[1] Although the Request for Stay states at page 2 that the Petition to Vacate was concurrently filed, the two papers were received by the Office one day apart.

REVIEW OF FACTS

1. U. S. Patent No. 6,410,516 (the '516 patent) issued on June 25, 2002.

2. The '516 patent is the subject of litigation that commenced on June 25, 2002, the same day the '516 patent issued.

3. A request for reexamination of the '516 patent was filed on April 4, 2005 by a third party requester and was assigned control number 90/007,503 (the '503 reexamination proceeding).

4 On June 8, 2005, reexamination was ordered for the '503 reexamination proceeding.

5. On August 8, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) to vacate the '503 proceeding on the grounds that the reexamination order was an *ultra vires* act on the part of the Office.

6. Also on August 8, 2005, the patent owner filed a request which was taken as a petition to stay the '503 reexamination proceeding until the authority of the Office to proceed with the reexamination was finally decided.

7. On October 6, 2005, both August 8, 2005 patent owner petitions were dismissed by the Office in a single combined Decision on Petition.

8. On November 25, 2005, patent owner filed a request for reconsideration directed solely to the issue of vacating the order for reexamination.

8. A final agency decision under 5 U.S.C. § 704 denying the requested relief to vacate the reexamination order in the '503 decision was mailed by the Office on February 8, 2006.

9. On December 2, 2005, a second request for reexamination of the '516 patent was filed by a different third party requester, and was assigned control number 90/007,828 (the '828 reexamination proceeding).

9. On December 12, 2005, reexamination was ordered for the '828 reexamination proceeding.

10. On February 16, 2006, patent owner filed the present petition to vacate the '828 proceeding on the grounds that the reexamination order was an *ultra vires* act on the part of the Office.

11. On February 17, 2006, patent owner filed the present petition, which is taken as a petition to stay the '828 proceeding.

12. A patent owner's statement under 37 CFR 1.530 has not been received in the either the '503 *ex parte* examination proceeding or the '828 *ex parte* reexamination proceeding.

13. There has been no further examiner's action in the '503 *ex parte* reexamination proceeding or in the '828 *ex parte* reexamination proceeding.

DECISION ON PETITION TO VACATE THE DECEMBER 12, 2005 ORDER GRANTING REEXAMINATION

35 U.S.C. 303 states, in part:

> "(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. ... The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

MPEP §2240 states, in part:

> "If a second or subsequent request for *ex parte* reexamination is filed (by any party) while a first *ex parte* reexamination is pending, the presence of a substantial new question of patentability depends on the prior art (patents and printed publications) cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different than that raised in the pending reexamination proceeding. If the prior art cited raises the same substantial new question of patentability as that raised in the pending reexamination proceedings, the second or subsequent request should be denied.

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(C) provides:

> Rejections may be made in reexamination proceedings based on intervening patents or printed publications where the patent claims under reexamination are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, under 35 U.S.C. 120, the effective date of these claims would be the filing date of the application which resulted in the patent. Intervening patents or printed publications are available as prior art under In re Ruscetta, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), and In re van Langenhoven, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11.

Review of Patent Owner's Argument for Vacatur

In the instant petition to vacate the reexamination order, the patent owner urges that the order for reexamination constitutes an *ultra vires* action because it was not based solely on prior art consisting of patents and printed publication.

Patent owner asserts that the examiner's order states that the best date to which the claims of the '516 are entitled is November 13, 1991, but has, nevertheless, based a finding that the request for reexamination raises several substantial new questions of patentability on documents that are not prior patents or publications because the dates for these documents are subsequent to November 13, 1991. [2]

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[2] Petition, pages 4-5, section IV.(1)(A).

Patent owner also asserts that the analysis supporting the examiner's conclusion that the claims of the '516 are limited to a date of November 13, 1991 was improper, because the examiner considered enablement and description issues to determine that the claims are entitled only to the November 13, 1991 date. Patent owner argues that enablement and description issues cannot be considered for original patent claims in a reexamination proceeding in order to establish certain documents as being prior patents or printed publications; patent owner cites MPEP § 2258(G)(II) as supporting this allegation. [3] Patent owner further argues that the examiner's analysis is not specific enough as because "the majority of the 203 patent claims, including those for which a SNQ was asserted to exist, are not even mentioned in the purported analysis on pages 4-6 of the December 12, 2005 Order." [4]

Patent owner also asserts that the examiner's order improperly relies on references that are not prior art (as to the November 13, 1991 date) in order to support a conclusion that certain references raise a substantial new question of patentability based upon inherent anticipation of the '516 claims. [5]

Analysis and Findings

1. A "New" Substantial New Question of Patentability Is Raised By The Request For Reexamination

As earlier noted, the '516 patent is the subject of the previously ordered '503 *ex parte* reexamination proceeding, which is still pending. Pursuant to MPEP § 2240, a second or subsequent request for *ex parte* reexamination that is filed during the pendency of first *ex parte* reexamination proceeding will be ordered only if the prior art relied upon in the latter filed request for reexamination raises a substantial new question of patentability that is different from the substantial new question of patentability raised in the pending *ex parte* reexamination proceeding. Therefore, as a threshold matter, it is necessary to ascertain whether there is at least one substantial new question of patentability raised in the '828 request that was not raised in the pending '503 proceeding.

A review of the examiner's Order Granting Request for *Ex Parte* Reexamination in the '828 *ex parte* reexamination proceeding shows that the examiner found at least one substantial new question of patentability that was not raised in the '503 proceeding. As one example, [6] the examiner's order finds that the December 2, 2005 request for reexamination established a substantial new question of patentability based upon six documents regarded by the examiner as being printed publications which are prior art with respect to the '516 patent. [7] None of these documents was relied upon in the '503 *ex parte* reexamination proceeding by the third party requester in order to establish a substantial new question of patentability. None of these documents formed the basis for a finding that a substantial new question of patentability was raised in that proceeding. Therefore, the examiner's order in the '828 *ex parte* reexamination proceeding raises a different substantial new question of patentability than those raised in the '828 *ex parte* reexamination proceeding, in compliance with the provisions set forth in MPEP § 2240.

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[3] Petition, page 6, section IV.(1)(B).
[4] Petition, footnote 5.
[5] Petition, pages7-9, section IV(2)
[6] A single substantial new question of patentability is all that is necessary to provide a basis for an order granting a request for reexamination. Therefore, no analysis has been made with respect to every substantial new question found by the examiner.
[7] Order Granting Request for *Ex Parte* Reexamination, pages 9-10.

2. Consideration Of A Benefit Claim In A Patent Being Reexamined (*Per Se*) Is Not Precluded By 35 U.S.C. §§ 301 And 302, And Does Not Render The December 12, 2005 Order Granting Reexamination An *Ultra Vires* Action

Patent owner's argument that the order granting reexamination is an *ultra vires* action because the examiner considered "enablement and description issues" to limit the '516 claims to the November 13, 1991 filing date of the '516 patent is grounded in the language of 35 U.S.C. §§ 301 and 302. Pursuant to these sections, the USPTO Director has authority to conduct *ex parte* reexamination proceedings of issued United States patents based upon "patents or printed publications." Patent owner argues that any determination based upon requester's argument that certain subject matter claimed in the '516 patent is not supported by the disclosure(s) of the parent application(s) for which 35 U.S.C. § 120 benefit is claimed in the '516 patent, violates the "patents or printed publications" requirement of 35 U.S.C. §§ 301 and 302. Patent owner concludes that because the examiner's order "purports to analyze whether the earlier applications from which the '516 patent claims benefit 'enable' and/or 'describe' the subject matter of the claims of the '516 patent," the order is an *ultra vires* action (by the Office) because the examiner's analysis "violates the Reexamination Statute and is statutorily unauthorized." [8]

Patent owner fails to cite any authority for this proposition, other than MPEP § 2258(G)(II). That section is entitled "Scope of *Ex Parte* Reexamination," and it discusses the examination phase of reexamination pursuant to 37 CFR 1.552 in which claims are examined for patentability. It is, however, the action of the examiner in finding a substantial new question of patentability that is relevant here, and not an action of the examiner in examining the claims of the '516 patent, that patent owner contests. Therefore, MPEP § 2217 is relevant here, and not MPEP § 2258(G)(II). It is to be noted that MPEP §2258(G) cites to MPEP § 2217, "Statement in the Request Applying Prior Art," which discusses the consideration of a substantial new question of patentability set forth in a request for *ex parte* reexamination. MPEP § 2217 contains broad language such as "[O]ther matters, such as ... U.S.C. 101, U.SC. 112, fraud, etc., will not be considered when making the determination on the request." However, this broad language is explained and limited by the inclusion of specific clarifying language, which states:

> "The statement applying the prior art may, where appropriate, point out that claims in the patent for which reexamination is requested are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, the effective date of some of the claims in a patent which resulted from a continuing application under 35 U.S.C. 120 could be the filing date of the continuing application since those claims were not supported in the parent application. Therefore, intervening patents or printed publications are available as prior art. See *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11."

Thus, although MPEP § 2217 broadly cautions against generally considering 35 U.S.C. 112 issues (*e.g.*, claim indefiniteness, enablement, description) in deciding a request for reexamination, MPEP § 2217 unequivocally states that a determination of the effective filing date for the original claims of a patent for which reexamination is requested **can be proper when considering a request for reexamination, in order to determine whether a given patent or printed publication is prior art to the patent claims**. A determination in accordance with the language of MPEP § 2217 is particularly appropriate where the patent for which reexamination is requested includes a 35 U.S.C. § 120 benefit claim in which one or more of the applications included in that benefit claim is a continuation-in-part (C-I-P) application with

[8] Petition, page 6, last paragraph.

respect to its parent application, and/or the patent for which the patent for which reexamination is requested is itself said to be a C-I-P of a parent application. The rationale with respect to this approach to the determination of a filing date for the claims of the patent that is the subject of a request for reexamination is that the analysis of the support in **a parent application** for the claims of a patent claiming 35 U.S.C. § 120 benefit as a C-I-P of that parent application is an analysis of the **parent application**, and **not a claim-support analysis of the specification of the patent for which reexamination has been requested**. Stated differently, where a patent for which reexamination is requested contains a 35 U.S.C. § 120 benefit claim and there is at least one C-I-P application in the benefit claim, the determination that the claims of that patent are not entitled to an effective date of one or more a parent applications is not a determination that the claims of that patent lack enablement or written description in that patent. Rather, it is simply a determination that the claims of that patent **are not enabled by, or not supported by, the written description of the parent application(s). The "defect" in support is not in the patent claiming 35 U.S.C. § 120, but rather in the parent application(s).**

It should be noted that, even with respect to the examination phase of reexamination conducted pursuant to 37 CFR 1.552, MPEP § 2258(C) clearly provides that it is can be proper to examine a 35 U.S.C. § 120 benefit claim in *ex parte* reexamination proceedings. Thus, MPEP §§ 2217 and 2258(C) are consistent. When a patent contains a 35 U.S.C. § 120 benefit claim, it can be proper to consider and determine the effective filing date for the claims of that patent when considering a request for *ex parte* reexamination of that patent, and equally proper to subsequently apply that determination when examining the patent (after it has been determined that the request for reexamination raised at least one substantial new question patentability). Patent owner's citation of MPEP § 2258(G)(II) does not establish otherwise.

Thus, where the Office "reexamines" the 35 U.S.C. § 112, first paragraph, support for the claims of a child patent, upon which to base the 35 U.S.C. § 120 benefit of the parent application, the Office may do so in order to establish an intervening reference (one with a date prior to the child patent date but after the parent date) as available against the child patent claims. This is permitted by the reexamination statute, to provide a substantial new question of patentability using the intervening reference (*i.e.*, this is an appropriate application of a patent or printed publication to the patent claims). The Office is only precluded from doing this support analysis where it was already carried out in the prosecution of the child patent.

Applying this statement of the law, two scenarios are presented:

> (1) In a proceeding to reexamine <u>a continuation or divisional patent</u>, the Office is generally precluded from reexamining the 35 U.S.C. § 112, first paragraph, claim support for the 35 U.S.C. § 120 benefit of the parent application, because there is a presumption (in absence of a strong showing to the contrary) that the Office already determined (in the examination of the child application that became the patent) that the child's claims were supported by the disclosure of the parent and the child is a proper continuation or divisional. If the child's claims were not supported by the disclosure of the parent, the Office would presumably have rejected those claims under 35 U.S.C. § 112, first paragraph. Since the Office has presumably already considered the issue and determined that any patent or publication not having a date prior to the effective filing date of the parent is unavailable against the child patent's claims, it may not reconsider the issue in a reexamination proceeding. Therefore, criticism of the specification of the parent application as not supporting the child patent claims would generally be precluded for the case of a continuation or divisional child patent.
>
> (2) On the other hand, in a proceeding to reexamine <u>a C-I-P patent</u>, the Office is not generally precluded from carrying out the 35 U.S.C. § 112, first paragraph, support analysis for the 35

> U.S.C. § 120 claim benefit of the parent application date. The finding that a child application is a proper C-I-P application of its parent does not imply that the examiner found sufficient written description and enablement *in the parent* to support the claims of the child patent, since the claims of the child C-I-P application can be supported by disclosure of the child that would be new matter in the parent. Thus, the Office is presumed to be permitted to make the "112" support analysis in a C-I-P scenario, unless there is actual evidence that the analysis was carried out in the child patent.

The present fact situation is a C-I-P scenario; thus, the issue is squarely whether there is evidence that the "112" support analysis was carried out in the prosecution of the child patent. In the present instance, no evidence has been presented by the petition, nor in the record as a whole, that the "112" support analysis upon which the order for reexamination is based was previously carried out in the prosecution of the child '516 patent. This will be discussed further below.

In the present instance the patent claims would need to be fully supported by the parent applications, of which the patent is a C-I-P. This support analysis has not been shown to have been carried out in the prosecution of the patent. The support consideration of whether any of the prior C-I-P applications (for which 35 U.S.C. § 120 benefit is claimed in the '516 patent) describes and enables the subject matter claimed in the '516 patent does not require an examination of **the specification of the '516 patent** to determine whether **the specification of the '516 patent** describes and enables the invention recited by the '516 claims (or claims prohibited "new matter"). The '516 patent claims may very well be fully supported (described and enabled) by the specification of the '516 patent, while those claims are not entitled to the effective date of the parent cases. On the current record, consideration of the effective filing date for the claims of the '516 patent only relates to the question of whether the benefit applications themselves describe and enable the '516 patent claims so as to entitle the '516 patent claims to an early effective filing date based upon the filing date of one or more of the benefit applications. Such consideration can in no way be construed as a reexamination of the sufficiency of the specification of the '516 patent in terms of compliance with 35 U.S.C. § 112, first paragraph, and § 132. The issue of whether a given publication or patent qualifies as prior art against the '516 patent is proper in this reexamination. This follows because a finding that the specification of a given parent C-I-P application does not describe and enable the invention claimed in the patent being reexamined in no way expressly or inherently compels a conclusion that the specification of the '516 patent is itself defective under 35 U.S.C § 112, first paragraph and/or defective under 35 U.S.C. § 132.

3. The Order Granting Request For Ex Parte Reexamination Properly Establishes At Least One Substantial New Question Of Patentability.

The record in this reexamination proceeding shows that the 35 U.S.C. § 120 benefit claim in the '516 patent recites seven different prior patent applications that are asserted as being C-I-P applications with respect to their immediate parent applications. A C-I-P application is an application filed during the lifetime of an earlier nonprovisional application, repeating some portion of, or all of, the earlier nonprovisional application and adding subject matter not disclosed in said earlier nonprovisional application. [9] The record further shows that, in the instant proceeding, the reexamination requester has cited publications which were not of record during the examination of the '516 patent, and has argued that the claims of the '516 patent are not entitled to an effective filing date based on the C-I-P parent applications. The requester's argument is based on requester's position that **those C-I-P application specifications do not support the claims of the '516 patent.**

A review of the Order Granting Request for *Ex Parte* Reexamination in the '828 *ex parte* reexamination proceeding shows that the examiner's analysis included a detailed listing of a number of limitations in '516 patent claims that are not considered by the examiner to be supported **by the** benefit-claim **applications** which were filed prior to November 13, 1991. [9] The examiner did not criticize the claims of the '516 patent on 35 U.S.C § 112 grounds as lacking enabling support or failing to be supported by the written description in the '516 patent specification. Instead, the examiner simply determined that, based upon analysis of the '516 patent claims, one or more of the limitations in the '516 patent claims lacks support by any 35 U.S.C. § 120 benefit-claim application in the '516 patent that has a filing date earlier than November 13, 1991. This was done in accordance with the practice described in MPEP § 2217, which in turn relies upon the practice described in MPEP § 201.11. The examiner then continued by explaining why one or more of the patents or printed publications having a date earlier than November 13, 1991, raised a substantial new question of patentability.

It is noted that with respect to the issue of limiting the '516 patent claims to a date of November 13, 1991, patent owner does not regard the examiner's order for reexamination as being complete because it does not mention all of the 203 patent claims at pages 4-6 of the order. However, a finding that a request for *ex parte* reexamination that raises a substantial new question of patentability for at least one patent claim will mandate the reexamination of all patent claims not otherwise having been held "invalid" by a final court, (*i.e.*, nonappealable) court decision. [10]

Patent owner's arguments with respect to the allegedly incomplete nature of the examiner's order granting reexamination (on the grounds that the order fails to include a discussion of the benefit claim analysis) are not persuasive. Initially, it is pointed out that MPEP § 2246 indicates that the examiner's order **should** include a discussion of the reasons why a particular patent or printed publication is considered to be prior art as to a given patent claim. It is noted that the examiner did, on pages 5 and 6 of the order for reexamination, specifically indicate that <u>no claims</u> of the '516 patent were supported by the 07/341,436 parent application, and specified, by way of example, certain instances in which certain of the claims of the '516 patent would not be supported by the "pre-November 1991" applications. On the other hand, patent owner has not indicated even a single claim that patent owner deems to be entitled to a filing date earlier than November 13, 1991. MPEP § 2246 does not command that the order for *ex parte* reexamination must include a discussion more complete than that provided by the examiner in the order granting reexamination in the '828 reexamination proceeding. In the absence of specific discussion, it is clearly implicit that the examiner relied upon the discussion the reexamination request.

In addition, petitioner's arguments directed at the completeness of the examiner's order and/or the accuracy of requester's analysis of the 35 U.S.C. § 120 benefit claim in the request are not directed to the question of whether the order granting reexamination is, or is not, *ultra vires*. Rather, an *ultra vires* question is a question of whether or not the reexamination order is based upon matters that are proper for raising a substantial new question (of patentability) in a reexamination proceeding, *i.e.*, a question of whether the Office had jurisdiction to reexamine such matters. [11] If the Office properly has jurisdiction, the fact that the basis for same was not

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[9] See pages 4 and 5 of the Order.

[10] 35 U.S.C. § 304(a); 37 CFR 1.525; MPEP § 2246

[11] Patlex Corporation v. Quigg, 680 F.Supp. 33, 37 (D.D.C. 1988)

completely detailed in the order does not establish that the Office's action in ordering reexamination was an *ultra vires* action.

The issue of the completeness and/or accuracy of the examiner's order, or of requester's request for reexamination on which the order was based, goes to the merits, (*i.e.*, accuracy), of the examiner's determination that a substantial new question of patentability was properly established by the request for reexamination, and not to the Office's jurisdiction to issue an order containing that determination. Unlike the issue of jurisdiction (*ultra vires* order), the issue of the completeness and/or correctness of the order is not petitionable. Rather, that issue is resolved during the examination and prosecution of the proceeding, including any appeal that may be appropriate.. See MPEP § 2246(1).

4. Additional Arguments Presented By Patent Owner Are Mooted By The Finding That At Least One Substantial New Question Of Patentability Was Properly Found By The Examiner

As noted at page 3, *supra*, patent owner also argues that even though the examiner held that the claims of the '516 patent were entitled only to a date of November 13, 1991, the examiner improperly applied documents that were dated subsequent to November 13, 1991 in order to find the existence of a substantial new question of patentability. Patent owner additionally argues that the examiner improperly applied documents that dated after November 13, 1991 to find that a substantial new question of patentability exists based upon "inherent anticipation."

These arguments will not be further discussed for several reasons. First, as pointed out in section 3, *supra*, the examiner has established at least one substantial new question of patentability that did rely upon documents dated subsequent to November 13, 1991, and also did not rely upon "inherent anticipation." Second, as also pointed out in section 3, *supra*, jurisdiction to reexamine the claims of a patent requires only that a substantial new question of patentability be found for at least one claim of that patent. As the examiner has determined that a substantial new question of patentability exists based upon an analysis permitted by the reexamination statutes and reliant upon facts found by the examiner, it is clear that the Order Granting Request for *Ex Parte* Reexamination dated December 12, 2005 does not constitute an *ultra vires* action. The examiner's order facially appears to be within the bounds of the reexamination statutes. Resolution of all questions regarding the accuracy of any rejection that may subsequently be made by the examiner during the examination of the '516 patent pursuant to 37 CFR 1.552, including questions based upon issues such as whether the examiner has properly determined the effective date of any particular claim of the '516 and whether the examiner has properly applied the doctrine of inherent anticipation (if a rejection on that ground is made) is properly the subject of appeal pursuant to pursuant to 35 U.S.C. § 306 and the regulations that implement the appeal rights conferred thereby.

It is not the function of the petition process to resolve the matter of applying the prior art. As pointed out in *Heinl v. Godici*, 143 F. Supp. 2d 593 (E.D. Va. 2001), "[c]ourts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both (a) the fact that the issue as to the status of the cited references as prior art based on an analysis of the effective date for the claims of the '516 patent has never been determined in the prior proceedings, and (b) the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

In conclusion:

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 December 5, 2005 reexamination request properly raised a substantial new question of patentability.

DECISION ON PATENT OWNER'S PETITION TO STAY REEXAMINATION

The patent owner petition to stay this reexamination proceeding was filed on February 17, 2006, one day after the filing of the petition to vacate the reexamination order of December 12, 2005. The patent owner has requested that the Office stay the instant reexamination proceeding until the authority of the Office to proceed with the reexamination is finally decided.

It is initially noted that no patent owner statement was filed in the '828 *ex parte* reexamination proceeding on or before the due date of February 12, 2006, [12] thereby bringing the proceeding up for the first *ex parte* examination on the merits of the claims *at that point in time.* [13] Nevertheless, the patent owner's petition to stay has been granted to the extent that action on the proceeding was delayed pending a consideration of the concurrently filed petition to vacate the reexamination order. At this point in time, however, the proceeding is ripe for action on the merits. A review of the petition to stay, and the record as a whole, fails to reveal any compelling legal or factual basis to support the grant of a further stay of the reexamination proceeding, when it has now been determined by the Office that jurisdiction to order reexamination was not lacking. In *Ethicon v. Quigg,* 849 F.2d 1422; (Fed. Cir. 1988), it was held that a stay of reexamination was not appropriate due to the existence of concurrent litigation involving the patent for which reexamination in the Office was sought. While the stay in the instant reexamination proceeding involves the alleged *ultra vires* nature of the reexamination request, much of the rationale of the *Ethicon* decision is applicable to the instant petition.

In *Ethicon,* the court gave considerable, indeed dispositive, weight to the language of 35 U.S.C. § 305 that requires *ex parte* reexamination proceedings in the Office to be conducted with special dispatch, notwithstanding the existence of concurrent court litigation. The court further noted that "litigation and reexamination are distinct proceedings, distinct purposes, procedures and

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[12] The Order Granting Request for *Ex Parte* Reexamination dated December 12, 2005, set a two month period in which a patent owner's statement pursuant to 37 CFR 1.530 could be filed.

[13] See 37 CFR 1.530 and 37 CFR 1.550; see also MPEP § 2254.

outcomes." *Id*, at 1154. In the instant reexamination proceeding, concurrent litigation exists with respect to the '516 patent, and, therefore, the benefits discussed in *Ethicon* at page 1157 with respect to conducting reexamination in the Office - even when the involved patent is in litigation - are present in the instant reexamination proceeding. Further, although patent owner states that the stay being sought is for a defined period time, [14] in fact the stay is being sought until there has been a final decision on the issue of whether the order granting reexamination was an *ultra vires* act. Final determination is stated by patent owner to include court review if necessary to decide the question, [15] and that in turn means that the stay requested amounts to a stay of the '828 *ex parte* reexamination proceeding for an indeterminate amount of time. This clearly runs counter to the statutory requirement for special dispatch.

Note is taken of the fact that in drafting the reexamination statute, it was Congress' intent that patent owners be protected from harassment. *Patlex Corporation* v. *Mossinghoff*, 771 F.2d 480 (Fed. Cir. 1985). However, patent owner nowhere offers a convincing rationale explaining why the filing of the request for reexamination in this instance, and its resolution, would constitute harassment of patent owner. Harassment is not established merely because the request for reexamination is a second request for *ex parte* reexamination of the '516 patent. Patent owner has also not shown that the filing of the request reexamination was an action taken with an intent to harass. Patent owner does not offer any evidence that the third party requester in the '828 reexamination proceeding is "improperly seeking reexamination." [16] Patent owner only relies upon the assumption that patent owner's position in its February 16, 2006 petition to vacate is correct. Yet, that is a matter to be settled via examination and the appeal process, not by petition. It is noted that patent owner does not offer any explanation of the conclusory statement that continuing with this reexamination would prejudice patent owner at trial. [17] Even if patent owner were correct that the request for *ex parte* reexamination filed on December 2, 2005 includes matters outside of the scope of reexamination, the court would nevertheless be in a position to examine such matters independently of any finding by the Office, and to thereafter accord these matters such effect as the court deems warranted.

Given the rationale discussed in *Ethicon* against staying a reexamination proceeding, and weighing the allegations of potential prejudice to patent owner in conducting the instant reexamination proceeding against the fact that any such stay would be for an indeterminate amount of time (so as to make the conducting of this proceeding with special dispatch problematic), this reexamination proceeding <u>will not be further stayed</u>.

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[14] Petition to Stay, page 4.
[15] Petition to Stay, page 3.
[16] Petition to Stay, page 2.
[17] Petition to Stay, page 4

CONCLUSION

1. The petition under 37 CFR 1.181 to vacate the reexamination order dated December 12, 2005 as being an *ultra vires* action on the part of the Office is dismissed.

2. The petition to stay the '828 *ex parte* reexamination proceeding pending a final determination on the question of whether the reexamination order is an *ultra vires* act has been granted only to the extent that no examination of the patentability of the claims was undertaken pending the issuance of this decision in the 37 CFR 1.181 petition to vacate, but is dismissed with respect to staying the proceedings subsequent to the mailing date of this decision.

3. The reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit for appropriate action, including consideration of whether to merge the '828 *ex parte* reexamination proceeding with the '503 *ex parte* reexamination proceeding.

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

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

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March 22, 2006

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REEXAM UNIT

Bawa Biotechnology Consulting LLP
21005 Starflower Way
Ashburn, VA 20147

(For Requester)

[Enclosure: Third Party Requester's Opposition and Concurrently Filed Submissions]

In re The President and Fellows of
Harvard University *et al*
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent No. 6,410,516 B1

: DECISION REFUSING
: CONSIDERATION OF, AND
: RETURNING OPPOSITION

This is a decision on the April 10, 2006 third party requester paper filed in reply to the patent owner petitions entitled "PETITION UNDER CFR 1.181 TO VACATE DECEMBER 12, 2005 ORDER GRANTING REEXAMINATION" and "REQUEST FOR STAY OF REEXAMINATION UNDER 37 CFR 1.565(b) AND MPEP § 2286" that were filed on February 16, 2006 and February 17, 2006, respectively. The third party requester reply is taken as an opposition to the patent owner's petitions.

The proceeding and the third party requester opposition are before the Office of Patent Legal Administration.

SUMMARY

A. The third party opposition to the patent owner's February 16, 2006 petition to vacate is refused consideration and is moot, because a decision dismissing patent owner's petition was mailed on March 27, 2006.

B. The third party opposition to the patent owner's February 17, 2006 petition to stay the reexamination proceeding is refused consideration and is moot because a decision dismissing patent owner's petition was mailed on March 27, 2006.

C. The third party opposition to the patent owner's petitions, and all papers filed concurrently therewith are being returned to the third party requester.

REVIEW OF FACTS

1. U. S. Patent No. 6,410,516 (the '516 patent) issued on June 25, 2002.

2. The '516 patent is the subject of litigation that commenced on June 25, 2002, the same day the '516 patent issued.

3. A request for reexamination of the '516 patent was filed on April 4, 2005 by a third party requester and was assigned control number 90/007,503 (the '503 reexamination proceeding).

4 On June 8, 2005, reexamination was ordered for the '503 reexamination proceeding.

5. On August 8, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) to vacate the '503 proceeding on the grounds that the reexamination order was an *ultra vires* act on the part of the Office.

6. Also on August 8, 2005, the patent owner filed a request which was taken as a petition to stay the '503 reexamination proceeding until the authority of the Office to proceed with the reexamination was finally decided.

7. On October 6, 2005, both August 8, 2005 patent owner petitions were dismissed by the Office in a single combined Decision on Petition.

8. On November 25, 2005, patent owner filed a request for reconsideration directed solely to the issue of vacating the order for reexamination.

9. A final agency decision under 5 U.S.C. § 704 denying the requested relief to vacate the reexamination order in the '503 decision was mailed by the Office on February 8, 2006.

10. On December 2, 2005, a second request for reexamination of the '516 patent was filed by a different third party requester, and was assigned control number 90/007,828 (the '828 reexamination proceeding).

11. On December 12, 2005, reexamination was ordered for the '828 reexamination proceeding.

12. On February 16, 2006, patent owner filed a petition to vacate the '828 proceeding on the grounds that the reexamination order was an *ultra vires* act on the part of the Office.

13. On February 17, 2006, patent owner filed a petition, which was taken as a petition to stay the '828 proceeding.

14. The February 16, 2006 and February 17, 2006 patent owner petitions were served on the third party requester on February 13, 2006.

15. On March 27, 2006, the patent owner petitions were dismissed in a single combined decision on petition, and jurisdiction over the proceeding was returned to the Central Reexamination Unit for appropriate action.

16. On the April 10, 2006, the third party requester filed a paper in reply to the patent owner petitions, and this paper is taken as an opposition to the patent owner petitions.

DECISION ON THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO VACATE THE DECEMBER 12, 2005 ORDER GRANTING REEXAMINATION

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;" ...
>
> "When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester ... may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C.§ 305, **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.** It is advisable that, upon receipt and review of the served copy of such a 37 CFR 1.181 petition which the third party requester intends to oppose, the requester should immediately place a courtesy telephone call to both the Central Reexamination Unit of the Office of Patent Legal Administration and the Special Program Examiner in the Technology Center in which the reexamination proceeding is pending to notify the Office that an opposition to the 37 CFR 1.181 petition will be filed. Whenever possible, filing of the opposition should be submitted by facsimile transmission." [Emphasis added]

The record shows that the patent owner's February 16, 2006 petition to vacate the December 12, 2006 order granting reexamination was served on the third party requester on February 13, 2006. The present third party requester reply (opposition to the petition) was not filed until April 10, 2006, almost two months after patent owner's petition to vacate was served on the third party requester. A decision on the merits of patent owner's petition was mailed on March 27, 2006, prior to the filing of requester'sreply. Accordingly, the requester's reply was not considered.

The record further shows that the patent owner's petition to vacate was dismissed. Accordingly, the present third party requester reply to patent owner's petition to vacate the '828 reexamination proceeding is in fact moot.

DECISION ON THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO STAY THE '828 REEXAMINATION PROCEEDING

The record shows that the patent owner's February 17, 2006 petition to stay the '828 reexamination was also served on the third party requester on February 13, 2006. The record further shows that the March 27, 2006 decision on petition dismissed the patent owner's request to stay the '828 reexamination proceeding. Therefore, the third party requester's opposition to the February 17, 2006 patent owner petition is also moot, and it too will not be considered on its merits.

DECISION RETURNING THIRD PARTY REQUESTER'S OPPOSITION AND CONCURRENTLY FILED PAPERS

A cursory perusal of the third party requester's reply in opposition to the February 16, 2006 and February 17, 2006 petitions shows that the reply contains allegations directed to matters that are

outside of the scope of subject matter that may be considered in *ex parte* reexamination proceedings. [1] It also appears that the opposition contains argument going to the merits of patentability, as opposed to the merits of the procedural relief requested in the patent owner petitions. [2] In addition, the third party requester has filed papers concurrently with the opposition that are also directed to matters outside of the scope of reexamination, including material submitted as part of a 37 CFR 1.501 Information Disclosure Citation that is facially not prior art by reason of its March 31, 2006 date. [3]

Inasmuch as the third party requester's reply papers are non-enterable for the reasons set forth above, they are being returned to third party requester as improper papers in accordance with 37 CFR 1.550(g).

CONCLUSION

1. The third party reply in opposition to the February 16, 2006 and February 17, 2006 patent owner petitions has not been considered.

2. The third party opposition to the patent owner's petitions, and all papers filed concurrently therewith are being returned to the third party requester. A copy of this decision will, however, be made of record in the proceeding.

3. The reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit for appropriate action, including consideration of whether to merge the '828 *ex parte* reexamination proceeding with the '503 *ex parte* reexamination proceeding.

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

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

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April 24, 2006

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[1] See MPEP §§ 2217 and 2258(H).
[2] In general, see MPEP §2267, Revision 3, August 2005 at page 220-108, and 37 CFR 1.550(g) cited therein.
[3] 37 CFR 1.501 is entitled "Citation of Prior Art in patent files." Third party requester has directed a 37 CFR 1.501 submission to this reexamination proceeding, and not to the patented file, and the only document cited therein is clearly not prior art.

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

John P. White
COOPER & DUNLAP LLP
1185 Avenue of the Americas
New York, New York 10036

(for Patent Owner)

Grantland G. Drutchas
MCDONNELL BOEHNEN HULBERT
& BERGHOFF LLP
300 S. Wacker Drive, Suite 3100
Chicago, IL 60606

(for Third Party Requester)

MAILED
MAY 0 4 2006
REEXAM UNIT

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516

Dr. Raj Bawa
BAWA BIOTECHNOLOGY CONSULTING LLP
21005 Starflower Way
Ashburn VA 20147

(for Third Party Requester)

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 6,410,516, issued June 25, 2002, is the subject of Reexamination Control Nos. 90/007,503 and 90/007,828.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,503, was filed April 4, 2005 by Grantland G. Drutchas of McDonnell Boehnen Hulbert & Berghoff LLP in Chicago, IL 60606. The request urged that a substantial new question of patentability was raised by the newly cited references which either inherently or expressly disclose the use of a variety of prior art compounds as reducing NF-κB activity and resulting gene expression.

3. Reexamination was ordered for 90/007,503 on April 4, 2005.

4. A second request for re-examination, assigned Reexamination Control No. 90,007,828, was filed December 2, 2005 by Dr. Raj Bawa of Bawa Biotechnology Consulting LLP in Ashburn VA 20147. The request urged that a substantial new question of patentability was raised by the newly cited references which are directed to the use of oligonucleotides having a NF-κB binding cite for reduction of NF-κB activity.

5. Reexamination was ordered for 90/007,828 on December 2, 2005.

6. No Office action has been issued in either reexamination.

7. A petition was filed on April 4, 2006 by Patent Owner to merge the above-identified re-examination proceedings 90/007,503 and 90/007,828.

DISCUSSION

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

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

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.5659 (c) is appropriate. MPEP 2283 further sets forth:

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,503 and 90/007,828 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,503 and 90/007,828 as:

John P. White
COOPER & DUNLAP LLP
1185 Avenue of the Americas
New York, New York 10036

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,503 as:

Grantland G. Drutchas
MCDONNELL BOEHNEN HULBERT
& BERGHOFF LLP
300 S. Wacker Drive, Suite 3100
Chicago, IL 60606

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,828 as:

Dr. Raj Bawa
BAWA BIOTECHNOLOGY CONSULTING LLP
21005 Starflower Way
Ashburn VA 20147

CONCLUSION

Reexamination Control Nos. 90/007,503 and 90/007,828 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course

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

Deborah Jones
for Lissi M. Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,828	12/02/2005	6410516		4525

23432 7590 08/15/2006

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/15/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

8/16/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BAWA BIOTECHNOLOGY CONSULTING LLP

21005 STARFLOWER WAY

ASHBURN, VA 20147

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007828

PATENT NO. 6,410,516

ART UNI 3991

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Cooper & Dunham, LLP
1185 Avenue of the Americas
New York, NY 10036

(For Patent Owner)

MAILED

AUG 16 2006

Grantland G. Drutchas
McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive
Suite 3100
Chicago, IL 60606

(For Requester)

CENTRAL REEXAMINATION UNIT

Bawa Biotechnology Consulting LLP
21005 Starflower Way
Ashburn, VA 20147

(For Requester)

In re The President and Fellows of
Harvard University *et al*
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent No. 6,410,516 B1

In re The President and Fellows of
Harvard University *et al*
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent No. 6,410,516 B1

: DECISION ON REQUEST
: FOR RECONSIDERATION
: OF DECISION DISMISSING
: PETITION TO VACATE ORDER
: GRANTING REEXAMINATION

This is a decision on the June 13, 2006 patent owner petition entitled "REQUEST FOR RECONSIDERATION OF MARCH 27, 2006 DECISION DISMISSING PATENTEES' PETITION." [1] The petition was filed in the 90/0007,828 reexamination proceeding. [2]

The patent owner's request for reconsideration is before the Office of Patent Legal Administration.

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[1] The March 27, 2006 Decision treated the patent owner petition filed on February 16, 2006 requesting vacatur of *ex parte* reexamination proceeding 90/007,828 and the February 17, 2006 patent owner petition requesting stay of *ex parte* reexamination proceeding 90/007,828. It appears that present patent owner request for reconsideration is confined to requesting reconsideration of the refusal to grant vacatur, and is not addressed to the Office's refusal to stay the proceeding beyond March 27, 2006.

[2] A decision merging reexam *ex parte* reexamination proceeding control number 90/007,503 and *ex parte* reexamination proceeding control number 90/007,828 was mailed on May 4, 2006, and this decision is captioned accordingly.

SUMMARY

A. The request for reconsideration is dismissed for the reasons set forth below.

B. The December 12, 2005 order granting reexamination in the 90/007,828 proceeding remains intact. Therefore, the merger of the 90/007,828 and 90/007,503 proceedings remains intact.

REVIEW OF FACTS

1. U. S. Patent No. 6,410,516 (the '516 patent) issued on June 25, 2002.

2. The '516 patent is the subject of litigation that commenced on June 25, 2002, the same day that the '516 patent issued.

3. A request for reexamination of the '516 patent was filed on April 4, 2005 by a first third party requester and was assigned control number 90/007,503 (the '503 reexamination proceeding).

4 On June 8, 2005, reexamination was ordered for the '503 reexamination proceeding.

5. On August 8, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) to vacate the '503 proceeding on the grounds that the '503 reexamination order was an *ultra vires* act on the part of the Office.

6. Also on August 8, 2005, the patent owner filed a request which was taken as a petition to stay the '503 reexamination proceeding until the authority of the Office to proceed with the '503 reexamination was finally decided.

7. On October 6, 2005, both August 8, 2005 patent owner petitions were dismissed by the Office in a single combined decision on petition.

8. On November 25, 2005, patent owner filed a request for reconsideration directed solely to the issue of vacating the '503 order for reexamination.

8. On February 8, 2006, the Office denied the requested relief to vacate the reexamination order in the '503 reexamination proceeding.

9. On December 2, 2005, a second request for reexamination of the '516 patent was filed by a second third party requester, and was assigned control number 90/007,828 (the '828 reexamination proceeding).

9. On December 12, 2005, reexamination was ordered for the '828 reexamination proceeding.

10. On February 16, 2006, patent owner filed a petition to vacate the '828 reexamination proceeding on the grounds that the '828 reexamination order was an *ultra vires* act on the part of the Office.

11. On February 17, 2006, patent owner filed a paper, which was taken as a petition to stay the '828 proceeding.

12. On March 27, 2006, the Office, in a single combined decision, dismissed the patent owner petitions to vacate the '828 reexamination proceeding and to stay the '828 reexamination proceeding.

13. On April 4, 2006, patent owner filed a petition to merge the '503 and '828 reexamination proceedings. The Office mailed a decision merging the '503 and '828 reexamination proceedings on May 5, 2006.

14. On June 13, 2006, the present patent owner request for reconsideration of the March 27, 2006 decision was filed. The request for reconsideration included a 37 CFR 1.8 certificate of mailing dated June 8, 2006, as well as a 37 CFR 1.550(f) certificate of service on both third party requesters, also dated June 8, 2006. [3]

15. A patent owner's statement under 37 CFR 1.530 has not been received in the either the '503 *ex parte* examination proceeding or the '828 *ex parte* reexamination proceeding.

16. An initial Office action on the merits of patentability of the claims was mailed in the merged reexamination proceeding on August 2, 2006.

DECISION ON REQUEST FOR RECONSIDERATION

37 CFR 1.8(a) provides in pertinent part:

> "Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.
> (1) Correspondence will be considered as being timely filed if:
> (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
> (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or
> (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with §1.6(d); and
> (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated."

37 CFR 1.181(f) provides:

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

---

[3] A copy of the request for reconsideration was received for the '828 reexamination proceeding, but was not received for '503 reexamination proceeding. As these proceedings have been merged, a copy of the present request for reexamination has been placed in the Image File Wrapper (IFW). All future patent owner papers are to be filed in duplicate, with a copy directed to each reexamination file, and are to further comply with the requirements set forth in the Decision Merging Reexamination Proceedings dated May 5, 2006.

MPEP § 2246, Part I, states, in part:

> "A petition under 37 CFR 1.181 may... be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> "(A) the reexamination order is not based wholly on prior art patents or printed publications;"

Preliminary Matter

The present patent owner request for reconsideration does not request reconsideration of the Office's holding in the March 27, 2006 Decision that the February 17, 2006 petition for a stay was dismissed.

Analysis and Finding

Inspection of the record reveals as follows. The patent owner has requested reconsideration of the Office's March 27, 2006 Decision dismissing the February 16, 2006 patent owner petition to vacate; yet, the request for reconsideration was not filed until June 13, 2006. The request for reconsideration included a 37 CFR 1.8 certificate of mailing that was dated June 8, 2006.

As provided by MPEP § 2246 Part I, a patent owner petition to vacate a decision granting reexamination is a petition under 37 CFR 1.181 for the exercise of supervisory authority. 37 CFR 1.181(f) establishes a two month period for filing a petition under Part 1 of Title 37 of the Code of Federal Regulations. It is noted that the present request for reconsideration was filed on June 13, 2006, more than two months subsequent to the March 27, 2006 decision dismissing patent owner's February 16, 2006 petition. The certificate of mailing date of June 8, 2006 provided for the request for reconsideration is also more than two months subsequent to the March 27, 2006 decision date. Accordingly, the request for reconsideration was not timely filed, and is, therefore, dismissed without consideration of its merits.

CONCLUSION

1. Patent owner's request for reconsideration is dismissed, as not being timely filed.

2. The reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit to await the filing of a patent owner response to the August 2, 2006 initial Office action on the patentability of the '516 patent claims.

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

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

sm
August 8, 2006

8-11-06
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UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 29 2006

CENTRAL REEXAMINATION UNIT

Gary J. Gershik
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036

(for Patent Owner)

Grantland G. Drutchas
Mcdonnell Boehren Hulbert & Berghoff
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Suite 3100
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(for Requester)

Bawa Biotechnology Consulting LLP
21005 Starflower Way
Ashburn, VA 20147

(for Requester)

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516 B1

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516 B1

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

This is a decision on the petition filed September 7, 2006 to request one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated May 11, 2006.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated August 2, 2006 which set a two-month date for filing a response thereto. The Office action is a final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.
>
> Addressing the requirement of 37 CFR 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:
>
> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The Office action was mailed on August 2, 2006. Since receiving the Office action, Patentees, counsel, and a technical expert have been studying the grounds of rejection of 160 claims of the patent on multiple grounds, based on 53 different references and a declaration. The number and complexity of issues presented in the Office action is substantial. An interview with the examiner has been scheduled for September 26, 2006; however, it is anticipated that consultation with the technical expert, the inventors, the licensee, and counsel after the interview will be necessary before finalizing and filing a response. The current deadline of October 2, 2006 is insufficient to provide patentees with time to consult with the technical expert about the issues discussed in the interview and to prepare the declaration. Further, coordinating with a technical expert in California, co-owners in Massachusetts, thirteen inventors, and counsel involved in litigation in both Massachusetts and Delaware regarding the 281-page Office action and 53 references will take additional time. Lastly, the sheer length and complexity of the Office action warrants granting this petition. The material incorporated by reference into the Office action totals 218 pages. An extension of time for one (1) month is requested to provide a fair opportunity for response.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. The office action is extensive and it is clear that the patent owner has been diligent in reviewing the file and preparing a response. The request has been made in anticipation of the additional time needed to consult with experts, conduct a personal interview with the examiner and prepare a coordinated response. In the interest of providing the patent owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for one (1) month is granted.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated August 2, 2006 is **granted**.

2. The Patent Owner's response is due November 2, 2006.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

for Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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NOV 17 2006

CENTRAL REEXAMINATION UNIT

Gary J. Gershik
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1185 Avenue of the Americas
New York, New York 10036 (for Patent Owner)

Grantland G. Drutchas
Mcdonnell Boehren Hulbert & Berghoff
300 S. Wacker Drive
Suite 3100
Chicago, IL 60606 (for Requester)

Bawa Biotechnology Consulting LLP
21005 Starflower Way
Ashburn, VA 20147 (for Requester)

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516 B1

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516 B1

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

This is a decision on the petition filed October 31, 2006 to request a one-week extension of time pursuant to 37 CFR 1.550 in addition to the extension of time granted September 29, 2006 for responding to the Office action dated August 2, 2006.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in addition to the extension of time for one month granted September 29, 2006 in which to file a response to the Office action dated August 2, 2006 which set a two-month date for filing a response thereto. The Office action is a final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.
>
> Addressing the requirement of 37 CFR 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:
>
> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The Office action was mailed on August 2, 2006. Since receiving the Office action, Patentees, counsel, and a technical expert have been studying the grounds of rejection of 160 claims of the patent on multiple grounds, based on 53 different references and a declaration. The number and complexity of issues presented in the Office action is substantial. An interview with the examiner was held October 13, 2006 and, as was anticipated, consultation with the technical expert, the inventors, the licensee, and counsel after the interview was necessary before finalizing and filing a response. The final document is substantial and includes a declaration which is over 70 pages long not counting numerous supporting documents. An extension of time for one (1) week is requested to provide all parties with a fair opportunity to review the final document.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. The office action was extensive and it is clear that the patent owner has been diligent in reviewing the file and preparing a response. The request has been made in anticipation of the additional time needed to provide an opportunity for all parties to review the final document. In the interest of providing the patent owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for one (1) week is granted. Patent Owner is advised that subsequent requests for extensions of time will be granted only in extraordinary situations.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated August 2, 2006 is **granted**.

2. The Patent Owner's response is due November 9, 2006.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

for Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,828	12/02/2005	6410516		4525

23432 7590 10/05/2007

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

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
Alexandria, VA 22313-1450
www.uspto.gov

10/5/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Grantland G. Drutchas

McDonnell Boehnen Hulbert & Berghoff

300 S. Wacker Drive, Suite 3100

Chicago, IL 60606

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007503

PATENT NO. 6,410,516

ART UNI 3991

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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OCT 05 2007

CENTRAL REEXAMINATION UNIT

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Grantland G. Drutchas
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21005 Starflower Way
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In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516 B1

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516 B1

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

This is a decision on the petition filed October 2, 2007 to request a two-week extension of time pursuant to 37 CFR 1.550(c) for responding to the Office action dated July 6, 2007.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an additional extension of time for two weeks in which to file a response to the Office action dated July 6, 2007 which set a two-month date for filing a response thereto. The Office action is a Final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.
>
> Addressing the requirement of 37 CFR 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:
>
> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The Final Office action was mailed on July 6, 2007. Since receiving the Office action, Patentees, counsel, and a technical expert have been studying the grounds of rejection of 150 claims of the patent on multiple grounds, based on 37 different references and a declaration. The number and complexity of issues presented in the Office action is substantial. An interview with the examiner was held on August 22, 2007 and, as was anticipated, consultation with the technical expert, the inventors, the licensee, and counsel after the interview was necessary before finalizing and filing a response. The final document is substantial. An extension of time for one (1) month was requested on August 24, 2007 and granted. An additional two weeks is requested to provide all parties with a fair opportunity to review the final documents.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. The office action was extensive and it is clear that the patent owner has been diligent in reviewing the file and preparing a response. The request has been made in anticipation of the additional time needed to provide an opportunity for all parties to review the final document. In the interest of providing the patent owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for two weeks is granted. Patent Owner is advised that subsequent requests for extensions of time will be granted only in extraordinary situations.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated July 6, 2007 is **granted**.

2. The Patent Owner's response is due October 20, 2007.

3. Response may be submitted as follows:

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

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

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

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

Deborah Jones

for Lissi M. Marquis,
Director,
Central Reexamination Unit

COOPER & DUNHAM LLP
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www.cooperdunham.com

*NEW YORK STATE BAR ADMISSION PENDING

FACSIMILE TRANSMISSION

PLEASE DELIVER THE FOLLOWING PAGES

TO : Deborah Jones, SPRE

COMPANY/FIRM : U.S. PATENT AND TRADEMARK OFFICE

FACSIMILE NO.: 571-273-1535

FROM : John P. White/Gary J. Gershik

TOTAL NUMBER OF PAGES, INCLUDING COVER PAGE: 6

DATE : October 2, 2007 TIME: _____

CLIENT/DOCKET: 0207/74753 and 0207/75848

IF YOU DO NOT RECEIVE ALL THE PAGES, PLEASE CALL BACK AS SOON AS POSSIBLE TO (212) 278-0400.

MESSAGE: **Please Deliver to Deborah Jones**

Merged Reexam: 90/007,503 and 90/007,828

Transmitted is a courtesy copy of: Petition For Extension Of Time Under 37 C.F.R. §1.550(c) For Responding To July 6, 2007 Final Office Action. Please review as soon as possible.

==========
THE INFORMATION CONTAINED IN THIS FACSIMILE TRANSMISSION IS INTENDED SOLELY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE DESIGNATED RECIPIENT(S) NAMED ABOVE. THIS TRANSMISSION MAY BE AN ATTORNEY-CLIENT COMMUNICATION CONTAINING INFORMATION THAT IS PRIVILEGED AND CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT A DESIGNATED RECIPIENT OR AN AGENT RESPONSIBLE FOR DELIVERING IT TO A DESIGNATED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT YOU HAVE RECEIVED THIS DOCUMENT IN ERROR, AND THAT ANY REVIEW, DISTRIBUTION, OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, OR IF UPON READING THIS DOCUMENT YOU HAVE REASON TO BELIEVE THAT THE DOCUMENT WAS INADVERTENTLY SENT TO YOU, PLEASE NOTIFY US IMMEDIATELY BY COLLECT TELEPHONE CALL AND RETURN THE ORIGINAL MESSAGE TO US BY MAIL. THANK YOU.

--URGENT ACTION REQUESTED--
Ex Parte REEXAMINATION

Docket No. 74753/JPW/GJG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

A Merged Proceeding of *Ex Parte* Reexamination Control Nos:

90/007,503 and 90/007,828
Filed April 4, 2005 Filed December 2, 2005

Merged Pursuant to May 4, 2006 Merger Decision
Group Art Unit: 3991 Examiner: B.M. Celsa

Patentees: David Baltimore, Ranjan Sen, Phillip A. Sharp, Harinder Singh, Louis Staudt, Jonathan H. Lebowitz, Albert S. Baldwin Jr., Roger G. Clerc, Lynn M. Corcoran, Patrick A. Baeuerle, Michael J. Lenardo, Chen-Ming Fan, and Thomas P. Maniatis

Patent No.: 6,410,516 B1 Serial No: 08/464,364

Issue Date: June 25, 2002 Filed: June 5, 1995

For : NUCLEAR FACTORS ASSOCIATED WITH TRANSCRIPTIONAL REGULATION

1185 Avenue of the Americas
New York, New York 10036
October 1, 2007

BY FACSIMILE 571-273-9900
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn. Director, Central Reexamination Unit

PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.550(c)
FOR RESPONDING TO JULY 6, 2007 FINAL OFFICE ACTION

A Final Office Action issued July 6, 2007 in connection with the above-identified merged *ex parte* reexamination. The July 6, 2007 Final Office Action set a two (2) month period for filing a response, i.e. by due September 6, 2007. On August 27, 2007 Patentees submitted a petition, and the U.S. Patent Office granted Patentees' petition, for a one (1) month extension of time such that a response to the July 6, 2007 Final Office Action

is now due October 6, 2007. Patentees hereby petition for a two (2) week extension of time so that a response to the July 6, 2007 Final Office Action will be due October 20, 2007. Patentees hereby authorize the Commissioner to charge the $200.00 fee under 37 C.F.R. § 1.17(g) for filing this Petition to Deposit Account No. 03-3125.

Reasons for Granting Petition

Extensions of time in an *ex parte* reexamination are governed by 37 C.F.R. § 1.550(c), which provides, in relevant part:

> (c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g).

Section 2265 of the M.P.E.P. provides that:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch.

Patentees respectfully submit that sufficient cause exists in the instant case for extending the deadline for responding to the July 6, 2007 Final Office Action by two weeks, i.e. until October 20, 2007.

The number and complexity of issues presented in the July 6, 2007 Final Office Action (which consists of 119 pages) is substantial. Since receiving the July 6, 2007 Final Office Action Patentees, their attorneys and their technical expert have been diligently studying the multiple grounds of rejection of claims of the

patent set forth. Multiple meetings and conferences, both by telephone and in person, have taken place to review and discuss the July 6, 2007 Final Office Action. Patentees have spent more than 60 hours consulting with their technical expert, Professor Inder Verma of the Salk Institute in San Diego, California. Patentees' have also interviewed the Examiner on August 22, 2007. However, Patentees' attorneys still need time to:

1) Finalize an expert Declaration, the finalization of which is complicated by Dr. Verma's absence from the United States between September 28, 2007 and October 13, 2007. During this period of time, Dr. Verma will be fulfilling prior obligations to give a lecture at the EFS Stem Cell Workshop in Milan, Italy and to serve as a Kennedy Visiting Professor at the Kennedy Institute of Rheumatology in London, England.

2) Allow a) the exclusive licensee located in Cambridge, Massachusetts, b) the three co-owners of the Patent, also located in Cambridge, Massachusetts, c) trial counsel involved in litigation in Massachusetts, and d) trial counsel involved in litigation in Delaware, to review and comment on a lengthy expert Declaration and a lengthy response to the July 6, 2007 Final Office Action.

In view of the preceding, there is sufficient cause to extend the period for reply by <u>two (2) weeks</u> to provide Patentees a fair opportunity to finalize an expert declaration by Dr. Verma and their response to the lengthy and complex attack on their patent set forth in the July 6, 2007 Final Office Action. Accordingly, Patentees respectfully submit that a <u>two week</u> extension of time should be granted.

Pursuant to the May 4, 2006 Merger Decision, this Petition is being filed in duplicate, each original bearing an original signature and identifying data for both reexamination files. As set forth above, the undersigned authorizes the Commissioner to charge any fee required in connection with the filing of this Petition to Deposit Account No. 03-3125.

Respectfully submitted,

John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Patent Owners
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.550(c) FOR RESPONDING TO THE JULY 6, 2007 FINAL OFFICE ACTION** and any enclosure has been sent to:

McDonnell Boehnen Hulbert & Berghoff, 300 South Wacker Drive, Suite 3200, Chicago, Illinois 60606, Attn: Grantland G. Drutchas, Esq.,

and

Bawa Biotechnology Consulting, LLC, 21005 Starflower Way, Ashburn, VA 20147, Attn: Dr. Raj Bawa,

each by U.S. Postal Service, first class mail service, with sufficient postage, on this 1st day of October, 2007.

Gary J. Gershik

Gary J. Gershik

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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OCT 26 2007

CENTRAL REEXAMINATION UNIT

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1185 Avenue of the Americas
New York, New York 10036

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Bawa Biotechnology Consulting LLP
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Ashburn, VA 20147

(For Third Party Requester)

In re Baltimore et al.
Merged Reexamination Proceedings
Control No.: 90/007,503 and 90/007,828
Filed: April 4, 2005 and December 2, 2005
For: U.S. Patent 6,410,516 B1

: **DECISION ON PETITION**
: **TO CONTINUE**
: ***EX PARTE***
: **REEXAMINATION**
: **PROCEEDINGS**

This is a decision on the October 22, 2007 patent owner Petition Under 37 CFR 1.182 and Request for Continued Reexamination.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. 03-3125, pursuant to petitioner's instructions.

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

REVIEW OF FACTS

1) U.S. Patent No. 6,410,516 B1 (the '516 patent) issued on June 25, 2002.

2) A first request for *ex parte* reexamination of the '516 patent was filed by a first third party requester on April 4, 2005, and assigned control number 90/007,503 (the '503 proceeding).

3) An Order granting reexamination in the '503 proceeding was mailed on June 8, 2005.

4) A second request for *ex parte* reexamination of the '516 patent was filed by a second third party requester on December 2, 2005, and assigned control number 90/007,828 (the '828 proceeding.)

5) An Order granting reexamination in the '828 proceeding was mailed on December 12, 2005.

6) A decision merging the '503 and '828 proceedings was issued May 4, 2006.

7) The '516 patent is the subject of two court proceedings: (i) *Ariad Pharmaceuticals, Inc. et al. v. Eli Lilly & Co.*, Civil Action No. 02-11280-RWZ in the U.S. District Court, District of Massachusetts (the Eli Lilly litigation); and, (ii) *Amgen Inc. et al. v. Ariad Pharmaceuticals, Inc.*, Civil Action No. 06-CV-00259-KAJ in the U.S. District Court for the District of Delaware (the Amgen litigation.)

8) On June 9, 2006, patent owner filed a complaint in U.S. District Court in the Eastern District of Virginia (the Eastern District court) against the Office, requesting that defendant be enjoined and constrained from continuing with the merged reexamination '503 and '828 proceedings.

9) A non-final Office action was mailed in the merged '503 and '828 proceedings on August 2, 2006, rejecting claims on various prior art grounds.

10) On October 3, 2006, the Eastern District court granted a motion by defendant to dismiss the complaint filed by patent owner on June 9, 2006, because the court found that Plaintiffs suffered no harm or imminent harm from the Office's decisions to reexamine the '516 patent and that the plaintiff did not have standing to bring suit.

11) An examiner interview was conducted with patent owner on October 13, 2006.

12) Patent owner then responded to the non-final Office action on November 17, 2006, with an amendment cancelling claims, and presenting arguments in response to the rejections of record, as well as multiple exhibits.

13) The decision of the Eastern District court was appealed to the Court of Appeals of the Federal Circuit, which dismissed the court proceeding on November 22, 2006.

14) On July 6, 2007, a final rejection was mailed in the merged '503 and '828 proceeding. The final rejection vacated some of the prior art rejections, repeated most of the remaining prior art rejections, and changed several rejections based on newly added prior art. In particular, at least the rejections issued under the headings GLUCOCORTICOIDS and ANTIBIOTICS were newly added by the

examiner.

15) A petition to withdraw the finality of the July 6, 2007 Office action was filed on July 25, 2007. The petition is awaiting decision.

16) An Information Disclosure Statement (the fifth in the case) was filed after the final rejection listing materials from the concurrent Amgen litigation.

17) A second personal examiner interview was conducted on August 22, 2007.

18) A further Information Disclosure Statement was filed after the interview, listing additional materials from the concurrent Amgen litigation.

19) Patent owner filed a petition requesting an extension of time on August 27, 2007, which was granted October 5, 2007, thereby extending the period for response to October 20, 2007.

20) On October 22, 2007,[1] patent owner filed the present petition requesting continued re-examination, pointing out numerous grounds of rejection appearing in the final Office action for the first time. Patent owner asserts that a concurrently filed response addresses the new rejections and reduces the issues in the merged proceedings by cancelling more than 90 claims, adding new claims to clearly distinguish over all of applied prior art, and addressing the new rejections and newly applied prior art references. A second declaration is also concurrently submitted to address issues raised for the first time in the final Office action.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the October 22, 2007 response. [2]

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[3] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution

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[1] The petition is timely, as it was filed on a Monday, while October 20, 2007 was a Saturday. It is to be noted that in this case, the petition is being granted; thus, pendency is continued. **However,** if the petition were dismissed, the prosecution of the present proceeding would have been terminated.

[2] Item 20 in the Review of Facts.

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

on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

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

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

In this instance, the patent owner was not aware of the newly entered grounds for rejection and newly cited prior art applied, for the first time in the final Office action, and therefore, was unable to address the new rejections or comprehend the new issues prior to the final Office action. Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's presentation of an amendment and further evidence directed to the determination of patentability are deemed a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate; and, as such, the granting of the present petition is consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the fifth and sixth Information Disclosure Statement submissions, the October 22, 2007 Amendment and the newly submitted declaration. These papers will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the Amendment After Final, and all papers

submitted in conjunction therewith. The Examiner will then issue an Office action treating these papers as patent owner responses received **after** a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present merged '7503 and '7828 *ex parte* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances.

3) The closing of prosecution rendered via the July 6, 2007, final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The October 22, 2007 response will be entered [4] by the Central Examination Unit, and will then be considered by the examiner. These papers will be treated as a response by patent owner received **after** a first Office action.

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

6) Telephone inquiries related to this decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

October 24, 2007
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[4] This decision takes no position on the propriety of the amendment, or whether it introduces new matter. Any issues raised by the amendment will be addressed by the examiner in the next Office action.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,828	12/02/2005	6410516		4525

23432 7590 12/27/2007

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/27/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 12/27/2007

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/27/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

John P. White (For Patent Owner)
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036

MAILED

DEC 27 2007

CENTRAL REEXAMINATION UNIT

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McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive
Suite 3200
Chicago, IL 60606

Bawa Biotechnology Consulting LLP (For Third Party)
21005 Starflower Way
Ashburn, VA 20147

In re Baltimore et al.	:	
Merged Reexamination Proceeding	:	**DECISION**
Control Nos. 90/007,503 and 90/007,828	:	**ON**
Filed: April 4, 2005 and December 2, 2005	:	**PETITION**
For: U.S. Patent 6,410,516 B1	:	

This is a decision on the petition of July 25, 2007 by Patent Owner entitled, "Petition under 37 C.F.R. §1.181 to Withdraw the Finality of the July 6, 2007 Final Office Action."

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

The petition fee of $400.00 set forth in 37 CFR §1.17(f) for the present petition under 37 CFR §1.181 has been charged to Deposit account No. 3-3125, pursuant to petitioner's instructions.

SUMMARY

For the reasons set forth below, the petition under 37 CFR §1.181 is **DISMISSED**.

REVIEW OF THE FACTS

1) U.S. Patent No. 6,410,516 B1 (the '516 patent) issued on June 25, 2002.

2) A first request for ex parte reexamination of the '516 patent was filed by a first third party requester on April 4, 2005, and assigned control number 90/007,503 (the '503 proceeding).

3) An Order granting reexamination in the '503 proceeding was mailed on June 8, 2005.

4) A second request for ex parte reexamination of the '516 patent was filed by a second third party requester on December 2, 2005, and assigned control number 90/007,828 (the '828 proceeding).

5) An Order granting reexamination in the '828 proceeding was mailed on December 12, 2005.

6) A decision merging the '503 and '828 proceedings was issued May 4, 2006.

7) The '516 patent is the subject of two court proceedings: (i) *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, Civil Action No. 02-11280-RWZ in the U.S. District Court, District of Massachusetts (the Eli Lilly litigation); and , (ii) *Amgen Inc. et al. v. Ariad Pharmaceuticals, Inc.*, Civil Action No. 06-CV-00259-KAJ in the U.S. District Court for the District of Delaware (the Amgen litigation).

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9) A non-final Office action was mailed in the merged '503 and '828 proceedings on August 2, 2006, rejecting claims on various prior art grounds.

10) On October 3, 2006, the Eastern District Court granted a motion by defendant to dismiss the complaint filed by Patent Owner on June 9, 2006, because the court found that Plaintiffs suffered no harm or imminent harm from the Office's decisions to reexamine the '516 patent and that the plaintiff did not have standing to bring suit.

11) An examiner interview was conducted with Patent Owner on October 13, 2006.

12) Patent Owner then responded to the non-final Office action on November 17, 2006, with an amendment cancelling claims, and presenting arguments in response to the rejections of record, as well as multiple exhibits.

13) The decision of the Eastern District court was appealed to the Court of Appeals of the Federal Circuit, which dismissed the court proceeding on November 22, 2006.

14) On July 6, 2007, a final rejection was mailed in the merged '503 and '828 proceeding. The final rejection vacated some of the prior art rejections, repeated most of the remaining prior art rejections, and changed several rejections based on newly added prior art. In particular, at least the rejections issued under the headings, "GLUCOCORTICOIDS AND ANTIBIOTICS" were newly added by the examiner.

15) On July 25, 2007 the Patent Owner filed the present petition requesting withdrawal of the finality of the Office action of July 6, 2007.

16) An Information Disclosure Statement (the fifth in the case) was filed after the final rejection listing materials from the concurrent Amgen litigation.

17) A second personal examiner interview was conducted on August 22, 2007.

18) A further Information Disclosure Statement was filed after the interview, listing additional materials from the concurrent Amgen litigation.

19) Patent Owner filed a petition requesting an extension of time on August 27, 2007, which was granted October 5, 2007, thereby extending the period for response to October 20, 2007.

20) On October 22, 2007, Patent Owner filed a petition requesting continued re-examination, pointing out numerous grounds of rejection appearing in the final Office action for the first time. Patent Owner asserts that a concurrently filed response addresses the new rejections and reduces the issues in the merged proceedings by cancelling more than 90 claims, adding new claims to clearly distinguish over all of the applied prior art, and addressing the new rejections and newly applied prior art references. A second declaration is also concurrently submitted to address issues raised for the first time in the final Office action.

21) On October 26, 2007, a decision on the petition under 37 CFR §1.182 of October 22, 2007 was mailed in which the petition for continued re-examination was **granted**, re-opening prosecution and entering the Patent Owner response of October 22, 2007.

LEGAL BASIS

M.P.E.P. §2271

> Before a final action is in order, a clear issue should be developed between the examiner and the Patent Owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the Patent Owner

> and the public, the examiner will twice provide the Patent Owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final.

M.P.E.P. 706.07(a)

> [A] second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final. If it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set in 37 CFR 1.18(p), of any claim not amended by applicant or Patent Owner in spite of the fact that other claims may have been amended to require newly cited art.

FACT SITUATION

The final Office action of 6 July 2007, as described by the Patent Owner, contained new grounds of rejection and new arguments in support of rejections including new references cited and applied by the examiner for the first time. The examiner cited seven references on a PTO-892 form, six of these references were neither previously cited by the Examiner nor submitted by the Patent Owners. In this instance, the Patent Owner was not aware of the newly entered grounds for rejection, and newly cited prior art applied, for the first time in the final Office action, and therefore, was unable to address the new rejections or comprehend the new issues prior to final Office action.

DECISION ON PETITION UNDER 37 CFR §1.181

The Patent Owner's petition under CFR §1.182 filed 25 July 2007 Requesting Continued Prosecution was granted on 26 October 2007. This decision ordered the withdrawal of the finality of the Office action of 6 July 2007 and entry of the response by the Patent Owner on 22 October 2007 and treatment as a response by the Patent Owner received after a first Office action. In view of this separate decision on petition mailed 26 October 2007, the instant petition requesting withdrawal of the finality of the Office action mailed 6 July 2007 is rendered moot, and therefore is **DISMISSED**.

CONCLUSION

1) The petition under 37 CFR §1.181 is **dismissed** as moot.

2) The directives provided in the "Conclusion" of the Decision on Petition under 37 CFR §1.181 filed 22 October 2007 is controlling.

3) Telephone inquiries related to this decision should be directed to Lissi Marquis, Director, Central Reexamination Unit (CRU), at 571-272-1596.

for Lissi Marquis
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,828	12/02/2005	6410516		4525

23432 7590 04/15/2008

COOPER & DUNHAM, LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Dr. Raj Bawa
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21005 Starflower Way
Ashburn, VA 20147

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,828*.

PATENT NO. *6410516*.

ART UNIT *3991*.

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

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

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Ashburn, VA 20147

In re Baltimore et al. Reexamination Proceeding Control No. 90/007,503 Filed: April 4, 2005 For: U.S. Patent No. 6,410,516 B1	:	DECISION ON PETITION
In re Baltimore et al. Reexamination Proceeding Control No. 90/007,828 Filed: December 2, 2005 For: U.S. Patent No.: 6,410,516 B1	:	

This is a decision addressing (1) patent owner "PETITION UNDER 37 C.F.R. § 1.183" to Waive the Service Rule, and (2) the patent owner "PETITION UNDER 37 C.F.R. §§ 1.59(b) and 1.182 TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP 724.02," submitted on February 25, 2008.

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

SUMMARY

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

The petition to expunge information under MPEP 724.02 and 37 CFR 1.59(b) is granted to the extent that the information is **provisionally sealed**, but is otherwise held in abeyance. The proceeding is **forwarded** to the Central Reexamination Unit for consideration.

BACKGROUND

1. U.S. Patent No. 6,410,516 to Baltimore et al. (the '516 patent) issued on June 25, 2002.

2. On April 4, 2005, a first third party requester filed a request for *ex parte* reexamination, which was assigned reexamination control number 90/007,503 (the '7503 proceeding).

3. On June 8, 2005, the Office granted the '7503 reexamination request and ordered reexamination.

4. On December 2, 2005, a second third party requester filed a second request for *ex parte* reexamination, which was assigned reexamination control number 90/007,828 (the '7859 proceeding).

5. On December 12, 2005, the Office granted the '7828 reexamination request and ordered reexamination.

6. On May 4, 2006, the Office issued a decision merging the '7503 and '7828 *ex parte* proceedings into a single merged proceeding.

7. On February 25, 2008, the patent owner filed a supplemental Information Disclosure Statement (IDS) in the now merged reexamination proceeding. The IDS was filed under seal and concurrently with a petition under MPEP 724.06 and 37 CFR 1.59 for expungement upon issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC). Concurrently, the patent owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.550(f).

8. The '516 patent is the subject of two Federal District Court proceedings: (i) *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.,* Civil Action No. 02-11280-RWZ in the U.S. District Court, District of Massachusetts; and (ii) *Amgen, Inc. et al. v. Ariad Pharmaceuticals, Inc.*, Civil Action No. 06-CV-00259-KAJ in the U.S. District Court, District of Delaware.

DECISION

37 CFR 1.550(f) provides (in part):

> (f) ... After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in reexamination proceeding in the manner provided by § 1.248.

37 CFR 1.183 provides:

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

37 CFR 1.59 provides:

> (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
> (2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175 will not be expunged from the application file.
>
> (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a) (2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

Waiver of Service under 37 CFR 1.550(f)

Information submitted for entry into the reexamination file is, by rule, made available to the public. In this instance, confidential litigation/proprietary materials (protected materials) have been submitted under MPEP 724 *et seq*. These materials have not been served on the reexamination requesters. Petitioner requests that the service of copy requirement of 37 CFR 1.550(f) be waived pursuant to 37 CFR 1.183 for these protected materials.

Under MPEP 724 *et seq.*, confidential protected information may be submitted for consideration by the examiner during the examination on the merits. Pursuant to MPEP 724 *et seq.*, only such information found to be important to a reasonable examiner in deciding whether or not a claim is patentable, i.e., information that is material to patentability, [1] is opened to the public in the

[1] Note MPEP 724.06 (emphasis added):

reexamination file. Requiring service of a copy of confidential protected information submitted under MPEP 724 *et seq.* would defeat the intent and purpose of submitting such confidential protected information. Furthermore, service of copy would thwart the intent and the purpose of any protective order issued by the federal court, in the related patent litigation, as well as undermine protective order procedure/mechanisms in general. It is only when information is found to be important to a reasonable examiner in deciding whether or not a claim is patentable, that the public interest in apprising the public as to the basis for patentability determination requires that the information be opened to the public. Such has not been found to be the case, at this point. Accordingly, an extraordinary situation is present where justice requires that the provisions of 37 CFR 1 .550(f) be waived to the extent that service on the third party requesters of the materials previously submitted and identified as "confidential"' is not required. Thus, the petition is **granted.**

It is to be noted that if any portion of the "confidential" information is subsequently found to be important to a reasonable examiner in deciding whether or not a claim is patentable, that portion would be made a part of the public record in the proceeding under the guidelines of MPEP 724.04(c), part (C), and it would accordingly become available to the public (and to the requesters).

Petition to Expunge under 37 CFR 1.59(b)

The information submitted with the petition under MPEP 724.02 appears to be appropriately submitted. Accordingly, the materials are **provisionally sealed**. As the materials are scanned into the Image File Wrapper (IFW) file, the provisional sealing of the materials will take the form of maintaining the papers electronically closed from the public and marking them as non-public.

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable," i.e. whether the information is material to patentability. Upon a review of the file history, it does not appear that the requisite determination has been made. Therefore, a decision on the petition to expunge at this time is premature, because any information submitted in confidence but found to

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37 CFR 1.59 provides that information, other than the original disclosure of the application, may be expunged from the file wrapper provided a petition to expunge under 37 CFR 1.59(b) and the required fee set forth in 37 CFR 1.17(g) are filed, and further that petitioner has established to the satisfaction of the Director that the return of the information is appropriate. Expungement of information that was originally submitted to the Office under MPEP § 724.02, or that should have been submitted in a sealed envelope as discussed in MPEP § 724.02, is appropriate when the petitioner complies with items (A)-(E) set forth in MPEP § 724.05, paragraph I, and the examiner or other appropriate Office official who is responsible for considering the information has determined that the **information is not important to a reasonable examiner in deciding whether to allow the application (i.e., the information is not material to patentability)**. Expungement of information that was inadvertently submitted to the Office is appropriate provided that items (A)-(F) set forth in MPEP § 724.05, paragraph II, are satisfied. See also MPEP § 724.

be "important to a reasonable examiner in deciding whether or not a claim is patentable" must not be expunged. Accordingly, it is not appropriate at this time to make a determination on whether to expunge. Rather, the proceeding is forwarded to the examiner for examination, and a determination in due course as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." Pursuant to MPEP 724.04(c), the examiner may issue a determination on the issue of importance of the provisionally sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but, in no event, later than the close of prosecution.

After a determination on the issue of importance of the provisionally sealed information is made of record (as discussed above), the issue of expungment will be ripe for a decision by the Central Reexamination Unit, at which point the petition to expunge may be renewed. **Patent owner is cautioned that a timely renewal of the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate is necessary, to prevent the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

CONCLUSION

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

2. The petition to expunge information submitted under MPEP 724.02 and 37 CFR 1.59(b) is granted to the extent that the submitted information is **provisionally sealed**, but is **otherwise held in abeyance**. The petition is subject to renewal at a later point in the proceeding, pursuant to the guidelines set forth above.

3. As pointed out above, the patent owner is cautioned that **a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file, and thus becoming open to the public**.

4. Jurisdiction over the present merged reexamination proceeding is being returned to the Central Reexamination Unit for further processing consistent with this decision Jurisdiction will then be forwarded to the examiner of record for examination, and, in due course, a determination as to whether or not any portion or all of the information submitted as protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable." Pursuant to MPEP 724.04(c), the examiner is to issue such a determination no later than the close of prosecution.

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,828	12/02/2005	6410516		4525

23432 7590 03/10/2009

COOPER & DUNHAM, LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAWA BIOTECHNOLOGY CONSULTING LLP
21005 STARFLOWER WAY
ASHBURN, VA 20147

Date: MAILED

MAR 10 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007828
PATENT NO. : 6410516
ART UNIT : 3900

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 03/10/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive, Suite 3100
Chicago, IL 60606

Date:

MAILED

MAR 10 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007503
PATENT NO. : 6410516
ART UNIT : 1600

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

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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MAR 10 2009

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In re Reexamination Proceeding of
Baltimore et al.
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent No. 6,410,516 B1

In re Reexamination Proceeding of
Baltimore et al.
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent No. 6,410,516 B1

DECISION DIMISSING PETITION TO CONTINUE *EX PARTE* REEXAMINATION PROCEEDINGS

This is a decision on the petition under 37 CFR 1.182 filed by the patent owner on January 30, 2009, requesting continued reexamination in the merged *ex parte* reexamination proceeding of reexamination proceedings control Nos. 90/007,503 and 90/007,828.

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration.

The authorization to charge the petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition to Deposit Account No. 03-3125 has been provided with the present petition.

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

REVIEW OF FACTS

1. On June 25, 2002, U.S. Patent No. 6,410,516 (the '516 patent) issued to David Baltimore et al.

2. On April 4, 2005, a first request for *ex parte* reexamination of the '516 patent was filed by a first third party requester, Grantland G. Drutchas of DcDonnell Boehnen Hulbert & Berghoff LLP, and was assigned control number 90/007,503 (the '7503 proceeding).

3. On June 8, 2005, the Office granted the reexamination request and ordered reexamination for the '7503 proceeding.

4. On December 2, 2005, a second request for *ex parte* reexamination of the '516 patent was filed by a second third party requester, Dr. Raj Bawa of Bawa Biotechnology Consulting LLP, and was assigned control number 90/007,828 (the '7828 proceeding).

5. On December 12, 2005, the Office granted the second reexamination request and ordered reexamination for the '7828 proceeding.

6. On May 4, 2006, the Office entered a decision merging the '7503 and '7828 proceedings into a singled merged *ex parte* reexamination proceeding.

7. On May 15, 2006, patent owner filed a notice of two concurrent court proceedings: (1) *Ariad Pharmaceuticals, Inc. et al. v. Eli Lilly & Co.*, Civil Action No. 02-11280-RWZ in the U.S. District Court, District of Massachusetts (the Eli Lilly litigation); and (2) *Amgen Inc. et al. v. Ariad Pharmaceuticals, Inc.*, Civil Action No. 06-CV-00259-KAJ in the U.S. District Court for the District of Delaware (the Amgen litigation).

8. On June 9, 2006, patent owner filed a compliant in U.S. District Court in Eastern District of Virginia (the Eastern District court), naming the Office as the defendant and requesting the Office be enjoined and constrained from continuing with the merged '7503 and '7828 reexamination proceedings.

9. On August 2, 2006, a first non-final Office action on the merits was mailed in the merged '7503 and '7828 reexamination proceeding.

10. On October 3, 2006, the Eastern District court granted a motion by the Office to dismiss the complaint filed by patent owner on June 9, 2006, because the court found that the plaintiffs suffered no harm, or imminent harm, from the Office's decisions to reexamine the '516 patent, and that the plaintiffs did not have standing to bring suit. Patent owner appealed the Eastern District court's decision to the Court of Appeals of the Federal Circuit.

11. On October 13, 2006, an examiner interview was conducted with patent owner.

12. On November 17, 2006, a response to the first non-final Office action was filed,

accompanied by an amendment canceling claims, and presenting arguments in response to the rejections of record, as well as multiple exhibits.

13. On November 22, 2006, the Court of Appeals of the Federal Circuit dismissed the patent owner's appeal of the October 3, 2006 decision of the Eastern District court.

14. On July 6, 2007, a final Office action was mailed in the merged '7503 and '7828 reexamination proceeding.

15. On July 25, 2007, patent owner filed a petition under 37 CFR 1.181 to withdraw the finality of the final Office action.

16. On August 22, 2007, a second examiner interview was conducted with patent owner.

17. Patent owner filed a petition pursuant to 37 CFR 1.550(c) on August 27, 2007, requesting a one-month extension of time, which was granted on September 29, 2007, and a petition on October 2, 2007, requesting a two-week extension of time, which was granted on October 5, 2007, thereby extending the time period for response to October 20, 2007.

18. On October 22, 2007, the patent owner filed a first request for continued reexamination accompanied by a petition under 37 CFR 1.182.

19. On October 25, 2007, the patent owner filed a response to the final Office action, accompanied by a certificate of mailing dated October 22, 2007.[1]

20. On October 26, 2007, the Office granted the first request for continued reexamination and the petition under 37 CFR 1.182, and withdrew the finality of the Office action mailed on July 6, 2007. The decision granting the first request for continued reexamination clearly stated that "[n]o further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances."

21. On December 27, 2007, the Office dismissed the petition under 37 CFR 1.181 as moot in view of the decision mailed on October 26, 2007, granting the first request for continued reexamination and the petition under 37 CFR 1.182.

22. On June 10, 2008, the Office mailed a notice of defective paper in *ex parte* reexamination, notifying the patent owner that the amendment filed on October 25, 2007 does not comply with 37 CFR 1.53(d)-(j) and requiring corrections.

23. On July 11, 2008, the patent owner filed a corrected amendment in response to the notice of defective paper in *ex parte* reexamination.

24. On October 16, 2008, a final Office action was mailed. The final Office action indicated

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[1] The response was considered timely filed on October 25, 2007, because the time period for response expired on October 20, 2007, which was a Saturday, and the response was accompanied by a certificate of mailing dated October 22, 2007, which was a Monday.

that: (1) the prosecution was reopened after the decision mailed on October 26, 2007, granting the request for continued reexamination; (2) the compliant amendment filed on July 11, 2008, including an amendment of the claims and an amendment of the specification, and the second Verma declaration, were entered and considered. The Office action also addressed the patent owner's arguments and explained why the declaration was found unpersuasive.

25. On December 2, 2008, a third examiner interview was conducted with patent owner.

26. On December 8, 2008, patent owner filed a petition for a one-month extension of time under 37 CFR 1.550(c), which was granted on December 22, 2008, thereby extending the time period for response to January 16, 2009.

27. On January, 13, 2009, the patent owner filed a petition for a ten-day extension of time under 37 CFR 1.550(c), which was granted on January 21, 2009, thereby extending the time period for response to January 26, 2009.

28. On January, 30, 2009, the patent owner filed a second request for continued reexamination accompanied by a petition under 37 CFR 1.182 (the present petition), and an after-final response including proposed amendments to the claims, accompanied by a certificate of mailing dated January 26, 2009.

29. On February 14, 2009, *Ex Parte* Reexamination Advisory Action Before the Filing of an Appeal Brief was mailed, notifying the patent owner that the after-final response fails to overcome all of the rejections in the final Office action mailed on October 16, 2008, and the proposed amendment will not be entered.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant merged reexamination proceeding to provide consideration of the after-final response filed on January 30, 2009.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[2] Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action

[2] *Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending*, 1292 *Off. Gaz. Pat. Office* 20 (March 1, 2005).

or action closing prosecution) was made available by the Office via a petition under 37 CFR 1.182, in appropriate circumstances. However, this relief is restricted in nature, as the statutory mandate for special dispatch in resolving reexamination proceedings is still paramount. Specifically, 35 U.S.C. 305 mandates that *ex parte* reexamination proceedings must be conducted "with special dispatch within the Office."

In this instance, a request for continued reexamination was previously granted, already delaying the conclusion of the merged reexamination proceeding of '7503 and '7828. The October 26, 2007 decision granting the first request for continued reexamination and the accompanied petition under 37 CFR 1.182, clearly stated that "[n]o further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances" [emphasis in original]. A review of the records of the instant merged *ex parte* reexamination proceeding reveals that there is no showing of extraordinary circumstances that would justify granting a second request for continued reexamination. After the decision granting the first request for continued reexamination, the finality of the final Office action mailed on July 6, 2007 was withdrawn, and the response filed on July 11, 2008 was entered and considered by the examiner. A second final Office action was mailed on October 16, 2008 and the examiner conducted a third interview with the patent owner on December 2, 2008. Patent owner also had the opportunity to appeal to the Board of Patent Appeals and Interferences for review of the examiner's final rejection by filing a notice of appeal under 37 CFR 41.31 and an appeal brief under 37 CFR 41.37. *See* 35 U.S.C. 134 and 306. Therefore, patent owner had sufficient opportunity to prosecute in the reexamination proceeding. Furthermore, arguments regarding the propriety of the examiner's action in closing prosecution and/or non-entry of various papers are matters within the jurisdiction of the Central Reexamination Unit (CRU), and are subject to petition under 37 CFR 1.181 to the CRU. Such arguments do not present an extraordinary circumstance to justify the second continued reexamination in the instant merged reexamination proceeding requested in the present petition.

Since patent owner's petition does not establish extraordinary circumstances, the petition is dismissed..

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed.

2) Jurisdiction over this reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further processing not inconsistent with this decision.

3) The CRU is directed to consider that it appears that the '7503 and '7828 reexaminations are terminated, because a proper response was not time filed within the time period for response set forth in the final Office action mailed on October 16, 2008, which has expired on January 26, 2009. The examiner denied entry of the proposed response filed on January 30, 2009, and patent owner did not timely file a notice of appeal.

4) Telephone inquiries related to this decision should be directed to Joni Y. Chang, Senior Legal Advisor, at (571) 272-7720.

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

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Commissioner for Patents
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Alexandria, VA 22313-1450
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MAILED

JUN 15 2006

CENTRAL REEXAMINATION UNIT

Rabinder N. Narula (For Patent Owner)
Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
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Bradley J. Olson (For Requester)
Dickstein Shapiro Morin & Oshinsky LLP
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In re Reissue Application of Peter S. Wöhrle Application No. 10/366,531 Filed: February 12, 2003 For: U.S. Patent No. 6,283,754 In re Peter S. Wöhrle Reexamination Proceeding Control No. 90/007,836 Filed: December 2, 2005 For: U.S. Patent No. 6,283,754	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. 6,283,754 issued on September 4, 2001, with 26 claims.

2. An application for reissue, assigned application No. 10/366,531, was filed by the patent owner on February 12, 2003.

3. The filing of the '531 reissue application was announced in the *Official Gazette* on May 13, 2003.

4. A request for reexamination was filed by a third party requester on December 2, 2005, and was assigned control No. 90/007,836.

5. Reexamination was ordered for the '7836 proceeding on

January 9, 2006.

6. A patent owner's statement under 37 CFR 1.530 has not been received in the '7836 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. 10/366,531 and reexamination control No. 90/007,836 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 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. 90/007,836 shows the presence of the following live claims: original patent claims 1-26.

   A review of reissue application No. 10/366,531 shows:

   (a) original patent claims 2, 6-12, 14-15, 17-22, and 24-26 are present;

   (b) original patent claims 1, 3-5, 13, 16, and 23 have been amended; and

   (c) new claims 27-112 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. 10/366,531 and Control Number 90/007,836. 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. 10/366,531 and reexamination control No. 90/007,836 **<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 reissue and reexamination proceedings is being transferred to the examiner via the Director of Technology Center 3700. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the expiration of the ONE (1) MONTH period (from the mailing of this decision) for filing the amendment.

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

decision.

5. Telephone inquiries related to this decision should be directed to Samuel Broda, Legal Advisor, at (571) 272-7711.

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

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20 April 2006

4-28-06
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,838	12/05/2005	6361030	8470-000142/RXA	1355

7590 01/24/2007

William E. McCracken
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6300 Sears Tower
233 South Wacker Drive
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2007

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

1/24/2007

Ryan W. Massey, Esq.
Harness Dickey & Pierce P. L. C.
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Troy MI 48098

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007838
PATENT NO. 6,361,030
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
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For the Patent Owner:

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For the Requester:

Ryan W. Massey
Harness, Dickey & Pierce, P.L.C.
5445 Corporate Drive, Suite 400
Troy, MI 48098

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

In re Reexamination proceeding 90/007,838
Filed: December 5, 2005
For: ANTIVIBRATION MOUNT AND MECHANICAL ASSEMBLY COMPRISING SUCH MOUNT

This is in response to Requester's petition filed February 27, 2006 under 37 CFR 1.181 and 1.515(c) requesting review of the January 31, 2006 Order Denying Request For Reexamination.

The petition is **DENIED**.

On December 5, 2005, the Requester filed a request for Reexamination of U.S. Patent No. 6,361,030 alleging that the claim of the patent was unpatentable over Japanese Utility Model Laid-Open Publication No. 58-037337 in view of any one of Engine Mounting Instruction Sheet for 3990914 Mounting Unit, dated 7/24/70; Chevrolet Assembly Instructions 3940195 for 1969 Camaro 12000 series or Chevrolet Motor Division 1970 Camaro "F" Series 3965175. On January 31, 2006, the Examiner issued an Order Denying Request for Reexamination. In the Denial Order the Examiner indicated that the Japanese publication '337 was considered and extensively discussed in the determination of patentability of the '030 patent and therefore does not raise a substantial new question of patentability. The examiner also found the teachings of 3990914 Mounting Unit, 1969 Camaro 12000 Series and Camaro F Series 396175 to be unimportant in the determination of the patentability of the patent claim because the teachings in these three documents were merely cumulative and representative of the state of the art. The examiner also noted that none of these references taught bent tabs extending from two lugs in combination with first and second fingers passing through the first and second windows in an anti-vibration mount.

Requestor argues that the examiner failed to recognize that the engine mounting instruction sheet for Part No. 3990913 [sic 3990914] discloses the engine mount as including the first and second parallel lugs as well as a single bent tab integrally formed with the second strength member, which is bent around the motor bracket for holding the motor bracket. It is further argued that one of ordinary skill in the art would readily recognize that the tab is provided to rest on the edge of the frame bracket while the bolt is inserted through the apertures in the lugs and through the aperture in the frame for mounting the engine block thereto. Requestor submitted that the alternative location of two bent tabs extending from the lugs as opposed to the single bent tab extending from the base of the first strength member is clearly within the level of ordinary skill in the art as the prior art clearly teaches a single bent tab for providing the same function as the claimed two bent tabs. Requestor therefore concluded that the presence of a bent tab as disclosed on the instruction sheet for Part No. 3990914 raises a substantial new question of patentability since none of the prior art previously considered by the examiner disclosed a bent tab disposed between two lugs of a strength member.

The presence or absence of "a substantial new question of patentability" (SNQ) determines whether or not reexamination is ordered. A prior art patent or publication raises a substantial new question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or publication important in deciding whether or not the claim is patentable. See MPEP 2242.

Requestor's arguments are not persuasive. In the denial of the request for reexamination, the examiner pointed out that the key features in the claim are the first and second fingers passing through the first and second windows of tabs and integral parallel lugs extended by bent tabs. The examiner held that none of the references cited in the request for reexamination taught bent tabs extending from the two lugs in combination with first and second fingers passing through the first and second windows in an anti-vibration mount. Requestor argues that the alternative location of two bent tabs extending from the lugs as opposed to the single bent tab extending from the base of the first strength member as taught in Part No. '914 as being with the level of ordinary skill. However, the test for determining whether or not a SNQ exists is whether or not the examiner would have considered the prior art important in deciding whether or not the claim is patentable. The examiner has concluded that the prior art cited in the request for reexamination does not teach the claimed features relied on for patentability and were therefore considered cumulative. Requestor has not provided convincing evidence to the contrary. Requestor's cited prior art teaches a tab between two lugs, but such teaching has been held to be merely cumulative of prior art already considered in that it does not teach two bent tabs extending from two lugs as pointed out by the examiner and required in the patent claim.

It is maintained that the prior art cited in the request for reexamination is merely cumulative of other engine mount structures cited and considered in the prosecution of the '030 patent. Therefore, the prior art cited in the request for reexamination of the patent is maintained to be not important in deciding whether or not the claim is

patentable, resulting in a holding that a substantial new question of patentability has not been shown to be present.

For the above reasons, the petition is **DENIED.**

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 Kenneth J. Dorner at (571) 272-6587.

Lissi Marquis, Director
Central Reexamination Unit

Kjd/kjd: 9/1/06

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JUL 20 2006

CENTRAL REEXAMINATION UNIT

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Thomas A. Rozylowics FISH & RICHARDSON P. C. 1425 K Street, N. W. Suite 1100 Washington, DC 20005	:	(For Third Party Requester)
JANELLE D. WAACK 1111 Louisiana 25th floor Houston, TX 77002-5242	:	(For Third Party Requester)
Robert C. Laurenson HOWREY LLP 2020 Main Street Suite 1000 Irvine, CA 92614	:	(For Third Party Requester)
In re : Castille Reexamination Proceeding Control No. 90/007,839 Filed: December 7, 2005 For U.S. Patent No. 5,734,961	:	DECISION, *SUA SPONTE,* MERGING REEXAMINATION PROCEEDINGS PURSUANT TO 37 C.F.R. § 1.565(c)

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,936 :
Filed: February 17, 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,942 :
Filed: February 17, 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,957 :
Filed: March 3, 2006 :
For U.S. Patent No. 5,734,961 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,839 (the '839 proceeding) with 90/007,936 (the '936 proceeding), 90/007,942 (the '942 proceeding) and 90/007,957 (the '957 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,734,961 issued on March 31, 1998.

2. The '839 reexamination proceeding, filed on December 7, 2005, is a reexamination proceeding that was requested by a third party requester.

3. An order granting reexamination in the '839 reexamination proceeding was mailed on January 5, 2006.

4. The '936 reexamination proceeding, filed on February 17, 2006, is a reexamination proceeding that was requested by a third party requester.

5. An order granting reexamination in the '936 reexamination proceeding was mailed on April 3, 2006.

6. The '942 reexamination proceeding, filed on February 17, 2006, is a reexamination proceeding that was requested by a third party requester.

7. An order granting reexamination in the '942 reexamination proceeding was mailed on April 11, 2006.

8. The '957 reexamination proceeding, filed on March 3, 2006, is a reexamination proceeding that was requested by a third party requester.

9. An order granting reexamination in the '957 reexamination proceeding was mailed on April 25, 2006.

10. The above named proceedings are all awaiting examiner action for a first Office action on the merits.

11. There are no amendments to the above proceedings at this time

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in all 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 90/007,839, 90/007,936 90/007,942 and 90/007957 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

Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,839, 90/007,936 90/007,942 and 90/007957 are **merged**. 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

MRenh

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.
90/007,839	12/07/2005	5734961	866093	1585

7590 04/14/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2008

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Hilda C. Galvan
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,839 90/007,936, 90/007,942, 90/007,957

PATENT NO. 5734961.

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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(For Patent Owner)

Hilda C. Galvan
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(For Third Party Requester)

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,839
Filed: December 7, 2005
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,936
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,942
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,957
Filed: March 3, 2006
For U.S. Patent No. 5,734,961

DECISION
GRANTING
PETITION

The four above-captioned *ex parte* reexamination proceedings have been previously merged into a single merged reexamination proceeding. The merged reexamination proceeding and the patent owner petition entitled "Petition Under 37 C.F.R. 1.182 For Expedited Examination Of Reexamination Proceedings" that was filed on March 21, 2008 are before the Director of the Central Reexamination Unit for consideration.

FEES

Although a $400.00 petition fee is required for a petition under 37 CFR 1.182, the instant petition has been forwarded to the undersigned for treatment as a petition under 37 CFR

1.181. Therefore, no fee is required for the petition. The previously submitted $400.00 petition fee has been refunded to Deposit Account No. 50-2929.

RELEVANT FACTS

1. The four *ex parte* reexamination proceedings that are included in the single merged reexamination proceeding were filed between December 7, 2005 and March 3, 2006.

2. Reexamination of the earliest filed individual reexamination proceeding, control number 90/007,839 (the '839 proceeding), was ordered January 5, 2006.

3. Reexamination of the latest filed individual reexamination proceeding, control number 90/007,958 (the '958 proceeding), was ordered April 25, 2006, with prosecution on the three earlier filed individual proceedings being necessarily delayed until it was determined whether reexamination could properly be ordered in the '958 proceeding.

4. Thereafter, merger of the four individual reexamination proceedings was considered to be proper, but was necessarily delayed in order to determine whether patent owner would exercise the statutory right (35 U.S.C. § 304) to file a patent owner's statement.

5. Upon expiration of the two month period for filing a patent owner's statement (plus allowance for mailing time and technical support treatment of such statement in the event that one had been filed), a decision merging the four individual reexamination proceedings was mailed on July 20, 2006.

6. A first Office action on the merits was mailed in the merged proceeding on December 14, 2007. The Office action set a thirty day or one month shortened statutory period, (whichever was longer), for filing a response thereto.

7. On January 3, 2008, patent owner filed a request for a one-month extension of time to file a response to the outstanding Office action because the action was twenty-two (22) pages in length, included various rejections, and patent owner was represented by two different law firms. An extension was granted to extend the response period through February 14, 2008.

8. A supplemental Office action was mailed on January 14, 2008 replacing the December 14, 2007 Office action, in which a technical defect in the December Office action was corrected.

9. One February 14, 2008, patent owner filed a timely response to the January 14, 2008 supplemental Office action, which response included eighty-three (83) new claims and fifty (50) pages of supporting remarks.

10. U.S. Patent No. 5,734,961 (the '961 patent) is the subject of multiple litigation proceedings, and at least one litigation is currently stayed pending completion of reexamination.

DECISION

The relief requested in the present petition is that the merged *ex parte* reexamination proceeding be accorded "expedited examination" and be considered with special dispatch. The record shows that the Office is currently treating the merged proceeding in accordance with established procedures, (MPEP §§ 2261 and 2286), which require that reexamination proceedings for a patent in litigation be given priority over all other cases, and that where litigation is stayed, that a thirty day or one month shortened statutory period will be set for response to Office actions.

Nevertheless, it must be noted that current statistics (through December 31, 2007) show that 26% of the *ex parte* reexamination requests filed and 52% of the *inter partes* reexamination requests filed involved patents that were also subject to litigation. Thus, there is a significant number of reexamination proceedings pending that involve litigation, including reexamination proceedings in which the litigation has been stayed.

Further, 35 U.S.C. § 305 requires that "[A]ll 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." Similarly, 35 U.S.C. § 314(c) provides that "[U]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." Thus, regardless of whether a given request for reexamination is directed to a patent that is the subject of concurrent litigation, <u>all</u> requests for reexamination must be considered promptly so as to meet the deadlines imposed by the reexamination statute. Accordingly, the examination of pending reexamination proceedings must be prioritized, even when considering that some of those proceedings must properly be advanced out of turn due to the status of concurrent litigation.

In light of these considerations, patent owner's petition for "'expedited examination'" and consideration of the present merged reexamination with special dispatch is <u>granted</u> to the extent that the merged proceeding <u>will</u> be examined in the Office in accordance with special dispatch and the priority treatment mandated by MPEP §§ 2261 and 2286 to the fullest extent that the Central Reexamination Unit (CRU) is able to do so. As there is litigation involving the '961 patent that has been stayed pending completion of reexamination, the present merged proceeding will be accorded the highest priority. However, patent owner must recognize, however, that the issues presented in the merged proceeding (a total of one hundred twelve (112) claims and 50 pages of remarks) are voluminous and complex, and that CRU must also treat a significant number of reexamination proceedings that are also entitled to "expedited examination" due to the existence of concurrent litigation that has been stayed due to copending reexamination in the Office.

CONCLUSION

1. Patent owner's petition is granted to the extent set forth above.

2. The merged reexamination proceeding is being forwarded to Art Unit 3992 for examination not inconsistent with this decision.

3. Telephone inquiries regarding this decision should be directed to Mark Reinhart at (571) 272-1611 or to Eric Keasel (571) 272-4929.

Lissi M. Marquis, Director
Central Reexamination Unit

March 27, 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.
90/007,839	12/07/2005	5734961	866093	1585

7590 11/03/2008

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2008

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

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Commissioner for Patents
United States Patent and Trademark Office
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NOV 03 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,839; 90/007,936; 90/007,942; 90/007,957

PATENT NO. 5734961.

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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MAILED

NOV 03 2008

CENTRAL REEXAMINATION UNIT

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,839
Filed: March 3, 2006
For: U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,936
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,942
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,957
Filed: March 3, 2006
For U.S. Patent No. 5,734,961

DECISION UNDER
37 CFR 1.181 FOR
RECONSIDERATION OF
DECISION DATED
APRIL 14, 2008

The four above-captioned *ex parte* reexamination proceedings have been previously merged into a single merged reexamination proceeding. The merged reexamination proceeding and the patent owner petition entitled "Petition Under 37 C.F.R. 1.181 Requesting Reconsideration of PTO Decision of April 14, 2008" (hereinafter "the present petition") that was filed on April 30, 2008 are before the Director of the Central Reexamination Unit for consideration.

The petition is granted for the reasons set forth below.

REVIEW OF REVELANT FACTS

1. On March 21, 2008, patent owner filed a petition entitled "Petition Under 37 C.F.R. 1.182 For Expedited Examination Of Reexamination Proceedings" in all four above-captioned *ex parte* reexamination proceedings. In this petition, patent owner stated that the term for U.S. Patent No. 5,734,961, will expire in either 2010 or 2011. See page 2 of this petition.

2. On April 14, 2008, the Office mailed a decision granting the petition of March 21, 2008 to the extent that the merged proceedings will be examined in accordance with special dispatch and the priority treatment mandated by MPEP 2261 and 2286 to the extent possible.

3. On April 30, 2008, patent owner filed the present petition requesting reconsideration of the decision of April 14, 2008 in light of the fact that the term for U.S. Patent No. 5,734,961, will expire no earlier than 2013 and not in either 2010 or 2011 as stated in the March 21, 2008 petition.

DECISION

The request for reconsideration in the present petition is granted. In review of the record, the decision of April 14, 2008 did not rely upon patent owner's statement that the term for U.S. Patent No. 5,734,961, will expire in either 2010 or 2011. As a result of this decision, the decision of April 14, 2008 is confirmed and maintained in light of the present petition.

CONCLUSION

1. Patent owner's present petition, dated April 30, 2008, for reconsideration of the April 14, 2008 decision is granted.

2. The decision of April 14, 2008 is confirmed and maintained.

3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, or Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929, or in their absence to the undersigned at (571) 272-3838.

Gregory A. 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.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/05/2008

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,396	01/27/2005	5770231	00166.0051-US09	9488

26853 7590 12/05/2008

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ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/05/2008

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ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/05/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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CENTRAL REEXAMINATION UNIT

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In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	: : : :

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. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

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 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 '7839, '7936, '7942, '7957, and '9261 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 original claims remain unamended and new claims 30-112 have been added in the '7839, '7936, '7942, and '7957 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. This may be accomplished by canceling new claims 30-112 in the '7839, '7936, '7942, and '7957 reexamination proceedings. 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 each of the five proceedings, 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.

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.

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 will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/007,839, 90/007,936, 90/007,942, 90/007,957, and 90/009,261 are **merged**.

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 or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/30/2008

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 12/30/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/30/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/30/2008

R. ROSS VIGUET
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/30/2008

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DIJON, 21000
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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JONES DAY
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DALLAS, TX 75201-1515

Date:

DEC 30 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007839
PATENT NO. : 5734961
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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DEC 30 2008
CENTRAL REEXAMINATION UNIT

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In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	DECISION DISMISSING PETITION UNDER 37 CFR 1.181 TO VACATE FINALITY
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of the finality of the rejection mailed August 19, 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

6. The five requests were merged on December 5, 2008.

7. A non-final rejection was mailed December 22, 2005 in the merged proceedings.

DECISION

In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

1. **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.

2. 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

Gregory Morse
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.
90/007,839	12/07/2005	5734961	866093	1585

7590 01/08/2009

R. ROSS VIGUET
FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVE.
SUITE 2800
DALLAS, TX 75201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2009

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Hilda. C. Galvan

Jones Day

2727 North Harwood Street

Dallas, TX 75201-1515

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,839; 90/007,936; 90/007,942; 90/007,957

PATENT NO. 5734961.

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

R. Ross Viguet FULBRIGHT & JAWORSKI L.L.P. 2200 Ross Ave Suite 2800 Dallas, TX 75201	:	(For Patent Owner)
ANTOR CORPORATION C/O JEAN-PAUL CASTILLE 28 RUE DES ARANDES DIJON 21000 FR FRANCE	:	(for Patent Owner Courtesy Only)
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Thomas A. Rozylowics FISH & RICHARDSON P. C. 1425 K Street, N. W. Suite 1100 Washington, DC 20005	:	(For Third Party Requester)
HOWREY LLP c/o IP Docketing Department Attn: JANELLE D. WAACK 1111 Louisiana 25th floor Houston, TX 77002-5242	:	(For Third Party Requester)
Robert C. Laurenson HOWREY LLP 2020 Main Street Suite 1000 Irvine, CA 92614	:	(For Third Party Requester)
Paul Rauch EVAN LAW GROUP LLC 600 West Jackson Blvd, Suite 625 Chicago, IL 60661	:	(For Third Party Requester)
	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR § 1.550(c)]

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,839
Deposited on: 7 December 2005
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,936
Deposited on: 17 February 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,942
Deposited on: 17 February 2006
For U.S. Patent No. 5,734,961

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,957
Deposited on: 3 March 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/009,261
Deposited on: 21 August 2008
For U.S. Patent No. 5,734,961

This is a decision on the 30 December 2008, petition for "Petition for Extension of Time Under 37 CFR § 1.550 (c)," requesting that the time for responding to the Office action mailed 22 December 2008, be extended by one-month in the above noted *ex parte* proceedings.

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 22 December 2008, 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 30 December 2008, together with the $200.00 petition fee as is required by 37 CFR §1.515(c) and as set forth in 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 reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner further notes the need for expert input whose availability during the response period is insufficient for a proper response. As such, the "sufficient cause" requirement is considered to be met by in this petition to the director of the Central Reexamination Unit. The sufficient cause justifies granting a one-month extension of time.

The petition request for a one month extension of time is hereby **granted**.

Conclusion

1. The patent owner's petition for extension of two-month time in which to file a response to the Office action dated 22 December 2008 is hereby **granted**.

2. The time to respond is extended by one-month.

3. The Patent Owner's response is due **22 February 2009**

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

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, Supervisory Patent Examiner, Art Unit 3992, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, at 571-272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners, Art Unit 3992, in the Central Reexamination Unit may be contacted.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Jean-Paul Castille

Reexamination Control 90/007,839
90/007,936
90/007,942
90/007,957
90/009,261
Patent 5,734,961

Decided: November 16, 2009

DECISION ON PETITIONS

This is a decision on:

"Petition to Suspend Rule Bd. R. § 41.37(v)(5) Pursuant to the Provisions of 37 C.F.R. § 1.183" ("Petition"), filed August 28, 2009, and

"Supplemental Petition to Suspend Rule Bd. R. § 41.37(v)(5) Pursuant to the Provisions of 37 C.F.R. § 1.183" ("Supplemental Petition"), filed October 8, 2009. (collectively "Petitions).

The Petition and Supplemental Petition seek permission to file an appeal brief that exceeds 30 pages in length.

Findings of Fact

1. In this proceeding, the five ex parte reexamination proceedings identified above have been combined.

2. A Final Rejection was entered on June 10, 2009 consisting of 72 pages.

3. Patent Owner filed a Notice of Appeal on July 9, 2009.

4. Patent Owner filed a Petition and Request to Extend Time Under 37 CFR 1.550(c) on September 1, 2009 seeking an extension of one month for filing an appeal brief.

5. Patent Owner filed an Appeal Brief on October 8, 2009.

6. On October 30, 2009, a Decision Granting Petition for Extension of Time was entered granting Patent Owner a one month extension for filing an appeal brief.

7. Under the *ex parte* appeal rules presently in force, specifically 37 C.F.R. § 41.37, there is no limitation on the length of appeal briefs.

8. Under proposed new *ex parte* appeal rules for which the effective date has been delayed indefinitely, 73 Fed. Reg. 74972 (Dec. 10, 2008), proposed 37 C.F.R. § 41.37(v)(5) places a limitation of 30 pages on the length of appeal briefs. The sections of the brief that are encompassed by this limitation are the grounds of rejection to be reviewed, statement of facts, and argument sections. *See* proposed new Rules 41.37(e) and (v)(5).

9. Before the effective date of the proposed new rules –

> the Office will not hold an appeal brief as non-compliant solely for following the new format even though it is filed before the effective date. Thus, appeal briefs filed before the effective date of [the proposed new rules] *must either comply with current 37 CFR 41.37 (which remains in effect) or revised 37 CFR 41.37* . . . .

73 Fed. Reg. 74972 (Dec. 10, 2009). (emphasis added).

10. Proposed new Rule 41.37(v)(5) provides that:

> A request to exceed the page limit [of the appeal brief] shall be made by petition under § 41.3 filed at least ten calendar days prior to the date the appeal brief is due.

11. The sections of Patent Owner's Appeal Brief consisting of the Grounds of Rejection to be Reviewed, Statement of Facts, and Argument together total 33 pages in length. Thus, under proposed new Rule 41.37(v)(5), the relevant sections of Patent Owner's Appeal Brief exceed the prescribed maximum by three pages.

DISCUSSION

Although Patent Owner has not expressly stated that its Appeal Brief is being filed under the proposed new rules, from the context of the Petition and Supplemental Petition, it is clear that is Patent Owner's intention. Thus, it is appropriate for the Chief Administrative Patent Judge to decide the Petitions under proposed new Rule 41.3(b).

The Petition was filed on August 28, 2009, which was more than ten days prior to the date the Appeal Brief originally was due on September 8, 2009, as required by proposed new Rule 41.37(v)(5). Thus, the Petition was timely filed.

As indicated above, this appeal involves five combined *ex parte* requests for reexamination. Further, the Final Rejection is 72 pages in length. These factors persuasively demonstrate that this appeal is more complex than a normal, single application *ex parte* appeal.

DECISION

For the foregoing reasons, the Petitions are GRANTED and Patent Owner's Appeal Brief is accepted.

Michael R. Fleming
Chief Administrative Patent Judge

Attorney for Patent Owner

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P.O. BOX 7037
ATLANTA, GA 30357-0037

(For Patent Owner)

MAILED

JUL 03 2006

CENTRAL REEXAMINATION UNIT

Marcus J. Millet
LERNER, DAVID, LITTENBERG, KRUMHOLZ
& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

(For Requester)

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,093
Filed: May 17, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,094
Filed: May 19, 2005
For: U.S. Patent No.: 6,275,213

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 90/007,844
Filed: December 13, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 90/007,843
Filed: December 13, 2005
For: U.S. Patent No.: 6,275,213

DECISION
DENYING
PETITIONS

This is a decision on the April 11, 2006 requester (hereinafter "requester" or "Sony") petitions filed (a) under 37 CFR 1.183 for waiver of the rules to permit entry of the petitions, and (b) under 37 CFR 1.182 for merger of:

1. Reexamination Control No.: 90/007,844 with Reexamination Control No.: 95/000,093, and

2. Reexamination Control No.: 90/007,843 with Reexamination Control No.: 95/000,094.[1]

On May 3, 2006, the patent owner (hereinafter "patent owner" or "Immersion") filed oppositions to Sony's petitions.

The petition fee of $400 set forth in 37 CFR 1.17(f) for each of the present petitions under 37 CFR §§ 1.182 and 1.183 has been charged to Sony's Deposit Account No. 12-1095, in accordance with petitioner's authorization at the last sentence of page 2 of the April 11, 2005 petitions. A total of $800 will be charged for the two petitions directed to the two sets of proceedings

The petitions and oppositions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office ("USPTO" or "Office").

For reasons set forth below, Sony's petitions are:

Granted as to the request under 37 CFR 1.183 for waiver of the rules to permit entry and consideration of the petitions; and

Denied as to the request under 37 CFR 1.183 for merger, i.e., as to the underlying relief requested.

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion, obtained a jury verdict (Civil Action No. 02-0710 CW) in the

[1] See the penultimate paragraph of the second page of the petitions which identifies the petitions as being filed under 37 CFR §§ 1.182 and 1.183.

United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination) infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[2]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony on Immersion's claims of infringement of the '333 and '213 patents.[3] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[4]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was not litigated in the district court proceeding.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was not litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441). The appeal is still pending.

8. On July 6, 2005, Immersion filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, Sony filed petitions and oppositions under 37 CFR 1.183 in response to Immersion's petitions.

10. On August 5, 2005, Immersion filed a reply to Sony's oppositions.[5]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '093 and '094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

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[2] 2005 U.S. Dist. LEXIS 4784.
[3] 2005 U.S. Dist. LEXIS 4781.
[4] 2005 U.S. Dist. LEXIS 4784.
[5] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply was accordingly not considered.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '093 and '094 *inter partes* reexamination proceedings (in the decision, it was noted that claim 1 in each reexamination was not part of the concurrent pending litigation).

13. On September 9, 2005, Immersion filed (a) renewed petitions to suspend the '093 and '094 *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, Immersion filed a petition in the two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Jurisdiction over the two proceedings was, in fact, retained by the Office of Patent Legal Administration.

15. On September 26, 2005, Sony filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. On March 15, 2006, Immersion filed its corrected substitute brief.

17. On November 17, 2005, the Director of the Office of Patent Legal Administration issued a decision granting Immersion's petitions, finding "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings until the U.S. Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal, in view of the statutory disclaimer of claim 1 of both the '213 and '333 patents.

18. On December 13, 2005, Sony filed requests for *ex parte* reexamination of claims 2, 3, 5, 6, 7, 15, 16, 17, 20, 21, 25, 41, 42, 43, 44, 45, 46, 49, 50, 53 and 54 of the '213 patent and claims 2, 3, 4, 5, 6, 7, 8, 9, 12, 13, 14, 15, 16, 17 and 18 of the '333 patent, the requests being assigned control Numbers 90/007,843 (for reexamination of the '213 patent) and 90/007,844 (for reexamination of the '333 patent).

19. On December 15, 2005, Sony filed petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a), requesting that the USPTO Director authorize Sony to file <u>additional</u> requests for *inter partes* reexamination of the '333 and '213 patents, in order to permit Sony to request *inter partes* reexamination of certain claims of the '213 and '333 patents that it failed to request in its initial set of *inter partes* reexamination requests, dated May 17 and 19, 2005.

20. On January 23, 2006, Immersion filed oppositions to Sony's petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

21. On March 9, 2006, a substantial new question of patentability (SNQ) was found for claims 2, 3, 5, 6, 15, 16, 17, 20, 21 and 25 of the '213 patent and for claims 2, 3, 4, 5, 6, 7, 8, 9, 12 and

13 of the '333 patent, and *ex parte* reexamination proceedings 90/007,843 and 90/007,844 (hereinafter, the '843 and '844 proceedings) were ordered.

22. On March 22, 2006, the Senior Legal Advisor of the Office of Patent Legal Administration issued a decision dismissing Sony's December 15, 2005 petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

23. On April 11, 2005, Sony filed the instant petitions. The instant petitions are filed under 37 CFR 1.183 for waiver of the rules to permit entry of the petitions, and under 37 CFR 1.182 for merger of the '844 and '093 proceedings, and merger of the '843 and '094 proceedings.

24. On May 3, 2006, Immersion filed oppositions to Sony's merger petitions.

25. On December 13, 2005, Sony brought action in the United States District Court, Eastern District of Virginia, pursuant to the Administrative Procedure Act (APA), 5 U.S.C. §§ 701-706, to obtain judicial review of the Office's November 17, 2005 petition decision suspending the '093 and '094 *inter partes* reexamination proceedings. Specifically, Sony sought review of the Office's November 17, 2005 decision which found that "good cause" existed under 35 U.S.C. § 314(c) to suspend the just-commenced '093 and '094 *inter partes* reexamination proceedings with respect to certain claims in the '213 and '333 patents on the ground that the validity of those claims were already the subject of an ongoing appeal in the U.S. Court of Appeals for the Federal Circuit. Sony argued that the Office abused its discretion in suspending the proceedings, contending the Office had a legal obligation to reexamine all claims in the patents (except the two disclaimed claims), including the claims Sony failed to request for reexamination.

26. On May 22, 2006, the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462, issued a decision in favor of the Office. The decision upheld the Office's finding of "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings and also upheld the Office's discretion to not reexamine claims of the '213 and '333 patents for which *inter partes* reexamination was not requested.

27. A patent owner's statement under 37 CFR 1.530 has not been received in the '843 and '844 *ex parte* reexamination proceedings, and the time for filing such statement has expired.

DECISION WAIVNG RULES, TO PERMIT CONSIDERATION OF MERGER PETITIONS

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)."

The present petitions do not have an entry right under the rules. *See* 37 CFR 1.510, 1.535, and 1.550. The appropriate provisions of the rules are, however, waived to permit consideration of the instant Sony merger petitions, based upon the specific facts and unique circumstances of the present situation, as well as statements made in the Office's March 22, 2006 decision dismissing Sony's petitions to file additional requests for *inter partes* reexamination. Likewise, the appropriate provisions of the rules are *sua sponte* waived to permit consideration of Immersion's oppositions to the merger petitions.

DECISION ON MERGER PETITIONS

37 CFR 1.989(a) provides:

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997. [Emphasis added].

In addition, MPEP 2686.01(I) provides:

> "If a second request for reexamination is filed where a certificate will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings **normally** will be merged once reexamination has been ordered in both proceedings. In this situation the second request is decided based on the original patent claims and if reexamination is ordered in the second proceeding, the reexamination proceedings **normally** would be merged."

Reexamination of the '333 patent has been ordered in the '844 *ex parte* proceeding and '093 *inter partes* proceeding, and reexamination of the '213 patent has been ordered in the '843 *ex parte* proceeding and '094 *inter partes* proceeding. In addition, a patent owner's statement under 37 CFR 1.530 has not been received in the '844 and '843 proceedings, and the time for filing such has expired. [6] [7] Accordingly, a decision under 1.989(a) on the Sony petitions for merger is timely.

The issue to be decided is whether the *ex parte* reexaminations should be merged with the respective *inter partes* reexaminations. The present petitions raise a novel question regarding merger practice, because, pursuant to 35 U.S.C. § 314(c), the present '093 and'094 *inter partes* reexaminations are currently suspended.

At page 3 of the petitions, Sony argues that:

> "there is every reason to merge the two proceedings, and no proper reason to refrain from such merger. As set forth in M.P.E.P. § 2686.01, '[i]f a second request for reexamination is filed where a certificate will issue for a first reexamination later than three months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings.' Here, all of the proceedings are at a relatively early stage; reexamination has been ordered in all of the proceedings, but no first Official Action has been issued in any of the proceedings. As the Office has already held that 'it is not in the Office's interest to conduct a piecemeal reexamination of a patent' because a reexamination of any claim 'will already require the Examiner to review the written description, the drawings, other claims in the patent and the prior art,' and accordingly, there is relatively little additional effort to reexamine all claims instead of just some' in a given reexamination proceeding. (Decision Denying Petitions dated August 23, 2005 in the '093 and '094 *Inter Partes* Reexaminations at 13.) There is no reason for the Office to consider the same issues twice, rather than once."

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, as with the Office's decisions to reexamine claims beyond those requested and to suspend an *inter partes* reexamination for "good cause," the Office's

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[6] Pursuant to MPEP 2283(III), "[I]f Request 2 is granted, the order in the second proceeding should be mailed immediately. The two requests should be held in storage until the patent owner's statement and any reply by the requester have been received in Request 2, or until the time for filing same expires."

[7] As to the suspended '093 and '094 proceedings, there is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding.

decision to merge two reexaminations is a purely discretionary act. *See Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas,* 2006 WL 1472462 (E.D.Va. May 22, 2006).

First, the statute does not require the Office to merge or consolidate multiple reexamination proceedings. In fact, the statute is silent as to this procedural issue. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a) ("If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings." (Emphasis added)). Furthermore, while the MPEP states that the Office will "normally" merge two reexaminations, that general policy does not address the unique circumstances here, in which one set of proceedings has been suspended. Indeed, the Office has never had to address the question of dissolving a suspension order for the sake of merging proceedings.

Pursuant to 35 U.S.C. 314(c), the USPTO Director may suspend an *inter partes* reexamination proceeding "for good cause." In the present instance, the Office's November 17, 2005 petition decision suspended the '093 and '094 *inter partes* reexamination proceedings because the Federal Circuit appeal on the same patent claims was far advanced in comparison to the *inter partes* reexamination proceedings, which had only recently been commenced. Thus, there was ample "good cause" to suspend the *inter partes* reexamination proceedings pending completion of the Federal Circuit appeal, in view of the statutory estoppel that would operate upon a final decision on the claims by the Federal Circuit. *See* 35 U.S.C. § 317(b).

Further, the U.S. District Court for Eastern District of Virginia upheld the Office decision to suspend the '093 and '094 *inter partes* reexamination proceedings, stating that "the PTO did not abuse its discretion in concluding that there was good cause to suspend reexamination of the litigated claims in light of the more advanced Federal Circuit appeal focusing on the same claims...." [8] The District Court found that "the PTO's decision to suspend *inter partes* review of the patent claims in issue here was clearly supported by good cause and therefore well within the bounds of the PTO's discretion." [9] Thus, Sony has already appealed the merits of the suspension order, but the court rejected that challenge.

Based on the above, the requested merger of the '844 *ex parte* reexamination proceeding with the '093 *inter partes* reexamination proceeding would consolidate a suspended *inter partes* proceeding with an *ex parte* proceeding which must go forward with special dispatch. *See Ethicon v. Quigg,* 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). The same would be true for the requested merger of the '843 *ex parte* reexamination proceeding with the '094 *inter partes* reexamination proceeding. In each instance, the requested merged proceeding would be required to proceed with special dispatch, based on the presence of the *ex parte* reexamination

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[8] *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas,* 2006 WL 1472462, Slip Copy at 11.
[9] *Id.* ,at 7.

proceeding. Thus, the merger of the two sets of proceedings would necessarily require dissolving the Office's decision to suspend the *inter partes* reexamination proceedings.

While Sony is correct that the Office usually prefers to avoid piecemeal reexamination, merging the two sets of proceedings in the present instance would clearly circumvent the Office's suspension decision of the *inter partes* reexamination proceedings, which was approved by the District Court based upon the reasoning advanced by the Office. Indeed, merging the proceedings here would render the Office's discretion to suspend meaningless, and would defeat the whole purpose behind the suspension decision, *i.e.*, to await the final outcome on the litigated claims. Furthermore, such a result would undermine the legislative intent underlying 35 U.S.C. 314(c) (expressly providing the Office with discretion to find "good cause" to suspend). In view of the foregoing, the more appropriate course is to preserve the suspension decision (and all the reasoning given therein) and deny the merger petition, rather than permit Sony to collaterally attack the suspension order (which has already been affirmed by the District Court). In other words, the Office does not find that its concern over piecemeal reexamination overrides, in this instance, the reasoning for why the Office suspended the *inter partes* reexamination proceedings. Moreover, there will not be any piecemeal reexamination if the Federal Circuit affirms the District Court's decision as to validity, because the *inter partes* reexaminations will be terminated under 35 U.S.C. 317(b) and 37 CFR 1.907(b).[10]

Accordingly, the request for merger is denied.

It is also noted that pursuant to 37 CFR 1.989(b):

> "An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560."

In the present instance, a merger of the '844 *ex parte* reexamination proceeding with the '093 *inter partes* reexamination proceeding would inappropriately provide Sony, as the third party requester of the *inter partes* reexamination, with *inter partes* participation rights as to the entirety of '844 *ex parte* reexamination proceeding, in which Sony's rights of participation are currently limited by the *ex parte* reexamination statute. Again, the same would be true for a merger of the '843 *ex parte* reexamination proceeding with the '094 *inter partes* reexamination proceeding. Sony's desire to have the Office consider in the *inter partes* reexamination context all the issues that Sony has raised in the *ex parte* reexaminations would improperly circumvent 35 U.S.C. § 317(a), which prohibits a third party requester from raising issues in a second *inter partes* reexamination when the third party has already triggered a pending *inter partes* reexamination. That prohibition, in view of the facts of the present case, also militates against granting Sony's petition to merge the two sets of proceedings. In other words, a third party should not be able circumvent § 317(a)'s prohibition by (i) triggering an *inter partes* reexamination limited to certain issues, (ii) raising new issues in an *ex parte* proceeding, and then (iii) automatically

[10] Should the Federal Circuit remand or vacate the lower court's validity findings, the Office at that time can consider reviewing the suspension decision as well as the question of merging the proceedings.

expecting the *ex parte* proceeding to be merged with the pending *inter partes* proceeding, let alone an *inter partes* proceeding that has been suspended for "good cause," which has already been affirmed by a district court.

CONCLUSION

1) The Sony (i.e., third party requester) petitions are

   Granted as to the request under 37 CFR 1.183 for waiver of the rules to permit entry and consideration of the petitions, and

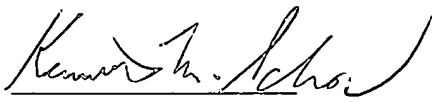
   Denied as to the request under 37 CFR 1.183 for merger, i.e., as to the underlying relief requested.

2) The above-captioned '093 and '094 *inter partes* reexamination proceedings remain suspended until the U.S. Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal identified above.

3) The above-captioned '843 and '844 *ex parte* reexamination proceedings are ready for action, and jurisdiction over the '843 and '844 proceedings is transferred to the examiner for that purpose.

4) The parties to the'093 and '094 *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

5) 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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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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JAN 30 2008

CENTRAL REEXAMINATION UNIT

James F. Vaughan (For Patent Owner)
Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Providence, RI 02903-7128

Marcus J. Millet (For Requester)
Lerner David Littenberg Kremholz & Mentl
600 South Avenue West
Westfield, NJ 07090

In re: Tremblay *et alia*	:
Reexamination Proceeding	: DECISION DISMISSING
Control No. 90/007,843	: AS MOOT PETITION
Request Deposited: December 13, 2005	: UNDER 37 CFR 1.181
For: U.S. Patent No. 6,275,213	:

This is a decision on the December 31, 2007, patent owner "PETITION UNDER 37 CFR 1.181" requesting that the office action mailed November 1, 2007 be withdrawn and a new office action remailed.

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

The petition is dismissed as moot with respect to the requested relief for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent), issued to Tremblay *et alia*, on August 14, 2001.

2. On December 13, 2005, a third party deposited a Substitute Request for *Ex Parte* Reexamination of the '213 patent. The reexamination proceeding was assigned Control No. 90/007,843 (hereinafter, the '7843 proceeding).

3. The reexamination order was granted in the '7843 proceeding on March 9, 2006.

4. A non-final office action was mailed on November 1, 2007.

5. The office action of November 1, 2007 was withdrawn and a new office action was mailed on January 25, 2008.

DECISION

Upon review of the office action mailed November 1, 2007, errors were found that necessitated issuance of a new office action. The errors were unrelated to the arguments set forth by petitioner. A new office action was mailed on January 25, 2008. Accordingly, the present petition is dismissed as moot. The merits of the arguments in the petition are not discussed in the present decision.

CONCLUSION

1. Petitioner's request is dismissed as moot. The office action mailed January 25, 2008 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,843	12/13/2005	6275213	SCEA3.6-011	5596

7590 03/03/2008

JAMES F. VAUGHAN
WOMBLE CARLYLE SANDRIDGE & RICE PLLC
P.O. BOX 7037
ATLANTA, GA 30357

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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James F. Vaughan
Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Atlanta, GA 30357

(For Patent Owner)

MAILED

MAR 03 2008

CENTRAL REEXAMINATION UNIT

Marcus J. Millet
Lerner David Littenberg Kremholz & Mentl
600 South Avenue West
Westfield, NJ 07090

(For Requester)

In re: Tremblay *et alia*	:
Reexamination Proceeding	: DECISION DISMISSING
Control No. 90/007,843	: AS MOOT PETITION
Request Deposited: December 13, 2005	: UNDER 37 CFR 1.181
For: U.S. Patent No. 6,275,213	:

This is a remailing of the decision originally mailed January 30, 2008 with the address of Patent Owner corrected. The decision is repeated below.

This is a decision on the December 31, 2007, patent owner "PETITION UNDER 37 CFR 1.181" requesting that the office action mailed November 1, 2007 be withdrawn and a new office action remailed.

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

The petition is dismissed as moot with respect to the requested relief for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent), issued to Tremblay *et alia*, on August 14, 2001.

2. On December 13, 2005, a third party deposited a Substitute Request for *Ex Parte* Reexamination of the '213 patent. The reexamination proceeding was assigned Control No. 90/007,843 (hereinafter, the '7843 proceeding).

3. The reexamination order was granted in the '7843 proceeding on March 9, 2006.

4. A non-final office action was mailed on November 1, 2007.

5. The office action of November 1, 2007 was withdrawn and a new office action was mailed on January 25, 2008.

DECISION

Upon review of the office action mailed November 1, 2007, errors were found that necessitated issuance of a new office action. The errors were unrelated to the arguments set forth by petitioner. A new office action was mailed on January 25, 2008. Accordingly, the present petition is dismissed as moot. The merits of the arguments in the petition are not discussed in the present decision.

CONCLUSION

1. Petitioner's request is dismissed as moot. The office action mailed January 25, 2008 is before Patent Owner for response.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

JUL 03 2006

CENTRAL REEXAMINATION UNIT

Marcus J. Millet
LERNER, DAVID, LITTENBERG, KRUMHOLZ
& MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

(For Requester)

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,093
Filed: May 17, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 95/000,094
Filed: May 19, 2005
For: U.S. Patent No.: 6,275,213

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 90/007,844
Filed: December 13, 2005
For: U.S. Patent No.: 6,424,333

In re Mark R. Tremblay et al.
Reexamination Proceeding
Control No.: 90/007,843
Filed: December 13, 2005
For: U.S. Patent No.: 6,275,213

DECISION
DENYING
PETITIONS

This is a decision on the April 11, 2006 requester (hereinafter "requester" or "Sony") petitions filed (a) under 37 CFR 1.183 for waiver of the rules to permit entry of the petitions, and (b) under 37 CFR 1.182 for merger of:

1. Reexamination Control No.: 90/007,844 with Reexamination Control No.: 95/000,093, and

2. Reexamination Control No.: 90/007,843 with Reexamination Control No.: 95/000,094.[1]

On May 3, 2006, the patent owner (hereinafter "patent owner" or "Immersion") filed oppositions to Sony's petitions.

The petition fee of $400 set forth in 37 CFR 1.17(f) for each of the present petitions under 37 CFR §§ 1.182 and 1.183 has been charged to Sony's Deposit Account No. 12-1095, in accordance with petitioner's authorization at the last sentence of page 2 of the April 11, 2005 petitions. A total of $800 will be charged for the two petitions directed to the two sets of proceedings

The petitions and oppositions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office ("USPTO" or "Office").

For reasons set forth below, Sony's petitions are:

Granted as to the request under 37 CFR 1.183 for waiver of the rules to permit entry and consideration of the petitions; and

Denied as to the request under 37 CFR 1.183 for merger, i.e., as to the underlying relief requested.

BACKGROUND

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent) issued on July 23, 2002, including claims 1-18.

2. U.S. Patent No. 6,275,213 (hereinafter, the '213 patent) issued on August 14, 2001, including claims 1-60.

3. The patent owner, Immersion, obtained a jury verdict (Civil Action No. 02-0710 CW) in the

[1] See the penultimate paragraph of the second page of the petitions which identifies the petitions as being filed under 37 CFR §§ 1.182 and 1.183.

United States District Court for the Northern District of California, finding that Sony (the real party in interest for the instant requests for reexamination) infringed claims 14-18 the '333 patent, and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent. The jury also found that claims 14-18 of the '333 patent and claims 7, 41-46, 49, 50, 53, and 54 of the '213 patent were not invalid.[2]

4. Judgment was entered in Civil Action No. 02-0710 CW on March 24, 2005, in favor of Immersion against Sony on Immersion's claims of infringement of the '333 and '213 patents.[3] Judgment was also entered in Immersion's favor as to Sony's counter-claims for declaratory judgment of non-infringement. In a separate order, the court also issued a permanent injunction against Sony, stayed pending appeal to the Federal Circuit, and imposed a compulsory license fee for the duration of the stay.[4]

5. On May 17, 2005, Sony filed a request for *inter partes* reexamination of claims 1 and 14-18 of the '333 patent, assigned control No. 95/000,093 (the '093 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '333 patent was <u>not</u> litigated in the district court proceeding.

6. On May 19, 2005, Sony filed a request for *inter partes* reexamination of claims 1, 7, 41-46, 49, 50, 53, and 54 of the '213 patent, assigned control No. 95/000,094 (the '094 proceeding). Of the claims for which reexamination was requested, the validity of only claim 1 of the '213 patent was <u>not</u> litigated in the district court proceeding.

7. On June 16, 2005, Sony appealed the district court decision to the U.S. Court of Appeals for the Federal Circuit (Appeal Nos. 05-1227, 1358 and 1441). The appeal is still pending.

8. On July 6, 2005, Immersion filed petitions to dismiss or suspend the instant *inter partes* reexamination proceedings pursuant to 37 CFR §§ 1.181, 1.182, 1.183, 1.987, and 35 U.S.C. § 314(c).

9. On July 29, 2005, Sony filed petitions and oppositions under 37 CFR 1.183 in response to Immersion's petitions.

10. On August 5, 2005, Immersion filed a reply to Sony's oppositions.[5]

11. On August 17, 2005, the Office issued orders granting the requests for *inter partes* reexamination in both the '093 and '094 reexamination proceedings, finding that the requests raised a substantial new question of patentability regarding (a) claims 1 and 14-18 of the '333 patent and (b) claims 1, 7, 41-46, 50, 53, and 54 of the '213 patent.

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[2] 2005 U.S. Dist. LEXIS 4784.
[3] 2005 U.S. Dist. LEXIS 4781.
[4] 2005 U.S. Dist. LEXIS 4784.
[5] MPEP § 2646 prohibits petitioner filing of such a reply, and the patent owner's reply was accordingly not considered.

12. On August 23, 2005, the Director of the Office of Patent Legal Administration issued a decision denying the petitions to dismiss or suspend the '093 and '094 *inter partes* reexamination proceedings (in the decision, it was noted that claim 1 in each reexamination was not part of the concurrent pending litigation).

13. On September 9, 2005, Immersion filed (a) renewed petitions to suspend the '093 and '094 *inter partes* reexamination proceedings, and (b) a statutory disclaimer of claim 1 in each of the '333 and '213 patents.

14. On September 12, 2005, Immersion filed a petition in the two *inter partes* reexamination proceedings requesting that the Office of Patent Legal Administration retain jurisdiction over the two proceedings, pending resolution of the matter petitioned in the September 9, 2005 petitions. Jurisdiction over the two proceedings was, in fact, retained by the Office of Patent Legal Administration.

15. On September 26, 2005, Sony filed an opposition to the petitions to suspend the *inter partes* reexamination proceedings.

16. On October 21, 2005, Sony filed its principal brief in the Federal Circuit appeal. On March 15, 2006, Immersion filed its corrected substitute brief.

17. On November 17, 2005, the Director of the Office of Patent Legal Administration issued a decision granting Immersion's petitions, finding "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings until the U.S. Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal, in view of the statutory disclaimer of claim 1 of both the '213 and '333 patents.

18. On December 13, 2005, Sony filed requests for *ex parte* reexamination of claims 2, 3, 5, 6, 7, 15, 16, 17, 20, 21, 25, 41, 42, 43, 44, 45, 46, 49, 50, 53 and 54 of the '213 patent and claims 2, 3, 4, 5, 6, 7, 8, 9, 12, 13, 14, 15, 16, 17 and 18 of the '333 patent, the requests being assigned control Numbers 90/007,843 (for reexamination of the '213 patent) and 90/007,844 (for reexamination of the '333 patent).

19. On December 15, 2005, Sony filed petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a), requesting that the USPTO Director authorize Sony to file <u>additional</u> requests for *inter partes* reexamination of the '333 and '213 patents, in order to permit Sony to request *inter partes* reexamination of certain claims of the '213 and '333 patents that it failed to request in its initial set of *inter partes* reexamination requests, dated May 17 and 19, 2005.

20. On January 23, 2006, Immersion filed oppositions to Sony's petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

21. On March 9, 2006, a substantial new question of patentability (SNQ) was found for claims 2, 3, 5, 6, 15, 16, 17, 20, 21 and 25 of the '213 patent and for claims 2, 3, 4, 5, 6, 7, 8, 9, 12 and

13 of the '333 patent, and *ex parte* reexamination proceedings 90/007,843 and 90/007,844 (hereinafter, the '843 and '844 proceedings) were ordered.

22. On March 22, 2006, the Senior Legal Advisor of the Office of Patent Legal Administration issued a decision dismissing Sony's December 15, 2005 petitions under 37 CFR 1.907(a) and 35 U.S.C. § 317(a).

23. On April 11, 2005, Sony filed the instant petitions. The instant petitions are filed under 37 CFR 1.183 for waiver of the rules to permit entry of the petitions, and under 37 CFR 1.182 for merger of the '844 and '093 proceedings, and merger of the '843 and '094 proceedings.

24. On May 3, 2006, Immersion filed oppositions to Sony's merger petitions.

25. On December 13, 2005, Sony brought action in the United States District Court, Eastern District of Virginia, pursuant to the Administrative Procedure Act (APA), 5 U.S.C. §§ 701-706, to obtain judicial review of the Office's November 17, 2005 petition decision suspending the '093 and '094 *inter partes* reexamination proceedings. Specifically, Sony sought review of the Office's November 17, 2005 decision which found that "good cause" existed under 35 U.S.C. § 314(c) to suspend the just-commenced '093 and '094 *inter partes* reexamination proceedings with respect to certain claims in the '213 and '333 patents on the ground that the validity of those claims were already the subject of an ongoing appeal in the U.S. Court of Appeals for the Federal Circuit. Sony argued that the Office abused its discretion in suspending the proceedings, contending the Office had a legal obligation to reexamine all claims in the patents (except the two disclaimed claims), including the claims Sony failed to request for reexamination.

26. On May 22, 2006, the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462, issued a decision in favor of the Office. The decision upheld the Office's finding of "good cause" to suspend the '093 and '094 *inter partes* reexamination proceedings and also upheld the Office's discretion to not reexamine claims of the '213 and '333 patents for which *inter partes* reexamination was not requested.

27. A patent owner's statement under 37 CFR 1.530 has not been received in the '843 and '844 *ex parte* reexamination proceedings, and the time for filing such statement has expired.

DECISION WAIVNG RULES, TO PERMIT CONSIDERATION OF MERGER PETITIONS

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)."

The present petitions do not have an entry right under the rules. *See* 37 CFR 1.510, 1.535, and 1.550. The appropriate provisions of the rules are, however, waived to permit consideration of the instant Sony merger petitions, based upon the specific facts and unique circumstances of the present situation, as well as statements made in the Office's March 22, 2006 decision dismissing Sony's petitions to file additional requests for *inter partes* reexamination. Likewise, the appropriate provisions of the rules are *sua sponte* waived to permit consideration of Immersion's oppositions to the merger petitions.

DECISION ON MERGER PETITIONS

37 CFR 1.989(a) provides:

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997. [Emphasis added].

In addition, MPEP 2686.01(I) provides:

> "If a second request for reexamination is filed where a certificate will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings **normally** will be merged once reexamination has been ordered in both proceedings. In this situation the second request is decided based on the original patent claims and if reexamination is ordered in the second proceeding, the reexamination proceedings **normally** would be merged."

Reexamination of the '333 patent has been ordered in the '844 *ex parte* proceeding and '093 *inter partes* proceeding, and reexamination of the '213 patent has been ordered in the '843 *ex parte* proceeding and '094 *inter partes* proceeding. In addition, a patent owner's statement under 37 CFR 1.530 has not been received in the '844 and '843 proceedings, and the time for filing such has expired. [6] [7] Accordingly, a decision under 1.989(a) on the Sony petitions for merger is timely.

The issue to be decided is whether the *ex parte* reexaminations should be merged with the respective *inter partes* reexaminations. The present petitions raise a novel question regarding merger practice, because, pursuant to 35 U.S.C. § 314(c), the present '093 and'094 *inter partes* reexaminations are currently suspended.

At page 3 of the petitions, Sony argues that:

> "there is every reason to merge the two proceedings, and no proper reason to refrain from such merger. As set forth in M.P.E.P. § 2686.01, '[i]f a second request for reexamination is filed where a certificate will issue for a first reexamination later than three months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings.' Here, all of the proceedings are at a relatively early stage; reexamination has been ordered in all of the proceedings, but no first Official Action has been issued in any of the proceedings. As the Office has already held that 'it is not in the Office's interest to conduct a piecemeal reexamination of a patent' because a reexamination of any claim 'will already require the Examiner to review the written description, the drawings, other claims in the patent and the prior art,' and accordingly, there is relatively little additional effort to reexamine all claims instead of just some' in a given reexamination proceeding. (Decision Denying Petitions dated August 23, 2005 in the '093 and '094 *Inter Partes* Reexaminations at 13.) There is no reason for the Office to consider the same issues twice, rather than once."

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, as with the Office's decisions to reexamine claims beyond those requested and to suspend an *inter partes* reexamination for "good cause," the Office's

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[6] Pursuant to MPEP 2283(III), "[I]f Request 2 is granted, the order in the second proceeding should be mailed immediately. The two requests should be held in storage until the patent owner's statement and any reply by the requester have been received in Request 2, or until the time for filing same expires."

[7] As to the suspended '093 and '094 proceedings, there is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding.

decision to merge two reexaminations is a purely discretionary act. *See Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas,* 2006 WL 1472462 (E.D.Va. May 22, 2006).

First, the statute does not require the Office to merge or consolidate multiple reexamination proceedings. In fact, the statute is silent as to this procedural issue. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a) ("If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings." (Emphasis added)). Furthermore, while the MPEP states that the Office will "normally" merge two reexaminations, that general policy does not address the unique circumstances here, in which one set of proceedings has been suspended. Indeed, the Office has never had to address the question of dissolving a suspension order for the sake of merging proceedings.

Pursuant to 35 U.S.C. 314(c), the USPTO Director may suspend an *inter partes* reexamination proceeding "for good cause." In the present instance, the Office's November 17, 2005 petition decision suspended the '093 and '094 *inter partes* reexamination proceedings because the Federal Circuit appeal on the same patent claims was far advanced in comparison to the *inter partes* reexamination proceedings, which had only recently been commenced. Thus, there was ample "good cause" to suspend the *inter partes* reexamination proceedings pending completion of the Federal Circuit appeal, in view of the statutory estoppel that would operate upon a final decision on the claims by the Federal Circuit. *See* 35 U.S.C. § 317(b).

Further, the U.S. District Court for Eastern District of Virginia upheld the Office decision to suspend the '093 and '094 *inter partes* reexamination proceedings, stating that "the PTO did not abuse its discretion in concluding that there was good cause to suspend reexamination of the litigated claims in light of the more advanced Federal Circuit appeal focusing on the same claims...." [8] The District Court found that "the PTO's decision to suspend *inter partes* review of the patent claims in issue here was clearly supported by good cause and therefore well within the bounds of the PTO's discretion." [9] Thus, Sony has already appealed the merits of the suspension order, but the court rejected that challenge.

Based on the above, the requested merger of the '844 *ex parte* reexamination proceeding with the '093 *inter partes* reexamination proceeding would consolidate a suspended *inter partes* proceeding with an *ex parte* proceeding which must go forward with special dispatch. *See Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). The same would be true for the requested merger of the '843 *ex parte* reexamination proceeding with the '094 *inter partes* reexamination proceeding. In each instance, the requested merged proceeding would be required to proceed with special dispatch, based on the presence of the *ex parte* reexamination

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[8] *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas,* 2006 WL 1472462, Slip Copy at 11.
[9] *Id.* ,at 7.

proceeding. Thus, the merger of the two sets of proceedings would necessarily require dissolving the Office's decision to suspend the *inter partes* reexamination proceedings.

While Sony is correct that the Office usually prefers to avoid piecemeal reexamination, merging the two sets of proceedings in the present instance would clearly circumvent the Office's suspension decision of the *inter partes* reexamination proceedings, which was approved by the District Court based upon the reasoning advanced by the Office. Indeed, merging the proceedings here would render the Office's discretion to suspend meaningless, and would defeat the whole purpose behind the suspension decision, *i.e.*, to await the final outcome on the litigated claims. Furthermore, such a result would undermine the legislative intent underlying 35 U.S.C. 314(c) (expressly providing the Office with discretion to find "good cause" to suspend). In view of the foregoing, the more appropriate course is to preserve the suspension decision (and all the reasoning given therein) and deny the merger petition, rather than permit Sony to collaterally attack the suspension order (which has already been affirmed by the District Court). In other words, the Office does not find that its concern over piecemeal reexamination overrides, in this instance, the reasoning for why the Office suspended the *inter partes* reexamination proceedings. Moreover, there will not be any piecemeal reexamination if the Federal Circuit affirms the District Court's decision as to validity, because the *inter partes* reexaminations will be terminated under 35 U.S.C. 317(b) and 37 CFR 1.907(b).[10]

Accordingly, the request for merger is denied.

It is also noted that pursuant to 37 CFR 1.989(b):

> "An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560."

In the present instance, a merger of the '844 *ex parte* reexamination proceeding with the '093 *inter partes* reexamination proceeding would inappropriately provide Sony, as the third party requester of the *inter partes* reexamination, with *inter partes* participation rights as to the entirety of '844 *ex parte* reexamination proceeding, in which Sony's rights of participation are currently limited by the *ex parte* reexamination statute. Again, the same would be true for a merger of the '843 *ex parte* reexamination proceeding with the '094 *inter partes* reexamination proceeding. Sony's desire to have the Office consider in the *inter partes* reexamination context all the issues that Sony has raised in the *ex parte* reexaminations would improperly circumvent 35 U.S.C. § 317(a), which prohibits a third party requester from raising issues in a second *inter partes* reexamination when the third party has already triggered a pending *inter partes* reexamination. That prohibition, in view of the facts of the present case, also militates against granting Sony's petition to merge the two sets of proceedings. In other words, a third party should not be able circumvent § 317(a)'s prohibition by (i) triggering an *inter partes* reexamination limited to certain issues, (ii) raising new issues in an *ex parte* proceeding, and then (iii) automatically

[10] Should the Federal Circuit remand or vacate the lower court's validity findings, the Office at that time can consider reviewing the suspension decision as well as the question of merging the proceedings.

expecting the *ex parte* proceeding to be merged with the pending *inter partes* proceeding, let alone an *inter partes* proceeding that has been suspended for "good cause," which has already been affirmed by a district court.

CONCLUSION

1) The Sony (i.e., third party requester) petitions are

   Granted as to the request under 37 CFR 1.183 for waiver of the rules to permit entry and consideration of the petitions, and

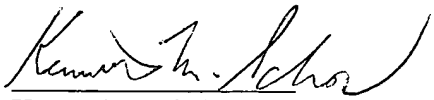
   Denied as to the request under 37 CFR 1.183 for merger, i.e., as to the underlying relief requested.

2) The above-captioned '093 and '094 *inter partes* reexamination proceedings remain suspended until the U.S. Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal identified above.

3) The above-captioned '843 and '844 *ex parte* reexamination proceedings are ready for action, and jurisdiction over the '843 and '844 proceedings is transferred to the examiner for that purpose.

4) The parties to the'093 and '094 *inter partes* reexamination proceedings should keep the Office apprised of the progress of the appeal in the concurrent litigation and notify the Office when that appeal has been resolved.

5) 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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James F. Vaughan (For Patent Owner)
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MAILED
OCT 29 2007
CENTRAL REEXAMINATION UNIT

In re: Trembley *et alia*	: DECISION GRANTING
Reexamination Proceeding	: ONE MONTH PETITION
Control No. 90/007,844	: FOR EXTENSTION OF TIME
Request Deposited: December 13, 2005	: [37 CFR 1.550(c)]
For: U.S. Patent No. 6,424,333	:

This is a decision on the October 23, 2007, patent owner "Petition for Extension of Time to Respond to Office Action Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action dated October 1, 2007, be extended an additional month.

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.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent), issued to Trembley *et alia*, on July 23, 2002.

2. On December 13, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '333 patent. The reexamination proceeding was assigned Control No. 90/007,844 (hereinafter, the '7844 proceeding).

3. The reexamination order was granted in the '7844 proceeding on March 9, 2006.

4. A non-final office action was mailed on October 1, 2007 setting a shortened period for response of 1 month.

DECISION

The Patent Owner requests an extension of time in which to file a response to the action of October 1, 2007, which set a one month period for response thereto. The request for extension is the first request for an extension of time with respect to the action. The present petition for extension of time was timely filed on September 28, 2007, together with authorization to charge 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 patent owner notes the litigation (that could serve as the basis for setting a shortened statutory period of one month) has been terminated. So the present request would restore the normal two-month response period. Reference is made to the petition for details of this 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 one month is considered sufficient.

Accordingly, the time for filing a reply to the outstanding Office action is extended for one month and therefor the reply is due on December 3, 2007.

CONCLUSION

1. Petitioner's request is granted. The non-final office action mailed October 1, 2007 is before Patent Owner for response. The period for response has been extended to December 3, 2007 (as December 1, 2007 is a Saturday).

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.
90/007,844	12/13/2005	6424333	SCEA3.6-012	7668

7590 11/18/2009

JAMES F. VAUGHAN
WOMBLE CARLYLE SANDRIDGE & RICE PLLC
P.O. BOX 7037
ATLANTA, GA 30357

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2009

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
MARCUS J. MILLET
LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK LLP
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

Date:

MAILED
NOV 18 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007844
PATENT NO. : 6424333
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

JAMES F. VAUGHN	: (For Patent Owner)
WOMBLE CARLYLE SANDRIDGE	:
& RICE PLLC	:
PO BOX 7037	:
ATLANTA GA, 30357	:
MARCUS J. MILLETT	: (For Third-Party Requester)
LERNER DAVID LITTENBERG KRUMHOLZ	:
& MENTLIK LLP	:
600 South Avenue West	:
Westfield, New Jersey 07090	:
In re Tremblay *et alia*	: DECISION ON
Reexamination Proceeding	: PETITION TO ENTER
Control No. 90 / 007,844	: DECLARATION IN *EX PARTE*
Request Deposited: December 13, 2005	: REEXAMINATION
For: U.S. Patent No.6,424,333	:

This is a decision on the August 24, 2009 petition entitled "Petition under 37 CFR 1.181" to have the Declaration of Robert Howe under 37 CFR 1.132 ("declaration") of February 12, 2009 entered. Petitioner seeks relief in the form of entry of the Howe declaration filed February 12. 2009. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is considered pursuant to 37 CFR 1.181; No fee is required.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,424,333 (hereinafter, the '333 patent), issued to Tremblay et alia, on July 23, 2002.

2. On December 13, 2005, a third party deposited a Request for Ex Parte Reexamination of the '333 patent. The reexamination proceeding was assigned Control No. 90/007,844

(hereinafter, the '7844 proceeding).

3. The reexamination order was granted in the '7844 proceeding on March 8, 2006.

4. An interview was held on November 20, 2008.

5. A response to the outstanding office action was received on December 1, 2008.

6. A supplemental response to the office action was received on February 12, 2009. This response included the proposed addition of claims and the Howe declaration. This response was not entered into the file by the examiner.

7. A final rejection was mailed on June 22, 2009. The final rejection noticed Owner of the non-entry of the supplemental reply.

8. A second interview was held on August 3, 2009.

9. On August 24, 2009 the instant petition under 37 CFR 1.181 for entry of the Howe declaration was filed.

DECISION

Petitioner was advised in the interview summary of November 20, 2008 that he may consider submission of a declaration which supports their argument that the SWIFT supplement does not disclose a 'series of impulses'. Petitioner's response of December 1, 2008 did not include such a declaration. Petitioners supplemental response of February 12, 2009 included proposed new claims 23 - 27 and the Howe declaration. Petitioner points to MPEP 2266 which incorporates 37 CFR 1.111 (a) (2) (i) (A) – (F) which proscribe conditions where the office may enter a supplemental reply if the reply is clearly limited to such actions. Petitioner submits entry of the Howe declaration should have been made as it was an adoption of the examiner's suggestion.

In Reexamination, supplemental amendment and argument are not entered as a matter of right, but are limited to situations specifically proscribed in MPEP 2266. Further, the examiner may not choose which parts of an Owner's submission he likes: there is no entry-in-part of responses. (MPEP 714.16(e) identifies an exception which is not relevant here and reiterates the general rule which does not allow entry in part.) MPEP 714.03(a) identifies conditions under which a supplemental reply will be entered, so long as the supplemental reply is limited in the manner described. As the supplemental response of February 12, 2009 proposed to add new claims 23 – 27 to the patent, the response is clearly not limited solely to adoption of the examiner's suggestion. The response fails to meet any of the criteria listed in 37 CFR 1.111 (a) (2) (i) (A) – (F) and accordingly denial of entry of the response by the examiner appears well founded and proper. There is no evidence the examiner abused his discretion in denying entry of the supplemental response which included the Howe declaration.

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, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.

Gregory Morse
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.
90/007,847	12/15/2005	6013338	740756-2888	8243

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

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

SEP 12 2006

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.: 90/007,847
Filed: December 15, 2005
For: U.S. Patent No.: 6,013,338

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the August 14, 2006 patent owner petition under 37 CFR 1.182 to enter and to have the examiner consider an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. Patent number 6,013,338 issued on January 11, 2000 with 52 claims.
2. A request for reexamination, assigned control No. 90/007,847 (the '847 proceeding), was filed on December 15, 2005, by the patent owner.
3. An order granting the reexamination request was mailed January 20, 2006.
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 '847 proceeding on July 24, 2006.
5. The instant petition was filed on August 14, 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 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 these additional 58 documents with their IDS filed on June 6, 2006, and (b) why patent owner waited until August 14, 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 24, 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

"an unsolicited report via email." Furthermore, patent owner has not in any way indicated how the references are material to patentability 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. 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 the 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 requests for consideration of the IDS filed on August 14, 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
c:\Kiva\kenids\decisions\7847 IDS after NIRC mailed before cert issued.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,847	12/15/2005	6013338	740756-2888	8243

22204 7590 11/21/2006

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/21/2006

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

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(For Patent Owner)

MAILED

NOV 21 2006

CENTRAL REEXAMINATION UNIT

In re Takashi Inushima et al.
Reexamination Proceeding
Control No.: 90/007,847
Filed: December 15, 2005
For: U.S. Patent No.: 6,013,338

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 14, 2006 patent owner petition under 37 CFR 1.182. In the August 14, 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 14, 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 14, 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 6,013,338 issued on January 11, 2000 with 52 claims.

2. A request for reexamination, assigned control No. 90/007,847 (the '847 proceeding), was filed on December 15, 2005, by the patent owner.
3. An order granting the reexamination request was mailed January 20, 2006.
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 '847 proceeding on July 24, 2006.
6. On August 14, 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 14, 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 14, 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 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. ... (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 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)

2. Overview:

The instant IDS and the original petition filed August 14, 2006 points out that Patent Owner's counsel received 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 14, 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 24, 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 14, 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 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 14) *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 14, 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 14, 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 24, 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 14, 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 24, 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
11/17/06

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FEB - 8 2007

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(For 3rd Party Requester)

Reexam Control No.: 90/007,853
Filed : December 24, 2005
For U.S. Patent No. : 6,243,999

Reexam Control No.: 90/008,176
Filed : September 12, 2006
For U.S. Patent No. : 6,243,999

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. 90/007,853 was ordered in a decision mailed January 6, 2006. A non-final Office action was mailed May 5, 2006. A response that included amendments to patent claims 1, 12, and 19, and added new claim 26 was filed July 3, 2006. Although new claim 26 was not presented in proper format (i.e., it was not totally underlined as required by 37 CFR 1.530(f)(2), the examiner, to expedite the proceedings considered the amendment and issued a final Office action requesting that any response include a properly amended new claim 26. An amendment in response to the Office action was filed September 25, 2006. The amendment proposed to amend patent claims 1, 2, 5, 7, 12, 13, 19, and 20 as well as new claim 26. The examiner issued an Advisory action on October 31, 2006 indicated that the amendment of September 25, 2006 would not be entered as it raised new issues. A notice of Appeal was filed December 8, 2006 along with a new proposed amendment. This new proposed amendment sought to amend claims 1, 12, 19, and 26. The examiner issued an Advisory action on January 7, 2007 denying entry of the amendment as the claims were not amended according to 37 CFR 1.530(f)(1) and (2). The amendment proposed to delete matter found in the patent by using strike through rather than bracketing; matter added to patent claims was not underlined (for example "solid" added to claim 2 was not underlined); and claim 26, which is new relative to the patent is not totally underlined and includes deleted matter (the deleted matter should not appear at all in a new claim). Thus, the pending claims are those presented with the May 25, 2006 amendment.

Reexamination in application control No. 90/008,176 was ordered in a decision mailed October 20, 2006. On December 18, 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). Patent owner did file an amendment attempting to make the claims in this proceeding identical to those in reexamination proceeding 90/007,853. A Notice of Defective Paper in *Ex Parte* Reexamination was mailed on December 18, 2006 indicating that the communication of December 8, 2006 lacked proof of service as required by 37 CFR 1.248 and 1.540, and that the amendment failed to comply with 37 CFR 1.530(d)-(j). Patent Owner filed the required proof of service on January 19, 2007 but did not cure the claim informalities. Specifically, in claim 1, lines 14 and 20, it is proposed to delete a ";" by striking through it rather than by enclosing it in brackets. Likewise, it is proposed to delete a "." In claim 1, line 28 and claim 19, line 11 by striking through it rather than enclosing it in brackets.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR § 1.565(c)). In view of the above, merger is appropriate and is hereby ordered.

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

As noted above, the claims have been amended in both proceedings. However, the claims are not identical, nor are they in the proper format as required by 37 CFR 1.530(d)-(j). **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 the proper format, 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. 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. 90/007,853 and 90/008,176 are hereby merged. Upon mailing of this decision, both files will be forwarded to the examiner for issuance of an Office action on the merits.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

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(For Patent Owner)

MAILED
MAR 13 2006
REEXAM UNIT

In re: Spencer B. Dick *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,857
Filed: December 27, 2005
For: US Patent No. 6,886,462

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 Petition Requesting Reconsideration And Grant of *Ex Parte* Request for Reexamination of US Patent No. 6,886,462. The timely filed petition was received March 4, 2006.

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

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. US Patent No. 6,886,462 was issued on May 3, 2005.

2. A Patent Owner request for reexamination was filed on December 27, 2006 under control no. 90/007,857.

3. The Order was denied for *ex parte* reexamination in a paper mailed February 10, 2006 due to the Information Disclosure Statement (IDS) identifying the effective date for the non-patent literature document as 2005. The IDS 2005 date rendered the document as unavailable as prior art for the purpose of reexamination of the patent requesting reexamination.

4. The patent owner petitioned for reconsideration of the order denial on March 4, 2006. The Patent Owner identified the 2005 date as a typographical error. The correct date should have been 2000.

5. The petition was timely filed with authorization to charge any required fees.

6. A corrected copy of the IDS listing the correct non-patent literature document date was received by the USPTO on March 9, 2006.

DISCUSSION

The Patent Owner 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. 6,886,462 reexamination proceeding control number 90/007,857.

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.

37 CFR § 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 patent owner'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 90/007,857. The explanation for how the cited reference on the Information Disclosure Statement dated December 27, 2005 was improperly cited is persuasive. The IDS date listed reflects a typographical error. The corrected IDS date of 2000 would render the document as prior art for the purpose of reexamination of the US Patent No. 6,886,462. Thus a 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.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

DECISION

1. The Patent Owner's Petition filed under 37 CFR 1.515 (c) of March 4, 2006 for requesting withdrawal of the Order Denial and thus Granting the reexamination request in proceeding control number 90/007,857 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

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

KOLISCH HARTWELL, P.C.
200 Pacific Building
520 SW Yamhill Street
Portland, OR 97204

(For Patent Owner)

MAILED

JUL 24 2006

CENTRAL REEXAMINATION UNIT

R. Scott Johnson
MCKEE, VORHEES, & SEASE, P.L.C.
801 Grand, Suite 3200
Des Moines, IA 50309-2721

(For Third Party Requester)

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

In re: Spencer B. Dick *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,857
Filed: December 27, 2005
For: US Patent No. 6,886,462

In re: Spencer B. Dick *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,925
Filed: February 10, 2006
For: US Patent No. 6,886,462

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).

REVIEW OF FACTS

1. US Patent No. 6,886,462 was issued on May 3, 2005.

2. A Patent Owner request for reexamination was filed on December 27, 2006 under control no. 90/007,857.

3. The Order was denied for *ex parte* reexamination in a paper mailed February 10, 2006 due to the Information Disclosure Statement (IDS) identifying the effective date for the non-patent literature document as 2005. The IDS 2005 date rendered the document as unavailable as prior art for the purpose of reexamination of the patent requesting reexamination.

4. The patent owner petitioned for reconsideration of the order denial on March 4, 2006. The Patent Owner identified the 2005 date as a typographical error. The correct date should have been 2000.

5. The petition was timely filed with authorization to charge any required fees.

6. A corrected copy of the IDS listing the correct non-patent literature document date was received by the USPTO on March 9, 2006.

7. The order was granted for reexamination of US Patent No. 6,886,462 as control number 90/007,857.

8. A request from a third party requester was filed on February 10, 2006 under control number 90/007,925 for reexamination of US Patent No. 6,886,462.

9. The Order granting reexamination was granted April 14, 2006 for control number 90/007,925.

10. Control numbers 90/007,857 and 90/007,925 are awaiting a first Office action on the merits and there are 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 90/007,857 and 90/007,925 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. 90/007,857 and 90/007,925 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

MReinhart for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,858	12/22/2005	5838906	6620-66570-01	4371

30080 7590 07/24/2007

LAW OFFICE OF CHARLES E. KRUEGER
P.O. BOX 5607
WALNUT CREEK, CA 94596-1607

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/24/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

7/24/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

STEPHEN A. WIGHT
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET, SUITE 1600
PORTLAND, OR 97204

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007858
PATENT NO. 5,838,906
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

Law Office of Charles E. Kruger
P.O. Box 5607
Walnut Creek, CA 94596-1607

(For Patent Owner)

Stephen A. Wight
Klarquist Sparkman LLP
121 SW Salmon Street
Suite 1600
Portland, OR 97204

(For Third Party Requester)

MAILED

JUL 24 2007

CENTRAL REEXAMINATION UNIT

In re
Reexamination Proceeding
Control No.: 90/007,858
Filed: December 22, 2005
For: U.S. Patent No.: 5,838,906 C1

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the July 3, 2007 patent owner petition titled "PETITION TO STAY REEXAMINATION PURSUANT TO 37 C.F.R. § 1.182 AND § 1.565(e)."

The petition and the 95/000,185 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for decision.

The patent owner petition is dismissed.

REVIEW OF SALIENT FACTS

1. Patent number 5,838,906 (the '906 patent) issued on November 17, 1998.
2. The USPTO Director ordered reexamination on October 30, 2003, and the proceeding was assigned control No. 90/006,831 (the '831 reexamination proceeding).
3. On September 27, 2005, a Notice of Intent to Issue Reexamination Certificate was mailed, confirming the patentability of all of the claims of the '906 patent.
4. On June 6, 2006, an *Ex Parte* Reexamination Certificate was published confirming the patentability of all of the claims (claims 1-10) of the '906 patent.
5. On December 22, 2005, a request for reexamination of the '906 patent was filed by the present third party requester, and was assigned control number 90/007,858 (the '858 reexamination proceeding).

6. On February 9, 2006, reexamination was ordered in the '858 reexamination proceeding for claims 1-10 of the '906 patent, based upon a different substantial new question of patentability than had been raised in the prior concluded '831 reexamination proceeding. There has been no first Office action on the merits issued in the '858 reexamination proceeding.
7. On April 17, 2006, patent owner filed a petition under 37 CFR 1.182, requesting relief in the form of an "early interview", *i.e.*, an interview prior to the issuance of the first Office action. [1]
8. The third party requester, then, on May 9, 2006, filed a paper titled "Reply By Third Party Requester Under 37 CFR 1.535."
9. On June 29, 2006, an Office decision was issued, expunging the April 17, 2006 patent owner petition and the May 9, 2006 requester reply from the record, as improper papers, not authorized for filing in a reexamination.
10. On June 18, 2007, the patent owner filed a "Submission Under 37 CFR § 1.565(a)," informing the Office of *Doyle v. Koppolu*, Interference 105,563 McK (the '563 interference proceeding), which was declared between the '906 patent (subject to the present reexamination) and U.S. Patent Application No. 09/442,070. The declaration of interference was entered May 24, 2007.
11. On July 3, 2007, the patent owner filed the present petition to stay the '858 reexamination proceeding, based upon the '563 interference proceeding.

DECISION

MPEP 2284 provides:

> "The general policy of the Office is **that a reexamination proceeding will not be delayed, or stayed, because of an interference** or the possibility of an interference. The reason for this policy is the requirement of 35 U.S.C. 305 that all reexamination proceedings be conducted with "special dispatch" within the Office. In general, the Office will follow the practice of making the required and necessary decisions in the reexamination proceeding and, at the same time, going forward with the interference to the extent desirable." [Emphasis added.]

Accordingly, the requested stay of the '858 reexamination proceeding is not granted, in order to permit the reexamination proceeding to proceed forward with "special dispatch" within the Office, as is mandated by 35 U.S.C. 305. The statutory language is based on the public interest in speedily resolving any reexamination proceeding that is filed. The reexamination requester, the patent owner, and the public have a right to such a resolution. To the extent that the patent owner, in this instance, may be willing to "waive" its right to the statutorily mandated speedy resolution of the substantial new question of patentability as to the patent claims, both the requester and the public have not waived their rights.

---

[1] Patent owner petition filed April 17, 2006, page 18.

Patent owner petitioner urges that the present '858 reexamination proceeding be stayed based upon the '563 interference proceeding because the Board of Patent Appeals and Interferences (the Board) and the Central Reexamination Unit (CRU) "will be making separate determinations on issues of patentability," [2] if the reexamination proceeding is not stayed. Petitioner argues that this could result in different conclusions and a "chaotic situation." However, MPEP 2284, points out that "[d]ecisions in the interference will take into consideration the status of the reexamination proceeding and what is occurring therein." Likewise, any decision as to patentability made in the interference proceeding will be taken into account in the reexamination proceeding. Of course, to ensure consideration, any information from one of the proceedings clearly must be properly and procedurally called to the attention of the deciding official in the other proceeding; however, both proceedings provide mechanisms to do so.

Petitioner argues that the Board is likely to determine the patentability issues "in the interference, before the same issues are finally determined in the reexamination." [3] Initially, it is noted that petitioner does not provide evidence to support that conclusion. In addition, the Board has stated in *Dietz-Band v. Gray*, 73 USPQ2d 1857 (Bd. Pat. App. & Int. 2004) (Reported, unpublished) to the contrary:

> "Experience ... demonstrates that carrying out an interference with "special dispatch" within the meaning of the term in 35 U.S.C. §305 is easier said than done. While most interferences are now being conducted on a regular basis within the two-year goal of 37 CFR §1.610(c), nevertheless two parties are always involved in an interference. Our post-Shaked experience convinces us that an examiner in an *ex parte* reexamination is in a better position than the board in an interference to proceed with "special dispatch." [73 USPQ2d at 1860]

Even if there should be a rare case where petitioner's scenario becomes fact (and petitioner has presented no reason to believe that the present fact-situation would become that rare case), the Board determination will be of record for the benefit of the examination in the reexamination proceeding. On the other hand, if reexamination is stayed (as requested) and there is a delay in finally determining the patentability issues in the interference proceeding, the reexamination proceeding will be inappropriately delayed contrary to the mandate of the statute for special dispatch within the Office.

It is further to be noted that petitioner's arguments as to the potential for "different conclusions," and timing considerations as to the patentability determination, can be made any time a reexamination proceeding is co-pending with an interference proceeding. Yet, MPEP 2284 clearly provides that the general policy of the Office is that a reexamination proceeding will not be stayed, because of an interference proceeding. As to any difficulty that may arise in the future due to the concurrent reexamination and interference proceedings, MPEP 2284 states:

> "It is noted that 37 CFR 41.103 provides the Board with the flexibility to tailor a specific solution to occurrences where reexamination and interference proceedings for the same patent are copending, as such occurrences may arise."

---

[2] Patent owner petition filed July 3, 2007, page 3, first complete paragraph.
[3] Patent owner petition filed July 3, 2007, page 3, last complete paragraph.

Thus, any unique circumstance that may arise in the future can be addressed as it arises.

As a final point with respect to going forward with a reexamination proceeding and an interference proceeding concurrently, the *Dietz-Band v. Gray,* decision is on point. The Board stated in *Dietz-Band*:

> "Theoretically it might be argued that entry of a judgment in an interference against an original claim and issuance of a certificate in a reexamination holding that same original claim unpatentable is unnecessary. In effect, entry of a judgment and publication of a certificate holding a claim to be unpatentable could be argued to be "belt and suspenders" as to the claim. A penetrating analysis will show the contrary. First, **there is no inherent conflict between a judgment against a patent claim (which results in cancellation of the claim) and a certificate (which also results in cancellation of the claim)**. Second, **by keeping the interference and the reexamination separate, one unit of the agency does not disturb the normal operations of another unit of the agency**. In other words, (1) **the examiner proceeds with "special dispatch" [35 U.S.C. §305] to handle the reexamination** to its logical conclusion and **the board proceeds under its two-year guideline [37 CFR §1.610(c)] to handle the interference**, thereby minimizing the need for any patent term adjustment [35 U.S.C. §154]." [73 USPQ2d at 1859][Emphasis added]

Further:

> "We see no reason why a reexamination and an interference cannot proceed simultaneously. As noted above..., each proceeding is conducted (1) by a different unit of the agency, each having its expertise in its own area and (2) with a different purpose in mind." [73 USPQ2d at 1862]

The purpose of the reexamination is to determine whether original patent claims and any proposed amended claims are patentable over prior art patents and printed publications. The purpose of the interference is to resolve priority between the patentee and the applicant so that an examiner can determine whether the applicant is entitled to a patent. There is no inconsistency with pursuing both purposes at the same time, and in fact, it is in the best interest of all parties to do so.

CONCLUSION

1. The patent owner petition is <u>dismissed</u>.

2. The '858 *ex parte* reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit, Art Unit 3992.

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

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

July 24, 2007
C:\kiva\kenpet6\UV\ stay\7858 stay reexam for interference.doc

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 07 2007

CENTRAL REEXAMINATION UNIT

Law Office of Charles E. Kruger
P.O. Box 5607
Walnut Creek, CA 94596-1607

(For Patent Owner)

Stephen A. Wight
Klarquist Sparkman LLP
One World Trade Center
121 SW Salmon Street
Suite 1600
Portland, OR 97204

(For Third Party Requester)

In re	:
Ex Parte Reexamination Proceeding	: **DECISION**
Control No.: 90/007,858	: **DISMISSING**
Filed: December 22, 2005	: **PETITION**
For: U.S. Patent No.: 5,838,906 C1	:

This is a decision on the patent owner paper filed on June 8, 2007 entitled "PETITION UNDER 37 CFR 1.182." The patent owner paper and *ex parte* reexamination proceeding 90/007,858 are before the Office of Patent Legal Administration for consideration.

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

FEES

The patent owner petition has been filed under 37 CFR 1.182, and therefore requires a petition fee under 37 CFR 1.17(f). The petition fee is currently $ 400.00. Office records show that patent owner has remitted the petition fee by credit card concurrently with the filing of the petition.

REVIEW OF SALIENT FACTS

1. Patent number 5,838,906 (the '906 patent) issued on November 17, 1998.
2. The USPTO Director ordered, *sua sponte*, reexamination of the '906 patent on October 30, 2003, and the proceeding was assigned control No. 90/006,831 (the '831 reexamination proceeding).
3. On September 27, 2005, a Notice of Intent to Issue Reexamination Certificate was mailed, confirming the patentability of all of the claims of the '906 patent.
4. On June 6, 2006, an *Ex Parte* Reexamination Certificate was published confirming the patentability of all of the claims (claims 1-10) of the '906 patent.

5. On December 22, 2005, the third party requester filed the present (second) request for reexamination of the '906 patent, which has been assigned control number 90/007,858 (the '858 reexamination proceeding).

6. On February 9, 2006, reexamination was ordered in the '858 reexamination proceeding for claims 1-10 of the '906 patent, based upon a different substantial new question of patentability than had been raised in the prior concluded '831 reexamination proceeding.

7. On November 6, 2006, patent owner submitted an Information Disclosure Statement (hereinafter "IDS") that included information contained on a compact disc (hereinafter "CD"). The Image File Wrapper (IFW) file record shows that the CD was placed in an artifact folder. [1]

8. On January 23, 2007 patent owner submitted another IDS that included information contained on a compact disc CD. The Image File Wrapper (IFW) file record shows that this CD was also placed in an artifact folder.

9. On June 8, 2007, the present patent owner petition was filed.

10. A first office action on the merits was mailed on July 30, 2007.

DECISION

I. Pertinent Regulations and Examining Practice

37 CFR 1.52(e) provides in pertinent part:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:
>
> (i) A computer program listing (see § 1.96);
>
> (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
>
> (iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).
>
> (2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.
>
> (3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.
>
> ...

[1] An artifact form is completed and scanned for each artifact at the time the time the artifact is receive in the mailroom. The scanned form becomes part of the IFW file. An artifact is any non-scannable item included in a patent application, for example, videotapes, bound documents, CDs. Artifacts are stored in Artifact Folders.

37 CFR 1.98 provides:

(a)Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each foreign patent;

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed.

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified
in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

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

> 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).

The Legal Framework For EFS-Web, July 2007, provides:

> I. Introduction - Scope of Document
>
> This Legal Framework provides guidance on the background statutes, regulations and policies that support the Electronic Filing System - Web (EFS-Web) project. The document is provided as a reference for applicants, parties in reexamination proceedings, attorneys, and agents, as well as their staffs using the system.
>
> ...
>
> III. EFS-Web
>
> The EFS-Web interface is a streamlined approach to eFiling. EFS-Web integrates well with the current workflow for most inventors (applicants), reexamination parties, law firms, and corporations and other business entities. EFS-Web collects minimal data elements on screen. Needed patent information, however, is collected on form fillable PDF, or user created PDF files attached to the submission.
>
> ...
>
> IV. Relevant Statutes and Rules
>
> 35 USC 111 - filing a patent application
> 35 USC 302, 311 - filing a request for reexamination
> 37 CFR 1.52 - form of an application/reexamination
> 37 CFR 1.4 - signatures
> 37 CFR 1.6 - receipt of correspondence
>
> ...
>
> XXII. May a reissue application or a request for reexamination, and follow on papers be submitted via EFS-Web?
>
> Yes, the Summer 2007 update to EFS-Web permits a user to electronically submit a reissue application under 35 USC 251 and follow-on papers, a request for ex parte reexamination under 35 USC 302 and follow-on papers, or a request for inter partes reexamination under 35 USC 311 and follow-on papers. In reexamination, both the reexamination requester and the patent owner may file via EFS-Web.

II. Findings and Analysis

A. 37 CFR 1.182 Petition

On November 6, 2006 and on January 10, 2007, patent owner has filed papers styled as an Information Disclosure Statement (IDS). Each filing was accompanied by paper documents, and also by one or more compact discs (CDs). The present patent owner petition appears to be an attempt to obtain approval of the previous IDS filings. Specifically, patent owner requests clarification, pursuant to 37 CFR 1.182, of whether information may be submitted on one or more CDs under 37 CFR 1.98 if the CDs can be read using a Windows PC.

It is not clear from the record, or from the present June 8, 2007 patent owner petition, whether the paper documents filed on November 6, 2006 and January 10, 2007, represent all, or only part of, the information submitted on the CDs, or whether the paper documents contain information in addition to that submitted on the CDs. Further, it is not even clear from the petition whether petitioner is now seeking approval to submit court documents other than documents that have been included in the previously filed IDS statements. (It is to be noted that court documents that are not, *per se*, prior art documents, are not submitted pursuant to 37 CFR 1.98, or pursuant to 37 CFR 1.97, a rule that is referenced in 37 CFR 1.98. Rather, such documents are to be filed pursuant to 37 CFR 1.565(a)[2], and in accordance with the practice discussion in MPEP § 2282.)

In any event, a review of 37 CFR 1.98 and 37 CFR 1.565(a) shows that neither rule states that the filing of information pursuant is permitted to be accomplished by filing one or more CDs, merely because the CDs may be read using a Windows PC. Rather, 37 CFR 1.52(e) expressly defines the types of documents that are permitted to be filed on a CD rather than on paper. 37 CFR 1.52(e) also defines the type of electronic file format in which the documents must be presented on the CD. Thus, the mere fact that a CD may be readable on a Windows PC does not mean that the CD is in an electronic file format that satisfies the express requirements of 37 CFR 1.52(e)(3)(i). In fact, patent owner has not demonstrated that <u>any</u> of the documents that have been filed by patent owner on one or more CDs on either November 6, 2006 or January 10, 2007, comply with all of the provisions of 37 CFR 1.52(e), either as to content or to the electronic file format in which the documents are presented.

Due to the lack of clarity as to precisely what relief patent owner is seeking in this petition, and due to the fact that there is a rule that addresses the issue of submitting information on one or more CDs, therefore implicating 37 CFR 1.183, and not 37 CFR 1.182, patent owner has not established any basis for relief under 37 CFR 1.182.

B. 37 CFR 1.183 Petition

Even if the present patent owner petition is considered under 37 CFR 1.183 as a request to waive the general provisions of 37 CFR 1.52(e) that (1) list the specific types of document that may be filed on a CD, and (2) require that such files be in the particular electronic file format specified by 37 CFR 1.152(e), the petition is not grantable. Patent owner has not demonstrated an extraordinary situation in which justice would presently require waiver of 37 CFR 1.52.

As a basis for seeking relief, patent owner relies upon the burden on patent owner of the cost of

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[2] 37 CFR 1.565(a) provides, in pertinent part, that "[I]n an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings.

filing and storing a voluminous amount of paper, as well as upon the burden on the Office of handling and story a voluminous amount of paper. However, as of the date of the present decision, patent owner may now submit the documents in question utilizing the electronic EFS-Web filing system. Filings that utilize the EFS-Web system will become part of an electronic Image File Wrapper (IFW), which stores the filings as electronic image files, not as paper documents. Therefore, there is no longer a cost or storage burden on PTO with respect to documents filed utilizing the EFS-Web electronic filing system. It is also to be noted that documents so filed are available to patent owner, and that patent owner may therefore elect to utilize such storage, and/or storage on CD or other electronic medium, to reduce the burdens of storage and costs on patent owner. Therefore, patent owner has not demonstrated an entitlement to relief under 37 CFR 1.183.

CONCLUSION

1. The patent owner petition filed on June 8, 2007, is dismissed.

2. The examiner will consider only the documents that have filed on November 6, 2006 and January 10, 2007 in paper format.

3. If any documents considered in the July 30, 2007 Office action have not been submitted as

3. The '858 *ex parte* reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit, Art Unit 3992, for appropriate action in due course.

4. Telephone inquiries related to this decision should be directed to undersigned at (571) 272-7743, or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.

Stephen Marcus, Legal Advisor
Office of Patent Legal Administration

sm
September 4, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,858	12/22/2005	5838906	6620-66570-01	4371

30080 7590 09/22/2008

LAW OFFICE OF CHARLES E. KRUEGER
P.O. BOX 5607
WALNUT CREEK, CA 94596-1607

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/22/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

STEPHEN A. WRIGHT
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET, SUITE 1600
PORTLAND, OR 97204

MAILED
SEP 22 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,858*.

PATENT NO. *5838906*.

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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United States Patent and Trademark Office
P.O. Box 1450
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Law Offices of Charles Krueger
PO Box 5607
Walnut Creek, CA 94596-1607

(For Patent Owner)

MAILED

SEP 22 2008

CENTRAL REEXAMINATION UNIT

Stephen A. Wright
Klarquist Sparkman LLP
121 SW Salmon Street, Suite 1600
Portland, OR 97204

(For Requester)

In re Doyle *et alia*
Reexamination Proceeding
Control No. 90/007,858
Request Deposited: December 22, 2005
For: U.S. Patent No. 5,838,906

: DECISION DISMISSING
: AS MOOT PETITION
: FOR EXTENSION OF TIME
: 37 CFR 1.550(c)
:

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of the petition filed August 19, 2008 requesting an extension of time.

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,838,906 (hereinafter, the '906 patent), issued to Houser, on August 12, 1997.

2. On December 22, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '906 patent. The reexamination proceeding was assigned Control No. 90/007,858 (hereinafter, the '7858 proceeding).

3. The reexamination order was granted in the '7858 proceeding on February 9, 2006.

4. Later in prosecution, a timely Notice of Appeal was filed on July 18, 2008.

5. The present petition was filed on August 19, 2008.

6. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on September 10, 2008.

DECISION

The Patent Owner requests an extension of time in which to file an appeal brief. The present petition for extension of time was timely filed on August 19, 2008, together with authorization to charge 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.

ANALYSIS AND FINDINGS

Since the NIRC mailed prior to the deadline to file the Appeal Brief, no additional time is necessary. Accordingly, the request for an extension of time is dismissed as moot.

CONCLUSION

1. Petitioner's request is dismissed as moot.

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

Gregory Morse
Director, Central Reexamination Unit

mad

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Mailed : 06/06/06

DDJ

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

(for Patent Owner)

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

(for Third Party Requester)

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

(for Third Party Requester)

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JUN 0 6 2006

REEXAM UNIT

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

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

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 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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Wendy M. Lee (For Patent Owner)
For : Genentech, Inc.
1 DNA Way
South San Francisco, CA 94080-4990

MAILED

MAR 21 2007

CENTRAL REEXAMINATION UNIT

Lisa V. Mueller (For First Third Party Requester)
Wood, Phillips, Katz, Clark & Mortimer
500 West Madison Street,
Suite 3800 Chicago, IL 60661

Elliot M. Olstein (For Second Third Party Requester)
Carella, Byrne, Bain, Gilfillan, Cecchi,
Stewart & Olstein
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Roseland, New Jersey 07068

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

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

3/19/07
C:\kiva\kenpet6\RCR\7542_ applied-new-ref&made final.doc

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P.O. BOX 1450
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Wendy M. Lee (For Patent Owner)
For : Genentech, Inc.
1 DNA Way
South San Francisco, CA 94080-4990

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JUN 01 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

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

[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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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 10/09/2007

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

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10/10/07

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ALAN J. GRANT
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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)).

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United States Patent and Trademark Office
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10/10/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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WOOD PHILLIPS KATZ CLARK & MORTIMER
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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)).

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

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EXAMINER

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NOV 21 2007
CENTRAL REEXAMINATION UNIT

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(Patent Owner)

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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	:	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 724.02," 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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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.
90/007,542	05/13/2005	6331415	22338-10230	7585

47554 7590 05/05/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
www.uspto.gov

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

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

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
5 BECKER FARM ROAD, 2ND FLOOR
ROSELAND, NJ 07068

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
www.uspto.gov

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

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

David L. Fitzgerald
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Lisa V. Mueller
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Suite 3800
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Alan J. Grant
Carella, Byrne, Bain, Gilfillan,
Cecchi, Stewart & Olstein
5 Becker Farm Road, 2nd Floor
Roseland, NJ 07068 (for Requester)

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

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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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David L. Fitzgerald
Sidley Austin LLP
1501 K Street, N.W.
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(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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,861	12/28/2005	6933608	650082.16788	1499

21611 7590 09/05/2007
SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/05/2007

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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SNELL & WILMER LLP (OC) : (for Patent Owner)
600 ANTON BOULEVARD :
SUITE 1400 :
COSTA MESA CA 92626 :

MAILED

SEP 05 2007

CENTRAL REEXAMINATION UNIT

Michael D. Harris
KLEINBERG & LERNER, LLP : (for Third Party Requester)
2049 Century Park East :
Suite 1080 :
Los Angeles, CA 90067 :

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

In re: Fujisawa :
Ex Parte Reexamination Proceeding :
Control No. 90/007,861 :
Filed: December 28, 2005 :
For: US Patent No. 6,933,608 :

In re: Fujisawa :
Ex Parte Reexamination Proceeding :
Control No. 90/008,629 :
Filed: May 4, 2007 :
For: US Patent No. 6,933,608 :

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. 6,933,608 issued on July 10, 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,861 was requested by a third party requester on April 13, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/007,861 on February 10, 2006.

4. There are currently no amendments proceeding control number 90/007,861.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,629 was requested by a third party requester filed on May 4, 2007.

6. The Reexamination Order was granted in proceeding, control no. 90/008,629 on July 19, 2007.

7. There are currently no amendments proceeding control number 90/008,629.

8. Proceedings control numbers 90/007,861 and 90/008,629 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 90/007,861 and 90/008,629 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. 90/007,861 and 90/008,629 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

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Joseph W Price SNELL & WILMER LLP (OC) 600 ANTON BOULEVARD SUITE 1400 COSTA MESA CA 92626	:	(For Patent Owner)
Michael D. Harris KLEINBERG & LERNER, LLP 2049 Century Park East Suite 1080 Los Angeles, CA 90067	:	(for Third Party Requester)
Michael D Harris SOCAL IP LAW GROUP LLP 310 N. WESTLAKE BLVD. STE 120 WESTLAKE VILLAGE, CA 91362	:	(For Third Party Requester)
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS [37 CFR § 1.565(c)]
In re: Fujisawa *Ex Parte* Reexamination Proceeding Control No. 90/007,861 Deposited on: 28 December 2005 For: US Patent No. 6,933,608	:	
In re: Fujisawa *Ex Parte* Reexamination Proceeding Control No. 90/008,629 Deposited on: 4 May 2007 For: US Patent No. 6,933,608	:	
In re: Fujisawa *Ex Parte* Reexamination Proceeding Control No. 90/010,340 Deposited on: 17 November 2008 For: US Patent No. 6,933,608	:	

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FEB 26 2009

CENTRAL REEXAMINATION UNIT

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. 6,933,608 issued on 10 July 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,861 was requested by a third party requester on 13 April 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/007,861 on 10 February 2006.

4. *Ex Parte* Reexamination Proceeding, control no. 90/008,629 was requested by a third party requester filed on 4 May 2007.

5. The Reexamination Order was granted in proceeding, control no. 90/008,629 on 19 July 2007.

6. Proceedings control numbers 90/007,861 and 90/008,629 were merged on 5 September 2007.

7. There are amendments in the merged proceedings 90/007,861 and 90/008,629.

8. *Ex Parte* Reexamination Proceeding, control no. 90/010,340 was requested by a third party requester on 17 November 2008.

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 all of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate for consolidation of the proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/007,861; 90/008,629 and 90/010,340 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.

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

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. 90/007,861; 90/008,629 and 90/010,340 are hereby **merged**.

2. The patent owner's representative is required to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

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; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
for

Gregory A. Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,861	12/28/2005	6933608	650082.16788	1499

21611 7590 05/11/2010
SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2010

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

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Michael D. Harris
SoCal IP Law Group LLP
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(For third party requester)

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MAY 11 2010

CENTRAL REEXAMINATION UNIT

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/007,861
Filed: December 28, 2005
For: U.S. Patent No. 6,933,608

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/008,629
Filed: May 4, 2007
For: U.S. Patent No. 6,933,608

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/010,340
Filed: December 10, 2008
For: U.S. Patent No. 6,933,608

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the March 25, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated merged reexamination ("the March 25, 2010 patent owner petition to revive").[1]

The March 25, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the merged prosecution in this instance, the merged prosecution was "terminated" due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the August 7, 2009 final Office action.

The March 25, 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 ...

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).

37 CFR 41.33 provides, 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 § 41.37may be admitted as provided in § 1.116 of this title.

37 CFR 41.37 provides, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

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).

MPEP 2274 provides, in pertinent part:

I. AMENDMENT

Where the appeal brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the claims of the patent under reexamination in a patentable condition, the amendment may be entered.
*
*
IV. FAILURE TO TIMELY FILE APPEAL BRIEF

Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. ... The reexamination prosecution is then terminated, and a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

DECISION

The 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.

Regarding item (1), the instant merged reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the August 7, 2009 final Office action. Although patent owner filed a Notice of Appeal on December 4, 2009, patent owner failed to follow-up the Notice of Appeal with either (i) an Appeal Brief in accordance with 37 CFR 41.37(a)(1) or (ii) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the merged proceeding in condition for issuance of a reexamination

certificate by making all pending claims patentable, as provided in 37 CFR 41.33(a) and MPEP 2274(I).

Patent owner submitted an Appeal Brief and paid the corresponding fee of $540.00 on March 25, 2010, thereby satisfying item (1).

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 25, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the March 25, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 25, 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 in due course of the March 25, 2010 Appeal Brief.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Erik Kielin, of CRU Art Unit 3992, at (571) 272-1693.

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

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CENTRAL REEXAMINATION UNIT

Ole K. Nilssen 200 N. Harrison St., Suite 103 Algonquin IL 60102	:	(Patent Owner)
Virgil L. Beaston STERNE KESSLER GOLDSTEIN & FOX PLLC 1100 New York Avenue NW Washington, DC 20025-3934	:	(For Third Party Requester)
	:	DECISION GRANTING IN PART PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,864 Filed: January 4, 2006 For: US Patent No. 5,343,123	:	

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 29, 2007, be extended by two months.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed May 29, 2007, which set a two month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on July 6, 2007, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is met by reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner notes the large number of rejections and other proceedings whose time for response is very close to the instant proceeding for which a response is required. A sufficient cause in the patent owner's petition is shown to justify a one-month extension of time.

The petition request is **Granted in Part**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated May 29, 2007 is **granted in part**.

2. The Patent Owner's response is due **August 29, 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

MJR for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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CENTRAL REEXAMINATION UNIT

Ole K. Nilssen
200 N. Harrison St., Suite 103
Algonquin IL 60102

(Patent Owner)

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue NW
Washington, DC 20025-3934

(For Requester)

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,480 and 90/007,930
Filed: March 25, 2005 and February 13, 2006
For: U.S. Patent No.: 5,233,270

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,983
Filed: March 24, 2006
For: U.S. Patent No.: 6,172,464

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,470
Filed: March 18, 2005
For: U.S. Patent No.: 4,857,806

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,864
Filed: January 4, 2006
For: U.S. Patent No.: 5,343,123

DECISION ON PETITION UNDER 37 CFR 1.182 REGARDING EXTENDED EXAMINER INTERVIEW

This is a decision on the September 26, 2007 patent owner petition filed in each of the above-identified proceedings to conduct an extended personal interview with the Examiner for the duration of five hours to discuss each of the above-identified proceedings.

The petition is before the Office of Patent Legal Administration for consideration of whether the request for an extended interview should be granted.

The petition is dismissed.

REVIEW OF SALIENT FACTS

1. On September 25, 2007, the patent owner contacted Examiner Escalante and requested a personal interview for the above-identified proceedings. The examiner granted the initial request and indicated that the duration of the interview would not exceed one hour.

2. The patent owner filed a petition on Sept. 26, 2007, in each of the above identified proceedings "to confirm that Owner is entitled to interview the Examiner for a duration of one hour per patent at issue, or a total of five (5) hours for the above five (5) captioned reexamination proceedings."

3. Payment of the petition fees required for each proceeding was completed on October 4, 2007, thus affecting entry of the petitions in each respective proceeding on this date.

4. The status of each proceeding is as follows:

(a) Control nos. 90/007,480 & 90/007,930 have been merged. A final office action was mailed July 3, 2007. An amendment in response to the final office action was filed Sept. 7, 2007.

(b) Control nos. 90/007,518 & 90/007,823 have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

(c) Control no. 90/007,983 received a non-final office action mailed on May 17, 2007. An amendment in response to the non-final office action was filed July 19, 2007.

(d) Control no. 90/007,470 received a final office action mailed June 29, 2007. An amendment in response to the final office action was filed Sept. 4, 2007, and a Notice of Appeal was filed Oct. 1, 2007.

(e) Control no. 90/007,864 received a non-final office action mailed May 29, 2007. An amendment in response to the non-final office action was filed July 2, 2007.

5. Each proceeding has received at least one office action and has had a response* filed therein by patent owner awaiting action.

6. Each proceeding has claims rejected on different grounds based on different prior art references.

DISCUSSION

Interviews in *ex parte* reexamination proceedings are governed by 37 CFR 1.560, which reads:

Interviews in *Ex Parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner 's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

---

* It is noted that merged proceeding control no. 90/007,480 does not have a amendment filed therein, but has a petition awaiting decision to accept a late response.

As explained in MPEP 2281:

> In the case where the patent owner desires to initiate an interview, the patent owner should initially contact the examiner in charge of the proceeding to indicate what issues are sought to be discussed, and to determine if an interview will be granted. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview, and a copy of any proposed claims to be discussed, unless examiner waives this requirement. This provision will provide structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> The duration of the interview will not exceed one hour, unless the patent owner files a petition under 37 CFR 1.182 showing sufficient cause where more time is needed. In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied, to the extent such is deemed necessary. An hour of time in a structured planned interview should be sufficient to accomplish this, and in those rare instances where it is not, a patent owner may show cause to extend the time. During the interview, the examiner is always free to extend the duration of the interview to discuss issues that the examiner deems appropriate for (further) discussion. Such an extension of the duration of the interview is permitted at the examiner's sole discretion.
>
> Only one interview may be requested after an Office action and prior to filing the response to that action, absent a showing of good cause to conduct a second interview during this period.

DECISION

Interviews are ***permitted*** during reexamination proceedings and are granted at the discretion of the examiner if they are deemed to facilitate prosecution with special dispatch. Interviews may be requested after an Office action, prior to filing a response to that action, in order to define the claims over the applied prior art. As the interview must be conducted in a structured and planned manner, one hour of time should be sufficient to accomplish this.

The patent owner has requested that five different reexamination proceedings be discussed during one personal interview and that one hour be allotted to each proceeding to result in a personal interview with a duration of five hours.

Each of the proceedings is at a different stage of prosecution. Each of the proceedings has different prior art rejections applied against the claims, with a total of at least ten (10) different prior art references being at issue. Responses have already been filed in the proceedings and are awaiting action.

An extended interview in this case, which would raise numerous different issues, involve proceedings at various stage of prosecution, and be conducted over a lengthy period of time, would not be productive and would not facilitate the handling of these cases with special dispatch. The patent owner acknowledges in the petition that there are "a multitude of issues to be discussed" and that additional issues relating to priority particular to only two of the proceedings will be raised.

The goal of conducting a targeted, planned interview to define the claims over the prior art would not be accomplished by combining five different sets of claims and over ten different prior art references along with a variety of other issues in a single discussion. Moreover, none of these proceedings are at an appropriate stage of prosecution during which interviews are normally granted. Further, such a lengthy interview would not be an efficient use of Office resources and would not serve the public interest.

It is also noted that the petition states the patent owner is entitled to an interview in each proceeding and is entitled to one hour for each interview. Interviews are *permitted* at the discretion of the examiner; interviews are not entitlements. Further, the manual states that an interview *will not exceed one hour.* Interviews are not guaranteed to last one hour and may be held for less than one hour at the discretion of the examiner in the interest of expediting prosecution in an efficient manner.

The patent owner has not provided a sufficient showing of good cause as to why additional time, especially for a time period of five hours, in which to conduct an interview should be permitted in this situation. The petition states that patent owner's request is for reasons of efficiency, to conserve resources, and to lessen the amount of travel time. Economic and time considerations for the patent owner do not give rise to an adequate showing as there are other means of communication, including the telephone, available to the patent owner to interact with the examiner.

CONCLUSION

1. The petition requesting an extended personal examiner interview conducted at one time for all of the above identified proceedings is dismissed.

2. The patent owner is required to identify which one of the above proceedings will be the subject of the personal interview and indicate what issues are sought to be discussed so that the examiner can determine if an interview will be granted.

3. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview along with a copy of any proposed claims to be discussed unless the examiner waives this requirement.

4. The duration of the interview for an individual proceeding, if granted, will not exceed one hour.

5. The patent owner is reminded that merged proceedings require papers to be filed in each proceeding within the merged proceeding. In this case, patent owner filed a single petition in each of the merged proceedings, which is not in accordance with the guidelines set forth in the merger decision. The petition must be filed in each proceeding in the merged proceedings. In this instance, the Office has waived this procedure, but this is not to be construed as a waiver as to future filings. A paper must be filed in each proceeding within the merged proceedings going forward.

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

cdd
October 4, 2007

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Crowell & Moring LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300

(For Patent Owner)

JAN 25 2007

J. M. Mark Gilbreath
Gilbreath & Associates, P.C.
P.O. Box 2428
Bellaire, TX 77402-2428

(For 3rd Party Requester)

Reexam Control No.: 90/007,870
Filed : January 10, 2006
For U.S. Patent No. : 5,575,333

Reexam Control No.: 90/008,117
Filed : July 20, 2006
For U.S. Patent No. : 5,575,333

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).

Consideration of 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."

Reexamination in application control No. 90/007,870 was ordered in a decision mailed January 30, 2006. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/008,117 was ordered in a decision mailed September 21, 2006. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

As evidenced by the above facts, reexamination control No. 90/007,870 and reexamination control No. 90/008,117 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. 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. 90/007,870 and 90/008,117 are hereby merged into a single proceeding. 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,872	01/12/2006	6424008	0756-7609	6976

7590 09/24/2008

EXAMINER

Eric J. Robinson
ROBINSON INTELLECTUAL PROPERTY LAW OFFICE, P.C.
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ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2008

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

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(Courtesy Copy)

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SEP 24 2008

CENTRAL REEXAMINATION UNIT

In re Yamazaki et al
Ex Parte Reexamination Proceeding
Control No. 90/007,872
Filed: January 12, 2006
For: U.S. Patent No. 6,424,008

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the August 22, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the August 22, 2008 patent owner petition to revive").

The August 22, 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 August 22, 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 1.137 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 (c) provides, in pertinent part:

Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be . . . an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee . . .

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing

unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection II, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted an appeal brief and an appeal brief fee on July 24, 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 August 22, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the August 22, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[2] is **granted**.

A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. Eric Robinson. In the absence of a change of power of attorney in the patent file, i.e., in application no. 09/239,948, listing Mr. Robinson as an attorney of record, however, any future decisions regarding this matter will be mailed only to the correspondence address of record for the patent owner.[3]

CONCLUSION

- The August 22, 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 3991 for processing of the July 24, 2008 appeal brief.

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[1] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (c).

[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 an appeal brief pursuant to 37 CFR 41.37(a).

[3] **The September 14, 2007 change of correspondence address filed by Mr. Robinson in the patent file, application no. 09/239,948, is ineffective**, since Mr. Robinson is not listed as an attorney of record in the declaration filed on January 29, 1999 in application no. 09/239,948. A change of correspondence address (changing the correspondence address to the current address of record) was later filed on November 5, 2001, in application no. 09/239,948 by one of the attorneys of record listed on the January 29, 1999 declaration. No ***change of power of attorney***, however, has yet been filed in application no. 09/239,948, listing Mr. Eric Robinson as attorney of record.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Erik Kielin, of CRU Art Unit 3992, at (571) 272-1693.

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

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

cn

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CENTRAL REEXAMINATION UNIT

ERIC ROBINSON
PMB 955
21010 SOUTHBANK ST.
POTOMAC FALLS VA 20165

(For Patent Owner)

In re YAMAZAKI *et al.*	: DECISION ON
Ex Parte Reexamination Proceeding	: PETITION IN
Control No.: 90/007,872	: AN *EX PARTE*
Filed: January 12, 2006	: REEXAMINATION
For: U.S. Patent No.: 6,424,008	: PROCEEDING

This is a decision on the October 2, 2009 patent owner petition, denominated "PETITION UNDER 37 CFR 1.183," and requesting waiver the time period for submission of a reply brief in accordance with 37 CFR 41.41(a)(1).

The petition is before the Office of Patent Legal Administration.

A petition fee of $130 set forth in 37 CFR 1.17(h) for the present petition was concurrently submitted via electronic transmission. However a petition under 37 CFR 1.183 requires a petition fee of $400 set forth in 37 CFR 1.17(f). Therefore the remaining petition fee $270 for the present petition under 37 CFR 1.183 was charged to Deposit account No. 50-2280 in accordance with petitioner's fee authorization on page 3 of the present petition.

For the reasons set forth below, the petition under 37 CFR 1.183 is dismissed.

REVIEW OF THE FACTS

1. U.S. Patent No. 6,424,008 (the '008 patent) issued on July 23, 2002.

2. On January 12, 2006, a request for *ex parte* reexamination of the '088 patent was filed by patentee and assigned control number 90/007,872 (the '7872 reexamination proceeding).

3. On March 8, 2006, the Office issued an Order granting reexamination in the '7872 reexamination proceeding of all the claims in the '008 patent. The Office action set a two-month shortened statutory period for filing a patent owner's statement.

4. On May 10, 2006, patent owner filed a statement addressing the Order granting reexamination in the '7872 reexamination proceeding.

5. On May 21, 2007, the Office issued a first Office action on the merits in the '7872 reexamination proceeding, rejecting all the claims of the '008 patent.

6. On July 25, 2007, patent owner filed a response, which amended the issued patent claims

and traversed the rejections of record.

7. On January 24, 2008, the Office issued a final Office action rejecting all the remaining claims as amended.

8. On April 25, 2008, patent owner filed a notice of appeal.

9. On July 24, 2008, patent owner concurrently filed both an appeal brief and a petition for an extension of time in order to have the Office receive the brief as timely.

10. On August 13, 2008, the Office dismissed the petition for an extension of time and found the brief to be untimely submitted and the '7872 reexamination proceeding to be terminated..

11. On August 22, 2008, patent owner filed a petition for revival of the proceeding.

12. On September 24, 2008, the Office issued a decision granting patent owner's request for revival.

13. On May 29, 2009, the Office issued an examiner's answer.

14. On July 31, 2009, patent owner filed a reply brief.

15. On September 19, 2009, the Office issued a miscellaneous communication noting the reply brief was not compliant with 37 CFR 41.41(a).

16. On October 2, 2009, patent owner submitted a revised reply brief along with the present petition requesting waiver of the time requirement of 37 CFR 41.41(a)(1). Patent owner did not submit a petition for an extension of time under 37 CFR 1.550(c).

DECISION ON PETITION UNDER 37 CFR 1.183

37 CFR 1.183 states:

> 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 41.41 states:

> (a) (1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.
>
> (2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.
>
> (b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.
>
> (c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to

> the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.

In the present petition, patent owner requests that the Office suspend the two month time period of 37 CFR 41.41(a)(1) to accept as timely patent owner's revised reply brief submitted on October 2, 2009. Patent owner argues that suspension of the rules is appropriate, because the examiner did not fully consider the originally filed reply brief on July 31, 2009. Contrary to the assertions of patent owner, the examiner was not required to consider a non-compliant reply brief.

The examiner did not consider the contents of the July 31, 2009 reply brief, because patent owner was attempting to enter new evidence into record via reply brief. Specifically, the examiner noted that the use of US PG Publication 2003/0168694 to Colclaser in the July 31, 2009 reply brief amounted to the inclusion of new evidence in a reply brief. In accordance with 37 CFR 41.41(b), the examiner was not required consider the substance of the July 31, 2009 reply brief. The examiner merely followed the requirements of the rule and properly declined consideration of a non-compliant reply brief.

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. Patent owner's petition only states that the examiner did not consider the entirety of the July 31, 2009. As pointed out above the examiner was not required to consider a non-compliant brief. The failure of patent owner to comply with the rules, in the form of submitting a compliant reply brief, does not present an ***extraordinary situation*** under 37 CFR 1.183 to justifying suspension of the rules. See also MPEP 1208, part II, Form Paragraph 12.182, Examiner Note 2. The present "situation" falls directly within that guidance; there is nothing "extraordinary" in this instance. Therefore, justice does not require suspension of 37 CFR 41.41(a) (1). Accordingly, the present petition is DISMISSED.

CONCLUSION

1. The petition under 37 CFR 1.183 is **dismissed**.

2. The revised reply brief will not been entered. A copy of the un-entered brief will remain in the electronic image file wrapper (IFW) for the proceeding.

3. The reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination consistent with this decision.

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

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Robert C.J. Tuttle
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1000 Town Center, 22nd Floor
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(For Third Party Requester)

Ex parte Indra R. Baxi
Reexamination Proceeding
Control No.: 90/007,874
Filed: Jan. 17, 2006
For: U.S. Patent 5,198,240

: **DECISION ON PETITION**
: **TO CONTINUE**
: ***EX PARTE***
: **REEXAMINATION**
: **PROCEEDINGS**

This is a decision on the January 17, 2008, patent owner Petition Under 37 CFR 1.182 and Request for Continued Reexamination.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to patent owner's deposit account, pursuant to petitioner's instructions, and the notice of appeal fee of $510 has been charged to patent owner's credit card.

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

REVIEW OF FACTS

1) U.S. Patent No. 5,198,240 (the '240 patent) issued on March 30, 1993.

2) A request for *ex parte* reexamination of the '240 patent was filed by a third party requester on Jan. 17, 2008, and assigned control number 90/007,874 (the '7874 proceeding).

3) An Order granting reexamination in the '7874 proceeding was mailed on February 3, 2006.

4) A first non-final Office action was mailed August 3, 2006, which patent owner responded

to with an amendment and arguments on Nov. 1, 2006.

5) A second non-final Office action was mailed Jan. 31, 2007, which patent owner responded to with an amendment and arguments on March 26, 2007.

6) On July 17, 2007, a final rejection was mailed.

7) Patent owner filed, after the final rejection, an amendment and arguments on Sept. 13, 2007, and a supplemental amendment and arguments on Oct. 5, 2007.

8) Neither submission after the final rejection was entered, as indicated in an advisory action mailed Dec. 21, 2007, which stated that the proposed amendments appeared to lack proper support and raised new issues under 35 U.S.C. §112, second paragraph.

9) On January 17, 2008, patent owner filed this petition and request with a new amendment and remarks, along with a notice of appeal.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the January 17, 2008 response.

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."

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

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

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 § 1.182 petition be filed for 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 final rejection noted that the patent owner failed to provide evidence that the check valve of Baxi contained such a significant amount of back pressure that the gauge would display an inaccurate reading of the pressure in the tank of Baxi. The patent owner believed that the response to the final rejection amending the claims 9 and 20 to change "for sensing" to "directly measuring" would overcome the prior art rejection. The response was not persuasive, and the advisory action raised the issue of lack of support for the proposed amendments to claims 9 and 20 adding the language "directly measuring" with respect to the second pressure sensing means. The proposed response submitted with this request for continued reexamination addresses the indefiniteness issues of the last patent owner response with different claim amendments and indicates that declaratory evidence is being obtained to support patent owner's arguments regarding the back pressure.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's presentation of an amendment paper amending the claims in response to the remarks in the advisory action and indicating that declaratory evidence is being prepared to support the arguments 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 January 17, 2008 Amendment. This paper will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the January 17, 2008 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 '7874 *ex parte* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted absent a

showing of extraordinary circumstances.

3) The closing of prosecution rendered via the July 17, 2007 final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The January 17, 2008 response will be entered [2] 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

February 5, 2008

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

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Pillsbury Winthrop Shaw Pittman LLP
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(For 3rd Party Requester)

Reexam Control No.: 90/007,878
Filed : January 17, 2006
For U.S. Patent No. : 5,514,154

Reexam Control No.: 90/008,865
Filed : October 4, 2007
For U.S. Patent No. : 5,514,154

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).

Consideration of 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."

Reexamination in application control No. 90/007,878 was ordered in a decision mailed February 14, 2006. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the response. There have been no changes made to the specification, claims or drawings. Claims 1-23, all of the claims, are being reexamined in this proceeding.

Reexamination in application control No. 90/008,865 was ordered in a decision mailed November 26, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. There have been no changes made to the specification, claims, or drawings. Claims 1, 3, 4 and 8-11 are being reexamined in this proceeding.

As evidenced by the above facts, reexamination control No. 90/007,878 and reexamination control No. 90/008,865 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 of claims 1-23 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. 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. 90/007,878 and 90/008,865 are hereby merged into a single proceeding. 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

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

Fulwider Patton LLP
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045

(For Patent Owner)

MAILED

MAY 2 0 2009

CENTRAL REEXAMINATION UNIT

Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, VA 22102

(For 3rd Party Requester)

Reexam Control No.: 90/007,878
Filed : January 17, 2006
For U.S. Patent No. : 5,514,154

Reexam Control No.: 90/008,865
Filed : October 4, 2007
For U.S. Patent No. : 5,514,154

Reexam control No.: 90/009,309
Filed : October 24, 2008
For U.S. Patent No. : 5,514,154

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings, all filed by the same third party requester, are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Consideration of 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."

Reexamination in application control No. 90/007,878 was ordered in a decision mailed February 14, 2006, indicating that claims 1-23, all of the claims in the patent, would be reexamined. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 were filed subsequent to the March 23, 2007 response. The response made no changes to the specification, drawings, and/or claims.

Reexamination in application control No. 90/008,865 was ordered in a decision mailed November 26, 2007, indicating that claims 1, 3, 4, and 8-11 would be reexamined. No patent owner's statement was filed in this proceeding.

In a decision mailed January 31, 2008, reexamination proceedings 90/007,878 and 90/008,865 were merged. The decision indicated that claims 1-23, all of the claims in the patent, would be reexamined. A non-final Office action was mailed June 30, 2008. A request for extension of time was received July 11, 2008 and granted in a decision mailed July 22, 2008, extending the period for response up to and including September 30, 2008. On October 2, 2008 an amendment was filed with a certificate of mailing dated September 30, 2008. On March 18, 2009 an Information Disclosure Statement was filed. The amendment of October 2, 2008 made no changes to the specification, drawings and/or claims. No Office action has been prepared that is responsive to the October 2, 2008 amendment.

Reexamination in application control 90/009,309 was ordered in a decision mailed December 12, 2008, indicating that claims 4 and 12 would be reexamined. No patent owner's statement was filed in this proceeding. An Information Disclosure Statement was filed March 18, 2009. No changes to the specification, drawings and/or claim have been made in this proceeding. No Office action has been issued in this proceeding since the mailing of the decision granting reexamination.

As evidenced by the above facts, reexamination control No. 90/007,878, reexamination control No. 90/008,865, and reexamination control No. 90/009,309 are currently pending. Since the order to reexamine has been mailed in each of the 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 Each Proceeding

The patent owner is required to maintain identical specifications, drawings, and claims in each of the three files. In view of the fact that all proceedings are identical at this point, 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 1-23, all of the patent claims, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the three reexaminations. All papers issued by the Office will contain the identifying data for each of the cases, and each action will be entered into each of the 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 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. 90/007,878, 90/008,865, and 90/009,309 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination unit for issuance of an Office action.

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

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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JUL 27 2006
CENTRAL REEXAMINATION UNIT

JUL 27 2006
CENTRAL REEXAMINATION UNIT

DICKSTEIN SHAPIRO MORIN
& OSHINSKY LLP
2101 L Street, NW
Washington, DC 20037

(For Patent Owner)

NOVAK, DRUCE, DELUCA
& QUIGG, LLP
1300 Eye St. NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party
Requester)

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

In re: Kobayashi *et alia* :
Reexamination Proceeding :
Control No. 90/007,879 :
Filed: January 17, 2006 :
For U.S. Patent No. 4,922,432 :

In re: Kobayashi *et alia* :
Reexamination Proceeding :
Control No. 90/007,945 :
Filed: February 22, 2006 :
For U.S. Patent No. 4,922,432 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,879 (the '879 proceeding) and the reexamination control number 90/007,945 (the '945 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,922,432 issued on May 1, 1990.

2. The 90/007,879 reexamination proceeding was filed on January 17, 2006 by a third party requester.

3. The '879 proceeding Order granting reexamination was mailed on February 24, 2006.

4. The 90/007,945 reexamination proceeding was filed February 22, 2006 by a third party requester.

7. The '945 proceeding Order granting reexamination was mailed on April 19, 2006.

8. There are no amendments to either the '879 or the '945 proceedings at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/007,879 and 90/007,945 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 90/007,879 and 90/007,945 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 both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/007,879 and 90/007,945 are **merged**. 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 J. Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

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

for
Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington DC 20006-5403

(for Patent Owner)

MAILED

DEC 13 2007

CENTRAL REEXAMINATION UNIT

NOVAK, DRUCE, DELUCA
& QUIGG, LLP
1300 Eye St. NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party
Requester)

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

In re: Kobayashi *et alia* :
Reexamination Proceeding :
Control No. 90/007,879 :
Filed: January 17, 2006 :
For U.S. Patent No. 4,922,432 :

In re: Kobayashi *et alia* :
Reexamination Proceeding :
Control No. 90/007,945 :
Filed: February 22, 2006 :
For U.S. Patent No. 4,922,432 :

This is a decision on the December 3, 2007, petition for "Petition for Extension of Time Under 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed November 21, 2007, be extended by two months.

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

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

Copied from 90007945 on 12/17/2007

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed November 21, 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 December 6, 2007, together with the $200.00 petition fee required by 37 CFR 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 that the expert testimony upon which the patent owner will rely to respond to the Office action will not be available until December. As such the sufficient cause requirement is met to justify a one-month extension of time. The patent owner's representative further notes the length of the Office action and references applied, however this is not considered to justify additional time for which to respond. A sufficient cause in the patent owner's petition is shown to justify a one-month extension of time.

The petition request is **Granted-in-Part**.

Copied from 90007945 on 12/17/2007

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated November 21, 2007 is **granted in part**.

2. The Patent Owner's response is due **January 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
SPE ~~SPRE~~ AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,945	02/22/2006	4922432		4490

24998 7590 12/13/2007

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2007

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

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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.
90/007,879	01/17/2006	4922432	8089.002	1132

24998 7590 12/13/2007

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2007

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,879	01/17/2006	4922432	8089.002	1132

24998 7590 12/13/2007

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,945	02/22/2006	4922432		4490

24998 7590 12/13/2007

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1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2007

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington DC 20006-5403

(for Patent Owner)

MAILED

DEC 13 2007

CENTRAL REEXAMINATION UNIT

NOVAK, DRUCE, DELUCA
& QUIGG, LLP
1300 Eye St. NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party
Requester)

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

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/007,879
Filed: January 17, 2006
For U.S. Patent No. 4,922,432

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/007,945
Filed: February 22, 2006
For U.S. Patent No. 4,922,432

This is a decision on the December 3, 2007, petition for "Petition for Extension of Time Under 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed November 21, 2007, be extended by two months.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed November 21, 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 December 6, 2007, together with the $200.00 petition fee required by 37 CFR 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 that the expert testimony upon which the patent owner will rely to respond to the Office action will not be available until December. As such the sufficient cause requirement is met to justify a one-month extension of time. The patent owner's representative further notes the length of the Office action and references applied, however this is not considered to justify additional time for which to respond. A sufficient cause in the patent owner's petition is shown to justify a one-month extension of time.

The petition request is **Granted-in-Part**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated November 21, 2007 is **granted in part**.

2. The Patent Owner's response is due **January 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
SPE ~~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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,879	01/17/2006	4922432	8089.002	1132

24998 7590 07/22/2009

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,945	02/22/2006	4922432		4490

24998 7590 07/22/2009

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,094	03/28/2008	4922432	06816.0070.RXUS00	3207

24998 7590 07/22/2009

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2009

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
VINCENT M. DELUCA
NOVAK DRUCE DELUCA & QUIGG LLP
1300 EYE ST., NW, SUITE 400 EAST TOWER
WASHINGTON, DC 20005

Date:

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007879
PATENT NO. : 4922432
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
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOWREY LLP
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

Date:

MAILED
JUL 22 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009094
PATENT NO. : 4922432
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

Thomas J D'Amico
DICKSTEIN SHAPIRO MORIN
& OSHINSKY LLP
2101 L Street, NW
Washington, DC 20037

(For Patent Owner)

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

Vincent M. DeLuca
NOVAK, DRUCE, DELUCA
& QUIGG, LLP
1300 Eye St. NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

Robert C Laurenson
HOWREY LLP-CA
C/O IP Docketing Department
2941 Fairview Park Drive
Suite 200
Falls Church, VA 22042-2924

(For Third Party Requester)

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/007,879
Deposited: 17 January 2006
For U.S. Patent No. 4,922,432

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/007,945
Deposited: 22 February 2006
For U.S. Patent No. 4,922,432

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/009,094
Deposited: 28 March 2006
For U.S. Patent No. 4,922,432

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
37 CFR §§ 1.550(c) & 1.181

This is a decision on the 17 July 2009, "Common Petition for Extension of Time to File Reply Brief and Request for Oral Hearing for Reexamination Control Numbers 90/007,879, 90/007,945 & 90/009,094 Under 37 CFR § 1.550(c)" requesting that the time for responding to the Examiner's Answer mailed 19 July 2009, be extended by one (1) month. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g). The petition indicates the required certificate of service.

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 for response be extended in which to file a Reply Brief response to the Examiner's Answer mailed 19 June 2009. The petition for extension of time was timely filed on 17 July 2009, together with fee for the $200.00 petition fee as required by 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. ...

ANALYSIS AND FINDINGS

The patent owner's representative petition 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 Examiner's Answer was mailed 19 July 2009. The petition notes that the extension of time is needed because the "references cited in the Examiner's Answer are technically complex and the Examiner's Answer itself quite lengthy..." The examiner's time between patent owner's responses and subsequent actions noted in the prosecution history are not germane to the issue of "sufficient cause" in the instant petition. Since the issues in the Final rejection mailed 24 September 2008 and the Examiner's Answer mailed 19 June 2009 are substantially the same there are no new issues that would require further consideration. It is noted that the patent owner further states that the offices will be closed 8-16 August 2009 for a holiday period. This time is not necessitated by any actions from the Office and could have been reasonably anticipated by the patent owner.

The petition request to extend the response time by one (1) month is hereby dismissed.

CONCLUSION

1. The patent owner's petition for extension of one (1) month time in which to file a response to the Examiner's Answer dated 16 June 2009 is hereby **dismissed**

2. The Patent Owner's response is due **16 August 2009.**

3. 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.

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/
for

_____

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,879	01/17/2006	4922432	8089.002	1132

24998 7590 03/25/2010

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,945	02/22/2006	4922432		4490

24998 7590 03/25/2010

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,094	03/28/2008	4922432	06816.0070.RXUS00	3207

24998 7590 03/25/2010

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

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WASHINGTON, DC 20005

Date:

MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007879
PATENT NO. : 4922432
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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WASHINGTON, DC 20005

Date: MAILED
MAR 25 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007945
PATENT NO. : 4922432
ART UNIT : 3900

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FALLS CHURCH, VA 22042-2924

Date:

MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009094
PATENT NO. : 4922432
ART UNIT : 3992

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

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MAR 25 2010

CENTRAL REEXAMINATION UNIT

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Falls Church, VA 22-42-2924

In re Kobayashi *et alia* Reexamination Proceeding Control No. 90/007,879 For: U.S. Patent No. 4,922,432	: DECISION DISMISSING : PETITION UNDER : 37 CFR 1.181 :
In re Kobayashi *et alia* Reexamination Proceeding Control No. 90/007,945 For: U.S. Patent No. 4,922,432	: : : :
In re Kobayashi *et alia* Reexamination Proceeding Control No. 90/009,094 For: U.S. Patent No. 4,922,432	: : : :

This is a decision on the January 20, 2010 paper entitled "COMMON PETITION UNDER 37 C.F.R. §1.181 REQUESTING FINDING "NEW GROUND OF REJECTION" IN SUPPLEMENTAL EXAMINER'S ANSWER" requesting "a ground of rejection set forth in the Supplemental Examiner's Answer be designated as a 'new ground 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

MPEP 1207.04 states, in part:

"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."

The final office action of September 24, 2008 and the examiner's answer of June 19, 2009 contain the same grounds of rejection. Specifically, claims 1-3, 6-8, and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski, T.J. et al., *The VLSI Design Automation Assistant." from Algorithms to Silicon,* IEEE Design and Test, Aug., 1985 (hereinafter "Kowalski '85") in view of Kowalski, T.J. et al., *The VLSI Design Automation Assistant: A Knowledge-Based Expert System,* PhD thesis, Dept. Electrical and Computer Eng., Carnegie-Mellon University, Pittsburgh, Pa, April 1984 (hereinafter "Kowalski '84"), and further in view of Dirkes, *E., A Module binder for the CMU- DA System,* masters thesis, Dept. Electrical and Computer Eng., Carnegie-Mellon University, Pittsburgh, Pa., April 1985 (hereinafter "Dirkes"). Claims 4, 5, and 9-12 are rejected as being obvious over the above three references and further in view of Baitinger.

In response to the reply brief filed August 19, 2009, the examiner issued a supplemental examiner's answer responding to new issues raised in the reply brief (citing 37 CFR 41.43(a)). No ground of rejection was included in the supplemental examiner's answer. The examiner restated the new issues set forth by appellant in the reply brief, followed by a response to those new issues. The positions by the examiner are summarized in a table on pages 6 and 7 of the supplemental examiner's answer. However, it appears that petitioner views this table as an entire new rejection of claim 13. This is not the case. The factual discussion of the references and rationale in support of the rejection is more extensive than the table on pages 6 and 7 of the supplemental examiner's answer. In the final office action of September 24, 2008, the discussion of claim 13 as being unpatentable over the two Kowalski articles and Dirkes spans pages 7-15. The same discussion spans pages 7-15 of the examiner's answer of June 19, 2009.

Petitioner presents a table on pages 3 and 4 of the petition allegedly illustrating the examiner's position set forth in the final rejection of claim 13. However, petitioner interjects his own comments into the table that do not appear in the 9 pages devoted to the rejection in the final office action and the examiner's answer. A detailed discussion of the discrepancies is outside the scope of the present decision as it would represent arguments related to the rejection of record (i.e. an appealable issue).

As the supplemental examiner's answer is limited to the examiner's response to new issues raised in the reply brief and does not include a new ground of rejection, the petition is **dismissed**.

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**.

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Commissioner for Patents
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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.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

4. This is not a final agency action. The decision is made without prejudice to a request for reconsideration or higher-level review.

Gregory Morse
Director, Central Reexamination Unit

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1940 Duke Street
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JUL 11 2006

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Lawrence E. Laubscher Jr. (For 3rd Party Requester)
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Annapolis, MD 21403

Reexam Control No.: 90/007,822
Filed : November 28, 2005
For U.S. Patent No. : 5,514,909

DECISION MERGING REEXAMINATION PROCEEDINGS

Reexam Control No.: 90/007,883
Filed : January 20, 2006
For U.S. Patent No. : 5,514,909

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).

Consideration of 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."

Reexamination in application control No. 90/007,822 was ordered in a decision mailed January 19, 2006. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,883 was ordered in a decision mailed March 8, 2006. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

As evidenced by the above facts, reexamination control No. 90/007,822 and reexamination control No. 90/007,883 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. 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 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

Reexamination Control Nos. 90/007,822 and 90/007,883 are hereby merged into a single proceeding. 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 Mark Reinhart, Special Programs Examiner, at telephone No. (571) 272-1611.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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FOR FIRST THIRD PARTY REQUESTER

Lawrence Laubscher, Jr.
Laubscher & Laubscher, P.C.
1160 Spa Road
Suite 2B
Annapolis, Maryland 21403

FOR SECOND THIRD PARTY REQUESTER

MAILED

OCT 18 2006

CENTRAL REEXAMINATION UNIT

In re Seigo Yamamoto et al.
Reexamination Proceeding
Control No. 90/007,822
Filed: November 28, 2005
For: U.S. Patent No. 5,514,909

In re Seigo Yamamoto et al.
Reexamination Proceeding
Control No. 90/007,883
Filed: January 20, 2006
For: U.S. Patent No. 5,514,909

In re Reissue Application of
Seigo Yamamoto et al.
Application No. 11/430,302
Filed: August 4, 2005
For: U.S. Patent No. 5,514,909

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. Patent No. 5,514,909 (the '909 patent) issued on May 7, 1996, with 11 claims.

2. A first request for reexamination, assigned Control No. 90/007,822 (the '7822 proceeding), was filed by a first third party requester on November 28, 2005.

3. Reexamination was ordered in the '7822 reexamination proceeding on January 19, 2006.

4. A second request for reexamination, assigned Control No. 90/007,883 (the '7883 proceeding), was filed by a second third party requester on January 20, 2006.

5. Reexamination was ordered in the '7883 reexamination proceeding on March 8, 2006.

6. An application for reissue, assigned application No. 11/430,302 (the '302 application) was filed by the patent owner on May 9, 2006.

7. On May 24, 2006, a notification of concurrent proceedings under 37 CFR1.565 was filed by the patent owner in the '7822 proceeding, informing the Office of the '7883 reexamination proceeding and of the '302 reissue application.

8. Also on May 24, 2006, a notification of concurrent proceedings under 37 CFR 1.565 was filed by the patent owner in the '7883 proceeding, informing the Office of the '7822 reexamination proceeding and of the '302 reissue application.

9. The filing of the '302 reissue application was announced in the *Official Gazette* on June 20, 2006.

10. On July 10, 2006, a decision merging the '7822 and '7883 reexamination proceedings was mailed by the Office.

11. On September 29, 2006 a non-final office action was mailed in the merged '7822 and the '7883 reexamination proceedings.

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. 11/430,302 and merged reexamination control Nos. 90/007,822 and 90/007,883 are currently pending. The order to reexamine has been mailed in both reexamination proceedings, 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 already merged reexamination proceedings will be merged in accordance with the decision set forth below.

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

Furthermore, in the event that a request for continued examination (RCE) is filed for the '302 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 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 files for merged reexamination control Nos. 90/007,822 and 90/007,883 shows:

   (a) Original patent claims 1-11 are present.

   (b) No amendments have been made.

   A review of reissue application No. 11/430,302 shows:

   (a) Original patent claims 1-11 are present.

   (b) A new claim numbered 12 was added.

   Accordingly, the claims are not identical in all the proceedings.

   An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all the proceedings, specifically, Application No. 11/430,302 and merged Control Numbers 90/007,822 and 90/007,883. 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, any claim which does not contain identical text in all the 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 previously merged reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the reissue application and the reexamination proceedings, and each action will be entered into each of the files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with three copies being filed for entry in the three files, with each of the three bearing a signature. Any such response must contain identifying data *for all of the cases*, i.e, the reissue application and the two reexamination proceedings. *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 merged reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate for both reexamination proceedings 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 as to the reissue application, while retaining the merged reexamination proceeding for Control Nos. 90/007,822 and 90/007,883. The reissue application will be held abandoned. The merged reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued for the merged reexamination proceeding in accordance with the last action of the Office, unless further action in the merged proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the merged 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 severance of the reissue application from the merged reexamination proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following such severance 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 as to the reissue application, while retaining the merged reexamination proceeding for Control Nos. 90/007,822 and 90/007,883, and continue examination as to the merged reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 11/430,302 and merged reexamination control Nos. 90/007,822 and 90/007,883 **are merged** into a single proceeding.

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

3. Jurisdiction over the merged reissue/reexamination proceeding is being transferred to Technology Center 2800 in which the reissue proceeding is assigned. The examiner assigned the merged reissue/reexamination proceeding is not to be one who was involved in any part of the examination of the '909 patent (e.g., by preparing/signing an action). See MPEP 2236.

4. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the housekeeping amendment to place the same amendments in 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 Karen Hastings, Legal Advisor, at (571) 272-7717.

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

kmh
17 October 2006

October 18, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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REENA KUYPER, ESQ
BYARD NILSSON, ESQ
9220 Sunset Boulevard
Suite 315
Los Angeles, CA 90069

(For Patent Owner)

MAILED

JUN 29 2006

CENTRAL REEXAMINATION UNIT

Donald E. Stout, Esq.
ANTONELLI TERRY STOUT & KRAUS LLP
1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209-3873

(For Requester)

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

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/006,976
Filed: March 26, 2004
For: US Patent No. 5,255,309

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/007,092
Filed: June 18, 2004
For: US Patent No. 5,255,309

In re: Katz
Ex Parte Reexamination Proceeding
Control No. 90/007,884
Filed: January 20, 2006
For: US Patent No. 5,255,309

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. 5,255,309 issued October 19, 1993.

2. *Ex Parte* Reexamination Proceeding, control no. 90/006,976 was a director ordered reexamination dated March 26, 2004.

3. *Ex Parte* Reexamination Proceeding, control no 90/007,092 was requested by a third party requester on June 18, 2004.

4. *Ex Parte* Reexamination Proceedings, control no. 90/006,976 and 90/007,092 were merged *sua sponte* on March 7, 2005.

5. *Ex Parte* Reexamination Proceedings, control no.90/007,884 was requested by a third party requester for reexamination of US Patent No. 5,255,309 on January 20, 2006 by a third party requester.

6. *Ex Parte* Reexamination control no. 90/007,884 order was granted March 20, 2006 and awaits first office action on the merits from the examiner in charge.

7. The previously merged proceedings, control nos. 90/006,976 and 90/007,092 are both after final action.

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 90/006,976; 90/007,092 and 90/007,884 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. 90/006,976; 90/007,092 and 90/007,884 are **merged**. The reexamination files are being forwarded to the examiner for issuing a first Office action. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment if needed.

2. The status of the previously merged proceedings 90/006,976 and 90/007,092 will be returned to the examiner awaiting further action and the final status removed. 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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Finnegan, Henderson, Farabow
Garrett & Dunner
901 New York Avenue
Washington, DC 20001-4413

(For Patent Owner)

MAILED

SEP 25 2007

CENTRAL REEXAMINATION UNIT

Blakely Sokoloff Taylor
& Zafman
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025

(For *Inter Partes* Requester)

In re Weber et al.
Ex parte Reexamination
Proceeding
Control No. 90/007,885
Filed: January 20,2006
For: U.S. Patent No. 6,688,280

In re Weber et al.
Inter partes Reexamination
Proceeding
Control No. 95/000,050
Filed: September 17, 2004
For: U.S. Patent No. 6,688,280

DECISION TO MERGE
REEXAMINATION PROCEEDINGS

The above-captioned reexamination proceedings are before the Office Of Patent Legal Administration (OPLA) for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at the present time.

REVIEW OF THE FACTS

1. United States Patent Number 6,688,280 issued February 10, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control Number 95/000,050 was filed September 14, 2004,by Clyde C. Bryant for Entec Engine Corporation, the real party in interest.

3. An order and an office action for reexamination of *inter partes* reexamination Control Number 95/000,050 was mailed on December 10, 2004.

4. On January 24, 2005, patent owner filed, in the '050 proceeding, a response to the Office action.

5. On numerous dates after January 24, 2005, patent owner filed, in the '050 proceeding, an IDS submission under 37 CFR 1.933 and 37 CFR 1.555(a).

6. On February 25, 2005, requester filed, in the '050 proceeding, comments after the patent owner's response.

7. On September 22, 2005, examiner mailed an Office action closing prosecution, in the '050 proceeding.

8. On October 24, 2005,patent owner filed, in the '050 proceeding, a response to the Office action closing prosecution.

9. On November 25, 2005, requester filed, in the '050 proceeding, comments after the patent owner's response to the action closing prosecution.

10. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,885 was filed January 20, 2006, by the patent owner.

11. On January 25, 2006, patent owner filed, in the '885 proceeding, a notice pursuant to 37 CFR 1.565(a) of the filing of the *inter partes* reexamination.

12. An order for reexamination of *ex partes* reexamination Control Number 90/007,885 was mailed on February 8, 2006.

13. On numerous dates after February 8, 2006, patent owner filed, in the '885 proceeding, Information Disclosure Statement (IDS) submissions under 37 CFR 1.555(a).

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> "If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997."

The general policy of the Office is that an *ex parte* reexamination proceeding and an *inter partes* reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. Pursuant to MPEP 2686.01:

> "If a second request for reexamination is filed where a certificate

> will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings."

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. In the present instance,a complete examination can be given to both proceedings incorporating all of the issues raised in both proceedings. In the *ex parte* reexamination (control No. 90/007,885),a request for reexamination was filed by patent owner on January 25, 2006 and an order for reexamination was mailed on February 8, 2006. On January 25, 2006, the patent owner filed a statement in the *ex parte* reexamination pursuant to 37 CFR 1.565(a). An *inter partes* reexamination (Control No. 95/000,050) request was filed on September 14, 2004 and the order granting the reexamination was mailed on December 10, 2004. Accordingly, the two proceedings are ripe for a consolidated examination thereof. On January 25, 2006, the patent owner filed a notice pursuant to 37 CFR 1.985(a) apprising the Office of the *inter partes* reexamination (Control No. 95/000,050) filed on January 25, 2006.

In order to provide efficient and prompt handling of the two reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, pursuant to 37 CFR 1.989(a),the 95/000,050 and 90/007,885 reexamination proceedings <u>are merged</u>. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*. Since the claims <u>are</u> the same in both files, a "housekeeping amendment" is NOT needed.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination. Pursuant to 37 CFR 1.989 (b), the merged proceeding is governed by 37 CFR 1.902 through 1.997. While the rights of any third party requester <u>of the *ex parte* reexamination</u> are governed by 37 CFR 1.510 through 1.560, in this instance, there is no third party requester of the *ex parte* reexamination, since the patent owner requested the *ex parte* reexamination.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will

take the form of a single action which applies to both proceedings. All papers issued by the Office, filed by the patent owner and filed by the third party requester will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both files, for entry into each file.

All papers filed by the patent owner and by the third party requester are to be directed:

By Mail to: Attn:"Mail Stop *Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

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

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Patent owner and requester are reminded that every paper filed with the Office in the merged proceeding subsequent to this Decision must be served on the other party (in this instance, there are two parties, patent owner and requester), including papers filed *via* facsimile transmission.

C. Amendments:

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Point in Prosecution That the Merged Proceeding Will Be Examined:

MPEP 2686.01 provides:

> "After the second reexamination proceeding is merged with the first reexamination proceeding, prosecution will be conducted at the most advanced point possible for the first proceeding. Thus, if a final rejection (a Right of Appeal Notice) has been issued in the first proceeding, prosecution will ordinarily be reopened to consider the substantial new question of patentability presented in the second request unless the examiner concludes that no new rejection or change of position is warranted. Also, the patent owner will be provided with an opportunity to respond to any new rejection in a merged reexamination proceeding prior to an Action Closing Prosecution (ACP) being issued."

Accordingly, the examination may be conducted at the more advanced stage of the present *inter partes* reexamination proceeding (as opposed to that of the *ex parte* reexamination proceeding), unless the examiner concludes that a new rejection or change of position is warranted.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,050 and *ex parte* Reexamination Control No. 90/007,885 are *sua sponte* merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination proceeding is being forwarded via the Central Reexamination Unit (CRU) to the examiner for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Kery A. Fries, Senior Legal Advisor, at (571)272-7757.

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

September 23, 2007
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Patent owner filed the EP request
Claims are the same in both proceedings
Both are IFW files

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CENTRAL REEXAMINATION UNIT

Finnegan, Henderson, Farabow
Garrett & Dunner
901 New York Avenue
Washington, DC 20001-4413

(For Patent Owner)

Louis T. Isaf, Esq.
Womble,Carlyle, Sandridge, & Rice PLLC
PO Box 7037
Atlanta, GA 30357-0037

(For *Inter Partes* Requester)

In re Weber et al. *Ex parte* Reexamination Proceeding Control No. 90/007,885 Filed: January 20,2006 For: U.S. Patent No. 6,688,280	DECISION TO MERGE REEXAMINATION PROCEEDINGS

In re Weber et al.
Inter partes Reexamination
Proceeding
Control No. 95/000,050
Filed: September 17, 2004
For: U.S. Patent No. 6,688,280

The above-captioned reexamination proceedings are before the Office Of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at the time.

This decision is being re-mailed to correct the correspondence address of the third party requester. The proper law firm representing the third party requester is Womble, Carlyle, Sandridge & Rice PLLC.

REVIEW OF THE FACTS

1. United States Patent Number 6,688,280 issued February 10, 2004.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,885 was filed January 20, 2006, by the patent owner.

3. A request for *inter partes* reexamination, assigned Reexamination Control Number 95/000,050 was filed September 14, 2004,by Clyde C. Bryant for Entec Engine Corporation, the real party in interest.

Number 90/007,885 was mailed on February 8, 2006.

5. On numerous dates after February 8, 2006, patent owner filed, in the '885 proceeding, an IDS submission under 37 CFR 1.555(a).

6. On January 25, 2006, patent owner filed, in the '885 proceeding, a notice pursuant to 37 CFR 1.565(a) of the filing of the *inter partes* reexamination.

7. An order and an office action for reexamination of *inter partes* reexamination Control Number 95/000,050 was mailed on December 10, 2004.

8. On January 24, 2005, patent owner filed, in the '050 proceeding, a response to the Office action.

9. On February 25, 2005, requester filed, in the '050 proceeding, a response to the patent owner's comments.

10. On September 22, 2005, examiner mailed an Office action closing prosecution, in the '050 proceeding.

10. On October 24, 2005,patent owner filed, in the '050 proceeding, a response to the Office action closing prosecution.

11. On November 25, 2005, requester filed, in the '050 proceeding, a response to patent owner's comments after action closing prosecution.

12. On numerous dates after November 25, 2006, patent owner filed, in the '050 proceeding, an IDS submission under 37 CFR 1.933 and 37 CFR 1.555(a).

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> "If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997."

The general policy of the Office is that an ex parte reexamination proceeding and an inter partes reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. Pursuant to MPEP 2686.01:

> "If a second request for reexamination is filed where a certificate

> will issue for a first reexamination later than 3 months from the filing of the second request, the proceedings normally will be merged once reexamination has been ordered in both proceedings."

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. In the present instances, both reexamination proceedings are in the early stages, and a complete examination can be given to both proceedings incorporating all of the issues raised in both proceedings. In the *ex parte* reexamination (control No. 90/007,885),a request for reexamination was filed by patent owner on January 25, 2006 and an order for reexamination was mailed on February 8, 2006. On January 25, 2006, the patent owner filed a statement in the *ex parte* reexamination pursuant to 37 CFR 1.565(a). An *inter partes* reexamination (Control No. 95/000,050) request was filed on September 14, 2004 and the order granting the reexamination was mailed on December 10, 2004. Accordingly, the two proceedings are ripe for a consolidated examination thereof. On January 25, 2006, the patent owner filed a notice pursuant to 37 CFR 1.985(a) apprising the Office of the *inter partes* reexamination (Control No. 95/000,050) filed on January 25, 2006.

In order to provide efficient and prompt handling of the two reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the two reexamination proceedings be merged and a joint examination be conducted. Accordingly, pursuant to 37 CFR 1.989(a),the 95/000,050 and 90/007,885 reexamination proceedings <u>are merged</u>. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination. Pursuant to 37 CFR 1.989 (b), the merged proceeding is governed by 37 CFR 1.902 through 1.997. While the rights of any third party requester <u>of the *ex parte* reexamination</u> are governed by 37 CFR 1.510 through 1.560, in this instance, there is no third party requester of the *ex parte* reexamination, since the patent owner requested the *ex parte* reexamination.

B. Papers mailed/filed:

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

All papers filed by the patent owner and the third party requester should be directed:

By Mail to: **Mail Stop *Inter Partes* Reexam**
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: **(571) 273-0100**
Central Reexamination Unit

By hand: **Customer Service Window**
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

Patent owner and requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

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

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings,

which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,050 and *ex parte* Reexamination Control No. 90/007,885 are *sua sponte* merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination proceedings are being forwarded via the Central Reexamination Unit and OPLA to the examiner for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at (571)272-7757.

Steve Marcus
Legal Advisor
Office of Patent Legal Administration

September 28, 2007

Patent owner filed the EP request
Claims are the same in both proceedings
Both are IFW files

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

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Jack S. Barufka
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(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/007,888
Filed: January 23, 2006
For: U.S. Patent No. 6,432,133

Inter Partes Reexamination Proceeding
Control No. 95/000,247
Filed: March 30, 2007
For: U.S. Patent No. 6,432,133

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF SALIENT FACTS

1. U.S. patent No. 6,432,133 ("the '133 patent") issued to Lilip Lau *et al* on August 13, 2002, and was assigned to Advanced Cardiovascular Systems, Inc., now by change of name, Abbott Cardiovascular Systems.

2. A request for *ex parte* reexamination of claims 1-3, 8 and 9 of the '133 patent was filed on January 23, 2006, by Jack S. Barufka as the third party requester, and the request was assigned control number 90/007,888 ("the '888 *ex parte* reexamination proceeding").

3. On February 14, 2006, *ex parte* reexamination was ordered for claims 1-15 of the '133 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability for claims 1-3, 8 and 9 of the '133 patent.

4. A request for *inter partes* reexamination of claims 1-9 and 11 the '133 patent was filed on March 30, 2007, by Jack S. Barufka as the third party requester in which Medtronic

Vascular, Inc. was identified as the real party in interest. The request was assigned control number 95/000,247 ("the '247 *inter partes* reexamination proceeding").

5. On April 24, 2007, *inter partes* reexamination was ordered based on the examiner's determination that the March 30, 200 request raised a substantial new question of patentability for claims 1-9 and 11 of the '133 patent.

6. There has been no further Office action in the '247 *inter partes* reexamination proceeding, but, on December 21, 2006, an Office action was mailed in the '888 *ex parte* reexamination proceeding that confirmed the patentability of claims 10, 11 and 15 of the '133 patent.

7. Patent owner filed a response to the December 21, 2006 Office action on March 3, 2007, in which reconsideration of the rejection of the rejected patent claims was requested without amendment.

8. Although judgment was entered pursuant to a district court decision that claims 1-3 and 9 of the '133 patent were valid and had been infringed by Medtronic, and Medtronic filed a Notice of Appeal to the Court of Appeals for the Federal Circuit, on August 1, 2007, the appeal by Medtronic was dismissed by the Federal Circuit as being premature, and the case was remanded to the District Court for additional consideration of certain matters. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '247 proceeding) is an *inter partes* proceeding. The *inter partes* proceeding is still pending, and has not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/000,247 and 90/007,888 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

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[1] *Advanced Cardiovascular Systems Inc. et al v. Medtronic Vascular, Inc. et al*, slip. op. No. 2007-1365 (Fed. Cir. August 1, 2007)

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 neither the claims nor the specification have been amended in either reexamination proceeding, so that the claims and the specification are currently the same in both files, a "housekeeping amendment" is NOT needed.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. Therefore, the third party requester has the full *inter partes* reexamination participation rights in the merged proceeding that are set forth in 37 CFR 1.902 through 1.997.

It is noted that reexamination was ordered for claims 1-15 of the '133 patent (*i.e.*, all of the patent claims) in the '888 *ex parte* reexamination proceeding. [2], but the Order Granting *Inter Partes* Reexamination in the '247 *inter partes* reexamination proceeding did not specify which claims of the '133 patent would be subject to *inter partes* reexamination. The examiner will conduct reexamination in the merged proceeding for all of the claims of the '133 patent, (*i.e.*, claims 1-15 whether in original form or as amended during subsequent prosecution), and for any new claims subsequently entered as a result of amendment in the merged proceeding.

B. Papers mailed/filed:

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

All papers filed by the patent owner and the third party requester should be directed:

by Mail to:

Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

[2] Order Granting *Ex Parte* Reexamination, February 14, 2006, paragraph bridging pages 8 and 9.

by Hand to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Patent owner and requester are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other party (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other party, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as indicated above.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, (which incorporates the provisions of 37 CFR 1.530), and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP §2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time 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's appellant brief (or that of the *inter partes* requester) which may be filed, even though the brief relates to merged multiple proceedings and copies usually must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,247 and *ex parte* Reexamination Control No. 90/007,888 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to the undersigned, at 571-272-7743, or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710.

Stephen Marcus, 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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,888	01/23/2006	6432133	067448-0000004	1233

24201 7590 10/02/2008

FULWIDER PATTON LLP
HOWARD HUGHES CENTER
6060 CENTER DRIVE, TENTH FLOOR
LOS ANGELES, CA 90045

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2008

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

JACK S. BARUFKA
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

MAILED

02 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,247*. & 90/007,888

PATENT NUMBER *6,432,133*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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MAILED

OCT 02 2008

CENTRAL REEXAMINATION UNIT

Ex parte Reexamination Proceeding
Control No. 90/007,888
Filed: January 23, 2006
For: U.S. Patent No. 6,432,133

Inter Partes Reexamination Proceeding
Control No. 95/000,247
Filed: March 30, 2007
For: U.S. Patent No. 6,432,133

DECISION DISMISSING AND EXPUNGING PARTY PETITIONS AND, *SUA SPONTE*, EXPUNGING IMPROPER PARTY PAPERS

This is a decision on the petition filed on August 29, 2008 entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 AND COMMUNICATION TO EXAMINER" ("the petition"). This decision also treats the paper filed on September 11, 2008 entitled "PATENT OWNER'S REBUTTAL PETITION TO THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 AND COMMUNICATION TO EXAMINER" ("the opposition petition").

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

The third party requester and patent owner petitions are dismissed, and various papers are being expunged from the record, as will be discussed below.

FEES

Third party requester has authorized a charge against Deposit Account No. 03-3975 in the amount of $400.00 for the petition fee required by 37 CFR 1.183 and 1.17(f). That amount will be charged in the record of the reexamination control number 95/000,247. Patent owner also remitted the necessary $400.00 petition fee, and payment of the fee has been recorded in the record of reexamination control number 95/000,247.

RELEVANT BACKGROUND

1. U.S. patent No. 6,432,133 ("the '133 patent") issued to Lilip Lau et al on August 13, 2002, and was assigned to Advanced Cardiovascular Systems, Inc., now by change of name, Abbott Cardiovascular Systems.

2. A request for *ex parte* reexamination of claims 1-3, 8 and 9 of the '133 patent was filed on January 23, 2006, by Jack S. Barufka as the third party requester, and the request was assigned control number 90/007,888 ("the '888 *ex parte* reexamination proceeding").

3. On February 14, 2006, *ex parte* reexamination was ordered for claims 1-15 of the '133 patent.

4. A request for *inter partes* reexamination of claims 1-9 and 11 the '133 patent was filed on March 30, 2007, by Jack S. Barufka as the third party requester, in which Medtronic Vascular, Inc. was identified as the real party in interest. The request was assigned control number 95/000,247 ("the '247 *inter partes* reexamination proceeding").

5. On December 21, 2006, an Office action was mailed in the '888 *ex parte* reexamination proceeding that confirmed the patentability of claims 10, 11 and 15 of the '133 patent.

6. On March 3, 2007, patent owner filed a response to the '888 proceeding December 21, 2006 Office action, in which reconsideration of the rejection of the rejected patent claims was requested without amendment.

7. On April 24, 2007, *inter partes* reexamination was ordered for claims 1-9 and 11, but an Office action on claim patentability was not mailed at that time.

8. Although judgment was entered pursuant to a district court decision that claims 1-3 and 9 of the '133 patent were valid and had been infringed by Medtronic, and Medtronic filed a Notice of Appeal to the Court of Appeals for the Federal Circuit, on August 1, 2007, the appeal by Medtronic was dismissed by the Federal Circuit as being premature, and the case was remanded to the District Court for additional consideration of certain matters.

9. On February 7, 2008, the Office mailed a decision, *sua sponte*, merging the '888 ex parte reexamination proceeding and the '247 *inter partes* reexamination proceeding into a single combined reexamination proceeding ("the merged proceeding") to be conducted in accordance the rules and procedures that govern an *inter partes* reexamination proceeding.

10. On March 3, 2008, a non-final Office action was mailed in the merged proceeding.

11. After securing a one-month extension of time, patent owner filed a timely response to the March 3, 2008 Office action on June 5, 2008. The response included a 37 CFR 1.8 certificate of mailing dated June 3, 2008.

12. On July 3, 2008, third party requester filed written comments directed to both the March 3, 2008 Office action and the June 5, 2008 patent owner response.

13. On July 10, 2008, patent owner filed a paper entitled "Supplemental Information Disclosure Statement ("IDS").

14. On August 28, 2008, third party requester filed the present original petition.

15. On September 11, 2008, patent owner filed the present opposition petition.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's 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 1.906 provides:

(a) Claims in an *inter partes* 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 *inter partes* 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 an *inter partes* reexamination proceeding. If such issues are raised by the patent owner or the third party requester during 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 desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

37 CFR 1.939 provides:

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.
(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination.

37 CFR 1.945 provides:

(a) The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.
(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:
(1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
(2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
(3) A compelling reason to enter the supplemental response.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of

service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948 provides:

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

37 CFR 1.985 provides:

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. <u>Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.</u> [Emphasis added.]

MPEP § 724.02 provides, in part:

Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.

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

MPEP §724.04(c) provides, in part:

> Any materials, i.e., information, submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:
>
> (A) Any materials, i.e., information, properly submitted under MPEP § 724.02 in a reexamination proceeding will be sealed from public view. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is material to patentability. A petition to expunge (37 CFR 1.59) should accompany the submission of proprietary materials, and in any event, must be filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC). If the petition to expunge is not filed in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process, or the petition is filed, and denied/dismissed, then the materials submitted under MPEP § 724.02 will be released to the public with any other papers in the reexamination file. ...

DECISION

I. Consideration of the Third Party Requester Petition

Third party requester has apparently recognized that having once filed written comments on July 3, 2008 that are directed to the March 3, 2008 non-final Office action and the June 5, 2008 patent owner response thereto, the written comments (in the form of a "communication" to the examiner) that are incorporated into the present petition and the three exhibits that were filed concurrently with the present petition do not enjoy an entry right under the provisions of 37 CFR 1.947 and 37 CFR 1.948. Therefore, third party requester has petitioned for waiver of the provisions 37 CFR 1.939, which would preclude consideration of these papers.

Requester has not, however, demonstrated that an extraordinary situation exists such that the written comments and accompanying exhibits must be entered at the present stage of the proceeding, whereby the regulations should be waived in the interest of justice. Rather, the record shows that the merged reexamination proceeding is only at the stage where the examiner will act on party responses and written comments to a non-final rejection. Requester has not demonstrated why these comments and information could not be submitted at a later stage of the proceeding.

Also, it is stated in the present petition that at least some one of the information in the attached exhibits is not particularly relevant to the prior patent to which the information in the document is directed. [1] That being the case, it is found that this information is not of such character that the failure of the examiner to consider it at the present stage of the merged reexamination proceeding would preclude requester from obtaining "justice" in the present merged proceeding.

Further, the submitted documents are marked "Confidential - Outside Attorney's Only," and so are presumably subject to a protective order issued by a court of competent jurisdiction. However, this information was not submitted in an envelope clearly labeled as including confidential material or with a petition to expunge, as required by MPEP §§ 724.02 and 724.04.

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[1] "Third Party Requester's Petition ... ," last paragraph on page 3 and continuing on page 4.

Finally, the present petition contains a comment directed to the conduct of patent owner based on patent owner having submitted the confidential information to third party requester. [2] A reexamination proceeding, (which is an administrative proceeding conducted under the provisions of the reexamination statute and rules, not a litigation before a court), is limited by the provisions of 37 CFR 1.906 to issues of patentability based on prior patens and printed publications. Comments on party conduct are not proper in the merged reexamination proceeding. The Office will not waive the provisions of 37 CFR 1.906, because such provisions are contained in the reexamination statute that limits reexamination proceedings to consideration of prior patents and printed publications. [3]

For the foregoing reasons, the relief requested by third party requester will not be granted. Further, as the present petition contains remarks precluded by 37 CFR 1.906, the petition paper will be expunged from the record by being marked "closed" and "non-public" in the electronic Image File Wrapper (IFW) of the files comprising the merged reexamination proceeding. [4] The submitted documents themselves have been marked as being non-public, and are not accessible to the public.

II. Consideration of the Patent Owner's Opposition Petition

The patent owner opposition paper is moot in view of the disposition of the third party requester petition. However, the opposition paper also includes a comment directed to the conduct of third party requester, and for that reason, will be expunged from the record in the manner discussed above.

III. Patent Owner's Response to the March 3, 2008 Office Action

A review of the record occasioned by the party petition and opposition papers has shown that the June 5, 2008 patent owner response to the non-final Office action mailed on March 3, 2008 contains material that is not provided for by 37 CFR 1.906. Such material appears at footnote 4 of the paper, which is directed to an issue of conduct on the part of the third party requester. As noted in Section I, above, comments directed to the conduct of another party are not are not proper in reexamination proceedings before the Office. Accordingly, the patent owner response of June 5, 2008, but not the attachments thereto, will be expunged in the manner discussed in Section I.

Patent owner is provided with a non-extendable period of fifteen (15) days from the date of this decision to provide a redacted version of the June 5, 2008 response, that does not include comments directed to party comments. Patent owner should review the entire document carefully; submission of a redacted version that includes any comment directed to conduct of the third party requester will result in a final refusal to accept a patent owner response to the March 3, 2008 Office action. The redacted submission may not include any changes beyond redaction of material that constitutes a comment directed to the conduct of the third party requester.

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[2] Beginning at the top of page 3, and also in the first paragraph of subsection A on page 3.
[3] See: 35 U.S.C. §§ 301 and 311.
[4] Papers that have been scanned into the electronic IFW cannot be physically removed.

IV. Third Party Requester's July 3, 2007 Written Comments

A review of the record occasioned by the party petition and opposition papers has shown that the July 3, 2008 written comments to the March 3, 2008 Office action and the June 5, 2008 patent owner response to that Office action mailed on March 3, 2008 contains a section entitled "Update to Related Litigation." 37 CFR 1.985(b) provides that "any person," (including a third party requester) may call attention to a concurrent proceeding *e.g.*, concurrent litigation on the patent that is the subject of an *inter partes* reexamination proceeding, the notice of which must be strictly limited to bare notice of the concurrent proceeding. In this case, the Notice is not so limited because, the information is provided within the written comments paper. The information contained in the submitted as a separate paper, as required by 37 CFR 1.985(b); however, in this instance the information is not provided for in a paper that is limited to the notice regarding the related litigation. so limited. Rather, the "Update to Related Litigation is not provided in a separate paper as required by the rule. Accordingly, the July 3, 2008 third party written comments, but not the attachments thereto, are being expunged from the record in the manner discussed in Section I, above.

Third party requester is provided with a non-extendable period of fifteen (15) days from the date of this decision to provide a redacted version of the July 3, 2008 written comments, which does not include information regarding the concurrent litigation. Requester may then also file a separate paper directed to the status of the concurrent litigation limited to bare notice thereof. Requester should review the entire document carefully; submission of a redacted version that includes any information regarding the status of the concurrent litigation will result in a final refusal to accept third party requester comments directed to the March 8, 2008 Office action and the patent owner response thereto..

V. Treatment of Patent Owner's IDS Filed July 10, 2008

A review of the IDS paper filed on July 10, 2008 shows that the submitted paper includes a letter from patent owner's counsel to third party requester's counsel. That letter is not "prior art," and perforce, cannot contain information material to patentability of the claimed invention in the merged reexamination proceedings. Further, the letter also contains statements that have been redacted, but it is stated in the paper that such statements will show that certain positions taken by the third party requester are "inconsistent" with arguments made by requester to the Office. As such, submission of the letter appears to be for the purpose of rebutting a position taken by the third party requester, and is, therefore, improper pursuant to the provisions of 37 CFR 1.945 absent a showing of why such a supplemental response should be entered, pursuant to 37 CFR 1.945(b).

The letter from patent owner's counsel has been expunged from the record in the manner discussed in Section I, above.

ADDITIONAL DISCUSSION

The parties are advised that the Office intends to conduct the present merged proceeding with special dispatch. Accordingly, the parties are advised to carefully review the reexamination statute and rules, and the practice guidelines set forth in the Manual of Patent Examining Procedure, prior to filing any papers in this proceeding. A paper that appears to be filed in clear violation of the statutes, rules or procedures, or that appears to

be interposed for purposes of delay, does not meet the requirements of 37 CFR 10.18(b). The filing of such a paper will result in consideration of referral to the Office of Enrollment and Discipline for such action as it may deem to be appropriate.

CONCLUSION

1. The third party requester petition is dismissed, and is being expunged from the record.

2. The patent owner petition is dismissed as being moot, and is being expunged from the record.

3. The June 5, 2008 patent owner response paper, but not the attachments thereto, is being expunged from the record.

4. Patent owner is being provided with a non-extendable period of fifteen (15) days from the date of this decision to provide a redacted version of the June 5, 2008 patent owner response paper.

5. The July 3, 2008 third party requester written comments paper, but not the attachments thereto, is being expunged from the record.

6. Third party requester is being provided with a non-extendable period of fifteen (15) days from the date of this decision to provide a redacted version of the July 3, 2008 requester written comments paper.

7. The letter from patent owner's counsel to third party requester's counsel submitted on by patent owner on July 10, 2008 is being expunged from the record.

8. Telephone inquiries related to this decision should be directed to Stephen Marcus, Senior Legal Advisor, 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

sm
September 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Fulwider Patton LLP
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045

(For Patent Owner)

MAILED

OCT 2 6 2007

CENTRAL REEXAMINATION UNIT

Jack S. Barufka
Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, VA 22102

(For 3rd Party Requester)

Reexam Control No.: 90/007,889
Filed : January 23, 2006
For U.S. Patent No. : 6,066,167

Reexam Control No.: 90/008,620
Filed : May 7, 2007
For U.S. Patent No. : 6,066,167

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).

Consideration of 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."

Reexamination in application control No. 90/007,889 was ordered in a decision mailed February 14, 2006. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the response. There have been no changes made to the specification, claims or drawings. Claims 1-8, all of the claims, are being reexamined in this proceeding.

Reexamination in application control No. 90/008,620 was ordered in a decision mailed June 14, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the mailing of the order granting reexamination. There have been no changes made to the specification, claims, or drawings. Claims 1-8, all of the claims, are being reexamined in this proceeding.

As evidenced by the above facts, reexamination control No. 90/007,889 and reexamination control No. 90/008,620 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. 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. 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. 90/007,889 and 90/008,620 are hereby merged into a single proceeding. 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

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(For 3rd Party Requester)

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Filed : January 23, 2006
For U.S. Patent No. : 6,066,167

Reexam Control No.: 90/008,620
Filed : May 7, 2007
For U.S. Patent No. : 6,066,167

Reexam Control No.: 90/009,159
Filed : May 23, 2008
For U.S. Patent No. : 6,066,167

DECISION MERGING
REEXAMINATION
PROCEEDINGS

MAILED

SEP 10 2008

CENTRAL REEXAMINATION UNIT

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).

Consideration of 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."

Reexamination in application control No. 90/007,889 was ordered in a decision mailed February 14, 2006 indicating that claims 1-8, all of the claims in the patent would be reexamined.

Reexamination in application control No. 90/008,620 was ordered in a decision mailed June 14, 2007 indicating that claims 1-8, all of the claims in the patent would be reexamined.

In a decision mailed October 26, 2007, reexamination proceedings 90/007,889 and 90/008,620 were merged. This merged proceeding received an Office action on February 11, 2008. Following the grant of an extension of time request, a response to the Office action was received

May 14, 2008. Subsequently, on July 10, 2008 a Supplemental Disclosure Statement was filed. No further action has taken place in this merged reexamination proceedings. Further, there have been no amendments made to the claims, specification and/or drawings.

Reexamination in application control No. 90/009,159 was ordered in a decision mailed June 17, 2008 indicating that claims 5 and 8 would be reexamined. An Information Disclosure Statement was filed on July 11, 2008. No amendments to the claims, specification and/or drawings have been made in this reexamination proceeding. No office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,889, reexamination control No. 90/008,620, and reexamination control No. 90/009,159 are currently pending. Since the order to reexamine has been mailed in each of the 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 Each Proceeding

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

Conduct of Proceedings

The reexamination proceedings are hereby consolidated and will result in the issuance of a single certificate. Claims 1-8, 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 each of the reexamination proceedings. All papers issued by the Office will contain the identifying data for each case, and each action will be entered into each of the 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 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. 90/007,889, 90/008,620 and 90/009,159 are hereby merged into a single proceeding. 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.

Gregory Morse, Director
Central Reexamination Unit

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(For Patent Owner)

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OCT 2 2007
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(For 3rd Party Requester)

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OCT 2 6 2007
CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/007,890
Filed : January 23, 2006
For U.S. Patent No. : 6,066,168

DECISION MERGING REEXAMINATION PROCEEDINGS

Reexam Control No.: 90/008,619
Filed : May 7, 2007
For U.S. Patent No. : 6,066,168

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).

Consideration of 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."

Reexamination in application control No. 90/007,890 was ordered in a decision mailed February 14, 2006. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the response. There have been no changes made to the specification, claims or drawings. Claims 1-18, all of the claims, are being reexamined in this proceeding.

Reexamination in application control No. 90/008,619 was ordered in a decision mailed June 20, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the mailing of the order granting reexamination. There have been no changes made to the specification, claims, or drawings. Claims 1-8, 12 and 14, are being reexamined in this proceeding.

As evidenced by the above facts, reexamination control No. 90/007,890 and reexamination control No. 90/008,619 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. 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. 90/007,890 and 90/008,619 are hereby merged into a single proceeding. 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

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Reexam Control No.: 90/007,890
Filed : January 23, 2006
For U.S. Patent No. : 6,066,168

Reexam Control No.: 90/008,619
Filed : May 7, 2007
For U.S. Patent No. : 6,066,168

Reexam Control No.: 90/009,158
Filed : May 23, 2008
For U.S. Patent No. : 6,066,168

DECISION MERGING
REEXAMINATION
PROCEEDINGS

MAILED

SEP 2 4 2008

CENTRAL REEXAMINATION UNIT

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).

Consideration of 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."

Reexamination in application control No. 90/007,890 was ordered in a decision mailed February 14, 2006 indicating that claims 1-3, and 11 of the patent would be reexamined.

Reexamination in application control No. 90/008,619 was ordered in a decision mailed June 20, 2007 indicating that claims 1-8, 12 and 14 of the patent would be reexamined.

In a decision mailed October 26, 2007, reexamination proceedings 90/007,890 and 90/008,619 were merged. This merged proceeding received an Office action on February 11, 2008. Following the grant of an extension of time request, a response to the Office action was received May 14, 2008. Subsequently, on July 11, 2008 two Supplemental Disclosure Statements were

filed. No further action has taken place in this merged reexamination proceedings. Further, there have been no amendments made to the claims, specification and/or drawings.

Reexamination in application control No. 90/009,158 was ordered in a decision mailed July 11, 2008 indicating that claims 1-3, and 11 would be reexamined. No amendments to the claims, specification and/or drawings have been made in this reexamination proceeding. No office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,890, reexamination control No. 90/008,619, and reexamination control No. 90/009,158 are currently pending. Since the order to reexamine has been mailed in each of the 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 Each Proceeding

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

Conduct of Proceedings

The reexamination proceedings are hereby consolidated and will result in the issuance of a single certificate. Claims 1-8, 11, 12, and 14, the claims of the patent for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexamination proceedings. All papers issued by the Office will contain the identifying data for each case, and each action will be entered into each of the 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 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. 90/007,890, 90/008,619 and 90/009,158 are hereby merged into a single proceeding. 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.

Gregory Morse, Director
Central Reexamination Unit

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NOV 28 2008

CENTRAL REEXAMINATION UNIT

Christie Parker & Hale, LLP
P.O. Box 7068
Pasadena, CA 91109-7066

(For Patent Owner)

Crowell & Moring, LLP
Intellectual Property Group
P. O. Box 14300
Washington, D.C. 20044-4300

(For Requester)

In re Obradovich
Ex Parte Reexamination Proceeding
Control No. 90/007,896
Filed: January 23, 2006
For: U.S. Patent No. 6,282,464

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the October 7, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the October 7, 2008 patent owner petition to revive").

The October 7, 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 $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) will be charged to deposit account no. 11-1159, as authorized on the first page of the transmittal form received on October 7, 2008.[1]

SUMMARY

The October 7, 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

[1] The patent owner indicates, on the first page of the instant petition, that a credit card authorization form PTO-2038 was submitted on October 7, 2008, authorizing the Office to charge the $1620 petition fee under 37 CFR 1.17(m). Office records fail to reveal, however, the receipt in this reexamination proceeding of a petition fee under 37 CFR 1.17(m) paid by credit card on or after October 7, 2008.

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 was unintentional. The patent owner has submitted a notice of appeal and appeal fee on October 20, 2008, which satisfies item (1).[2] A petition fee and a proper statement under 37 CFR 1.137(b)(3) have also been submitted with the October 7, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

[2] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (b).

Accordingly, the October 7, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[3] is **granted**.

CONCLUSION

- The October 7, 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 October 7, 2008 patent owner response to the August 14, 2008 final Office action.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Albert Gagliardi, of CRU Art Unit 3992, at (571) 272-2436.
- 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

[3] 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.
90/007,909	01/31/2006	6975732	283800US6RX	3750

22850 7590 09/02/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/02/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. (For Patent Owner)
1940 Duke Street
Alexandria, VA 22314

In re Nishiguchi *et alia*	: DECISION DENYING
Reexamination Proceeding	: PETITION UNDER
Control No. 90/007,909	: 37 CFR 1.181 AND
For: U.S. Patent No. 6,975,732	: 37 CFR 1.515(c)

This is a decision on the May 2, 2006 paper entitled "PATENT OWNER'S RESPONSE", which is construed as a petition under 37 CFR 1.515(c) and 37 CFR 1.181 requesting reconsideration of the order denying the request for *ex parte* reexamination mailed April 24, 2006. The petition was timely filed. No fee is required. The petition is now before the Director of the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 6,975,732 (hereinafter, the '732 patent) issued on December 13, 2005 to Nishiguchi *et alia.*

2. On January 31, 2006, a request for *ex parte* reexamination was deposited by patent owner, and this reexamination proceeding was assigned Control No. 90/007,909 (hereinafter, the '7909 proceeding).

3. An order denying the request for ex parte reexamination was mailed on April 24, 2006.

4. On May 2, 2006, a paper entitled "PATENT OWNER'S RESPONSE" was filed.

DECISION

Upon a *de novo* review of the request papers, patent owner requests that reexamination of the '732 patent be granted due to references brought to light in a JPO Appeal Decision. However, as set forth in section IV of the request, the new references were applied to a different claim in the Japanese appeal.

"Independent Claim 1 is more specific than Claims 1 and 2 of the corresponding Japanese priority document, which was the subject of the JPO Appeal Decision. In particular, independent Claim 1 further defines the compression encoding used by including sub-band dividing audio data into a plurality of frequency bands and quantizing a frequency component transformed from audio data for each of a plurality of frequency bands according to a masking spectrum associated with the frequency component for each of the plurality of frequency bands in a minimum audible curve based on the human auditory sense. The JPO Appeal Decision did not deal with these further claim limitations, as they were absent in the claims considered by the Japanese appeal panel."

The request also clearly sets forth that requester does not consider the submitted prior art to meet various limitations in the claims.

"It is respectfully submitted that neither JP 61-121500 (corresponding to JP Application No. 60-2817), nor JP 62-168199 (corresponding to JP Application No. 61-57308) teach or suggest the division of audio data into a plurality of frequency bands, or quantizing the frequency component according to a masking spectrum for each of the plurality of frequency bands and a minimum audible curve based on the human auditory sense."

An independent *de novo* review agrees with requester's conclusion. It is also noted that these are the limitations that were added to the claims in the preliminary amendment of March 13, 2002 to overcome prior art that was of record during prosecution of the '732 patent and/or prosecution of the parent applications.

The newly submitted references are cumulative to the art that was before the examiner during the prosecution that led to the '732 patent. Therefore, an examiner would not consider these references to contain new teachings. Thus, there is no substantial new question of patentability raised by the references presented in the request.

SUMMARY AND CONCLUSION

No substantial new question of patentability affecting at least one claim of U.S. Patent No. 6,975,732 has been presented by requester for the reasons set forth above.

The petition is **DENIED**.

The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Eric Keasel for

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,910	02/01/2006	6175752	003168.0333	2596

21003 7590 03/31/2009

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NEW YORK, NY 10112-4498

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2009

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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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JACKSON & CO., LLP
6114 LA SALLE AVENUE
#507
OAKLAND, CA 94611-2802

(For Patent Owner)

MAILED
MAR 31 2009
CENTRAL REEXAMINATION UNIT

PENG CHEN
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE SUITE 100
SAN DIEGO, CA 92130-2040

(For Third Party Requester)

WALTER EGBERT, III
BAKER BOTTS L.L.P.
30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK, NY 10112-4498

(Courtesy Copy)

In re Say et al.
Ex Parte Reexamination Proceeding
Control No. 90/007,910
Filed: February 1, 2006
For: U.S. Patent No. 6,175,752

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the March 3, 2009 patent owner petition entitled "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)." The present petition is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed Notice of Appeal and revive the present terminated reexamination prosecution ("the March 3, 2009 patent owner petition to revive").[1]

The appropriate fees of $540 and $1620 set forth in 37 CFR 41.20(b)(1) and 37 CFR 1.17(m), respectively, for the Notice of Appeal filed on March 3, 2009 and the present petition filed under 37 CFR 1.137(b) have been charged to deposit account number 02-4377 on March 3, 2009.

The present petition and the 90/007,910 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The petition to revive is **granted**.

[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 October 2, 2008.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 305 provides, in pertinent part:

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*

*

(d) *Terminal disclaimer.*

*

*

(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 711.03(c)(II)(A)(2)(b) provides, in pertinent part:

A reply under 37 CFR 1.113 to a final action must include ... cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, ... the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee; [or]

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance;

*

*

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was

unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Patent owner submitted a Notice of Appeal and paid the corresponding fee of $540.00 on March 3, 2009, thereby satisfying item (1).[2] A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the March 3, 2009 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 (item 4). 37 CFR 1.137(d)(3)

Accordingly, the March 3, 2009 patent owner petition to revive is **granted**

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent and (2) the 90/007,910 proceeding. The current correspondence address of record **in the patent file** is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of JACKSON & CO., LLP, 6114 LA SALLE AVENUE #507, OAKLAND CA 94611-2802. Accordingly, all future correspondence will be directed to JACKSON & CO., LLP, 6114 LA SALLE AVENUE #507, OAKLAND, CA 94611-2802, unless patent owner changes the correspondence address of record in the patent (the same address should be explicitly made of record in the reexamination proceeding).

As a one-time courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of JACKSON & CO., LLP, 6114 LA SALLE AVENUE #507, OAKLAND,

[2] See MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

CA 94611-2802, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. The March 3, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. 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).

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for processing of the March 3, 2009 Notice of Appeal.

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Albert Gagliardi, of CRU Art Unit 3992, at (571) 272-2436.

5. Any inquiry concerning this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,913	02/01/2006	6284478	518852800200	5776

21003 7590 11/23/2007

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,665	05/25/2007	6284478	12008.6USR3	3355

23552 7590 11/23/2007
MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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CENTRAL REEXAMINATION UNIT

Walter M. Egbert, III
BAKER BOTTS, L.L.P.
30 Rockefeller Plaza
New York, NY 10112

(for Patent Owner)

Peng Chen
Morrison & Foerster, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

(for Third Party Requester)

In re Heller et al.
Reexamination Proceeding
Control No.: 90/007,913
Filed: February 1, 2006
For: U.S. Patent 6,284,478

In re Heller et al.
Reexamination Proceeding
Control No.: 90/008,665
Filed: May 25, 2007
For: U.S. Patent 6,284,478

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).

REVIEW OF SALIENT FACTS

1. United States Patent 6,284,478 issued September 4, 2001, is the subject of Reexamination Control Nos. 90/007,913 and 90/008,665.

2. A first request for Reexamination, assigned Reexamination Control No. 90/007,913 was filed February 1, 2006 by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1-74.

3. Reexamination was ordered for 90/007,913 on February 24, 2006.

4. A first non-final Office action for 90/007,913 was mailed on November 29, 2006.

5. Patent Owner filed a response on February 1, 2007.

6. A second request for Reexamination, assigned Reexamination Control No. 90/008,665, was filed May 25, 2007 by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references in combination with previously cited references regarding claims 1-3, 9, 22-30, 32-35, 39-41, 43-46, 52-59, 61, 64, 66, 67, and 69-74.

7. Reexamination was ordered for 90/008,665 on July 31, 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* 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 SALIENT FACTS, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 2283 further sets forth:

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,913 and 90/008,665 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 of this decision placing identical claims in both files. The paper should be strictly limited to the bare presentation of 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 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. 90/007,913 and 90/008,665 as:

Reexamination Control Ns. 90/007,913 and 90/008,665 as:

Walter M. Egbert, III
BAKER BOTTS, L.L.P.
30 Rockefeller Plaza
New York, NY 10112

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control No. 90/007,913 and 90/008,665 as:

Peng Chen
Morrison & Foerster, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

CONCLUSION

Reexamination Control Nos. 90/007,913 and 90/008,665 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

for Deborah Green
Lissi M. Marquis, Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

Peng Chen
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

(For Third Party Requester)

In re Heller et al.
Reexamination Proceeding
Control No.: 90/007,914
Filed: February 1, 2006
For: U.S. Patent 6,329,161

In re Heller et al.
Reexamination Proceeding
Control No.: 90/008,713
Filed: July 25, 2007
For: U.S. Patent 6,329,161

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,329,161, issued December 11, 2001, is the subject of Reexamination Control Nos. 90/007,914 and 90/008,713.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,914 ('7914), was filed February 1, 2006 by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1 - 10, 16 - 20, 22, 25 - 43, 47, and 48.

3. Reexamination was ordered for '7914 on February 28, 2006.

4. A first Office action for '7914 was mailed December 15, 2006.

Copied from 90008713 on 01/15/2008

5. Patent owner filed a response on March 1, 2007.

6. A second request for re-examination, assigned Reexamination Control No. 90/008,713, was filed July 25, 2007 by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references in combination with previously cited references regarding claims 1 - 48.

7. Reexamination was ordered for 90/008,713 on October 18, 2007.

8. Patent Owner filed a "Waiver of Patent Owner's Statement under 37 CFR §1.530" on November 18, 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* proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under §1.570.

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. §1.565(c), the 90/007,914 and 90/008,713 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 in both files are not the same, the Patent Owner is given one month to to file a "Housekeeping" amendment in order to make the claims the same in each file (identical amendments to be placed in both files) See MPEP §2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

Copied from 90008713 on 01/15/2008

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,914 and 90/008,713 as:

Walter M. Egbert, III
BAKER & BOTTS, L.L.P.
30 Rockefeller Plaza
New York, NY 10112

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,914 and 90/008,713 as:

Peng Chen
Morrison & Foerster, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

CONCLUSION

Reexamination Control Nos. 90/007,914 and 90/008,713 are merged. The Patent Owner is given **one month** from the date of the mailing of this decision to merge in order to file amendments in both cases making the claims identical. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course after the Patent Owner has filed the "Housekeeping" amendment.

for Lissi M. Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,916	02/06/2006	6583123	24047.330-USC03	3145

26853 7590 05/17/2007

COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/17/2007

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

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Thomas Bradshaw
Covington & Burling LLP
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401

(For Patent Owner)

MAILED

MAY 17 2007

CENTRAL REEXAMINATION UNIT

In re: Robert W. Henderson et al
Ex Parte Reexamination Proceeding
Control No. 90/007,916
Filed: February 10, 2006
For: US Patent No. 6,583,123

DECISION
DISMISSING
PETITION

This is a decision on the petition entitled "PETITION UNDER 37 CFR 1.181 TO WITHDRAW FINALITY OF OFFICE ACTION" filed December 18, 2006 to request the withdrawal of the finality of the Office action mailed August 23, 2006.

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

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

FEE

The petition is being considered pursuant to 37 CFR 1.181. No fee is required for the petition.

REVIEW OF FACTS

1. A patent owner request for *ex parte* reexamination of United States Patent No. 6,583,123 (the '123 patent) was filed by patent owner on February 6, 2006 and assigned control number 90/007,916 (the '916 reexamination proceeding).

2. An Order granting reexamination in the '916 reexamination proceeding was mailed on February 23, 2006.

3. A first non-final Office action rejecting all of the claims of the '123 patent under 35 USC 103 over Bucci, Pujalte, Henderson, Konig, and Andersen was mailed May 31, 2006.

4. On June 30, 2006, patent owner filed a response that included four (4) declarations by Dr. Lippiello. No amendments were made to the '123 patent claims and no additional claims were proposed.

5. On July 12, 2006, the Examiner held a personal interview with patent owner's representatives.

6. On July 19,2006 Patent Owner filed an Information Disclosure Statement listing GB 2317109, WO 96/33703 and including a search report from EP 98915591.

7. On August 23, 2006, a Final Office action was mailed repeating the rejection of claims 8-13 on the same grounds as had been set forth in the May 31, 2006 non-final Office action. Claims 1-7 were confirmed as being patentable. [1]

8. On September 25, 2006, Patent Owner filed a response in which no claims of the '123 patent were amended, additional claims 14-19 were proposed and several declarations were filed. Patent owner argued that the finality of the August 23, 2006 Office action was premature, or, in the alternative, that entry and consideration of the amendment was proper because there was good cause for therefor.

9. On October 13, 2006 the Examiner held a personal interview with patent owner's representatives.

9. On October 18, 2006, an Advisory action was mailed in which the examiner stated that the arguments and declarations were considered but rejection of record would be maintained as to finally rejected claims 8-13. Claims 1-7 of the '123 patent were again confirmed as being patentable. Newly proposed claims 14-19 were not be entered because they raised new matter issues and were presented without canceling the same number of finally rejected claims.

10. On October 25, 2006 the patent owner filed a Notice of Appeal.

11. On December 18, 2006, patent owner filed the present petition.

12. On December 18, 2006, patent owner also filed a petition under 37 CFR 1.182 for continued reexamination.

13. On December 26, 2006, patent owner filed an appeal brief.

14. No action has been taken with respect to the December 18, 2006 petition under 37 CFR 1.182.

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[1] See page 3, paragraph 5 of the Office action dated August 23, 2006. The cover sheet for this Office action incorrectly indicates that claims 1-13 were rejected.

RELEVANT STATUTES, REGULATIONS AND PRACTICE

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.

37 CFR 1.116 provides, in part:

> (b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, ..., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
> (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
> (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
> (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.
>
> ...
>
> (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 ... 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 1.550(a) provides:

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

MPEP 2271 provides, in part:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...
>
> It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

MPEP 706.07(a) states in part:

> Under present practice, second or any subsequent actions of the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP 2272 provides, in part:

> It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution. Consideration of amendments submitted after final rejection and prior to, or with, the appeal will be governed by the strict standards of 37 CFR 1.116. ...
>
> 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.

DECISION

A review of the record shows that after reexamination was ordered, a first non-final Office action was mailed on May 31, 2006 in which the examiner rejected patent claims 1-13 (all of the '123 patent claims) for obviousness under 35 U.S.C. § 103 based upon Bucci, Pujalte, Henderson, Konig, and Andersen prior patents and printed publications. Thereafter, on June 30, 2006, patent owner requested reconsideration of the examiner's non-final Office action, without amendment of the patent claims, and without presentation of additional claims. The examiner then issued an Office action on August 23, 2006 in which claims 1-13 of the '123 patent for obviousness under 35 U.S.C. § 103 based upon Bucci, Pujalte, Henderson, Konig, and Andersen prior patents and printed publications was maintained. This Office action was made final. On September 25, 2006, patent owner filed a response to the final rejection in which patent owner did not amend any of the finally rejected claims, but included both additional claims proposed for the first time, and additional declarations attempting to rebut patentability.

Patent owner contends that the finality of the August 23, 2006 Office action was "premature, improper and unfairly prejudicial." [2] Patent owner argues that finality was improper because there were no amendments to the claims and the Examiner introduced new grounds of rejection which were not necessitated by amendment or introduction of information submitted by the Patent Owner. [3]

However, a review of the examiner's final Office action dated August 23, 2006 shows that the examiner did <u>not</u> introduce a new ground of rejection. Rather, a review of the record shows that the patent owner's June 30, 2006 response to the examiner's non-final Office action included a rebuttal argument and four verified statements (declarations) as additional evidence to overcome the examiner's rejection of claims 1-13. In order to compose a complete response to the June 30, 2006 patent owner response, it was necessary that the examiner's Office action dated August 23,

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[2] Petition Under 37 CFR 1.181 to Withdraw Finality of Office Action, December 18, 2006, page 2.
[3] *Id.*, at page 10.

2006 addressed both patent owner's rebuttal argument and the declaration evidence that were part of patent owner's response. No new rejections were made and no new references were proffered with respect to finally rejected claims 8-13. The Townsend Letters article, which is of record in the patented file, was not employed as evidence to establish a prima facie case of obviousness in the examiner's stated grounds of rejection. Rather, the Townsend Letters article was offered as evidence to address patent owner's evidence offered to overcome the examiner's stated grounds of rejection.

Thus, the examiner's designation of the August 23, 2006 Office action as a final action was in full compliance with the practice set forth in MPEP § 706(a), which is applicable to *ex parte* reexamination proceedings in accordance with MPEP § 2271. No new evidence was relied upon by the examiner in her grounds of rejection to establish a *prima facie* case of obviousness. Rather, the examiner's action, which, in accordance with MPEP § 2272 was required to reflect the development of a complete issue between patent owner and the examiner as to patentability before it could be made final, relied only upon the same evidence relied upon to set forth a prima facie case of obviousness as had been relied on in the non-final Office action dated May 31, 2006. That the examiner cited to certain additional evidence in order to address the evidence proffered by patent owner to rebut the examiner's *prima facie* does not show the lack of a clear issue between patent owner and the examiner. Otherwise, an action could never be made final so long as a patent owner could offer evidence to rebut a *prima facie* case of unpatentability in the immediately prior Office action.

Further, in the response to the final office action, patent owner clearly requested the examiner to either withdraw the finality of the office action or enter and consider the amendment and evidence submitted in the response. The examiner did in fact consider the amendment and the remarks as requested. The after-final amendment adding six new claims (claims 14-19) was not entered because it raised new issues and was not accompanied by the cancellation of a corresponding number of finally rejected claims. Patent owner's response after final rejection does not explain by claims 14-19 could not have been presented prior to final rejection, that is, why there was good and sufficient for entry of the these claims after final rejection reason as required by 37 CFR 1.116(b)(3). The new evidence submitted after final rejection was in fact entered, [4] but was not deemed to overcome the rejection of record of claims 8-13 for the reasons set forth in the final office action of August 23, 2006 and reiterated in the advisory action mailed October 18, 2006.

CONCLUSION

1. The Patent Owners' petition for withdrawal of the finality of the Office action mailed August 23, 2006 and entry of the amendment after final action filed October 18, 2006 is **dismissed**.

2. Patent Owners' petition under 37 CFR 1.182 for Continued Reexamination has been forwarded to the Office of Petitions for a decision.

3. Any request for reconsideration must be submitted within the time set by 37 CFR 1.181(f).

---

[4] Advisory Action, October 18, 2006, paragraph 9.

4. Any 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

5. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

Deborah Jones

for Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Thomas Bradshaw
Covington & Burling LLP
1201 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2001

(For Patent Owner)

MAILED

JUN 08 2007

CENTRAL REEXAMINATION UNIT

In re: Robert W. Henderson et al.
Reexamination Proceeding
Control No.: 90/007,916
Filed: February 6, 2006
For: U.S. Patent No.: 6,583,123

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the December 18, 2006 patent owner petition, denominated "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. DA 50-0740.

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

REVIEW OF FACTS

1) U.S. Patent No. 6,583,123 (the '123 patent) issued on June 24, 2003.

2) A patent owner request for *ex parte* reexamination of United States Patent No. 6,583,123 (the '123 patent) was filed by patent owner on February 6, 2006, and assigned control number 90/007,916 (the '916 reexamination proceeding).

3) An Order granting reexamination in the '916 reexamination proceeding was mailed on February 23, 2006.

4) A first non-final Office action rejecting all of the claims of the '123 patent under 35 U.S.C. 103 over Bucci, Pujalte, Henderson, Konig, and Andersen was mailed May 31, 2006.

5) On June 30, 2006, patent owner filed a response that included four (4) declarations by Dr. Lippiello. No amendments were made to the '123 patent claims, and no additional claims were proposed.

6) On July 12, 2006, the examiner conducted a personal interview with patent owner's representatives.

7) On July 19,2006, the patent owner filed an Information Disclosure Statement (IDS) listing GB 2317109, WO 96/33703 and including a search report from EP 98,915,591.

8) On August 23, 2006, a final Office action was mailed, repeating the rejection of claims 8-13 on the same grounds as had been set forth in the May 31, 2006 non-final Office action. Claims 1-7 were confirmed as being patentable.[1]

9) On September 25, 2006, patent owner filed a response in which no claims of the '123 patent were amended, additional claims 14-19 were proposed, and several declarations were filed. Patent owner argued that the finality of the August 23, 2006 Office action was premature, or, in the alternative, that entry and consideration of the amendment was proper because there was good cause for therefor.

10) On October 13, 2006, the examiner conducted a personal interview with patent owner's representatives.

11) On October 18, 2006, an advisory Office action was mailed, in which the examiner stated that the arguments and declarations were considered, but the rejection of record would be maintained as to finally rejected claims 8-13. Claims 1-7 of the '123 patent were again confirmed as being patentable. Newly proposed claims 14-19 were not be entered, because they were found by the examiner (a) to raise new matter issues and (b) to have been presented without canceling the same number of finally rejected claims.

12) On October 25, 2006, the patent owner filed a Notice of Appeal.

13) On December 18, 2006, patent owner filed a petition under 37 CFR 1.181, requesting withdrawal of the finality of the August 23, 2006 Office action.

14) On December 18, 2006, patent owner also filed the instant petition under 37 CFR 1.182, for continued reexamination and entry of the September 25, 2006 patent owner response.

15) On December 26, 2006, patent owner filed an appeal brief.

16) On May 17, 2007 the Director of the Central Reexamination Unit (CRU) issued a decision dismissing patent owner's petition for withdrawal of the finality of the August 23, 2006 Office action.

[1] See page 3, paragraph 5, of the Office action dated August 23, 2006. The cover sheet for that Office action incorrectly states that claims 1-13 were rejected

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 September 25, 2006. [2]

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [3] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that all 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.

Petitioner 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."

Patent owner's arguments are directed entirely to the propriety of the final rejection. This issue has been addressed in the petition decision of the CRU Director mailed May 17, and it is not relevant to whether the continuation of prosecution should be granted.

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[2] Item 9 in the Review of Facts.

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

A review of the record reveals the following, which could justify the granting of the petition for further prosecution if patent owner were to provide a statement withdrawing the September 25, 2006 amendment and provide in its place an appropriate amendment accompanied by the requisite arguments and submission.

(1) Via the September 25, 2006 non-entered amendment, the patent owner proposed addition of new claims 14-19. In issuing the advisory Office action on October 18th, 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, and do not re-prosecute the proceeding or merely round out the claim coverage,[4] may, in some instances, evidence a *bona fide* effort to advance prosecution. It is to be noted that, in this instance, the examiner indicated that the proposed claims raise an issue of new matter, and a review of the September 25, 2006 submission shows that patent owner did not comply[5] with the 37 CFR 1.530(e) requirement to provide an explanation of the support in the disclosure for the amendment. Patent owner did not submit any argument or evidence with this petition to address the issue of new matter.

(2) Patent owner contends that it has not had a fair opportunity to present additional evidence and argument in response to new arguments raised by the Examiner during the interview [6] on October 13, 2006 and in the advisory action[7] of October 18, 2006. This may constitute grounds for granting the petition under 37 CFR 1.182 if patent owner accompanied the petition with a submission designed to address these arguments and expedite resolution of the proceeding by possibly avoiding the need for the delay inherent in the appeal process. However, in this instance, the patent owner has not submitted any argument or evidence to be considered if prosecution were to be reopened.

The failure to submit evidence or argument to address the outstanding issues militates against a

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[4] The addition of a set of new claims would generally expand the issues for consideration in the reexamination proceeding such that the examiner would need to determine whether the new claims enlarge the scope of the claims of the patent in contravention of the prohibition of same in 35 U.S.C. § 314(c); this would require a limitation-by-limitation comparison of all the new claims to the existing patent claims. The examiner would further need to determine if there is proper original disclosure support for the added claims (e.g., new matter and description issues), whether the new claims comply with the requirements of 35 U.S.C. 112, 2nd paragraph, and whether the new claims are patentable over the prior art of record. On the other hand, where claims are presented to overcome the rejections of record, and are not being added merely to round out claim coverage, the patent owner should address the aforementioned potential delay factors by pointing out how the newly proposed claims differ from the existing claims (what limitations have been added or deleted as compared to the existing claims), where in the disclosure is the support for each difference, why the claims are believed to not enlarge the scope of the broadest existing patent claim(s), and why the difference(s) in the claims is believed to define over the applied art.

[5] The generic statement on page 14 of the submission that the claim amendments are supported by "the specification and claims as originally filed" does not suffice. It is also noted that the form in which the amendment was presented does not comply with 37 CFR 1.530(f) and (i).

[6] The date of this interview is referred to incorrectly throughout the petition as November 13, 2006.

[7] This Advisory action is incorrectly referred to as having issued November 18, 2006 throughout the petition.

finding that reopening prosecution will materially advance prosecution.

Based on the facts and circumstances of the present situation, it is found that the September 25, 2006 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 September 25, 2006 amendment[8] to the claims (submitted under 37 CFR 1.116) will not be entered by the Central Reexamination Unit, and will not be considered by the examiner.

3) Jurisdiction over the reexamination proceeding will be retained by OPLA for 30 days. At the expiration of this 30-day period, if a request for reconsideration has not been filed, jurisdiction over the reexamination proceeding will be forwarded to the Central Reexamination Unit for further handling not inconsistent with this decision.

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 Schor,
Senior Legal Advisor
Office of Patent Legal Administration

June 7, 2007

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[8] It is noted that the Examiner has already granted entry of all the evidence and argument submitted September 25, 2006.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,919	02/06/2006	6397275	VISN-27,365	5529

25883 7590 05/28/2008

HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/28/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

(For Patent Owner)

MAILED

MAY 28 2008

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
D. Clapp et al. :
Control No. 90/007,919 : DECISION GRANTING PETITION
Filed: February 6, 2006 :
U.S. Patent No. 6,397,275 :
Attorney Docket No. VISN-27,365 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 25, 2008, 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 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 (Amendment And Response To Office Action filed September 29, 2006 and March 25, 2008 - item 1), an authorization to charge counsel's deposit account for the $770.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a terminal disclaimer and $130.00 fee (parent utility application was filed September 7, 1994) (item 4).

The petition for entry of the late papers is granted.

$900.00 ($770.00 for the petition fee and $130.00 for the terminal disclaimer fee) has been charged to counsel's deposit account no. 20-0780 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 Amendment And Response To Office Action filed September 29, 2006 and March 25, 2008, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Roland Foster, in CRU Art Unit 3992, who can be reached at 571-272-7538.

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

Fred A. Silverberg

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

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.
90/007,919	02/06/2006	6397275	VISN-27,365	5529

25883 7590 10/30/2008

HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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Brian D Walker
HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS TX 75374-1715

(For Patent Owner)

MAILED

OCT 30 2008

CENTRAL REEXAMINATION UNIT

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

In re: Clapp *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,919
Deposited on: 6 February 2006
For: US Patent No. 6,397,275

This is a decision on the 21 October 2008, petition for patent owner's "Request for Extensions of Time" pursuant to 37 CFR § 1.550 (c) requesting that the time for responding to the Office action mailed 21 August 2008, be extended by one-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 21 August 2008, which set a two-month date for filing a response thereto. The Office action is a Final Office action. The petition for extension of time was timely filed on 21 October 2008, together with electronic fee transmittal for the $200.00 petition fee as 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 patent owner requests an extension of one-month be granted to the Final Office action mailed 21 August 2008. The Patent owner requests the time be extended by one-month. In the Office action the time set for response is the shortened statutory period of two-months. The due date from the outstanding Office action is 21 October 2008.

On balance, there is always a question when considering the balance between the need for "special dispatch" and the need for a fair opportunity to respond to the outstanding Office action. The showing of sufficient cause is the criteria for this evaluation. In this petition the patent owner has not provided an explanation for sufficient cause as to why the time is needed beyond that which is already set in the Office action and should be granted. The petition states that the extension is necessary for good and sufficient reasons but has provided no explanation as to the facts under which the extension is needed and should be granted. While it is noted that the patent owner has been unavailable, there is nothing in the petition as to the length of time nor what elements of the Office action might require the need for additional time.

The petition request is hereby **Dismissed**

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 21 August 2008 is hereby **dismissed**

2. The Patent Owner's response is due **21 October 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

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, or Eric Keasel at (571) 272-4929 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

Gregory Morse
Director,
Central Reexamination Unit 3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,922	02/09/2006	6253313	33142.21	6363

20277 7590 10/12/2007
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/12/2007

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,156	10/20/2006	6253313	33142.20	2960

26161 7590 10/12/2007
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/12/2007

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

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OCT 12 2007

CENTRAL REEXAMINATION UNIT

Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Patent Owner)

David M. O'Dell
Haynes and Boone LLP
901 Main Street, Suite 3100
Dallas, TX 75202

(For Third Party Requester)

In re Morrison et al.
Reexamination Proceeding
Control No. 90/007,922
Request Deposited: February 9, 2006
For: U.S. Patent No. 6,253,313

In re Morrison et al.
Reexamination Proceeding
Control No. 90/008,156
Request Deposited: October 20, 2006
For: U.S. Patent No. 6,253,313

: 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. 6,253,313 (hereinafter, the '313 patent), issued to Morrison et al., on June 26, 2001.

2. On February 9, 2006, a third party deposited a Request for *Ex Parte* Reexamination of claims 3-25 of the '313 patent. The reexamination proceeding was assigned Control No. 90/007,922 (hereinafter, the '7922 proceeding).

3. The Reexamination Order was granted in the '7922 proceeding on August 22, 2006.

4. There are currently no amendments in the '7922 proceeding.

5. On October 20, 2006, a third party deposited a Request for *Ex Parte* Reexamination of claims 3-25 of the '313 patent. The reexamination proceeding was assigned Control No. 90/008,156 (hereinafter, the '8156 proceeding).

6. The Reexamination Order was granted in the '8156 proceeding on December 22, 2006.

7. There are currently no amendments in the '8156 proceeding.

8. The '7922 and the '8156 proceedings await the first action on the merits from the assigned examiner.

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 '7922 and the '8156 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. 90/007,922 and 90/008,156 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: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Lissi Mojica Marquis
Director, Central Reexamination Unit

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DEC 13 2006

CENTRAL REEXAMINATION UNIT

Robert A. Vitale, Jr. Niro, Scavone, Haller & Niro 181 West Madison Suite 4600 Chicago, Illinois 60602	)))))	**FOR PATENT OWNER**
John S. Pratt, Esq. Kilpatrick Stockton, LLP 1100 Peachtree Street Suite 2800 Atlanta, Georgia 30309-4530	)))))	**FOR THIRD PARTY REQUESTER**
In re Randall J. Huebner et al. Reexamination Proceeding Control No. 90/007,923 Filed: February 10, 2006 For: U.S. Patent No. 5,472,444	)))))	**DECISION ON PETITION UNDER 37 CFR 1.59(b) AND MPEP 724.05 TO EXPUNGE DOCUMENT SUBMITTED UNINTENTIONALLY**

This is a decision on the patent owner petition under 37 CFR 1.59(b), filed November 14, 2006, to expunge information from the above-captioned reexamination proceeding. The petition is before the Office of Patent Legal Administration for decision.

The petition is **DISMISSED**.

BACKGROUND

1. Patent No. 5,472,444 (the '444 patent) issued on December 5, 1995.

2. A request for reexamination, assigned Control No. 90/007,923 (the '7923 proceeding), was filed by a third party requester on February 10, 2006.

3. Reexamination was ordered in the '7923 reexamination proceeding on March 10, 2006.

4. An Office action on the merits was mailed on August 18, 2006.

5. Patent owner filed a response to the Office action on October 17, 2006.

6. Patent owner filed the present petition requesting that selected portions of the October 17, 2006 response be expunged and replaced with "redacted sheets" submitted with the petition.

DECISION ON PETITION TO EXPUNGE

The relevant portion of M.P.E.P. §724.05 II which relates to this petition is reproduced below, with emphasis added in bold italics.

> **II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION**
>
> A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:
>
> > (A) the Office can effect such return prior to the issuance of any patent on the application in issue;
> >
> > (B) it is stated 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;
> >
> > (C) the information has not otherwise been made public;
> >
> > (D) there is 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;
> >
> > (E) it is established to the satisfaction of the Commissioner that the information to be returned is not material information under 37 CFR 1.56; and
> >
> > (F) the petition fee as set forth in 37 CFR 1.17(h) is included.
>
> A request to return information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis.

Petitioner requests that certain limited statements contained on pages 5 and 17 of the Response to Office Action submitted on October 17, 2006, be expunged from the record, because the third party requester alleges that disclosure of such material violates a protective order. Petitioner states that the abovementioned items should be deemed unintentionally submitted, because, if it had been aware

of the requester's position, it would not have included any of this information in the response. The petition is accompanied by two additional copies of the relevant pages of the response. In one, the offending passages have been struck-through but are readable, [1] and in the other the offending passages have been removed and the text reformatted.

As a preliminary matter, petitioner is advised that the Office will not replace individual pages. The correct manner of effecting the replacement is to submit a copy of the ***entire paper*** with the offending passages redacted. Furthermore, ***the redacted pages should not be reformatted.*** The affected sections can either be blacked out or whited out and a legend such as "Redacted Material" overlaid thereon, in a manner which makes it clear to an observer where material has been concealed.

In addition, petitioner's submission fails to meet the burden for establishing that the material should be expunged from the file on at least two counts: [2]

(1) there is no indication that the material has not otherwise been made public, nor a commitment to retain the information for the required period.

(2) the file record clearly establishes that ***the information was submitted intentionally.*** Specifically, the information was submitted by patent owner as part of the arguments in favor of patentability in the response filed October 17, 2006. The statements in the petition make it clear that patent owner made a conscious decision to submit the information. Patent owner's request to the third party requester establishes that patent owner recognized that the confidentiality of the information was subject to dispute. When a timely response was not received, patent owner relied on its own judgment and submitted the information. The information in question has been determined by the undersigned to not to have been submitted unintentionally.

In view of the above, the petition to have the material expunged is **DISMISSED**.

DECISION PROVISIONALLY SEALING PAPERS

The substance of petitioner's request is the substitution of a redacted version of the October 17, 2006 response for the previously filed version. The appropriate mechanism for requesting this result is by way of a petition under 37 CFR 1.182, with the appropriate petition fee, to seal the paper filed October 17, 2006, and replace it by a properly redacted copy.

To prevent possible harm to the petitioner, the October 17, 2006, response is being **provisionally "sealed" from public view** in the Image File Wrapper (IFW) for the instant proceeding **on an**

---

[1] This copy will be closed and not be made public.

[2] Although there is no explicit allegation of irreparable harm, the violation of a protective order is considered to meet this requirement.

interim basis by being designated as "non-public." (Note that this refers to the response and not the supporting exhibits. Patent owner need not resubmit the accompanying exhibits, as there is no allegation that the accompanying exhibits constitute material which is protected and would require sealing.)

Patent owner is given **ONE MONTH** from the date of the present decision in which to appropriately file a petition under 37 CFR 1.182 to seal the IFW record versions of the October 17, 2006, response and to substitute a properly redacted version of the submission. A $400.00 petition fee must be included. Patent owner is advised that such petition will not be granted, unless all the points identified above are adequately addressed. If a petition under 37 CFR 1.182 to seal is not received within ONE MONTH from the date of the present decision, then the provisionally "sealed" papers will be unsealed and examination will proceed based on the existing copy of the response.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.59(b) to expunge is dismissed.

2. The Response to Office action filed October 17, 2006 is being provisionally sealed on an interim basis for a period of ONE MONTH from the mailing date of this decision.

3. **If a petition under 37 CFR 1.182 to seal is not received within ONE MONTH from the date of the present decision, then the provisionally "sealed" papers will be unsealed.**

4. If a petition under 37 CFR 1.182 to seal is filed, it should be directed to:

By Mail: Mail Stop "*Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By FAX: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

5. Jurisdiction over the present reexamination proceeding is being retained in the Office of Patent Legal Administration. After the issue of protected materials is resolved, jurisdiction will be returned to the examiner, via the Central Reexamination Unit 3993 Special Program Examiner, for appropriate action on the response filed on October 17, 2006.

6. Telephone inquiries related to the present decision should be directed to Pinchus M. Laufer, Legal Advisor, at 571-272-7726, or, in his absence, to the undersigned at 571-272-7710.

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

December 13, 2006
C:\kiva\kenpet6\expung\7923_no-expunge-intentionally-submitted_prov-seal.wpd

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1/11/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Kilpatrick Stockton LLP

Attn: Eugene B. Joswick

1100 Peachtree Street Suite 2800

Atlanta GA 30309-4530

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007923

PATENT NO. 5,472,444

ART UNI 3993

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,923	02/10/2006	5472444	39262/317705	7067

7590 01/11/2007

ROBERT A. VITALE, JR.
NIRO SCAVONE HALLER & NIRO
181 WEST MADISON, SUITE 4600
CHICAGO, IL 60602

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/11/2007

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

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Robert A. Vitale, Jr. Niro, Scavone, Haller & Niro 181 West Madison Suite 4600 Chicago, Illinois 60602	)))))	**FOR PATENT OWNER**
John S. Pratt, Esq. Kilpatrick Stockton, LLP 1100 Peachtree Street Suite 2800 Atlanta, Georgia 30309-4530	)))))	**FOR THIRD PARTY REQUESTER**

MAILED

JAN 1 1 2007

CENTRAL REEXAMINATION UNIT

In re Randall J. Huebner et al. Reexamination Proceeding Control No. 90/007,923 Filed: February 10, 2006 For: U.S. Patent No. 5,472,444	)))))	**DECISION ON PETITION UNDER 37 CFR 1.182 TO SEAL DOCUMENT AND REPLACE WITH A REDACTED VERSION**

This is a decision on the patent owner petition under 37 CFR 1.182, filed January 3, 2007, to seal the October 17, 2006 response and replace it with a redacted version. The petition is before the Office of Patent Legal Administration for decision.

The petition is **GRANTED**.

BACKGROUND

1. Patent No. 5,472,444 (the '444 patent) issued on December 5, 1995.

2. A request for reexamination, assigned Control No. 90/007,923 (the '7923 proceeding), was filed by a third party requester on February 10, 2006.

3. Reexamination was ordered in the '7923 reexamination proceeding on March 10, 2006.

4. An Office action on the merits was mailed on August 18, 2006.

5. Patent owner filed a response to the Office action on October 17, 2006.

6. Patent owner filed a petition requesting that selected portions of the October 17, 2006 response be expunged and replaced with "redacted sheets" submitted with the petition on November 14, 2006.

7. A decision dismissing the petition to expunge was mailed on December 13, 2006. The decision provisionally sealed the October 17, 2006 response and afforded patent owner one month to submit a petition under 37 CFR 1.182 to seal the document and replace it with a redacted version.

8. Patent owner filed the present petition requesting that the October 17, 2006 response be sealed and replaced with a redacted version submitted with the petition. The $400.00 petition fee under 37 CFR 1.17(f) as required by 37 CFR 1.182 has been charged to Deposit account DA 14-1131.

DECISION SEALING PAPERS

In a decision mailed December 13, 2006, the petition to expunge filed November 14, 2006 was dismissed because the paper was found to have been intentionally submitted and because there was no indication that the material has not otherwise been made public, nor a commitment to retain the information for the required period.

It was also noted in the December 13, 2006 petition decision that the present reexamination proceeding was contained in an Image File Wrapper (IFW) and the relief to be requested would be the substitution of a redacted version of the document for the original document. The regulations did not expressly provide for such relief; therefore, a petition under 37 CFR 1.182 would be required to obtain such relief by first sealing the original document within the IFW, and then substituting a redacted version of that document. The originally filed response of October 17, 2006 was provisionally sealed for a limited period of time to permit the patent owner to file the requisite 37 CFR 1.182 petition.

Upon review of the present petition to seal the original response filed October 17, 2006, and enter into the record a redacted version of that response, the matter was referred to the primary examiner in the '7923 proceeding to determine whether any of the information redacted from the response would be regarded as being important to a reasonable examiner in deciding whether or not a claim is patentable during the course of the '7923 proceeding. The primary examiner has answered in the negative. Therefore, the information redacted from the response filed on October 17, 2006 is not considered to be information "important" to the patentability of any claim in the '7923 proceeding. In addition, petitioner makes representations that the materials to be redacted have not otherwise

been made public and that petitioner is under an obligation to retain the information for the required period. Accordingly, the relief requested in the present petition will be granted.

CONCLUSION

1. The petition to seal the response filed October 17, 2006 and to substitute the redacted version submitted January 3, 2007 is granted.

2. The Response to Office action filed October 17, 2006 will be permanently sealed by closing these documents (and the partially redacted sheets filed with the November 13, 2006 petition) in the Image File Wrapper (IFW).

3. The permanently sealed response will not form part of the record in the '7923 reexamination proceeding.

4. The redacted version of the response, as filed on January 3, 2007, will replace the permanently sealed response as part of the record in the '7923 reexamination proceeding.

5. Jurisdiction over the present reexamination proceeding is being returned to the examiner, via the Central Reexamination Unit 3993 Special Program Examiner, for appropriate action on the response filed on October 17, 2006 as completed by the redacted submission filed January 3, 2007.

6. Telephone inquiries related to the present decision should be directed to Pinchus M. Laufer, Legal Advisor, at 571-272-7726, or, in his absence, to the undersigned at 571-272-7710.

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

January 9, 2007
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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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KOLISCH HARTWELL, P.C.
200 Pacific Building
520 SW Yamhill Street
Portland, OR 97204

(For Patent Owner)

MAILED

JUL 24 2006

CENTRAL REEXAMINATION UNIT

R. Scott Johnson
MCKEE, VORHEES, & SEASE, P.L.C.
801 Grand, Suite 3200
Des Moines, IA 50309-2721

(For Third Party Requester)

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

In re: Spencer B. Dick *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,857
Filed: December 27, 2005
For: US Patent No. 6,886,462

In re: Spencer B. Dick *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,925
Filed: February 10, 2006
For: US Patent No. 6,886,462

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).

REVIEW OF FACTS

1. US Patent No. 6,886,462 was issued on May 3, 2005.

2. A Patent Owner request for reexamination was filed on December 27, 2006 under control no. 90/007,857.

3. The Order was denied for *ex parte* reexamination in a paper mailed February 10, 2006 due to the Information Disclosure Statement (IDS) identifying the effective date for the non-patent literature document as 2005. The IDS 2005 date rendered the document as unavailable as prior art for the purpose of reexamination of the patent requesting reexamination.

4. The patent owner petitioned for reconsideration of the order denial on March 4, 2006. The Patent Owner identified the 2005 date as a typographical error. The correct date should have been 2000.

5. The petition was timely filed with authorization to charge any required fees.

6. A corrected copy of the IDS listing the correct non-patent literature document date was received by the USPTO on March 9, 2006.

7. The order was granted for reexamination of US Patent No. 6,886,462 as control number 90/007,857.

8. A request from a third party requester was filed on February 10, 2006 under control number 90/007,925 for reexamination of US Patent No. 6,886,462.

9. The Order granting reexamination was granted April 14, 2006 for control number 90/007,925.

10. Control numbers 90/007,857 and 90/007,925 are awaiting a first Office action on the merits and there are 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 90/007,857 and 90/007,925 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. 90/007,857 and 90/007,925 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

MReinhart for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

MURABITO, HAO & BARNES, LLP TWO NORTH MARKET STREET, THIRD FLOOR SAN JOSE CA 95113	For Patent Owner
Kenneth H. Ohriner PERKINS COIE LLP P. O. Box 1208 Seattle, WA 98111	For Third Party Requester
Fulghum, Roger BAKER BOTTS LLP 910 Louisiana St. One Shell Plaza Houston, TX 77002	
	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Lin *Ex Parte* Reexamination Proceeding Control No. 90/007,929 Filed: February 12, 2006 For: US Patent No. 6,804,129	
In re: Lin *Ex Parte* Reexamination Proceeding Control No. 90/008,378 Filed: December 15, 2006 For: US Patent No. 6,804,129	

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. 6,804,129 issued on October 12, 2004.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,929 was requested by a third party requester on February 12, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/007,929 on April 11, 2006.

4. There are currently no amendments proceeding control number 90/007,929.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,378 was requested by a third party requester filed on December 15, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,378 on January 26, 2007.

7. There are currently no amendments proceeding control number 90/008,378.

8. Proceedings control numbers 90/007,929 and 90/008,378 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 90/007,929 and 90/008,378 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. 90/007,929 and 90/008,378 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
MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for
Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,929	02/12/2006	6804129	38616.8908	1490

41066 7590 01/03/2008

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/03/2008

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,378	12/15/2006	6804129	072395.0109	3897

41066 7590 01/03/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,291	10/01/2007	6804129	10598.0002-00	6022

41066 7590 01/03/2008

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MURABITO, HAO & BARNES, LLP
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For Patent Owner

MAILED
JAN 03 2008
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For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
EX PARTE & INTER PARTES
REEXAMINATION
PROCEEDINGS

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/007,929
Deposited on: 12 February 2006
For: US Patent No. 6,804,129

In re: Lin :
Ex Parte Reexamination Proceeding :
Control No. 90/008,378 :
Deposited on: 15 December 2006 :
For: US Patent No. 6,804,129 :

In re: Lin :
Inter Partes Reexamination Proceeding :
Control No. 95/000,291 :
Deposited on: 16 August 2007 :
For: US Patent No. 6,804,129 :

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. § 1.989

DISCUSSION

As noted under 37 CFR 1.989. Merger of concurrent reexamination proceedings.

37 CFR 1.989

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an ex parte reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by § 1.902 through 1.997, except that the rights of any third party requester of the ex parte reexamination shall be governed by § § 1.510 through 1.560.

As noted in the above noted facts, the *inter partes* reexamination proceeding and the *ex parte* reexamination proceedings are currently pending Since reexamination has been ordered in all the proceedings and the time period for filing the appropriate subsequent patent owner's response has expired, a decision under 37 CFR § 1.989 (a) is timely.

The general policy of the Office is that the examination of the *inter partes* reexamination proceeding and the *ex parte* reexamination proceedings will not be conducted separately but will be conducted at the same for a single patent resulting in a single reexamination certificate. The reason for this policy is to prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding.

In review of the prosecution history of the inter partes reexamination control number 95/000,291 there have been no amendments to the claims since the order has only just been granted. There is no first Office action on the merits at this time.

In review of the prosecution history of the ex parte proceedings 90/007,929 and 90/008,378 there are no amendments at this time to the claims or specification in these previously merged proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.989(a), the 90/95/000,291; 90/007,929 and 90/008,378 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 throughout the prosecution of the merged proceedings.

III. Conduct of Merged Proceeding.

A. Governing regulations for the merged proceedings:

The present decision merges the ex parte proceedings and the inter partes proceeding. Pursuant to 37 CFR 1.989 (b), the merges proceeding is to be governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed.

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. 95/000,291; 90/007,979 and 90/008,378 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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,929	02/12/2006	6804129	38616.8908	1490

41066 7590 06/27/2008

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SAN JOSE, CA 95113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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4/11/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

KENNETH H. OHRINER

PERKINS COIE LLP

P.O. BOX 1208

SEATTLE, WA 98111

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007929 + 95/000391 + 90/008378

PATENT NO. 6,804,129

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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JUN 27 2008

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(For 90/007,929 Requester)

In re Lin
Inter partes Reexamination Proceeding
Control No.: 95/000,291
Filed: October 1, 2007
For: U.S. Patent No. 6,804,129

In re Lin
Ex parte Reexamination Proceeding
Control No.: 90/008,378
Filed: December 15, 2006
For: U.S. Patent No. 6,804,129

In re Lin
Ex parte Reexamination Proceeding
Control No.: 90/007,929
Filed: February 12, 2006
For: U.S. Patent No. 6,804,129

DECISION GRANTING PETITION UNDER 37 CFR § 1.183

This is a decision on the June 13, 2008 patent owner petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length.

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

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,804,129 (the '129 patent) issued on October 12, 2004.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,929 ('929), was filed on February 12, 2006, by the '929 third party requester. An order granting reexamination of the '129 patent was mailed for the '929 reexamination proceeding on April 11, 2006.

3. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/008,378 ('378), was filed on December 15, 2006, by the '378 third party requester. An order granting reexamination of the '129 patent was mailed for the '378 reexamination proceeding on January 26, 2007.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,291 ('291), was filed on October 1, 2007, by the '291 third party requester. An order granting reexamination of the '129 patent was mailed for the '291 reexamination proceeding on November 9, 2007.

5. A decision merging the '929, '378, and '291 reexamination proceedings was mailed on January 3, 2008.

6. A non-final Office action regarding the merged proceeding was mailed on March 26, 2008.

7. On April 28, 2006, patent owner filed a response that was 168 pages in length to the March 26, 2008 Office Action.

8. On June 13, 2008, the patent owner filed the instant petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length.

DECISION

37 CFR 1.943(b) prohibits a patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds 50 pages in length. In the instant petition, the patent owner requests relief from such limitation on filing its response to the Office action of March 26, 2008. The April 28, 2006 response to the March 26th Office action is 168 pages in length. Based upon the need to address the patentability issues raised in the three merged reexamination proceedings, the requested page limit of 168 pages is deemed equitable in addressing the Office action. Accordingly, the petition is granted:

(A) For only the April 28, 2006 response supplied by the patent owner in response to the March 26, 2008 Office action, and thus

(B) To permit patent owner to provide one-hundred and sixty-eight (168) pages for patent owner's response to the March 26, 2008 Office action, as patent owner has done.

CONCLUSION

1. The renewed petition under 37 CFR 1.183 for waiver of the length requirement of 37 CFR 1.943(b) is granted to permit patent owner's April 28, 2006 response to the March 26, 2008 first Office action, which response is one-hundred and sixty-eight (168) pages in length.

2. The date for filing of any third party requester comments under 37 CFR 1.947 runs thirty (30) days from the date of this decision waiving the length requirement of 37 CFR 1.943(b), to now complete the response *as to the length requirement*.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

4. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Office of Patent Legal Administration, at (571) 272-7710.

for

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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(For *Inter Partes* Requester)

MAILED

MAY 05 2009

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(For First *Ex Parte* Requester)

Roger Fulghum
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Houston, TX 77002

(For Second *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,291
Filed: October 1, 2007
For: U.S. Patent No. 6,804,129

Ex Parte Reexamination Proceeding
Control No. 90/007,929
Filed: February 12, 2006
For: US Patent No. 6,804,129

Ex Parte Reexamination Proceeding
Control No. 90/008,378
Filed: December 15, 2006
For: US Patent No. 6,804,129

DECISION GRANTING PETITION

This is a decision on the patent owner paper entitled "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)," filed on March 3, 2009.

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

The patent owner petition under 37 CFR 1.183 is granted for the concurrently submitted (March 3, 2009) patent owner 37 CFR 1.951(a) submission. The page limit of 37 CFR 1.943(b) submission is waived as to the 8 pages of the arguments portion of the patent owner's March 3, 2009 response that are found to exceed the 50-page limit.

Because the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 did not accompany the March 3, 2009 petition, the petition fee of $400.00 will charged to patent owner's Deposit Account (50-4160), as authorized on page 2 of the petition.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,804,129 (the '129 patent) issued on October 12, 2004.

2. On February 12, 2006, a first request for *ex parte* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 90/007,929 (the '7929 proceeding).

3. On April 11, 2006, the Office issued an order granting *ex parte* reexamination in the '7929 proceeding.

4. On December 15, 2006, a second request for *ex parte* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 90/008,378 (the '8378 proceeding).

5. On January 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8378 proceeding.

6. On August 9, 2007, the Office issued a "DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS," merging the '7929 and '8378 *ex parte* proceedings.

7. On October 1, 2007, a request for *inter partes* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 95/000,291 (the '291 proceeding).

8. On November 9, 2007, the Office issued an order granting *inter partes* reexamination in the '291 proceeding.

9. On January 3, 2008, the Office issued a "DECISION, *SUA SPONTE* MERGING *EX PARTE* & *INTER PARTES* REEXAMINATION PROCEEDINGS," merging the '7929, '8378, and '291 proceedings into a single, merged proceeding ("the merged proceeding").

10. On February 2, 2009, the Office mailed an Action Closing Prosecution in the merged proceeding.

11. On March 3, 2009, patent owner filed the instant petition paper entitled, "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)."

12. Concurrently on March 3, 2009, patent owner filed a 37 CFR 1.951(a) submission, after the February 2, 2009 Action Closing Prosecution.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

On March 3, 2009, patent owner concurrently filed with the instant petition a 37 CFR 1.951(a) submission, titled as a response to the February 2, 2009 Action Closing Prosecution. The response exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 8 pages (the response is a total of 66 pages - 1 page of identification information and introductory remarks, 7 pages of claim amendments, and 58 pages of arguments).[1] In the instant petition, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) with respect to the March 3, 2009 response.

In support of waiver of the rule, patent owner indicates that the February 2, 2009 Action Closing Prosecution "numbered 137 pages in length and recites eighteen issues."[2] Patent owner asserts that "[i]n order effectively address the patentability of the three merged proceedings, and rebut the eighteen issues raised in the Office Action, the Patent Owner feels it will be necessary to exceed the 50 page limit set forth in 37 C.F.R. § 1.943."[3]

In this instance, petitioner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a patent owner's response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the March 3, 2009 petition for waiver of 37 CFR 1.943(b) with respect to the submitted response. Upon review of the submitted response for economizing, extraneous

[1] Only those pages of patent owner's response upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2).
[2] Petition at page 1.
[3] Petition at pages 1-2.

material, and arrangement, without repetition of information already of record, it is found that the 8 pages of arguments in excess of 50 required to complete the patent owner's response are not unreasonable in this instance, in view of the present facts and circumstances.

Based on the February 2, 2009 Action Closing Prosecution, which sets forth 50 grounds of rejection of the claims in approximately 120 pages, and the review of the submitted response thereto, as well as on the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the arguments portion of patent owner's March 3, 2009 response exceeds the 50-page limit by 8 pages.

Accordingly, the patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **8 pages** of the arguments portion of the patent owner's March 3, 2009 response that exceed the 50-page limit.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) submission is waived as to the 8 pages of the arguments portion of the patent owner's March 3, 2009 response that exceed the 50-page limit.

2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at 571-272-7717.

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

04-28-09
C:\kiva\kenpet7\IP\UV\length\95_291+90_7929+90_8378 Grant Pg Length Waiver

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NOV 29 2006

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester) '7930

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(For Third Party Requester) – '7480

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

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,480
Filed: March 25, 2005
For U.S. Patent No. 5,233,270

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,930
Filed: February 13, 2006
For U.S. Patent No. 5,233,270

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of reexamination control number 90/007,480 and the reexamination control number 90/007,930 pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,233,270 issued on August 3, 1993.

2. The 90/007,480 reexamination proceeding was filed on March 25, 2005 by a third party requester.

3. The proceeding Order granting reexamination for control number 90/007,480 was mailed on May 23, 2005.

4. The 90/007,930 reexamination proceeding was filed February 13, 2006 by a third party requester.

5. The proceeding Order granting reexamination for control number 90/007,930 was mailed on April 24, 2006.

6. There are no amendments to either the control number 90/007,480 and 90/007,930 proceedings at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/007,480 and 90/007,930 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, there are no amendments at this time in either reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,480 and 90/007,930 are **merged**.

All correspondence regarding these proceedings should be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
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Alexandria, VA 22313-1450

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

By Hand: Customer Service Window
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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

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for

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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CENTRAL REEXAMINATION UNIT

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(Patent Owner)

Virgil L. Beaston
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In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,480 and 90/007,930
Filed: March 25, 2005 and February 13, 2006
For: U.S. Patent No.: 5,233,270

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,983
Filed: March 24, 2006
For: U.S. Patent No.: 6,172,464

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,470
Filed: March 18, 2005
For: U.S. Patent No.: 4,857,806

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,864
Filed: January 4, 2006
For: U.S. Patent No.: 5,343,123

DECISION ON PETITION UNDER 37 CFR 1.182 REGARDING EXTENDED EXAMINER INTERVIEW

This is a decision on the September 26, 2007 patent owner petition filed in each of the above-identified proceedings to conduct an extended personal interview with the Examiner for the duration of five hours to discuss each of the above-identified proceedings.

The petition is before the Office of Patent Legal Administration for consideration of whether the request for an extended interview should be granted.

The petition is dismissed.

REVIEW OF SALIENT FACTS

1. On September 25, 2007, the patent owner contacted Examiner Escalante and requested a personal interview for the above-identified proceedings. The examiner granted the initial request and indicated that the duration of the interview would not exceed one hour.

2. The patent owner filed a petition on Sept. 26, 2007, in each of the above identified proceedings "to confirm that Owner is entitled to interview the Examiner for a duration of one hour per patent at issue, or a total of five (5) hours for the above five (5) captioned reexamination proceedings."

3. Payment of the petition fees required for each proceeding was completed on October 4, 2007, thus affecting entry of the petitions in each respective proceeding on this date.

4. The status of each proceeding is as follows:

(a) Control nos. 90/007,480 & 90/007,930 have been merged. A final office action was mailed July 3, 2007. An amendment in response to the final office action was filed Sept. 7, 2007.

(b) Control nos. 90/007,518 & 90/007,823 have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

(c) Control no. 90/007,983 received a non-final office action mailed on May 17, 2007. An amendment in response to the non-final office action was filed July 19, 2007.

(d) Control no. 90/007,470 received a final office action mailed June 29, 2007. An amendment in response to the final office action was filed Sept. 4, 2007, and a Notice of Appeal was filed Oct. 1, 2007.

(e) Control no. 90/007,864 received a non-final office action mailed May 29, 2007. An amendment in response to the non-final office action was filed July 2, 2007.

5. Each proceeding has received at least one office action and has had a response* filed therein by patent owner awaiting action.

6. Each proceeding has claims rejected on different grounds based on different prior art references.

DISCUSSION

Interviews in *ex parte* reexamination proceedings are governed by 37 CFR 1.560, which reads:

Interviews in *Ex Parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner 's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

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* It is noted that merged proceeding control no. 90/007,480 does not have a amendment filed therein, but has a petition awaiting decision to accept a late response.

As explained in MPEP 2281:

> In the case where the patent owner desires to initiate an interview, the patent owner should initially contact the examiner in charge of the proceeding to indicate what issues are sought to be discussed, and to determine if an interview will be granted. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview, and a copy of any proposed claims to be discussed, unless examiner waives this requirement. This provision will provide structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> The duration of the interview will not exceed one hour, unless the patent owner files a petition under 37 CFR 1.182 showing sufficient cause where more time is needed. In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied, to the extent such is deemed necessary. An hour of time in a structured planned interview should be sufficient to accomplish this, and in those rare instances where it is not, a patent owner may show cause to extend the time. During the interview, the examiner is always free to extend the duration of the interview to discuss issues that the examiner deems appropriate for (further) discussion. Such an extension of the duration of the interview is permitted at the examiner's sole discretion.
>
> Only one interview may be requested after an Office action and prior to filing the response to that action, absent a showing of good cause to conduct a second interview during this period.

DECISION

Interviews are ***permitted*** during reexamination proceedings and are granted at the discretion of the examiner if they are deemed to facilitate prosecution with special dispatch. Interviews may be requested after an Office action, prior to filing a response to that action, in order to define the claims over the applied prior art. As the interview must be conducted in a structured and planned manner, one hour of time should be sufficient to accomplish this.

The patent owner has requested that five different reexamination proceedings be discussed during one personal interview and that one hour be allotted to each proceeding to result in a personal interview with a duration of five hours.

Each of the proceedings is at a different stage of prosecution. Each of the proceedings has different prior art rejections applied against the claims, with a total of at least ten (10) different prior art references being at issue. Responses have already been filed in the proceedings and are awaiting action.

An extended interview in this case, which would raise numerous different issues, involve proceedings at various stage of prosecution, and be conducted over a lengthy period of time, would not be productive and would not facilitate the handling of these cases with special dispatch. The patent owner acknowledges in the petition that there are "a multitude of issues to be discussed" and that additional issues relating to priority particular to only two of the proceedings will be raised.

The goal of conducting a targeted, planned interview to define the claims over the prior art would not be accomplished by combining five different sets of claims and over ten different prior art references along with a variety of other issues in a single discussion. Moreover, none of these proceedings are at an appropriate stage of prosecution during which interviews are normally granted. Further, such a lengthy interview would not be an efficient use of Office resources and would not serve the public interest.

It is also noted that the petition states the patent owner is entitled to an interview in each proceeding and is entitled to one hour for each interview. Interviews are *permitted* at the discretion of the examiner; interviews are not entitlements. Further, the manual states that an interview *will not exceed one hour*. Interviews are not guaranteed to last one hour and may be held for less than one hour at the discretion of the examiner in the interest of expediting prosecution in an efficient manner.

The patent owner has not provided a sufficient showing of good cause as to why additional time, especially for a time period of five hours, in which to conduct an interview should be permitted in this situation. The petition states that patent owner's request is for reasons of efficiency, to conserve resources, and to lessen the amount of travel time. Economic and time considerations for the patent owner do not give rise to an adequate showing as there are other means of communication, including the telephone, available to the patent owner to interact with the examiner.

CONCLUSION

1. The petition requesting an extended personal examiner interview conducted at one time for all of the above identified proceedings is dismissed.

2. The patent owner is required to identify which one of the above proceedings will be the subject of the personal interview and indicate what issues are sought to be discussed so that the examiner can determine if an interview will be granted.

3. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview along with a copy of any proposed claims to be discussed unless the examiner waives this requirement.

4. The duration of the interview for an individual proceeding, if granted, will not exceed one hour.

5. The patent owner is reminded that merged proceedings require papers to be filed in each proceeding within the merged proceeding. In this case, patent owner filed a single petition in each of the merged proceedings, which is not in accordance with the guidelines set forth in the merger decision. The petition must be filed in each proceeding in the merged proceedings. In this instance, the Office has waived this procedure, but this is not to be construed as a waiver as to future filings. A paper must be filed in each proceeding within the merged proceedings going forward.

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

cdd
October 4, 2007

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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(For Patent Owner)

MAILED

JUL 25 2006

CENTRAL REEXAMINATION UNIT

VIOLA T. KUNG, PHD
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Falls Church, VA 22042

(For Third Party Requester)

BURNS DOANE SWECKER AND MATHIS LLP
333 Twin Dolphin Dr., Ste 700
Redwood City, CA 94065

(For Third Party Requester)

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

In re: Mandez *et alia*
Reexamination Proceeding
Control No. 90/007,933
Filed: February 10, 2006
For U.S. Patent No. 6,023,708

In re: Mandez *et alia*
Reexamination Proceeding
Control No. 90/007,421
Filed: February 15, 2005
For U.S. Patent No. 6,023,708

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,933 (the '933 proceeding) and the reexamination control number 90/007,421 (the '421 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,023,708 issued on February 8, 2000.

2. The 90/007,421 reexamination proceeding was filed on February 15, 2005 by a third party requester.

3. The '421 proceeding Order granting reexamination was mailed on April 8, 2005.

4. A non-final Office action in the '421 proceeding was mailed on November 1, 2005.

5. A response and amendment to the claims from the Patent Owner was received by the Office March 16, 2006.

6. The 90/007,933 reexamination proceeding was filed February 10, 2006 by a third party requester.

7. The '933 proceeding Order granting reexamination was mailed on March 30, 2006.

8. There are no amendments to the '933 proceeding at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/007,421 and 90/007/933 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/007,421 and 90/007/933 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in Both Proceedings

As noted above, the claims have been amended in the 90/007,421 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,421 and 90/007/933 are **merged**. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

2. The status of the merged proceedings 90/007,421 and 90/007/933 will be returned to the examiner awaiting further action. An office action on the merits from the examiner in charge will be forthcoming in these newly merged proceedings.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MReinhart for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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R. Ross Viguet FULBRIGHT & JAWORSKI L.L.P. 2200 Ross Ave Suite 2800 Dallas, TX 75201	:	(For Patent Owner)
Alan L. Whitehurst. JONES DAY 51 Louisiana Avenue, N. W. Washington, DC 20001-2113	:	(For Third Party Requester)
Thomas A. Rozylowics FISH & RICHARDSON P. C. 1425 K Street, N. W. Suite 1100 Washington, DC 20005	:	(For Third Party Requester)
JANELLE D. WAACK 1111 Louisiana 25th floor Houston, TX 77002-5242	:	(For Third Party Requester)
Robert C. Laurenson HOWREY LLP 2020 Main Street Suite 1000 Irvine, CA 92614	:	(For Third Party Requester)
In re : Castille Reexamination Proceeding Control No. 90/007,839 Filed: December 7, 2005 For U.S. Patent No. 5,734,961	:	DECISION, *SUA SPONTE,* MERGING REEXAMINATION PROCEEDINGS PURSUANT TO 37 C.F.R. § 1.565(c)

MAILED

JUL 20 2006

CENTRAL REEXAMINATION UNIT

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,936 :
Filed: February 17, 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,942 :
Filed: February 17, 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,957 :
Filed: March 3, 2006 :
For U.S. Patent No. 5,734,961 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,839 (the '839 proceeding) with 90/007,936 (the '936 proceeding), 90/007,942 (the '942 proceeding) and 90/007,957 (the '957 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,734,961 issued on March 31, 1998.

2. The '839 reexamination proceeding, filed on December 7, 2005, is a reexamination proceeding that was requested by a third party requester.

3. An order granting reexamination in the '839 reexamination proceeding was mailed on January 5, 2006.

4. The '936 reexamination proceeding, filed on February 17, 2006, is a reexamination proceeding that was requested by a third party requester.

5. An order granting reexamination in the '936 reexamination proceeding was mailed on April 3, 2006.

6. The '942 reexamination proceeding, filed on February 17, 2006, is a reexamination proceeding that was requested by a third party requester.

7. An order granting reexamination in the '942 reexamination proceeding was mailed on April 11, 2006.

8. The '957 reexamination proceeding, filed on March 3, 2006, is a reexamination proceeding that was requested by a third party requester.

9. An order granting reexamination in the '957 reexamination proceeding was mailed on April 25, 2006.

10. The above named proceedings are all awaiting examiner action for a first Office action on the merits.

11. There are no amendments to the above proceedings at this time

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in all 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 90/007,839, 90/007,936 90/007,942 and 90/007957 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

Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,839, 90/007,936 90/007,942 and 90/007957 are **merged**. 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

MRenh

MARK J. REINHART
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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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 04/14/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Hilda C. Galvan
Jones Day
2727 North Hardwood Street
Dallas, TX 75201-1515

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,936. 90/007,839, 90/007,942, 90/007,957

PATENT NO. 5734961.

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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(For Patent Owner)

Hilda C. Galvan
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(For Third Party Requester)

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,839
Filed: December 7, 2005
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,936
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,942
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,957
Filed: March 3, 2006
For U.S. Patent No. 5,734,961

DECISION
GRANTING
PETITION

The four above-captioned *ex parte* reexamination proceedings have been previously merged into a single merged reexamination proceeding. The merged reexamination proceeding and the patent owner petition entitled "Petition Under 37 C.F.R. 1.182 For Expedited Examination Of Reexamination Proceedings" that was filed on March 21, 2008 are before the Director of the Central Reexamination Unit for consideration.

FEES

Although a $400.00 petition fee is required for a petition under 37 CFR 1.182, the instant petition has been forwarded to the undersigned for treatment as a petition under 37 CFR

1.181. Therefore, no fee is required for the petition. The previously submitted $400.00 petition fee has been refunded to Deposit Account No. 50-2929.

RELEVANT FACTS

1. The four *ex parte* reexamination proceedings that are included in the single merged reexamination proceeding were filed between December 7, 2005 and March 3, 2006.

2. Reexamination of the earliest filed individual reexamination proceeding, control number 90/007,839 (the '839 proceeding), was ordered January 5, 2006.

3. Reexamination of the latest filed individual reexamination proceeding, control number 90/007,958 (the '958 proceeding), was ordered April 25, 2006, with prosecution on the three earlier filed individual proceedings being necessarily delayed until it was determined whether reexamination could properly be ordered in the '958 proceeding.

4. Thereafter, merger of the four individual reexamination proceedings was considered to be proper, but was necessarily delayed in order to determine whether patent owner would exercise the statutory right (35 U.S.C. § 304) to file a patent owner's statement.

5. Upon expiration of the two month period for filing a patent owner's statement (plus allowance for mailing time and technical support treatment of such statement in the event that one had been filed), a decision merging the four individual reexamination proceedings was mailed on July 20, 2006.

6. A first Office action on the merits was mailed in the merged proceeding on December 14, 2007. The Office action set a thirty day or one month shortened statutory period, (whichever was longer), for filing a response thereto.

7. On January 3, 2008, patent owner filed a request for a one-month extension of time to file a response to the outstanding Office action because the action was twenty-two (22) pages in length, included various rejections, and patent owner was represented by two different law firms. An extension was granted to extend the response period through February 14, 2008.

8. A supplemental Office action was mailed on January 14, 2008 replacing the December 14, 2007 Office action, in which a technical defect in the December Office action was corrected.

9. One February 14, 2008, patent owner filed a timely response to the January 14, 2008 supplemental Office action, which response included eighty-three (83) new claims and fifty (50) pages of supporting remarks.

10. U.S. Patent No. 5,734,961 (the '961 patent) is the subject of multiple litigation proceedings, and at least one litigation is currently stayed pending completion of reexamination.

DECISION

The relief requested in the present petition is that the merged *ex parte* reexamination proceeding be accorded "expedited examination" and be considered with special dispatch. The record shows that the Office is currently treating the merged proceeding in accordance with established procedures, (MPEP §§ 2261 and 2286), which require that reexamination proceedings for a patent in litigation be given priority over all other cases, and that where litigation is stayed, that a thirty day or one month shortened statutory period will be set for response to Office actions.

Nevertheless, it must be noted that current statistics (through December 31, 2007) show that 26% of the *ex parte* reexamination requests filed and 52% of the *inter partes* reexamination requests filed involved patents that were also subject to litigation. Thus, there is a significant number of reexamination proceedings pending that involve litigation, including reexamination proceedings in which the litigation has been stayed.

Further, 35 U.S.C. § 305 requires that "[A]ll 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." Similarly, 35 U.S.C. § 314(c) provides that "[U]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." Thus, regardless of whether a given request for reexamination is directed to a patent that is the subject of concurrent litigation, <u>all</u> requests for reexamination must be considered promptly so as to meet the deadlines imposed by the reexamination statute. Accordingly, the examination of pending reexamination proceedings must be prioritized, even when considering that some of those proceedings must properly be advanced out of turn due to the status of concurrent litigation.

In light of these considerations, patent owner's petition for "'expedited examination'" and consideration of the present merged reexamination with special dispatch is <u>granted</u> to the extent that the merged proceeding <u>will</u> be examined in the Office in accordance with special dispatch and the priority treatment mandated by MPEP §§ 2261 and 2286 to the fullest extent that the Central Reexamination Unit (CRU) is able to do so. As there is litigation involving the '961 patent that has been stayed pending completion of reexamination, the present merged proceeding will be accorded the highest priority. However, patent owner must recognize, however, that the issues presented in the merged proceeding (a total of one hundred twelve (112) claims and 50 pages of remarks) are voluminous and complex, and that CRU must also treat a significant number of reexamination proceedings that are also entitled to "expedited examination" due to the existence of concurrent litigation that has been stayed due to copending reexamination in the Office.

CONCLUSION

1. Patent owner's petition is granted to the extent set forth above.

2. The merged reexamination proceeding is being forwarded to Art Unit 3992 for examination not inconsistent with this decision.

3. Telephone inquiries regarding this decision should be directed to Mark Reinhart at (571) 272-1611 or to Eric Keasel (571) 272-4929.

Lissi M. Marquis, Director
Central Reexamination Unit

March 27, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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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.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 11/03/2008

R. ROSS VIGUET
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2200 ROSS AVE.
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2008

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

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Hilda. C. Galvan

Jones Day

2727 North Harwood Street

Dallas, TX 75201-1515

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NOV 03 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,839; 90/007,936, 90/007,942; 90/007,957

PATENT NO. 5734961.

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
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Hilda C. Galvan
Jones Day
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(For Requester)

MAILED

NOV 03 2008

CENTRAL REEXAMINATION UNIT

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,839
Filed: March 3, 2006
For: U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,936
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,942
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,957
Filed: March 3, 2006
For U.S. Patent No. 5,734,961

: DECISION UNDER
: 37 CFR 1.181 FOR
: RECONSIDERATION OF
: DECISION DATED
: APRIL 14, 2008

The four above-captioned *ex parte* reexamination proceedings have been previously merged into a single merged reexamination proceeding. The merged reexamination proceeding and the patent owner petition entitled "Petition Under 37 C.F.R. 1.181 Requesting Reconsideration of PTO Decision of April 14, 2008" (hereinafter "the present petition") that was filed on April 30, 2008 are before the Director of the Central Reexamination Unit for consideration.

The petition is granted for the reasons set forth below.

REVIEW OF REVELANT FACTS

1. On March 21, 2008, patent owner filed a petition entitled "Petition Under 37 C.F.R. 1.182 For Expedited Examination Of Reexamination Proceedings" in all four above-captioned *ex parte* reexamination proceedings. In this petition, patent owner stated that the term for U.S. Patent No. 5,734,961, will expire in either 2010 or 2011. See page 2 of this petition.

2. On April 14, 2008, the Office mailed a decision granting the petition of March 21, 2008 to the extent that the merged proceedings will be examined in accordance with special dispatch and the priority treatment mandated by MPEP 2261 and 2286 to the extent possible.

3. On April 30, 2008, patent owner filed the present petition requesting reconsideration of the decision of April 14, 2008 in light of the fact that the term for U.S. Patent No. 5,734,961, will expire no earlier than 2013 and not in either 2010 or 2011 as stated in the March 21, 2008 petition.

DECISION

The request for reconsideration in the present petition is granted. In review of the record, the decision of April 14, 2008 did not rely upon patent owner's statement that the term for U.S. Patent No. 5,734,961, will expire in either 2010 or 2011. As a result of this decision, the decision of April 14, 2008 is confirmed and maintained in light of the present petition.

CONCLUSION

1. Patent owner's present petition, dated April 30, 2008, for reconsideration of the April 14, 2008 decision is granted.

2. The decision of April 14, 2008 is confirmed and maintained.

3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, or Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/05/2008

R. ROSS VIGUET
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,396	01/27/2005	5770231	00166.0051-US09	9488

26853 7590 12/05/2008

COVINGTON & BURLING, LLP
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WASHINGTON, DC 20004-2401

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/05/2008

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C/O JEAN-PAUL CASTILLE
28 RUE DES ARANDES
DIJON, 21000
FRANCE

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CENTRAL REEXAMINATION UNIT

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In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	: : : :

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. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

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 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 '7839, '7936, '7942, '7957, and '9261 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 original claims remain unamended and new claims 30-112 have been added in the '7839, '7936, '7942, and '7957 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. This may be accomplished by canceling new claims 30-112 in the '7839, '7936, '7942, and '7957 reexamination proceedings. 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 each of the five proceedings, 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.

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.

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 will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/007,839, 90/007,936, 90/007,942, 90/007,957, and 90/009,261 are **merged**.

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 or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

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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.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 12/30/2008

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/30/2008

ANTOR CORPORATION
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FRANCE

EXAMINER

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HILDA C. GALVAN
JONES DAY
2727 NORTH HARWOOD STREET
DALLAS, TX 75201-1515

Date:

DEC 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007839
PATENT NO. : 5734961
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
P.O. Box 1450
Alexandria, VA 22313-1450
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DEC 30 2008

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

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(For Third Party Requester)

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(For Third Party Requester)

EVAN LAW GROUP LLC
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CHICAGO, IL 60661

(For Third Party Requester)

R. Ross Viguet
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Ave.
Suite 2800
Dallas, TX 75201

(Courtesy Copy)

In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	DECISION DISMISSING PETITION UNDER 37 CFR 1.181 TO VACATE FINALITY
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of the finality of the rejection mailed August 19, 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

6. The five requests were merged on December 5, 2008.

7. A non-final rejection was mailed December 22, 2005 in the merged proceedings.

DECISION

In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

1. **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**.

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2. 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

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/30/2008

ANTOR CORPORATION
C/O JEAN-PAUL CASTILLE
28 RUE DES ARANDES
DIJON, 21000
FRANCE

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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

Copied from 90007839 on 01/07/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HILDA C. GALVAN
JONES DAY
2727 NORTH HARWOOD STREET
DALLAS, TX 75201-1515

Date:

DEC 30 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007839
PATENT NO. : 5734961
ART UNIT : 3900

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

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

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DEC 30 2008

CENTRAL REEXAMINATION UNIT

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28 RUE DES ARANDES
DIJON 21000 FR FRANCE

(For Patent Owner)

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(For Third Party Requester)

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(For Third Party Requester)

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(For Third Party Requester)

EVAN LAW GROUP LLC
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(For Third Party Requester)

R. Ross Viguet
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Ave.
Suite 2800
Dallas, TX 75201

(Courtesy Copy)

Copied from 90007839 on 01/07/2009

In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	DECISION DISMISSING PETITION UNDER 37 CFR 1.181 TO VACATE FINALITY
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of the finality of the rejection mailed August 19, 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

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added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

6. The five requests were merged on December 5, 2008.

7. A non-final rejection was mailed December 22, 2005 in the merged proceedings.

DECISION

In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

1. **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

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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.

2. 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

Gregory Morse
Director, Central Reexamination Unit

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 01/08/2009

R. ROSS VIGUET
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DALLAS, TX 75201-2784

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2009

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1425 K STREET NW
Washington, DC 20005

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,839; 90/007,936, 90/007,942; 90/007,957

PATENT NO. 5734961.

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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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Thomas A. Rozylowics FISH & RICHARDSON P. C. 1425 K Street, N. W. Suite 1100 Washington, DC 20005	:	(For Third Party Requester)
HOWREY LLP c/o IP Docketing Department Attn: JANELLE D. WAACK 1111 Louisiana 25th floor Houston, TX 77002-5242	:	(For Third Party Requester)
Robert C. Laurenson HOWREY LLP 2020 Main Street Suite 1000 Irvine, CA 92614	:	(For Third Party Requester)
Paul Rauch EVAN LAW GROUP LLC 600 West Jackson Blvd, Suite 625 Chicago, IL 60661	:	(For Third Party Requester)
	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR § 1.550(c)]

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,839
Deposited on: 7 December 2005
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,936
Deposited on: 17 February 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,942
Deposited on: 17 February 2006
For U.S. Patent No. 5,734,961

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,957
Deposited on: 3 March 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/009,261
Deposited on: 21 August 2008
For U.S. Patent No. 5,734,961

This is a decision on the 30 December 2008, petition for "Petition for Extension of Time Under 37 CFR § 1.550 (c)," requesting that the time for responding to the Office action mailed 22 December 2008, be extended by one-month in the above noted *ex parte* proceedings.

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 22 December 2008, 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 30 December 2008, together with the $200.00 petition fee as is required by 37 CFR §1.515(c) and as set forth in 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 reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner further notes the need for expert input whose availability during the response period is insufficient for a proper response. As such, the "sufficient cause" requirement is considered to be met by in this petition to the director of the Central Reexamination Unit. The sufficient cause justifies granting a one-month extension of time.

The petition request for a one month extension of time is hereby **granted**.

Conclusion

1. The patent owner's petition for extension of two-month time in which to file a response to the Office action dated 22 December 2008 is hereby **granted**.

2. The time to respond is extended by one-month.

3. The Patent Owner's response is due **22 February 2009**

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

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, Supervisory Patent Examiner, Art Unit 3992, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, at 571-272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners, Art Unit 3992, in the Central Reexamination Unit may be contacted.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,940	02/16/2006	5506587	1501-0684-2	9570

466 7590 12/15/2008

YOUNG & THOMPSON
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ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/15/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BARRY L. HALEY, ESQ. MALIN, HALEY, &
DiMAGGIO, P.A.
1932 SOUTH ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

Date:

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007940
PATENT NO. : 5506587
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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Eric Jensen
Young & Thompson
209 Madison Street, Suite 500
Alexandria, VA 22314

(For Patent Owner)

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DEC 15 2008

CENTRAL REEXAMINATION UNIT

Barry L. Haley
Malin, Haley, & DiMaggio, P.A.
1936 South Andrews Avenue
Fort Lauderdale, Florida 33316

(For Third Party Requester)

In re: Hakan Lans	: DECISION ON PETITION
Reexamination Proceeding	: TO CONTINUE
Control No.: 90/007,940	: *EX PARTE*
Filed: February 16, 2006	: REEXAMINATION
For: U.S. Patent No.: 5,506,587	: PROCEEDING

This is a decision on the November 5, 2008 patent owner petition, denominated "PETITION UNDER C.F.R. § 1.182 FOR 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 Deposit account No. 25-0120, as authorized on page 5 of the petition.

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

REVIEW OF FACTS

1) U.S. Patent No. 5,506,587 (the '587 patent) issued on April 9, 1996, with 13 claims.

2) A third party requester filed a request for *ex parte* reexamination of the '587 patent on February 16, 2006, and the resulting proceeding was assigned control number 90/007,940 (the '7940 reexamination proceeding).

3) An Order granting reexamination of claims 1-13 of the '587 patent in the '7940 reexamination proceeding was mailed on May 10, 2006.

4) A first non-final Office action was mailed December 28, 2007. The action rejected claims

1-3 and 9-11 under 35 U.S.C. 103 over Fraughton (U.S. 5,153,836) in view of Dielman ("Time and Frequency Standards From GPS"), claims 4 and 12 under 35 U.S.C. 103 over Fraughton in view of Dielman, further in view of Perkinson (US 3,341,812), claims 5-8 under 35 U.S.C. 103 over Fraughton in view of Dielman, further in view of Chisholm (US 3,801,979), and claim 13 under 35 U.S.C. 103 over Fraughton in view of Dielman and in view of Chisholm, further in view of Logsdon ("Global Positioning System Applications").

5) On February 28, 2008, patent owner filed a response in which no claims were amended, and arguments were presented traversing the rejections of record.

6) On September 5, 2008, the Office mailed a final Office action rejecting claims 1-13 under the same grounds as in the Office action mailed December 28, 2007. Additional prior art references were newly cited in support of the rationales behind the rejections.

7) On November 5, 2008, patent owner filed the present petition under 37 CFR 1.182 requesting (1) withdrawal of the finality of the September 5, 2008 Office action, or, in the alternative, (2) continued reexamination similar to that which would be in effect if Request for Reexamination (RCR) practice would be enacted. The patent owner also filed a response to the final rejection with arguments traversing the rejections, including remarks addressing the newly cited prior art references and a declaration by the inventor under 37 CFR 1.132 addressing the newly cited prior art references.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

§ 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).

ANALYSIS

Patent Owner requests withdrawal of the finality of the Sept. 5, 2008 office action, which was a final action. However, to be proper such a request is made under 37 C.F.R. 1.181, which provides for relief with respect to an action issued by the examiner in an *ex parte* re-examination. The patent owner instead requested relief under 37 C.F.R. 1.182, which is not the proper avenue for such a request. As the request was made in the alternative by requesting continued prosecution of the re-examination proceeding, which can be appropriately considered under 1.182, only this latter request for continued re-examination is addressed herein.
In the present petition, it is specifically requested that the Office continue the prosecution of the instant reexamination proceeding, to provide consideration of the arguments provided in the response and affidavit, both of which address newly cited prior art references (see Fact 7 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." [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

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

of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

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

In this instance, patent owner's response is directed towards rebuttal of two references, Raychaudhuri (U.S. 4,641,304) and Dunn (U.S. 3,742,498), newly cited in the final Office action. Patent owner contends that new evidence, in the form of a 37 CFR 1.132 declaration, and through arguments presented in a response, should be introduced in order to respond to the newly cited references. As new references were cited after patent owner's last response, patent owner's proposed November 5, 2008 response could not have been presented earlier, and it represents a good faith effort to advance prosecution. Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's presentation of evidence addressing the new references is deemed to provide the requisite *bona fide* effort to advance the prosecution. 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 patent owner's response after final rejection. These papers will be entered[2] 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 5, 2008 patent owner response, 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 '7940 *ex partes* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances.

[2] This decision takes no position as to the propriety of the response and affidavit. Any issues raised by the response will be addressed by the examiner in the next Office action.

3) The closing of prosecution rendered via the September 5, 2008 final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The November 5, 2008 response will be entered 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 Michael Cygan, Legal Advisor, at (571) 272-7700, or to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

Kenneth Schor

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

December 15, 2008

7940_grant_mc.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Thomas A. Rozylowics FISH & RICHARDSON P. C. 1425 K Street, N. W. Suite 1100 Washington, DC 20005	:	(For Third Party Requester)
JANELLE D. WAACK 1111 Louisiana 25th floor Houston, TX 77002-5242	:	(For Third Party Requester)
Robert C. Laurenson HOWREY LLP 2020 Main Street Suite 1000 Irvine, CA 92614	:	(For Third Party Requester)
In re : Castille Reexamination Proceeding Control No. 90/007,839 Filed: December 7, 2005 For U.S. Patent No. 5,734,961	:	DECISION, *SUA SPONTE,* MERGING REEXAMINATION PROCEEDINGS PURSUANT TO 37 C.F.R. § 1.565(c)

MAILED

JUL 20 2006

CENTRAL REEXAMINATION UNIT

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,936 :
Filed: February 17, 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,942 :
Filed: February 17, 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,957 :
Filed: March 3, 2006 :
For U.S. Patent No. 5,734,961 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,839 (the '839 proceeding) with 90/007,936 (the '936 proceeding), 90/007,942 (the '942 proceeding) and 90/007,957 (the '957 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,734,961 issued on March 31, 1998.

2. The '839 reexamination proceeding, filed on December 7, 2005, is a reexamination proceeding that was requested by a third party requester.

3. An order granting reexamination in the '839 reexamination proceeding was mailed on January 5, 2006.

4. The '936 reexamination proceeding, filed on February 17, 2006, is a reexamination proceeding that was requested by a third party requester.

5. An order granting reexamination in the '936 reexamination proceeding was mailed on April 3, 2006.

6. The '942 reexamination proceeding, filed on February 17, 2006, is a reexamination proceeding that was requested by a third party requester.

7. An order granting reexamination in the '942 reexamination proceeding was mailed on April 11, 2006.

8. The '957 reexamination proceeding, filed on March 3, 2006, is a reexamination proceeding that was requested by a third party requester.

9. An order granting reexamination in the '957 reexamination proceeding was mailed on April 25, 2006.

10. The above named proceedings are all awaiting examiner action for a first Office action on the merits.

11. There are no amendments to the above proceedings at this time

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in all 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 90/007,839, 90/007,936 90/007,942 and 90/007957 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

Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,839, 90/007,936 90/007,942 and 90/007957 are **merged**. 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

MRenh

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 04/14/2008

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DALLAS, TX 75201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Hilda C. Galvan
Jones Day
2727 North Harwood Street
Dallas, TX 75201-1515

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,839 90/007,936, 90/007,942, 90/007,957

PATENT NO. 5734961.

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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Fulbright & Jaworski LLP
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(For Patent Owner)

Hilda C. Galvan
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2727 North Harwood Street
Dallas, TX 75201-4556

(For Third Party Requester)

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,839
Filed: December 7, 2005
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,936
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,942
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,957
Filed: March 3, 2006
For U.S. Patent No. 5,734,961

DECISION
GRANTING
PETITION

The four above-captioned *ex parte* reexamination proceedings have been previously merged into a single merged reexamination proceeding. The merged reexamination proceeding and the patent owner petition entitled "Petition Under 37 C.F.R. 1.182 For Expedited Examination Of Reexamination Proceedings" that was filed on March 21, 2008 are before the Director of the Central Reexamination Unit for consideration.

FEES

Although a $400.00 petition fee is required for a petition under 37 CFR 1.182, the instant petition has been forwarded to the undersigned for treatment as a petition under 37 CFR

1.181. Therefore, no fee is required for the petition. The previously submitted $400.00 petition fee has been refunded to Deposit Account No. 50-2929.

RELEVANT FACTS

1. The four *ex parte* reexamination proceedings that are included in the single merged reexamination proceeding were filed between December 7, 2005 and March 3, 2006.

2. Reexamination of the earliest filed individual reexamination proceeding, control number 90/007,839 (the '839 proceeding), was ordered January 5, 2006.

3. Reexamination of the latest filed individual reexamination proceeding, control number 90/007,958 (the '958 proceeding), was ordered April 25, 2006, with prosecution on the three earlier filed individual proceedings being necessarily delayed until it was determined whether reexamination could properly be ordered in the '958 proceeding.

4. Thereafter, merger of the four individual reexamination proceedings was considered to be proper, but was necessarily delayed in order to determine whether patent owner would exercise the statutory right (35 U.S.C. § 304) to file a patent owner's statement.

5. Upon expiration of the two month period for filing a patent owner's statement (plus allowance for mailing time and technical support treatment of such statement in the event that one had been filed), a decision merging the four individual reexamination proceedings was mailed on July 20, 2006.

6. A first Office action on the merits was mailed in the merged proceeding on December 14, 2007. The Office action set a thirty day or one month shortened statutory period, (whichever was longer), for filing a response thereto.

7. On January 3, 2008, patent owner filed a request for a one-month extension of time to file a response to the outstanding Office action because the action was twenty-two (22) pages in length, included various rejections, and patent owner was represented by two different law firms. An extension was granted to extend the response period through February 14, 2008.

8. A supplemental Office action was mailed on January 14, 2008 replacing the December 14, 2007 Office action, in which a technical defect in the December Office action was corrected.

9. One February 14, 2008, patent owner filed a timely response to the January 14, 2008 supplemental Office action, which response included eighty-three (83) new claims and fifty (50) pages of supporting remarks.

10. U.S. Patent No. 5,734,961 (the '961 patent) is the subject of multiple litigation proceedings, and at least one litigation is currently stayed pending completion of reexamination.

DECISION

The relief requested in the present petition is that the merged *ex parte* reexamination proceeding be accorded "expedited examination" and be considered with special dispatch. The record shows that the Office is currently treating the merged proceeding in accordance with established procedures, (MPEP §§ 2261 and 2286), which require that reexamination proceedings for a patent in litigation be given priority over all other cases, and that where litigation is stayed, that a thirty day or one month shortened statutory period will be set for response to Office actions.

Nevertheless, it must be noted that current statistics (through December 31, 2007) show that 26% of the *ex parte* reexamination requests filed and 52% of the *inter partes* reexamination requests filed involved patents that were also subject to litigation. Thus, there is a significant number of reexamination proceedings pending that involve litigation, including reexamination proceedings in which the litigation has been stayed.

Further, 35 U.S.C. § 305 requires that "[A]ll 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." Similarly, 35 U.S.C. § 314(c) provides that "[U]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." Thus, regardless of whether a given request for reexamination is directed to a patent that is the subject of concurrent litigation, <u>all</u> requests for reexamination must be considered promptly so as to meet the deadlines imposed by the reexamination statute. Accordingly, the examination of pending reexamination proceedings must be prioritized, even when considering that some of those proceedings must properly be advanced out of turn due to the status of concurrent litigation.

In light of these considerations, patent owner's petition for "'expedited examination'" and consideration of the present merged reexamination with special dispatch is <u>granted</u> to the extent that the merged proceeding <u>will</u> be examined in the Office in accordance with special dispatch and the priority treatment mandated by MPEP §§ 2261 and 2286 to the fullest extent that the Central Reexamination Unit (CRU) is able to do so. As there is litigation involving the '961 patent that has been stayed pending completion of reexamination, the present merged proceeding will be accorded the highest priority. However, patent owner must recognize, however, that the issues presented in the merged proceeding (a total of one hundred twelve (112) claims and 50 pages of remarks) are voluminous and complex, and that CRU must also treat a significant number of reexamination proceedings that are also entitled to "expedited examination" due to the existence of concurrent litigation that has been stayed due to copending reexamination in the Office.

CONCLUSION

1. Patent owner's petition is granted to the extent set forth above.

2. The merged reexamination proceeding is being forwarded to Art Unit 3992 for examination not inconsistent with this decision.

3. Telephone inquiries regarding this decision should be directed to Mark Reinhart at (571) 272-1611 or to Eric Keasel (571) 272-4929.

Lissi M. Marquis, Director
Central Reexamination Unit

March 27, 2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 11/03/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2008

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NOV 03 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,839; 90/007,936; 90/007,942; 90/007,957

PATENT NO. 5734961.

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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(For Patent Owner)

Hilda C. Galvan
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(For Requester)

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,839
Filed: March 3, 2006
For: U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,936
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,942
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,957
Filed: March 3, 2006
For U.S. Patent No. 5,734,961

MAILED

NOV 03 2008

CENTRAL REEXAMINATION UNIT

DECISION UNDER
37 CFR 1.181 FOR
RECONSIDERATION OF
DECISION DATED
APRIL 14, 2008

The four above-captioned *ex parte* reexamination proceedings have been previously merged into a single merged reexamination proceeding. The merged reexamination proceeding and the patent owner petition entitled "Petition Under 37 C.F.R. 1.181 Requesting Reconsideration of PTO Decision of April 14, 2008" (hereinafter "the present petition") that was filed on April 30, 2008 are before the Director of the Central Reexamination Unit for consideration.

The petition is granted for the reasons set forth below.

REVIEW OF REVELANT FACTS

1. On March 21, 2008, patent owner filed a petition entitled "Petition Under 37 C.F.R. 1.182 For Expedited Examination Of Reexamination Proceedings" in all four above-captioned *ex parte* reexamination proceedings. In this petition, patent owner stated that the term for U.S. Patent No. 5,734,961, will expire in either 2010 or 2011. See page 2 of this petition.

2. On April 14, 2008, the Office mailed a decision granting the petition of March 21, 2008 to the extent that the merged proceedings will be examined in accordance with special dispatch and the priority treatment mandated by MPEP 2261 and 2286 to the extent possible.

3. On April 30, 2008, patent owner filed the present petition requesting reconsideration of the decision of April 14, 2008 in light of the fact that the term for U.S. Patent No. 5,734,961, will expire no earlier than 2013 and not in either 2010 or 2011 as stated in the March 21, 2008 petition.

DECISION

The request for reconsideration in the present petition is granted. In review of the record, the decision of April 14, 2008 did not rely upon patent owner's statement that the term for U.S. Patent No. 5,734,961, will expire in either 2010 or 2011. As a result of this decision, the decision of April 14, 2008 is confirmed and maintained in light of the present petition.

CONCLUSION

1. Patent owner's present petition, dated April 30, 2008, for reconsideration of the April 14, 2008 decision is granted.

2. The decision of April 14, 2008 is confirmed and maintained.

3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, or Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/05/2008

EXAMINER

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DALLAS, TX 75201

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,396	01/27/2005	5770231	00166.0051-US09	9488

26853 7590 12/05/2008

COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

EXAMINER

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DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/05/2008

R. ROSS VIGUET
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ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/05/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/05/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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CENTRAL REEXAMINATION UNIT

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In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	: : : :

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. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

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 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 '7839, '7936, '7942, '7957, and '9261 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 original claims remain unamended and new claims 30-112 have been added in the '7839, '7936, '7942, and '7957 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. This may be accomplished by canceling new claims 30-112 in the '7839, '7936, '7942, and '7957 reexamination proceedings. 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 each of the five proceedings, 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.

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.

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 will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/007,839, 90/007,936, 90/007,942, 90/007,957, and 90/009,261 are **merged**.

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
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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 or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/30/2008

R. ROSS VIGUET
FULBRIGHT & JAWORSKI LLP
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 12/30/2008

R. ROSS VIGUET
FULBRIGHT & JAWORSKI LLP
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DALLAS, TX 75201-2784

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/30/2008

R. ROSS VIGUET
FULBRIGHT & JAWORSKI LLP
2200 ROSS AVE., SUITE 2800
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/30/2008

ANTOR CORPORATION
C/O JEAN-PAUL CASTILLE
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DIJON, 21000
FRANCE

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HILDA C. GALVAN
JONES DAY
2727 NORTH HARWOOD STREET
DALLAS, TX 75201-1515

Date:

DEC 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007839
PATENT NO. : 5734961
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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DEC 30 2008

CENTRAL REEXAMINATION UNIT

ANTOR CORPORATION (For Patent Owner)
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28 RUE DES ARANDES
DIJON 21000 FR FRANCE

Alan L. Whitehurst (For Third Party Requester)
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Washington, DC 20001-2113

Thomas A. Rozylowics (For Third Party Requester)
FISH & RICHARDSON P.C.
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Suite 1100
Washington, DC 20005

HOWREY LLP-HN (For Third Party Requester)
C/O IP DOCKETING DEPARTMENT
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Robert C. Laurenson (For Third Party Requester)
HOWREY LLP
2020 Main Street
Suite 1000
Irvine, CA 92614

EVAN LAW GROUP LLC (For Third Party Requester)
600 WEST JACKSON BLVD., SUITE 625
CHICAGO, IL 60661

R. Ross Viguet (Courtesy Copy)
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Ave.
Suite 2800
Dallas, TX 75201

In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	: DECISION DISMISSING : PETITION UNDER 37 CFR 1.181 : TO VACATE FINALITY
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	:
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	:
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	:
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	:

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of the finality of the rejection mailed August 19, 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

6. The five requests were merged on December 5, 2008.

7. A non-final rejection was mailed December 22, 2005 in the merged proceedings.

DECISION

In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

1. **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.

2. 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

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/30/2008

R. ROSS VIGUET
FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVE.
SUITE 2800
DALLAS, TX 75201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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

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90/007,936	02/17/2006	5734961	18768-002LL1	7819

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90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

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90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/30/2008

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7590 12/30/2008

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EXAMINER

ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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DALLAS, TX 75201-1515

Date:

DEC 30 2008
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

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PATENT NO. : 5734961
ART UNIT : 3900

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DEC 30 2008

CENTRAL REEXAMINATION UNIT

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DIJON 21000 FR FRANCE

(For Patent Owner)

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51 Louisiana Avenue, N.W.
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(For Third Party Requester)

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(For Third Party Requester)

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HOWREY LLP
2020 Main Street
Suite 1000
Irvine, CA 92614

(For Third Party Requester)

EVAN LAW GROUP LLC
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CHICAGO, IL 60661

(For Third Party Requester)

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FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Ave.
Suite 2800
Dallas, TX 75201

(Courtesy Copy)

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In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	DECISION DISMISSING PETITION UNDER 37 CFR 1.181 TO VACATE FINALITY
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of the finality of the rejection mailed August 19, 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

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3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

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added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

6. The five requests were merged on December 5, 2008.

7. A non-final rejection was mailed December 22, 2005 in the merged proceedings.

DECISION

In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

1. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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2. 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

Gregory Morse
Director, Central Reexamination Unit

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7590 01/08/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

JANELLE D. WAACK

1111 LOUISIANA 25TH FLOOR

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007942

PATENT NO. 5,734,961

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)).

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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
www.uspto.gov

R. Ross Viguet FULBRIGHT & JAWORSKI L.L.P. 2200 Ross Ave Suite 2800 Dallas, TX 75201	:	(For Patent Owner)
ANTOR CORPORATION C/O JEAN-PAUL CASTILLE 28 RUE DES ARANDES DIJON 21000 FR FRANCE	:	(for Patent Owner Courtesy Only)
Alan L. Whitehurst. JONES DAY 51 Louisiana Avenue, N. W. Washington, DC 20001-2113	:	(For Third Party Requester)
Thomas A. Rozylowics FISH & RICHARDSON P. C. 1425 K Street, N. W. Suite 1100 Washington, DC 20005	:	(For Third Party Requester)
HOWREY LLP c/o IP Docketing Department Attn: JANELLE D. WAACK 1111 Louisiana 25th floor Houston, TX 77002-5242	:	(For Third Party Requester)
Robert C. Laurenson HOWREY LLP 2020 Main Street Suite 1000 Irvine, CA 92614	:	(For Third Party Requester)
Paul Rauch EVAN LAW GROUP LLC 600 West Jackson Blvd, Suite 625 Chicago, IL 60661	:	(For Third Party Requester)
	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR § 1.550(c)]

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,839
Deposited on: 7 December 2005
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,936
Deposited on: 17 February 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,942
Deposited on: 17 February 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,957
Deposited on: 3 March 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/009,261
Deposited on: 21 August 2008
For U.S. Patent No. 5,734,961

MAILED
JAN 08 2009
CENTRAL REEXAMINATION UNIT

This is a decision on the 30 December 2008, petition for "Petition for Extension of Time Under 37 CFR § 1.550 (c)," requesting that the time for responding to the Office action mailed 22 December 2008, be extended by one-month in the above noted *ex parte* proceedings.

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 22 December 2008, 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 30 December 2008, together with the $200.00 petition fee as is required by 37 CFR §1.515(c) and as set forth in 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 reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner further notes the need for expert input whose availability during the response period is insufficient for a proper response. As such, the "sufficient cause" requirement is considered to be met by in this petition to the director of the Central Reexamination Unit. The sufficient cause justifies granting a one-month extension of time.

The petition request for a one month extension of time is hereby **granted**.

Conclusion

1. The patent owner's petition for extension of two-month time in which to file a response to the Office action dated 22 December 2008 is hereby **granted**.

2. The time to respond is extended by one-month.

3. The Patent Owner's response is due **22 February 2009**

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
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401 Dulany Street
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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, Supervisory Patent Examiner, Art Unit 3992, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, at 571-272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners, Art Unit 3992, in the Central Reexamination Unit may be contacted.

/Mark Reinhart/
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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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,943	02/17/2006	6076935	60038.300502	4876

32112 7590 03/26/2010

IPLO-Intellectual Property Law Offices
95 SOUTH MARKET STREET SUITE 570
San Jose, CA 95113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/26/2010

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 Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MICHAEL J. MAZZA
SEDGWICK DETERT MORAN & ARNOLD LLP
One Market Plaza Steuart Tower 8th Floor
San Francisco, CA 94105

Date:

MAILED

MAR 26 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007943
PATENT NO. : 6076935
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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IPLO-Intellectual Property Law Offices
95 SOUTH MARKET STREET SUITE 570
San Jose CA 95113

(For Patent Owner)

MAILED

MAR 26 2010

CENTRAL REEXAMINATION UNIT

MICHAEL J. MAZZA
SEDGWICK, DETERT, MORAN, & ARNOLD LLP
ONE MARKET PLAZA
STEUART TOWER, 8TH FLOOR
SAN FRANCISCO, CA 94105

(For Requester)

In re Kester
Ex Parte Reexamination Proceeding
Control No. 90/007,943
Filed: February 17, 2006
For: U.S. Patent No. 6,076,935

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the April 28, 2009 patent owner petition entitled "PETITION FOR CONTINUED REEXAMINATION UNDER § 1.182."

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

The petition fee under 37 C.F.R. § 1.17(f) of $400 has been submitted.

The petition is **dismissed**.

BACKGROUND

- On February 17, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/007,943 ("the '7943 proceeding").
- Prosecution progressed until, on November 24, 2008, a final Office action was issued.
- On January 23, 2009, patent owner submitted claim amendments and remarks in response to the final Office action.
- On February 25, 2009, the Office mailed an advisory Office action denying entry of the claim amendments submitted on January 23, 2009.
- On March 24, 2009, patent owner filed a Notice of Appeal.

- On April 28, 2009, patent owner filed the instant petition entitled "PETITION FOR CONTINUED REEXAMINATION UNDER § 1.182," requesting entry of the amendment and remarks filed on January 23, 2009.

- On May 15, 2009, patent owner filed an Appellant's Brief.

APPLICABLE REGULATION

37 CFR 1.182 provides:

> All **situations not specifically provided** for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

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

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the

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

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. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier; thus, a petition for continuation of the reexamination prosecution should explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

In this instance, patent owner's response includes a submission directed towards the entry of claim amendments and accompanying remarks, as described in patent owner's instant petition. These amendments were denied entry in the advisory Office action of February 25, 2009. These amendments were alleged, in the originally filed submission of the amendment on January 23, 2009, to address the rejections made in the final Office action.

As to why a petition for entry of the January 23, 2009 amendment is required at this stage of the proceeding, patent owner argues only an unfamiliarity with reexamination procedure. Petition at 1. However, MPEP 2272 clearly sets forth after-final procedure for *ex parte* proceedings, and states that after-final amendments "will be governed by the strict standards of 37 CFR 1.116" and that "the patent owner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR 1.53(b), or 1.53(d), and with no opportunity to file a request for continued examination under 37 CFR 1.114." Therefore, patent owner was clearly on notice of the after-final procedure for *ex parte* proceedings.

Patent owner has not identified how the amendment would specifically overcome the rejections made over the disclosure of the Nüssli reference, such that entry of the amendment is a *bona fide* effort towards an efficient resolution of the substantial new question of patentability raised in the proceeding sufficient to outweigh the delay in the proceedings to consider the amendment. Patent owner states that in amending "retaining means" to "housing corners . . . with associated retaining fasteners" in claim 11, the Nüssli reference is thereby distinguished as these structures "are not in any way taught or made obvious by Nussli."[2] However, as the rejection states that the retaining means includes housing corner receiving pockets fastened by Velcro™,[3] which is one of the types of fasteners set forth in dependent claim 13, the patent owner has not clearly distinguished how the proposed amendment would overcome the rejection set forth in the Office action. Irrespective of the merits of the amendment, the instant petition fails to clearly show how the amendment is a *bona fide* effort to address the <u>rejections</u> of the claims so as to define the issues for appeal, or the issuance of a reexamination certificate. Reopening of the prosecution to consider this amendment absent a showing of such a *bona fide* effort would instead validate the patent owner's unnecessary delay in presenting the instant amendment in this proceeding contrary to the requirement of "special dispatch within the Office."

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[2] Patent owner's remarks accompanying the instant petition, at pages 7-8.

[3] Office action of April 11, 2007, page 4; final Office action of November 24, 2008, pages 2-3 and 6-7.

Furthermore, patent owner's petition does not present reasons why the proposed amendments could not have been submitted, or the need for the amendments anticipated, prior to the final Office action. Furthermore, the facts of this proceeding do not show that the proposed amendments could not have been submitted, or the need for the amendments anticipated, prior to the final Office action. The proposed amendment is alleged to be responsive to anticipation and obviousness rejections over the Nüssli reference, which were made in both the first Office action and in the final Office action. Since patent owner was notified in the first Office action that the claims at issue were rejected as anticipated and/or made obvious over the Nüssli reference, the need for the instant amendment could have been anticipated after the first Office action. The proposed amendments are not in response to newly raised issues; rather, the amendments address issues that have been present since the first Office action. For this reason, patent owner does not present reasons, nor does the history of the proceedings show, why the proposed amendments could not have been submitted, nor the need for the amendments anticipated, prior to the final Office action.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- 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

March 25, 2010
C:\Kiva\Kenpet7\EP

UNITED STATES PATENT AND TRADEMARK OFFICE

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90/007,943	02/17/2006	6076935	60388.300503	4876

32112 7590 07/08/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2010

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One Market Plaza Steuart Tower 8th Floor
San Francisco, CA 94105

Date: **MAILED**

JUL 08 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007943
PATENT NO. : 6076935
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San Jose CA 95113

(For Patent Owner)

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JUL 08 2010

CENTRAL REEXAMINATION UNIT

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SAN FRANCISCO, CA 94105

(For Requester)

In re Kester
Ex Parte Reexamination Proceeding
Control No. 90/007,943
Filed: February 17, 2006
For: U.S. Patent No. 6,076,935

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the April 28, 2009 patent owner petition entitled "PETITION FOR CONTINUED REEXAMINATION UNDER § 1.182."

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

The petition is **dismissed** as moot.

BACKGROUND

- On February 17, 2006, a request for *ex parte* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 90/007,943 ("the '7943 proceeding").
- Prosecution progressed until, on November 24, 2008, a final Office action was issued.
- On January 23, 2009, patent owner submitted claim amendments and remarks in response to the final Office action.
- On February 25, 2009, the Office mailed an advisory Office action denying entry of the claim amendments submitted on January 23, 2009.
- On March 24, 2009, patent owner filed a Notice of Appeal.

- On April 28, 2009, patent owner filed the instant petition entitled "PETITION FOR CONTINUED REEXAMINATION UNDER § 1.182," requesting entry of the amendment and remarks filed on January 23, 2009.

- On May 15, 2009, patent owner filed an Appeal Brief.

- On March 26, 2010, a decision dismissing the patent owner's petition of April 28, 2009 was issued.

- On April 23, 2010, patent owner requested reconsideration of the March 26, 2010 Office decision.

- On April 26, 2010, patent owner filed an amended Appeal Brief.

- On June 7, 2010, the Office issued a Notice of Intent to Issue a Reexamination Certificate, entering the amendment of January 23, 2009.

APPLICABLE REGULATION

37 CFR 1.182 provides:

> All **situations not specifically provided** for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

DECISION

Patent owner filed the instant petition to seek entry of the amendment filed on January 23, 2009. That amendment was entered by the examiner in a Notice of Intent to Issue a Reexamination Certificate, issued by the Office on June 7, 2010. Patent owner has received the relief requested in the instant petition, and therefore the instant petition is therefore moot.

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The petition is **dismissed** as moot.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth M. Schor

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

July 7, 2010
Kenpet8

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CENTRAL REEXAMINATION UNIT

JUL 27 2006
CENTRAL REEXAMINATION UNIT

DICKSTEIN SHAPIRO MORIN
& OSHINSKY LLP
2101 L Street, NW
Washington, DC 20037

(For Patent Owner)

NOVAK, DRUCE, DELUCA
& QUIGG, LLP
1300 Eye St. NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party
Requester)

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

In re: Kobayashi *et alia* :
Reexamination Proceeding :
Control No. 90/007,879 :
Filed: January 17, 2006 :
For U.S. Patent No. 4,922,432 :

In re: Kobayashi *et alia* :
Reexamination Proceeding :
Control No. 90/007,945 :
Filed: February 22, 2006 :
For U.S. Patent No. 4,922,432 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,879 (the '879 proceeding) and the reexamination control number 90/007,945 (the '945 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,922,432 issued on May 1, 1990.

2. The 90/007,879 reexamination proceeding was filed on January 17, 2006 by a third party requester.

3. The '879 proceeding Order granting reexamination was mailed on February 24, 2006.

4. The 90/007,945 reexamination proceeding was filed February 22, 2006 by a third party requester.

7. The '945 proceeding Order granting reexamination was mailed on April 19, 2006.

8. There are no amendments to either the '879 or the '945 proceedings at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/007,879 and 90/007,945 reexamination proceedings are <u>merged</u>. 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 90/007,879 and 90/007,945 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 both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/007,879 and 90/007,945 are **merged**. 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 J. Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington DC 20006-5403

(for Patent Owner)

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CENTRAL REEXAMINATION UNIT

NOVAK, DRUCE, DELUCA
& QUIGG, LLP
1300 Eye St. NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party
Requester)

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

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/007,879
Filed: January 17, 2006
For U.S. Patent No. 4,922,432

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/007,945
Filed: February 22, 2006
For U.S. Patent No. 4,922,432

This is a decision on the December 3, 2007, petition for "Petition for Extension of Time Under 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed November 21, 2007, be extended by two months.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed November 21, 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 December 6, 2007, together with the $200.00 petition fee required by 37 CFR 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 that the expert testimony upon which the patent owner will rely to respond to the Office action will not be available until December. As such the sufficient cause requirement is met to justify a one-month extension of time. The patent owner's representative further notes the length of the Office action and references applied, however this is not considered to justify additional time for which to respond. A sufficient cause in the patent owner's petition is shown to justify a one-month extension of time.

The petition request is **Granted-in-Part**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated November 21, 2007 is **granted in part**.

2. The Patent Owner's response is due **January 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
SPE ~~SPRE~~-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,945	02/22/2006	4922432		4490

24998 7590 12/13/2007
DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2007

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,879	01/17/2006	4922432	8089.002	1132

24998 7590 12/13/2007
DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

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90/007,945	02/22/2006	4922432		4490

24998 7590 07/22/2009

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EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,094	03/28/2008	4922432	06816.0070.RXUS00	3207

24998 7590 07/22/2009
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24998 7590 07/22/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
VINCENT M. DELUCA
NOVAK DRUCE DELUCA & QUIGG LLP
1300 EYE ST., NW, SUITE 400 EAST TOWER
WASHINGTON, DC 20005

Date:

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007879
PATENT NO. : 4922432
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
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOWREY LLP
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

Date:

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009094
PATENT NO. : 4922432
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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Thomas J D'Amico DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L Street, NW Washington, DC 20037	:	(For Patent Owner)
Vincent M. DeLuca NOVAK, DRUCE, DELUCA & QUIGG, LLP 1300 Eye St. NW Suite 400 East Tower Washington, DC 20005	:	(For Third Party Requester)
Robert C Laurenson HOWREY LLP-CA C/O IP Docketing Department 2941 Fairview Park Drive Suite 200 Falls Church, VA 22042-2924	:	(For Third Party Requester)

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

In re: Kobayashi *et alia* Reexamination Proceeding Control No. 90/007,879 Deposited: 17 January 2006 For U.S. Patent No. 4,922,432	:	DECISION DISMISSING PETITION FOR EXTENSION OF TIME 37 CFR §§ 1.550(c) & 1.181
In re: Kobayashi *et alia* Reexamination Proceeding Control No. 90/007,945 Deposited: 22 February 2006 For U.S. Patent No. 4,922,432	:	
In re: Kobayashi *et alia* Reexamination Proceeding Control No. 90/009,094 Deposited: 28 March 2006 For U.S. Patent No. 4,922,432	:	

This is a decision on the 17 July 2009, "Common Petition for Extension of Time to File Reply Brief and Request for Oral Hearing for Reexamination Control Numbers 90/007,879, 90/007,945 & 90/009,094 Under 37 CFR § 1.550(c)" requesting that the time for responding to the Examiner's Answer mailed 19 July 2009, be extended by one (1) month. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g). The petition indicates the required certificate of service.

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 for response be extended in which to file a Reply Brief response to the Examiner's Answer mailed 19 June 2009. The petition for extension of time was timely filed on 17 July 2009, together with fee for the $200.00 petition fee as required by 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. ...

ANALYSIS AND FINDINGS

The patent owner's representative petition 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 Examiner's Answer was mailed 19 July 2009. The petition notes that the extension of time is needed because the "references cited in the Examiner's Answer are technically complex and the Examiner's Answer itself quite lengthy..." The examiner's time between patent owner's responses and subsequent actions noted in the prosecution history are not germane to the issue of "sufficient cause" in the instant petition. Since the issues in the Final rejection mailed 24 September 2008 and the Examiner's Answer mailed 19 June 2009 are substantially the same there are no new issues that would require further consideration. It is noted that the patent owner further states that the offices will be closed 8-16 August 2009 for a holiday period. This time is not necessitated by any actions from the Office and could have been reasonably anticipated by the patent owner.

The petition request to extend the response time by one (1) month is hereby dismissed.

CONCLUSION

1. The patent owner's petition for extension of one (1) month time in which to file a response to the Examiner's Answer dated 16 June 2009 is hereby **dismissed**

2. The Patent Owner's response is due **16 August 2009.**

3. 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.

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/
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
Address: COMMISSIONER FOR PATENTS
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,945	02/22/2006	4922432		4490

24998 7590 03/25/2010

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,879	01/17/2006	4922432	8089.002	1132

24998 7590 03/25/2010
DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,094	03/28/2008	4922432	06816.0070.RXUS00	3207

24998 7590 03/25/2010

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
VINCENT M. DELUCA
NOVAK DRUCE DELUCA & QUIGG LLP
1300 EYE ST., NW, SUITE 400 EAST TOWER
WASHINGTON, DC 20005

Date:

MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007879
PATENT NO. : 4922432
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE DELUCA & QUIGG LLP
1300 EYE STREET., N.W.
SUITE 400 EAST TOWER
WASHINGTON, DC 20005

Date: MAILED
MAR 25 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007945
PATENT NO. : 4922432
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOWREY LLP
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

Date:

MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009094
PATENT NO. : 4922432
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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MAR 25 2010

CENTRAL REEXAMINATION UNIT

DICKSTEIN SHAPIRO LLP (For Patent Owner)
1825 EYE STREET NW
Washington DC 20006-5403

NOVAK, DRUCE, DELUCA & QUIGG, LLP (For Requester)
1300 Eye St., NW
Suite 400 East Tower
Washington, DC 20005

HOWREY LLP-CA (For Requester)
C/O IP Docketing Department
2941 Fairview Park Drive
Suite 200
Falls Church, VA 22-42-2924

In re Kobayashi *et alia* Reexamination Proceeding Control No. 90/007,879 For: U.S. Patent No. 4,922,432	: DECISION DISMISSING : PETITION UNDER : 37 CFR 1.181 :
In re Kobayashi *et alia* Reexamination Proceeding Control No. 90/007,945 For: U.S. Patent No. 4,922,432	: : : :
In re Kobayashi *et alia* Reexamination Proceeding Control No. 90/009,094 For: U.S. Patent No. 4,922,432	: : : :

This is a decision on the January 20, 2010 paper entitled "COMMON PETITION UNDER 37 C.F.R. §1.181 REQUESTING FINDING "NEW GROUND OF REJECTION" IN SUPPLEMENTAL EXAMINER'S ANSWER" requesting "a ground of rejection set forth in the Supplemental Examiner's Answer be designated as a 'new ground 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

MPEP 1207.04 states, in part:

"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."

The final office action of September 24, 2008 and the examiner's answer of June 19, 2009 contain the same grounds of rejection. Specifically, claims 1-3, 6-8, and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski, T.J. et al., *The VLSI Design Automation Assistant." from Algorithms to Silicon,* IEEE Design and Test, Aug., 1985 (hereinafter "Kowalski '85") in view of Kowalski, T.J. et al., *The VLSI Design Automation Assistant: A Knowledge-Based Expert System,* PhD thesis, Dept. Electrical and Computer Eng., Carnegie-Mellon University, Pittsburgh, Pa, April 1984 (hereinafter "Kowalski '84"), and further in view of Dirkes, *E., A Module binder for the CMU- DA System,* masters thesis, Dept. Electrical and Computer Eng., Carnegie-Mellon University, Pittsburgh, Pa., April 1985 (hereinafter "Dirkes"). Claims 4, 5, and 9-12 are rejected as being obvious over the above three references and further in view of Baitinger.

In response to the reply brief filed August 19, 2009, the examiner issued a supplemental examiner's answer responding to new issues raised in the reply brief (citing 37 CFR 41.43(a)). No ground of rejection was included in the supplemental examiner's answer. The examiner restated the new issues set forth by appellant in the reply brief, followed by a response to those new issues. The positions by the examiner are summarized in a table on pages 6 and 7 of the supplemental examiner's answer. However, it appears that petitioner views this table as an entire new rejection of claim 13. This is not the case. The factual discussion of the references and rationale in support of the rejection is more extensive than the table on pages 6 and 7 of the supplemental examiner's answer. In the final office action of September 24, 2008, the discussion of claim 13 as being unpatentable over the two Kowalski articles and Dirkes spans pages 7-15. The same discussion spans pages 7-15 of the examiner's answer of June 19, 2009.

Petitioner presents a table on pages 3 and 4 of the petition allegedly illustrating the examiner's position set forth in the final rejection of claim 13. However, petitioner interjects his own comments into the table that do not appear in the 9 pages devoted to the rejection in the final office action and the examiner's answer. A detailed discussion of the discrepancies is outside the scope of the present decision as it would represent arguments related to the rejection of record (i.e. an appealable issue).

As the supplemental examiner's answer is limited to the examiner's response to new issues raised in the reply brief and does not include a new ground of rejection, the petition is **dismissed**.

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, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

4. This is not a final agency action. The decision is made without prejudice to a request for reconsideration or higher-level review.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Dorsey & Whitney, LLP
Intellectual Property Department
370 Seventeenth Street
Suite 4700
Denver, CO 80202-5647

(For Patent Owner)

MAILED

AUG 12 2008

CENTRAL REEXAMINATION UNIT

Thomas A. Miller
Miller, Matthias & Hull
One North Franklin Street, Suite 2350
Chicago, IL 60606

(For 3rd Party Requester)

In re	: Wendell B. Colson
Reexamination Proceeding	
Control No.	: 90/007,949
Filed	: February 23, 2006
For U.S. Patent No.	: 6,129,131

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on petitioner's request filed June 11, 2008 that seeks to restart the response date of the February 11, 2008 Office action issued in the above-identified reexamination proceeding based on the assertion that petitioner did not receive the Office action in question. There is no fee for this petition.

In order to overcome the presumption of delivery of an Office action, a practitioner must submit the following: (1) a statement from the practitioner stating that the Office action was not received by practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket record indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received and docketed. See 1156 O.G. 53.

The request filed June 11, 2008 includes all the above elements. The request is therefore GRANTED.

Under normal circumstances, upon the mailing of this decision, the proceeding would be forwarded to a Legal Instruments Examiner of the Central Reexamination Unit for the remailing of the Office action in question. However, inasmuch as petitioner has obtained a copy of the February 11, 2008 Office action and has submitted an amendment responsive to that Office action with the instant request, there is no need to remail the Office action establishing a new period for response. Instead, the response submitted with the instant request is deemed to have been timely filed.

Accordingly, upon the mailing of this decision, the file will be forwarded to the examiner in charge of the proceeding to consider the amendment filed June 11, 2008.

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

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

Date: 06/05/09

Patent No. : 5199436 C1
Ser. No. : 90/007,951
Inventor(s) : CORPORATION(OWNER), EXERGEN
Issued : 08/21/07
Title : **RADIATION DETECTOR HAVING IMPROVED ACCURACY**
Docket No. : **Exergen-436**

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: (571) 273-0025
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

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(703) 305-8309 or (703) 308-9390 #112

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

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

Richard L. Treanor, Ph.D,
Oblon Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

FOR PATENT OWNER

MAILED

AUG 08 2006

CENTRAL REEXAMINATION UNIT

Neil C. Jones
Nelson Mullins Riley
& Scarborough, LLP
Meridian Suite 1700
1320 Main Street
Columbia, South Carolina 29201

FOR THIRD PARTY REQUESTER

In re Georg Schnitzer et al.
Reexamination Proceeding
Control No. 90/007,956
Filed: February 28, 2006
For: U.S. Patent No. 5,586,992

DECISION ON PETITION TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS

This is a decision on the July 6, 2006 paper denominated "Notice of Request for Merger" which is being treated as a petition to request merger.

The petition paper has been referred to the Office of Patent Legal Administration.

The petition to merge the reexamination and reissue is dismissed as premature as explained below.

BACKGROUND

1. Patent No. 5,586,992 (the '992 patent) issued on December 24, 1996

2. A request for reexamination, assigned Control No. 90/007,956 (the '7956 proceeding), was filed by a third party requester on February 28, 2006.

3. Reexamination was ordered in the '7956 reexamination proceeding on March 28, 2006.

4. An application for reissue of the '992 patent, assigned application No. 11/449,006 (the '006 application) was filed by the patent owner on June 8, 2006.

5. A notification of concurrent proceedings under 37 CFR1.565 was filed by the patent owner in the '7956 proceeding, on June 8, 2006, informing the Office of the '006 reissue application.

6. On June 26, 2006 the Office mailed a Notice of Missing Parts in the '006 application.

7. On July 6, 2006, the patent owner filed a paper denoted "Notice of Request for Merger". This paper is being treated as a petition to merge the reissue application with the reexamination proceedings.

8. On July 20, 2006, the third party requester filed, in the '7956 proceeding, a paper in opposition to merger of the '006 reissue application with the reexamination proceedings.

BASIS OF DECISION

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.*** [Emphasis added]

MPEP §2285 states in relevant part:

> If a reissue application is filed during the pendency of a reexamination proceeding, the OPLA should be notified via e-mail, as promptly as possible after the reissue

application reaches the TC, that the proceedings are ready for consideration of merger. If any of the reexamination file, the reissue application, and the patent file are paper files, they should be hand delivered to the OPLA at the time of the e-mail notification to OPLA.

The decision on whether or not the proceedings are to be merged, or which proceeding (if any) is to be stayed, will generally be made as promptly as possible after receipt of the e-mail notification to OPLA and delivery of all the paper files to the OPLA. ***Until a decision is mailed merging the proceedings or staying one of the proceedings, the two proceedings will continue and be conducted simultaneously, but separately.*** [Emphasis added]

...

The decision on whether to merge the proceedings or stay a proceeding will be made on a case-by-case basis based upon the status of the various proceedings.

C. Reexamination Proceedings Underway, Reissue Application Filed.

...

Where reexamination has already been ordered prior to the filing of a reissue application, the following factors may be considered in deciding whether to merge the reissue application and the reexamination proceeding or stay one of them:

(A) The status of the reexamination proceeding: For example, consideration will be given as to whether a statement and reply have been received, a first Office action has been mailed, a final rejection has been given, or printing of the certificate has begun;

(B) The nature and scope of the reissue application: For example, consideration will be given as to whether the issues presented in the proceedings are the same, overlapping, or completely separate; and whether the reissue claims are broadened or are related to issues other than rejections based on patents or printed publications.

DECISION

As noted in the above cited sections of the MPEP, when a reexamination proceeding on a patent and an application for reissue of the same patent have both been initiated the Office will make a decision whether to merge the pending proceedings. The motivation behind this practice is to avoid inconsistent and possibly duplicative action in relation to the same patent.

The '006 application for reissue of the '992 patent is still in the Office of Initial Patent Examination (OIPE) and is not yet before the TC. As such, it is not ready for examination and a decision as to whether it would be appropriate to merge this particular reissue with the ongoing reexamination is premature. Note further, that on June 8, 2006 the Office mailed a letter in the '006 application indicating that the reissue application was not in condition for examination and noting multiple items which require correction.

The overarching consideration in reexamination proceedings is the statutory mandate of special despatch. Accordingly, as the '006 application is not in before the TC for examination, a decision on merger would be premature. Furthermore, due to the requirement of special despatch, it would be inappropriate to hold up action in the reexamination pending the possible correction of the deficiencies in the '006 application.

The petition for merger is dismissed.

CONCLUSION

1. The July 6, 2006 petition requesting merger of reissue application No. 11/449,006 and reexamination proceeding '7956 is dismissed.

2. Telephone inquiries related to the present decision should be directed to Pinchus M. Laufer, Legal Advisor, at 571-272-7726, or, in his absence, to the undersigned at 571-272-7710.

for Pinchus M. Laufer

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

August 1, 2006
C:\kiva\kenpetmerger\7956_moot_pet-requesting-merger.wpd

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,956	02/28/2006	5586992	20741/01500	8510

22850 7590 09/29/2006

C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2006

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9/29/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NEIL C. JONES

NELSON MULLINS RILEY & SCARBOROUGH LLP

1320 MAIN STREET, SUITE 1700

COLUMBIA, SC 29201

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007956

PATENT NO. 5,586,992

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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SEP 29 2006

CENTRAL REEXAMINATION UNIT

Richard L. Treanor
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

For Patent Owner

Neil C. Jones
Nelson Mullins Riley & Scarborough, LLP
1320 Main Street, Suite 1700
Columbia, SC 29201. Jones

For Requester

Ex Parte Schnitzer et al
Control No. 90/007,956
Filed: February 28, 2006
For: US Patent No. 5,586,992

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

This is a decision on the petition filed September 6, 2006 to request a two-month extension of time pursuant to 37 CFR 1.550 for responding to the non-final Office action dated August 3, 2006.

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

The petition is **granted** for <u>one</u> month the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Non-final Office action dated August 3, 2006, which set a two-month date for filing a response thereto. The request is timely filed and includes authorization to debit deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The petition for extension of time states that the patent owner and counsel have been diligently reviewing the Office action issued August 3, 2006; however, the patent owner is located in Germany, the expert in this case is located in the United Kingdom and consultation with the examiner and all parties has been scheduled for September 21, 2006. In order to prepare a completely responsive amendment, Patent Owner is requesting an additional two months, until December 3, 2006, to file a reply.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. In view of the fact that the request is made in anticipation of the need for additional time, it is clear that Patent Owner and counsel have been diligent in preparing a complete response to the Office action of August 3, 2006. It is also clear that the interview with the Examiner was made as quickly as possible with the intention of preparing a coordinated response thereafter. While coordinating inter-continentally can present some difficulties, it can be accomplished via internet and telephone. It is clear that all parties are familiar with the issues. The arrangement of face to face meetings is not seen to provide sufficient cause for an extension of time for two months. In the interest of providing the patent owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, an extension of time for one (1) month is granted.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated August 3, 2006 is **granted** for one month.

2. The Patent Owner's response is due November 3, 2006.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

for Lissi M. Marquis,
Director, Central Reexamination Unit

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JUL 20 2006

CENTRAL REEXAMINATION UNIT

R. Ross Viguet FULBRIGHT & JAWORSKI L.L.P. 2200 Ross Ave Suite 2800 Dallas, TX 75201	:	(For Patent Owner)
Alan L. Whitehurst. JONES DAY 51 Louisiana Avenue, N. W. Washington, DC 20001-2113	:	(For Third Party Requester)
Thomas A. Rozylowics FISH & RICHARDSON P. C. 1425 K Street, N. W. Suite 1100 Washington, DC 20005	:	(For Third Party Requester)
JANELLE D. WAACK 1111 Louisiana 25th floor Houston, TX 77002-5242	:	(For Third Party Requester)
Robert C. Laurenson HOWREY LLP 2020 Main Street Suite 1000 Irvine, CA 92614	:	(For Third Party Requester)
In re : Castille Reexamination Proceeding Control No. 90/007,839 Filed: December 7, 2005 For U.S. Patent No. 5,734,961	:	DECISION, *SUA SPONTE,* MERGING REEXAMINATION PROCEEDINGS PURSUANT TO 37 C.F.R. § 1.565(c)

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,936 :
Filed: February 17, 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,942 :
Filed: February 17, 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Reexamination Proceeding :
Control No. 90/007,957 :
Filed: March 3, 2006 :
For U.S. Patent No. 5,734,961 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,839 (the '839 proceeding) with 90/007,936 (the '936 proceeding), 90/007,942 (the '942 proceeding) and 90/007,957 (the '957 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,734,961 issued on March 31, 1998.

2. The '839 reexamination proceeding, filed on December 7, 2005, is a reexamination proceeding that was requested by a third party requester.

3. An order granting reexamination in the '839 reexamination proceeding was mailed on January 5, 2006.

4. The '936 reexamination proceeding, filed on February 17, 2006, is a reexamination proceeding that was requested by a third party requester.

5. An order granting reexamination in the '936 reexamination proceeding was mailed on April 3, 2006.

6. The '942 reexamination proceeding, filed on February 17, 2006, is a reexamination proceeding that was requested by a third party requester.

7. An order granting reexamination in the '942 reexamination proceeding was mailed on April 11, 2006.

8. The '957 reexamination proceeding, filed on March 3, 2006, is a reexamination proceeding that was requested by a third party requester.

9. An order granting reexamination in the '957 reexamination proceeding was mailed on April 25, 2006.

10. The above named proceedings are all awaiting examiner action for a first Office action on the merits.

11. There are no amendments to the above proceedings at this time

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in all 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 90/007,839, 90/007,936 90/007,942 and 90/007957 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

Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,839, 90/007,936 90/007,942 and 90/007957 are **merged**. 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

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 04/14/2008

R. ROSS VIGUET
FULBRIGHT & JAWORSKI LLP
2200 ROSS AVE., SUITE 2800
DALLAS, TX 75201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Hilda C. Galvan
Jones Day
2727 North Harwood Street
Dallas, TX 75201-1515

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,957. 90/007,839, 90/007,936, 90/007,942

PATENT NO. 5734961.

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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R. Ross Viguet (For Patent Owner)
Fulbright & Jaworski LLP
200 Ross Avenue
Suite 2800
Dallas, TX 75201-2784

Hilda C. Galvan (For Third Party Requester)
Jones Day
2727 North Harwood Street
Dallas, TX 75201-4556

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,839
Filed: December 7, 2005
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,936
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,942
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,957
Filed: March 3, 2006
For U.S. Patent No. 5,734,961

DECISION
GRANTING
PETITION

The four above-captioned *ex parte* reexamination proceedings have been previously merged into a single merged reexamination proceeding. The merged reexamination proceeding and the patent owner petition entitled "Petition Under 37 C.F.R. 1.182 For Expedited Examination Of Reexamination Proceedings" that was filed on March 21, 2008 are before the Director of the Central Reexamination Unit for consideration.

FEES

Although a $400.00 petition fee is required for a petition under 37 CFR 1.182, the instant petition has been forwarded to the undersigned for treatment as a petition under 37 CFR

1.181. Therefore, no fee is required for the petition. The previously submitted $400.00 petition fee has been refunded to Deposit Account No. 50-2929.

RELEVANT FACTS

1. The four *ex parte* reexamination proceedings that are included in the single merged reexamination proceeding were filed between December 7, 2005 and March 3, 2006.

2. Reexamination of the earliest filed individual reexamination proceeding, control number 90/007,839 (the '839 proceeding), was ordered January 5, 2006.

3. Reexamination of the latest filed individual reexamination proceeding, control number 90/007,958 (the '958 proceeding), was ordered April 25, 2006, with prosecution on the three earlier filed individual proceedings being necessarily delayed until it was determined whether reexamination could properly be ordered in the '958 proceeding.

4. Thereafter, merger of the four individual reexamination proceedings was considered to be proper, but was necessarily delayed in order to determine whether patent owner would exercise the statutory right (35 U.S.C. § 304) to file a patent owner's statement.

5. Upon expiration of the two month period for filing a patent owner's statement (plus allowance for mailing time and technical support treatment of such statement in the event that one had been filed), a decision merging the four individual reexamination proceedings was mailed on July 20, 2006.

6. A first Office action on the merits was mailed in the merged proceeding on December 14, 2007. The Office action set a thirty day or one month shortened statutory period, (whichever was longer), for filing a response thereto.

7. On January 3, 2008, patent owner filed a request for a one-month extension of time to file a response to the outstanding Office action because the action was twenty-two (22) pages in length, included various rejections, and patent owner was represented by two different law firms. An extension was granted to extend the response period through February 14, 2008.

8. A supplemental Office action was mailed on January 14, 2008 replacing the December 14, 2007 Office action, in which a technical defect in the December Office action was corrected.

9. One February 14, 2008, patent owner filed a timely response to the January 14, 2008 supplemental Office action, which response included eighty-three (83) new claims and fifty (50) pages of supporting remarks.

10. U.S. Patent No. 5,734,961 (the '961 patent) is the subject of multiple litigation proceedings, and at least one litigation is currently stayed pending completion of reexamination.

DECISION

The relief requested in the present petition is that the merged *ex parte* reexamination proceeding be accorded "expedited examination" and be considered with special dispatch. The record shows that the Office is currently treating the merged proceeding in accordance with established procedures, (MPEP §§ 2261 and 2286), which require that reexamination proceedings for a patent in litigation be given priority over all other cases, and that where litigation is stayed, that a thirty day or one month shortened statutory period will be set for response to Office actions.

Nevertheless, it must be noted that current statistics (through December 31, 2007) show that 26% of the *ex parte* reexamination requests filed and 52% of the *inter partes* reexamination requests filed involved patents that were also subject to litigation. Thus, there is a significant number of reexamination proceedings pending that involve litigation, including reexamination proceedings in which the litigation has been stayed.

Further, 35 U.S.C. § 305 requires that "[A]ll 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." Similarly, 35 U.S.C. § 314(c) provides that "[U]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." Thus, regardless of whether a given request for reexamination is directed to a patent that is the subject of concurrent litigation, <u>all</u> requests for reexamination must be considered promptly so as to meet the deadlines imposed by the reexamination statute. Accordingly, the examination of pending reexamination proceedings must be prioritized, even when considering that some of those proceedings must properly be advanced out of turn due to the status of concurrent litigation.

In light of these considerations, patent owner's petition for "'expedited examination'" and consideration of the present merged reexamination with special dispatch is <u>granted</u> to the extent that the merged proceeding <u>will</u> be examined in the Office in accordance with special dispatch and the priority treatment mandated by MPEP §§ 2261 and 2286 to the fullest extent that the Central Reexamination Unit (CRU) is able to do so. As there is litigation involving the '961 patent that has been stayed pending completion of reexamination, the present merged proceeding will be accorded the highest priority. However, patent owner must recognize, however, that the issues presented in the merged proceeding (a total of one hundred twelve (112) claims and 50 pages of remarks) are voluminous and complex, and that CRU must also treat a significant number of reexamination proceedings that are also entitled to "expedited examination" due to the existence of concurrent litigation that has been stayed due to copending reexamination in the Office.

CONCLUSION

1. Patent owner's petition is granted to the extent set forth above.

2. The merged reexamination proceeding is being forwarded to Art Unit 3992 for examination not inconsistent with this decision.

3. Telephone inquiries regarding this decision should be directed to Mark Reinhart at (571) 272-1611 or to Eric Keasel (571) 272-4929.

Lissi M. Marquis, Director
Central Reexamination Unit

March 27, 2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 11/03/2008

R. ROSS VIGUET
FULBRIGHT & JAWORSKI LLP
2200 ROSS AVE., SUITE 2800
DALLAS, TX 75201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2008

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United States Patent and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Robert C. Laurenson

Howrey LLP

2020 Main Street Suite 1000

Irvine CA 92614

MAILED

NOV 03 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007957, 90/007839, 90/007936, 90/007942

PATENT NO. 5,734,961

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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R. Ross Viguet
Fuibright & Jaworski LLP
2200 Ross Avenue
Suite 2800
Dallas, TX 75201-2784

(For Patent Owner)

Hilda C. Galvan
Jones Day
2727 North Harwood Street
Dallas, TX 75201-4556

(For Requester)

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,839
Filed: March 3, 2006
For: U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,936
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,942
Filed: February 17, 2006
For U.S. Patent No. 5,734,961

In re Jean-Paul Gilbert Castille
Reexamination Proceeding
Control No. 90/007,957
Filed: March 3, 2006
For U.S. Patent No. 5,734,961

MAILED

NOV 03 2008

CENTRAL REEXAMINATION UNIT

DECISION UNDER
37 CFR 1.181 FOR
RECONSIDERATION OF
DECISION DATED
APRIL 14, 2008

The four above-captioned *ex parte* reexamination proceedings have been previously merged into a single merged reexamination proceeding. The merged reexamination proceeding and the patent owner petition entitled "Petition Under 37 C.F.R. 1.181 Requesting Reconsideration of PTO Decision of April 14, 2008" (hereinafter "the present petition") that was filed on April 30, 2008 are before the Director of the Central Reexamination Unit for consideration.

The petition is granted for the reasons set forth below.

REVIEW OF REVELANT FACTS

1. On March 21, 2008, patent owner filed a petition entitled "Petition Under 37 C.F.R. 1.182 For Expedited Examination Of Reexamination Proceedings" in all four above-captioned *ex parte* reexamination proceedings. In this petition, patent owner stated that the term for U.S. Patent No. 5,734,961, will expire in either 2010 or 2011. See page 2 of this petition.

2. On April 14, 2008, the Office mailed a decision granting the petition of March 21, 2008 to the extent that the merged proceedings will be examined in accordance with special dispatch and the priority treatment mandated by MPEP 2261 and 2286 to the extent possible.

3. On April 30, 2008, patent owner filed the present petition requesting reconsideration of the decision of April 14, 2008 in light of the fact that the term for U.S. Patent No. 5,734,961, will expire no earlier than 2013 and not in either 2010 or 2011 as stated in the March 21, 2008 petition.

DECISION

The request for reconsideration in the present petition is granted. In review of the record, the decision of April 14, 2008 did not rely upon patent owner's statement that the term for U.S. Patent No. 5,734,961, will expire in either 2010 or 2011. As a result of this decision, the decision of April 14, 2008 is confirmed and maintained in light of the present petition.

CONCLUSION

1. Patent owner's present petition, dated April 30, 2008, for reconsideration of the April 14, 2008 decision is granted.

2. The decision of April 14, 2008 is confirmed and maintained.

3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, or Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse, Director
Central Reexamination Unit

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/05/2008

R. ROSS VIGUET
FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVE.
SUITE 2800
DALLAS, TX 75201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,396	01/27/2005	5770231	00166.0051-US09	9488

26853 7590 12/05/2008

COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/05/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/05/2008

ANTOR CORPORATION
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DIJON, 21000
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CENTRAL REEXAMINATION UNIT

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Dallas, TX 75201

In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	: : : :

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. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

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 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 '7839, '7936, '7942, '7957, and '9261 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 original claims remain unamended and new claims 30-112 have been added in the '7839, '7936, '7942, and '7957 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. This may be accomplished by canceling new claims 30-112 in the '7839, '7936, '7942, and '7957 reexamination proceedings. 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 each of the five proceedings, 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.

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.

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 will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/007,839, 90/007,936, 90/007,942, 90/007,957, and 90/009,261 are **merged**.

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

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401 Dulany Street
Alexandria, VA 22314

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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

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/30/2008

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EXAMINER

ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/30/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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2727 NORTH HARWOOD STREET
DALLAS, TX 75201-1515

Date:

DEC 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007839
PATENT NO. : 5734961
ART UNIT : 3900

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

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

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(For Patent Owner)

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Dallas, TX 75201

(Courtesy Copy)

In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	DECISION DISMISSING PETITION UNDER 37 CFR 1.181 TO VACATE FINALITY
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of the finality of the rejection mailed August 19, 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

6. The five requests were merged on December 5, 2008.

7. A non-final rejection was mailed December 22, 2005 in the merged proceedings.

DECISION

In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

1. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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Eric Keasel for

Gregory Morse
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In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

1. **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

Copied from 90007839 on 01/07/2009

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.

2. 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

Gregory Morse
Director, Central Reexamination Unit

Copied from 90007839 on 01/07/2009

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.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 01/08/2009

R. ROSS VIGUET
FULBRIGHT & JAWORSKI LLP
2200 ROSS AVE., SUITE 2800
DALLAS, TX 75201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Hilda C. Galvan
Jones Day
2727 North Harwood Street
Dallas, TX 75201-1515

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,957; 90/007,839, 90/007,936; 90/007,942

PATENT NO. 5734961.

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

R. Ross Viguet FULBRIGHT & JAWORSKI L.L.P. 2200 Ross Ave Suite 2800 Dallas, TX 75201	:	(For Patent Owner)
ANTOR CORPORATION C/O JEAN-PAUL CASTILLE 28 RUE DES ARANDES DIJON 21000 FR FRANCE	:	(for Patent Owner Courtesy Only)
Alan L. Whitehurst. JONES DAY 51 Louisiana Avenue, N. W. Washington, DC 20001-2113	:	(For Third Party Requester)
Thomas A. Rozylowics FISH & RICHARDSON P. C. 1425 K Street, N. W. Suite 1100 Washington, DC 20005	:	(For Third Party Requester)
HOWREY LLP c/o IP Docketing Department Attn: JANELLE D. WAACK 1111 Louisiana 25th floor Houston, TX 77002-5242	:	(For Third Party Requester)
Robert C. Laurenson HOWREY LLP 2020 Main Street Suite 1000 Irvine, CA 92614	:	(For Third Party Requester)
Paul Rauch EVAN LAW GROUP LLC 600 West Jackson Blvd, Suite 625 Chicago, IL 60661	:	(For Third Party Requester)
	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR § 1.550(c)]

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

In re : Castille :
Ex Parte Reexamination Proceeding :
Control No. 90/007,839 :
Deposited on: 7 December 2005 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Ex Parte Reexamination Proceeding :
Control No. 90/007,936 :
Deposited on: 17 February 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Ex Parte Reexamination Proceeding :
Control No. 90/007,942 :
Deposited on: 17 February 2006 :
For U.S. Patent No. 5,734,961 :

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

In re : Castille :
Ex Parte Reexamination Proceeding :
Control No. 90/007,957 :
Deposited on: 3 March 2006 :
For U.S. Patent No. 5,734,961 :

In re : Castille :
Ex Parte Reexamination Proceeding :
Control No. 90/009,261 :
Deposited on: 21 August 2008 :
For U.S. Patent No. 5,734,961 :

This is a decision on the 30 December 2008, petition for "Petition for Extension of Time Under 37 CFR § 1.550 (c)," requesting that the time for responding to the Office action mailed 22 December 2008, be extended by one-month in the above noted *ex parte* proceedings.

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 22 December 2008, 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 30 December 2008, together with the $200.00 petition fee as is required by 37 CFR §1.515(c) and as set forth in 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 reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner further notes the need for expert input whose availability during the response period is insufficient for a proper response. As such, the "sufficient cause" requirement is considered to be met by in this petition to the director of the Central Reexamination Unit. The sufficient cause justifies granting a one-month extension of time.

The petition request for a one month extension of time is hereby **granted**.

Conclusion

1. The patent owner's petition for extension of two-month time in which to file a response to the Office action dated 22 December 2008 is hereby **granted**.

2. The time to respond is extended by one-month.

3. The Patent Owner's response is due **22 February 2009**

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

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, Supervisory Patent Examiner, Art Unit 3992, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, at 571-272-4929, or Jessica Harrison, at (571) 272-4449, Supervisory Patent Examiners, Art Unit 3992, in the Central Reexamination Unit may be contacted.

/Mark Reinhart/
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,959	03/03/2006	6121314		8071

1095 7590 11/09/2007

NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER, NJ 07936-1080

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 104/3
EAST HANOVER, NJ 07936-1080

(For Patent Owner)

LAURENCE P. HOBBES
ROBERTS, MLOTKOWSKI & HOBBES
POST OFFICE BOX 10064
MCLEAN, VA 22102

(For Third Party Requester)

In re Reexamination Proceeding	:
F. Richter et al.	:
Control No. 90/007,959	: DECISION GRANTING PETITION
Filed: March 3, 2006	:
U.S. Patent No. 6,121,314	:
Attorney Docket No. 100-7554E (167-98)	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on September 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 ...."

On September 26, 2007, in the present petition, petitioner argues that a correspondence including a petition, a petition fee, an amendment and certificate of service were included with a correspondence submitted on August 17, 2007. As evidence thereof, petitioner submitted a copy of his postcard receipt which acknowledges receipt of, *inter alia*, a petition, a check for $1,500.00, an amendment and certificate of service on August 17, 2007. A copy of the correspondence, including a petition, a petition fee, an amendment and certificate of service was also submitted.

A review of the record reveals that while no correspondence submitted August 17, 2007 has been located in the Image File Wrapper, the Office financial records indicate that a $1,500.00 check for the petition fee was received on August 17, 2007. Accordingly, the evidence is convincing that a correspondence was submitted on August 17, 2007, including a petition, a check for $1,500.00, an amendment and certificate of service, which was subsequently misplaced in the USPTO.

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (amendment - item 1), a $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. The September 26, 2007 copy of the amendment originally submitted on August 17, 2007, will be used for examination purposes.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the amendment filed August 17, 2007, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Evelyn Huang, in CRU Art Unit 3991, who can be reached at 571-272-0686.

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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JUL 03 2008

CENTRAL REEXAMINATION UNIT

Ann R. Pokalsky
Dilworth & Barrese, LLP
333 Earle Ovington Blvd.
Uniondale, NY 11553

(For Patent Owner)

Laurence P. Hobbes
Roberts, Mlotkowski & Hobbes
P.O. Box 10064
McLean, VA 22102

(For Third Party Requester)

In re Reexamination Proceedings :
Richter et al. :
Control No. 90/007,959 :
Filed: March 3, 2006 :
For: U.S. Patent No. 6,121,314 :

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on June 16, 2008, for entry of late papers based upon unintentional delay.

The petition is before the Office of Patent Legal Administration for 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, *inter alia*, a reexamination response to the outstanding Office action, a Certificate of Service, a terminal disclaimer to address a non-statutory obvious-type double patenting rejection, and the requisite $1500.00 fee under 37 CFR 1.17(m). As such, petitioner has provided the response required by 37 CFR 1.137(b) (item 1). Further, payment of the requisite unintentional delay fee for a large entity was made (item 2). Finally, the petition contains the proper statement for unintentional delay in filing the required response (item 3). The present proceeding is a reexamination proceeding; thus, the petition does not require the terminal disclaimer of 37 CFR 1.137(b)(4) (item 4). See 37 CFR 1.137(d)(3).

A check of $1500.00 was enclosed, while the petition fee under 37 CFR 1.17(m) is $1540.00. Hence, an additional fee of $40.00 has been charged to Account No. 04-1121.

Accordingly, the present petition under 37 CFR 1.137(b) includes the requisite response (item 1), the $1540.00 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).

3. Any further communication as to the merits of the reexamination proceeding should be directed to examiner Evelyn Huang in the CRU, who can be reached at (571) 272-0686.

4. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor at 571-272-7710.

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

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CENTRAL REEXAMINATION UNIT

Leonard C. Mitchard
Nixon & Vanderhye, PC
901 North Glebe Road, 11th Floor
Arlington, VA 22203

(Patent Owner)

Judy Jarecki-Black
Merial Limited
3239 Satelite Blvd.
Duluth, GA 30096-4640

(Third Party Requester)

In re Donachie, *ex parte*
Reexamination Proceeding
Control No. 90/007,964
Filed: April 5, 2006
For: U.S. Patent No. 5,587,166

: DECISION ON PETITION
: AND ON OTHER PAPERS
: IN THE FILE

This is a decision on the August 30, 2007 patent owner paper entitled "PETITION TO REMOVE IMPROPER SUBMISSION FROM THE RECORD," and *SUA SPONTE* ON OTHER PAPERS IN THE PRESENT FILE.

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

The petition is dismissed for the reasons set forth below.

The third party requester paper filed July 5, 2007 entitled "REQUESTER NOTIFICATION OF ACTIVITY" is partially expunged.

FEES

As a petition styled and asserted by petitioner as being under 37 CFR 1.182 a fee, a petition fee of $400.00 under 37 CFR 1.17(f) is being charged to the patent owner's Deposit Account No. 14-1140 as authorized in the August 30, 2007 patent owner petition.

REVIEW OF FACTS

1. U.S. Patent No. 5,587,166 (the '166 patent), issued to William Donachie, on December 24, 1996.

2. A request for *ex parte* reexamination of the '166 patent was filed by a third party requester (requester), Merial LTD., on March 8, 2006. The request was assigned Control No. 90/007,964 (the '7964 proceeding).

3. On April 5, 2006, the Office granted the '7964 request for reexamination.

4. On December 22, 2006, the Office issued an Official action on the merits in the '7964 proceeding.

5. The '166 patent is subject to litigation in the United States District Court for the District of Delaware, INTERVET, INC. AND BTG INTERNATIONAL LIMITED V. MERIAL LIMITED, {Civil Action No. 05-887-KAJ (D. DEL)(The litigation)}.

6. On May 22, 2007, the patent owner responded to the December 22, 2006 Official Action.

7. On July 5, 2007, the third party requester submitted in the '7964 proceeding, a Notification of Activity pursuant to MPEP 2207, 2282 and 2286. The Notification of Activity included a copy of a 37 CFR 1.501 submission for the '166 patent and a copy of a new request for *ex parte* reexamination of the '166 patent.

8. Concurrent with the filing of the Notification of Activity on July 5, 2007, the third party requester filed a 37 CFR 1.501 submission in the '166 file history, and a new request for *ex parte* reexamination of the '166 patent. The new request was assigned Control No. 90/008,762 (the '8762 proceeding).

9. The '8762 proceeding's request for reexamination of the '166 patent includes, in addition to posited substantial new questions of patentability, a request for merger of the '8762 proceeding with the present '7964 proceeding.

10. On August 30, 2007, the patent owner petitioned to remove third party requester's July 5, 2007 37 CFR 1.501 submission from the file history of the '166 patent. Additionally, in the same petition paper, patent owner asserted an opposition to the third party requester's request that the '7964 and the '8762 proceedings be merged.

RELEVANT STATUTE, REGULATIONS, AND PROCEDURE

35 USC 301 states:

> 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. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the

patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

37 CFR 1.501 states:

(a) At any time during the period of enforceability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§1.502 and 1.902.
(b) If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.
(c) Citation of patents or printed publications by the public in patent files should either: (1) Reflect that a copy of the same has been mailed to the patent owner at the address as provided for in § 1.33(c); or in the event service is not possible (2) Be filed with the Office in duplicate.

37 CFR 1.565(a) states:

(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 2206 states (in part):

Prior art citations received in the Office will be forwarded to the Technology Center (TC) that currently examines the class and subclass in which the patent to which the prior art citations are addressed is classified as an original.

It is the responsibility of the TC to immediately determine whether a citation meets the requirements of the statute and the rules and to enter it into the patent file at the appropriate time if it is proper.

If a proper citation is filed after the date of an order for reexamination but it is not entitled to entry pursuant to the reexamination rules, the citation is retained (stored) in the TC until the reexamination is concluded. Note 37 CFR 1.502 and 1.902 and MPEP § 2294. An e-tag should be placed in the reexamination file history as a reminder of the citation to be placed in the patent file after conclusion of the reexamination proceeding. The citation is then placed in the TC's citation storage file. After the reexamination proceeding is concluded, the citation is removed from the storage file and processed for placement in the patent file. Citations filed after the date of an order for reexamination, which are not entitled to entry pursuant to the reexamination rules will not be considered by the examiner during the reexamination.

MPEP 2207 states:

The Solicitor's Office processes *notices* required by 35 U.S.C. 290, received from the clerks of the various courts, and has them entered in the patent file. However, it is considered desirable that the *entire court decision* be supplied to the Office for entry into the patent file. Accordingly, the Office will accept at *any time* from *any party* for placement in the patent file, submissions of the following: copies of notices of suits, copies of notices regarding other proceedings involving the patent and copies of decisions from litigations or other proceedings involving the patent. **The Office will also accept for entry into the patent file other court papers, or papers filed in the court, from litigations or other proceedings involving the patent.** It

is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers. **Such submissions must be provided without additional comment. Persons making such submissions must *limit the submission to the notification* and not include further arguments or information. It is to be understood that highlighting of certain text by underlining, fluorescent marker, etc., goes beyond bare notice of the prior or concurrent proceedings**. Any proper submission will be promptly placed on record (entered) in the patent file. Entry of these submissions is performed by the Files Repository personnel, unless a reexamination proceeding is pending, in which case, the Central Reexamination Unit, the Technology Center, or other area of the Office having responsibility for the reexamination enters the submission.

Where a request for reexamination has been filed, see MPEP § 2282 for *ex parte* reexamination and MPEP § 2686 for *inter partes* reexamination. See MPEP § 2240 and § 2242 for handling of requests for *ex parte* reexamination of patents involved in litigation. See MPEP § 2640 and § 2642 for handling of requests for *inter partes* reexamination of patents involved in litigation.

MPEP 2282 states (in part):

It is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing *ex parte* reexamination is or was involved, such as interferences, reissues, *inter partes* reexaminations, other *ex parte* reexaminations or litigations, and any results of such proceedings. In accordance with 37 CFR 1.565(a), the patent owner is required to provide the Office with information regarding the existence of any such proceedings, and the results thereof, if known. **Ordinarily, no submissions of any kind by third parties filed after the date of the order are entered into the reexamination or patent file while the reexamination proceeding is pending. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent**. It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers. **Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information.** *Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office.* It is to be understood that highlighting of certain text by underlining, fluorescent marker, etc., goes beyond bare notice of the prior or concurrent proceedings.

DECISION

I. THE 37 CFR 1.501 SUBMISSION

Petitioner seeks relief in the form of removal of a 37 CFR 1.501 submission filed on July 5, 2007 from the '166 patent's file history. Petitioner requests such relief in the '166 patent file history by filing petition papers in reexamination proceeding '7964, which is an *ex parte* reexamination of the '166 patent. In accordance with MPEP 2206 guidance, determinations regarding the propriety of prior art citations filed under 37 CFR 1.501(a) is the jurisdiction of the Technology Center (TC) where a patent is currently classified. The '166 patent is currently classified in

Class 424, subclass 255.1, which falls within the jurisdiction of TC 1600, Biotechnology. Relief as to papers in the '166 patent file cannot be granted via a petition in the present reexamination proceeding which is before the Central Reexamination Unit. Rather, proper petition procedure requires the patent owner to file a petition in the '166 patent file addressed to the Director of TC 1600. Further, the TC 1600 Director has acted in the '166 patent file to issue a decision expunging the July 5, 2007 submission in question. Therefore, the petition is dismissed as moot.

II. *SUA SPONTE* PARTIAL EXPUNGEMENT OF REQUESTER NOTIFICATION OF ACTIVITY:

On July 5, 2007, third party requester submitted a Notification of Activity (the notice) including papers from other proceedings related to the '166 patent. On page 2 of the notice, third party requester has set forth a listing of the exhibits styled to organize the bare notice of the papers in accordance with MPEP 2282 procedure. Exhibit E was listed as containing a rule 501 submission served upon the patent owner and filed with the Office concurrently on July 5, 2007. As noted above, this 37 CFR 1.501 submission, dated July 5, 2007, has been found improper and expunged in a decision promulgated by TC 1600. Therefore, the Exhibit E is not a paper from a prior or concurrent proceeding regarding the patent under reexamination. Accordingly, Exhibit E is not proper for submission under MPEP 2282 in the present reexamination proceeding.

Furthermore, Exhibit E contains arguments and information in regards to court papers and is not limited to bare notification, as required by MPEP 2282. Namely, the remarks section of the 501 submission in Exhibit E improperly interjects further argument and information amounting to an improper submission of court documents into the '7964 reexamination proceeding.

Accordingly, the third party requester Notification of Related Activity submission filed on July 5, 2007 is improper-in-part to the extent that Exhibit E was found to be an improper paper under 37 CFR 1.501 resulting in its removal from the '166 patent file. Furthermore, Exhibit E in the July 5, 2007 Notification of Related Activity is improper as a submission under MPEP 2282. The copy of the July 5, 2007 improper submission has been scanned into the electronic Image File Wrapper (IFW) of the proceeding. Thus, the copy cannot be physically returned to the requester. Rather, the copy of the submission papers is being expunged from the official record of the '7964 reexamination proceeding by closing the submission documents in the IFW file of the proceeding and marking the documents "not public."

It is to be noted that, even if a proper 37 CFR 1.501 submission would have been made, it would have been provisionally sealed until the Reexamination Certificate for the present proceeding would issue, since reexamination has already been ordered in the present proceeding – see 37 CFR 1.502. Thus, a copy of any such 37 CFR 1.501 submission could not be presented in this proceeding, in any event.

III. OPPOSITION TO REQUEST FOR MERGER

37 CFR 1.4(c) states:

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

In the August 30, 2007 patent owner petition, patent owner makes two separate and distinct requests - removal of a 37 CFR 1.501 submission in the file history of the '166 patent and opposition to the merger of the '7964 proceeding and the '8762 proceeding. These two separate and distinct requests contain issues, which are decided by different officials within the Office. Patent owner's request to remove the 37 CFR 1.501 submission from the '166 patent's file history has been addressed in this decision. Patent owner's opposition to merger is dismissed under 37 CFR 1.4(c), as improperly joined.

CONCLUSION

1. The August 30, 2007 patent owner petition is dismissed.

2. The third party requester Notification of Related Activity submission filed on July 5, 2007 is improper-in-part to the extent that the 37 CFR 1.501 submission styled as Exhibit E in the July 5, 2007 Notification of Related Activity is deemed an improper submission. Exhibit E is expunged from the official record by closing it and designating it as "non-public."

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

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

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

October 1, 2007
C:\kiva\kenids\decisions\5587166 expunge-improper-501-submission.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAR 13 2008

CENTRAL REEXAMINATION UNIT

Leonard Mitchard
Nixon & Vandehye
901 North Glebe Road, 11th Floor
Arlington VA, 22203

(for Patent Owner)

Judy Jarecki-Black, PhD, J.D.
Merial Limited
3239 Satellite Blvd.
Duluth, Georgia, 30096-4640

(for Third Party Requeste)

In re Donachie
Reexamination Proceeding
Control No.: 90/008,762
Filed: July 5, 2007
For: U.S. Patent 5,587,166

In re Donachie
Reexamination Proceeding
Control No.: 90/007,964
Filed: March 8, 2006
For: U.S. Patent 5,587,166

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 5,587,166 (the '166 patent) issued December 24, 1996 and is the subject of Reexamination Control Nos. 90/007,964 and 90/008,762.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,964, was filed March 8, 2006 by Judy Jarecki-Black of Merial Limited in Duluth, Georgia. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed invention or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/007,964 on April 5, 2006.

4. A first non-final Office action was issued on December 22, 2006.

5. Patent Owner filed a response on May 22, 2007.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,762, was filed July 5, 2007 by Judy Jarecki-Black of Merial Limited in Duluth, Georgia. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed invention or are so close as to establish a case of obviousness.

7. Reexamination was ordered for 90/008,762 on September 29, 2007.

81. No Office action has been issued in the later 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* 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 90/007,964 and 90/008,762 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,964 and 90/008,762 as:

Leonard Mitchard
Nixon & Vandehye
901 North Glebe Road, 11th Floor
Arlington VA 22203

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in both Reexamination Control No. 90/006,946 and 90/007,987as:

Judy Jarecki-Black
Merial Limited
3239 Satellite Blvd.
Duluth Georgia 30096-4640

CONCLUSION

Reexamination Control Nos. 90/006,946 and 90/007,987 are merged. **Since there has been no amendment to the specification or claims, the requirement to submit a "housekeeping amendment" is waived.** An Office action will issue in due course.

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

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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APR 03 2008

CENTRAL REEXAMINATION UNIT

Leonard Mitchard
Nixon & Vandehye
901 North Glebe Road, 11th Floor
Arlington VA, 22203

(for Patent Owner)

Judy Jarecki-Black, PhD, J.D.
Merial Limited
3239 Satellite Blvd.
Duluth, Georgia, 30096-4640

(for Third Party Requeste)

In re Donachie
Reexamination Proceeding
Control No.: 90/008,762
Filed: July 5, 2007
For: U.S. Patent 5,587,166

In re Donachie
Reexamination Proceeding
Control No.: 90/007,964
Filed: March 8, 2006
For: U.S. Patent 5,587,166

CORRECTED
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 5,587,166 (the '166 patent) issued December 24, 1996 and is the subject of Reexamination Control Nos. 90/007,964 and 90/008,762.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,964, was filed March 8, 2006 by Judy Jarecki-Black of Merial Limited in Duluth, Georgia. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed invention or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/007,964 on April 5, 2006.

4. A first non-final Office action was issued on December 22, 2006.

5. Patent Owner filed a response on May 22, 2007.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,762, was filed July 5, 2007 by Judy Jarecki-Black of Merial Limited in Duluth, Georgia. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed invention or are so close as to establish a case of obviousness.

7. Reexamination was ordered for 90/008,762 on September 29, 2007.

81. No Office action has been issued in the later 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* 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 90/007,964 and 90/008,762 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,964 and 90/008,762 as:

Leonard Mitchard
Nixon & Vandehye
901 North Glebe Road, 11th Floor
Arlington VA, 22203

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in both Reexamination Control No. 90/008,762 and 90/007,964as:

Judy Jarecki-Black
Merial Limited
3239 Satellite Blvd.
Duluth Georgia 30096-4640

CONCLUSION

Reexamination Control Nos. 90/008,762 and 90/007,964 are merged. **Since there has been no amendment to the specification or claims, the requirement to submit a "housekeeping amendment" is waived.** An Office action will issue in due course.

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

for Lissi M. Marquis, Director
Central Reexamination Unit

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Craig A. McRobbie
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8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747

For Patent Owner

MAILED

AUG 08 2007

CENTRAL REEXAMINATION UNIT

Stephen A. Bent
Foley & Lardner LLP
3000 K Street N.W.
Washington DC 20007

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,968
Filed: March 7, 2006
For: US Patent No. 6,984,406

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

This is a decision on the petition filed May 24, 2007 to request a three-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated march 29, 2007.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the

Office action dated March 29, 2007, which set a two-month date for filing a response thereto. The Office action is a Final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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 taken actions to prepare comparative testing as suggested by the examiner in an interview held January 10, 2007. These tests are ongoing and not yet completed. Patent Owner has encountered some unexpected problems such as the unavailability of a sample of Bacillus strain having ATCC accession no. 555045. A sample has been obtained from the assignee of the cited references, Chemgen Corporation. After confirmation that this actually corresponds to the mannanase of the cited art, the comparative testing can proceed. It is difficult to estimate the amount of time required for this testing and the subsequent preparation of suitable Declarations. An additional three months is requested to complete the testing and prepare an appropriate response.

Analysis and Findings

Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period; however, when balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a two-month extension of time in which to file a response to the outstanding Office action.

Accordingly, the period of time for filing a reply to the Office action dated March 29, 2007 is extended to run four (4) months from the date of the final Office action and is due on July 29, 2007. 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.

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated March 29, 2007 is **granted** for two (2) months.

2. The Patent Owner's response is due July 29, 2007.

3. Response may be submitted as follows:

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

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

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

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

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,969	03/08/2006	5470228	3022-0031	2952

22442 7590 01/24/2007

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

1/24/2007

David J. Kenealy

Cermak & Kenealy LLP

515 East Braddock Road, Suite B

Alexandria, VA 22314

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007969

PATENT NO. 5,470,228

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
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PATENT OWNER: Sheridan Ross PC 1560 Broadway Suite 1200 Denver, CO 80202 **REQUESTER:** David J. Kenealy Cermack & Kenealy LLP 515 East Braddock Road, Suite B Alexandria, VA 22314	PETITION TO REVIEW DENIAL OF REEXAMINATION REQUEST UNDER 37 CFR 1.515(C)
Reexamination Proceeding Control No. 90/007,969 Filed: March 8, 2006 For: U.S. Patent No. 5,470,228	

This is a decision on the petition filed by the requestor under 37 CFR 1.515(c) and 1.181(b) on May 4, 2006. Petitioner requests that the Director review the examiner's determination denying the Request filed March 8, 2006 for reexamination of Patent No. 5,470,228.

The petition is GRANTED.

On March 8, 2006, requestor filed a Request for Reexamination of U.S. Patent No. 5,470,228. In the Request, four new references were cited: United States Patent No. 4,197,642 issued to Wallshein, United States Patent No. 3,765,091 issued to Northcutt, United States Patent No. 3,028,671 issued to Berger and United States Patent No. 4,478,577 issued to Warren, Jr.. Requestor alleged that a substantial new question of patentability (SNQ) was raised by the obvious combination of the teachings of Merkel et al (previously considered in the prior examination of the '228 patent) in view of Wallshein '642, Northcutt or Berger. The combination of Northcutt and Wallshein '642 was also proposed as was the combination of Northcutt and Wallshein'642 with Merkel et al.

The Request was denied on April 4, 2006 in the Order Denying Request for Ex Parte Reexamination wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. With regard to Merkel et al taken with Wallshein '642, the examiner held that Wallshein '642 was considered "old art" because Wallshein '642 is the parent patent to continuation U.S. Patent No. 4,260,375 to Wallshein which was considered in the prior examination of the Franseen et al '228 patent and the disclosure of Wallshein '642 and Wallshein '375 are substantially identical. The examiner therefore held that Wallshein '642 alone or in combination with Merkel et al did not raise a SNQ. The examiner further held that the other cited references did not raise a SNQ because they were considered to be cumulative to that already considered in the prosecution of the Fransee et al '228 patent.

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. A SNQ may be based soley 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, in view of a material new argument or interpretation presented in the request. 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's primary argument is that the written record of the prosecution of the Franseen et al '228 patent fails to contain any evidence that Wallshein '375 was fully considered since there are no remarks addressing the disclosure of the Wallshein '375 patent. Petitioner argues that the examiner's initials indicating consideration of the Wallshein '375 patent without the discussion of it is insufficient to conclude that the Wallshein '375 patent was fully considered by the Office. It is further argued that a SNQ may be based on old art where old art is being presented in a new light or in a different way.

It is agreed that the consideration of Wallshein '642 raises a SNQ. Because Wallshein '642 is the parent patent to continuation Wallshein '375 and Wallshein '375 was initialed by the examiner as having been considered in the prosecution of the Franseen et al '228 patent, Wallshein '642 was effectively considered by the examiner in the prosecution of the Franseen et al '228 patent. However, MPEP 2242 states that a SNQ may be based on old art where the old art is being presented/viewed in a different light, or in a different way, as compared with its use in the earlier concluded examination, in view of a material new argument or interpretation presented in the Request. Requestor's proposed combination of Merkel et al with Wallshein '642 and discussion of the features taught by Wallshein '642 is seen to support the argument that Wallshein '642 has been presented in a new light. Since there was no discussion of Wallshein '375 in the prior examination of the Franseen et al '228 patent, the extensive discussion of the proposed combination of Merkel et al with Wallshein '642 set forth by the requestor must be regarded as a presentation in a new light or in a different way. Therefore, a SNQ is seen to exist in view of Wallshein '642.

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:9/28/06

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.
90/007,969	03/08/2006	5470228	3022-0031	2952

22442 7590 11/02/2007
SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/02/2007

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

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

(For Patent Owner)

MAILED
NOV 02 2007
CENTRAL REEXAMINATION UNIT

DAVID J. KENEALY
CERMAK & KANEALY LLP
515 EAST BRADDOCK ROAD, SUITE B
ALEXANDRIA, VA 22314

(For Third Party Requester)

In re Reexamination Proceeding :
Franseen et al. :
Control No. 90/007,969 : DECISION GRANTING PETITION
Filed: March 8, 2006 :
U.S. Patent No. 5,470,228 :
Attorney Docket No. 1029-203-2-RX :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on August 24, 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 (amendment- item 1), an authorization to charge counsel's deposit account for the $750.00 petition fee under 37 CFR 1.17(m)) (item 2) and the requisite statement (item 3).

A review of the petition revealed that the requisite proof of service on the third party requester was not submitted.

On October 17, 2007, in response to a telephone communication between Counsel Joseph

Kovarik and Senior Legal Advisor Fred Silverberg, a Certificate of Service on the third party requestor was submitted.

The petition for entry of the late papers is granted.

$750.00 has been charged to counsel's deposit account no. 19-1970 in accordance with the present petition.

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

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the amendment filed August 24, 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, Jeanne Clack, in CRU Art Unit 3993, who can be reached at 571-272-7714.

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,969	03/08/2006	5470228	3022-0031	2952

22442 7590 02/14/2008

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/14/2008

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

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FEB 14 2008

CENTRAL REEXAMINATION UNIT

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

(For Patent Owner)

DAVID J. KENEALY
CERMAK & KANEALY LLP
515 EAST BRADDOCK ROAD, SUITE B
ALEXANDRIA, VA 22314

(For Third Party Requester)

In re Reexamination Proceeding :
Franseen et al. :
Control No. 90/007,969 : DECISION GRANTING PETITION
Filed: March 8, 2006 :
U.S. Patent No. 5,470,228 :
Attorney Docket No. 1029-203-2-RX :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 31, 2008, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states, in part:

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

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (amendment- item 1), an authorization to charge counsel's deposit account for a small entity petition fee of $750.00 under 37 CFR 1.17(m) and for any fees due (item 2), the requisite statement (item 3) and proof of service on the third party requester.

On February 11, 2008, in response to a telephone communication between Counsel Joseph Kovarik and Senior Legal Advisor Fred Silverberg, a Notice of Appeal including an authorization to charge the $255.00 small entity Notice of Appeal Fee to counsel's deposit account and a Certificate of Service on the third party requestor were submitted.

The petition for entry of the late papers is granted.

The current small entity petition fee is $770.00 under 37 CFR 1.17(m).

Accordingly, $1,025.00 ($770.00 for the small entity petition fee and $255.00 for the small entity Notice of Appeal fee) have been charged to counsel's deposit account no. 19-1970.

The time period for filing an appeal brief and the appeal brief fee in response to the Notice of Appeal filed as a response required 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 3992 for further examination and consideration of the reexamination proceeding, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jeanne Clack, in CRU Art Unit 3993, who can be reached at 571-272-7714.

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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Steven M. Rabin Rabin & Berdo, PC 1101 14th Street, NW Suite 500 Washington, DC 20005	)))))	**FOR PATENT OWNER**
David Bogart Dort, Esquire Rubinstein Law Group, PC 1700 Diagonal Road Suite 300 Alexandria, Virginia 22314	)))))	**FOR THIRD PARTY REQUESTER**

MAILED
AUG 30 2006
CENTRAL REEXAMINATION UNIT

In re John E. Draim Reexamination Proceeding Control No. 90/007,974 Filed: March 18, 2006 For: U.S. Patent No. 6,701,126	: : : : :	**DECISION DISMISSING PETITION TO VACATE ORDER GRANTING REEXAMINATION**

This is a decision on the petition filed by patent owner on July 14, 2006 requesting that the order granting reexamination be vacated

The petition is dismissed.

BACKGROUND

1. Patent No. 6,701,126 (the '126 patent) issued on March 2, 2004.

2. A request for reexamination, assigned Control No. 90/007,974 (the '7974 proceeding), was filed by a third party requester on March 18, 2006.

3. Reexamination was ordered in the '7974 reexamination proceeding on May 16, 2006.

4. On July 14, 2006, the patent owner filed the present petition to vacate the May 16, 2006 order for reexamination, which petition is the subject of this decision.

RELEVANT STATUTES, REGULATIONS, AND PROCEDURE

Selected excerpts of the statutes, regulations and MPEP which are relevant to this decision are reproduced below with emphasis added (in bold) to highlight relevant portions.

35 U.S.C. § 303 Determination of issue by Director.

> (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 2242 provides in relevant part:

II.A. Prior Favorable Decisions by the U.S. Patent and Trademark Office (Office) on the Same or Substantially Identical Prior Art in Relation to the Same Patent.

> A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. In re Recreative Technologies, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent). For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of In re Hiniker, 150 F.3d 1362,1365-66,47 USPQ2d 1523, 1526 (Fed. Cir. 1998).
>
> 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.

DECISION

Patent owner contends that the request for reexamination of the '126 patent does not raise a substantial new question (SNQ) of patentability because the reference relied upon (U.S. Patent No. 6,964,613, issued to Castiel on October 11, 2005) as the basis for the SNQ is the parent of U.S. Patent Publication 2002/016070 (the '070 publication) which was made of record in the original prosecution of the application that matured into the '126 patent.

Patent owner argues that the decision to order reexamination is "contrary to the Office policy of affirming prior favorable decisions based on the same or substantially identical prior art." (Petition, at page 3.)

Since the reexamination request for the present proceeding was filed after 22 November 2002, reliance on previously cited art will not preclude the finding of a substantial new question of patentability. See 35 U.S.C. § 303, last sentence. A review of the record of the '126 patent file reveals that although the '070 publication was cited, its relevance to patentability was discussed only minimally. Furthermore, the '070 publication, clearly was never applied against any claim. Thus, the order of reexamination, which now discusses the manner in which the '613 patent is to be applied, is proper and is not contrary to Office policy.

Patent owner further alleges:

> "[T]here is nothing in the examiner's Order of May 16, 2006 to indicate that the examiner observed the guidance in MPEP§2242(II.A) that the examiner should check the patent's file history to ascertain whether any of the prior art advanced by the requester was previously cited/considered in an earlier concluded Office examination of the patent."

(Petition, paragraph bridging pages 3 and 4; Internal quotations omitted.)

The order of May 16, 2006, however, specifically states (on the bottom of page 2):

> These teachings are not cumulative to the prior art ***applied*** or ***discussed on the record*** in the examination of the United States Patent Number 6,701,126..." [Emphasis added]

This is a clear indication that the examiner did, in fact, review the patent file history and acted in accordance with the guidance set out in the MPEP in determining whether an SNQ was raised by the requester.

In view of the above, the petition to vacate the reexamination proceeding is dismissed.

CONCLUSION

1. The petition to vacate the reexamination order is dismissed.

2. Jurisdiction over the present reexamination proceeding is being returned to the Central Reexamination Unit, for preparation of an Office action in due course.

3. Telephone inquiries related to the present decision should be directed to Pinchus M. Laufer, Legal Advisor, at 571-272-7726, or, in his absence, to the undersigned at 571-272-7710.

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

August 28, 2006
C:\kiva\kenpet6\UV\7974_UV_Rech-Tech-art-not-applied.wpd

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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.
90/007,974	03/18/2006	6701126	MISC.R001	2512

7590 04/10/2007

RABIN & BERDO PC
1101 14TH STREET NW, SUITE 500
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/10/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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RABIN & BERDO PC
1101 14TH STREET NW, SUITE 500
WASHINGTON, DC 20005

In re Application of	:	
JOHN E. DRAIM	:	
Control No. 90/007,974 (U.S. Patent 6,701,126)	:	DECISION ON PETITION
Filed: March 18, 2006	:	TO WITHDRAW
Attorney Docket No. MISC.R001	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 23, 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 Steven M. Rabin on behalf of all attorneys of record. 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.

A review of the file discloses that a non-final Office action was mailed on March 13, 2007, which set forth a two month shortened statutory period for reply. To date, there is no indication that a reply to the Office action of March 13, 2007 has been received.

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: **JOHN E. DRAIM**
9310 Teller Court
Vienna, VA 22182

cc: **MR. PETER SAHAGAN**
Space Resource International Ltd.
C/O Ardustry Entertainment
9255 Sunset Blvd. Suite 1000
West Hollywood, CA 90069

cc: **DAVID BOGART DORT** (Third Party Requester)
Rubinstein Law Group PC
1700 Diagonal Road, Suite 300
Alexandria, VA 22314

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on March 23, 2007. There is no indication it was served on 3rd Party Requester.

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.
90/007,976	03/20/2006	6997570	430.248	4968

7590 09/29/2006

WARREN K. MACRAE
BRYAN CAVE LLP
1290 AVENUE OF THE AMERICAS
NEW YORK, NY 10104

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

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9/29/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ANN M. LEE

THE CLOROX COMPANY

P.O. BOX 24305

OAKLAND, CA 94623

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007976

PATENT NO. 6,887,570

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 29 2006

CENTRAL REEXAMINATION UNIT

Warren K. MacRae
BRYAN CAVE LLP
1290 Avenue of the Americas
New York, NY 10104

For Patent Owner

Ann M. Lee
The Clorox Company
1221 Broadway
Oakland, CA 94612

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,976
Filed: March 20, 2006
For: US Patent No. 6,887,570

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

This is a decision on the petition filed September 19, 2006 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated August 2, 2006.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated August 2, 2006, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The petition for extension of time states that the reexamination proceeding has recently been transferred to the above named firm and, in order to fully consider the rejections and prepare a proper response, an extension of time for one month is requested.

Analysis and Findings

The request for reexamination was filed on March 20, 2006 with service to the patent Owner. The order for reexamination was granted on March 20, 2006. No Patent Owner statement was received. A first Office action was mailed August 2, 2006. Since this time, patent owner has secured new counsel and, in anticipation of the need of some additional time for new counsel to review the patent file, the request, and the Office action, a request for an extension of time for one month is made. On balance it is considered that the petition explains the "sufficient cause" for an extension of time. An extension of time for one month is considered ample to allow all parties to review the record and provide rebuttal to the issues developed in the office action of August 2, 2006. In the interest of providing the patent owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, an extension of time for one (1) month is granted. It should be noted however, second or subsequent requests for extensions of time will be granted only in extraordinary situations. (MPEP 2265)

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated August 2, 2006 is **granted**.

2. The Patent Owner's response is due November 2, 2006.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

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
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APR 27 2007

CENTRAL REEXAMINATION UNIT

John Hornickel
3M Office of Intellectual Prop. Counsel
P.O. Box 33427
St. Paul, MN 55133

(for Patent Owner)

Rabinder N. Narula
Knobbe Martens Olson & Bear LLP
2040 Main Street, 14th Floor
Irvine CA 92614

(for Third Party Requester)

In re Calhoun et al
Reexamination Proceeding
Control No.: 90/007,978
Filed: March 2, 2006
For: U.S. Patent 5,897,930

In re Calhoun et al
Reexamination Proceeding
Control No.: 90/008,215
Filed: September 20, 2006
For: U.S. Patent 5,897,930

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 5,897,930 issued April 27, 1999, is the subject of Reexamination Control Nos. 90/007,978 and 90/008,215.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,978, was filed March 2, 2006 by Rabinder N. Narula of Knobbe Martens Olson & Bear LLP in Irvine CA. The request urged that a substantial new question of patentability was raised by the newly cited references with regards to claims 1-5.

3. Reexamination was ordered for 90/007,978 on April 12, 2006.

4. A first non-final Office action was issued on September 27, 2006.

5. Patent Owner filed a response on November 27, 2006.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,215, was filed Setpember 20, 2006 by Rabinder N. Narula of Knobbe Martens Olson & Bear LLP in Irvine CA. The request urged that a

substantial new question of patentability was raised by the newly cited references with regards to claims 1-5 of the patent.

7. Reexamination was ordered for 90/008,215 on October 12, 2006.

8. A non-final Office was issued issued in 90/008,215 on February 12, 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* 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 90/007,978 and 90/008,215 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,978 and 90/008,215 as:

John Hornickel
3M Office of Intellectual Prop. Counsel
P.O. Box 33427
St. Paul, MN 55133

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,978 and 90/008,215 as:

Rabinder N. Narula
Knobbe Martens Olson & Bear LLP
2040 Main Street, 14th Floor
Irvine CA 92614

CONCLUSION

Reexamination Control Nos. 90/007,978 and 90/008,215 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, 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 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.
90/007,980	03/22/2006	5612524	26260-3	8300

21171 7590 03/21/2008

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/21/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

SCOTT E. KAMHOLZ
FOLEY & HOAG LLP
155 SEAPORT BLVD.
BOSTON MA 02210-2600

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007980
PATENT NO. : 5612524
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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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(for Patent Owner)

MAILED

MAR 21 2008

CENTRAL REEXAMINATION UNIT

Scott E. Kamholz, Esq.
FOLEY HOAG, LLP
Seaport World Trade Center West
155 Seaport Boulevard
Boston, MA 02210-2600

(For Requester)

DECISION GRANTING
PETITION UNDER
37 CFR 1.59 (B) TO
EXPUNGE INFORMATION

In re: Sant' Anselmo *et alia*
Ex parte Reexamination Proceeding
Control No. 90/007,980
Deposited: March 22, 2006
For: US Patent No. 5,612,524

This is a decision on the 11 February 2008 Patent Owner requested petition titled "Petition Pursuant to 37 CFR 1.59(b) to Expunge Information."

This petition considers under 37 CFR 1.59 (b) a request to expunge materials submitted by the Patent Owner with the Information Disclosure Statement (IDS) filed 28 January 2008. The petition was filed in a timely manner with the authorization to debit a deposit account for the appropriate fee pursuant to 37 CFR 1.17 (g).

The petition to expunge filed under 37 CFR 1.59 (b) is **granted**.

CITATION OF APPROPRIATE PROCEDURE

MPEP 724.04

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:
(A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.
(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.
(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.
(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.
(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).
(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

DECISION

The petition to expunge filed under 37 CFR 1.59 (b) is **granted**.

Petitioner requests that a document filed in the Information Disclosure Statement (IDS) filed on 28 January 2008 identified as "Representative Differences Between the Algorithms Used By the Cognex Symbol Reader Products and Those Disclosed in the '524 Patent for Image Acquisition and Data Capture; 2 pages EXHIBIT C of Mar 23, 2007 Cognex Corporation's Non-Infringement Claim Charts" be expunged from the record.

Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public.

The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been closed from the official file.

CONCLUSION

1. The petition to expunge filed under 37 CFR 1.59 (b) is **granted**.

2. The electronic file with the IDS paper in question will be closed.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

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

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

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

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

MARK J. REINHART
SPE ~~SPRE~~-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

mar

Matthew E. Connors, Esquire Gauthier & Connors LLP 225 Franklin Street Suite 2300 Boston MA 02110	: : : :	For Patent Owner

MAILED

JUL 27 2007

CENTRAL REEXAMINATION UNIT

In re: Carlisle *Ex Parte* Reexamination Proceeding Control No. 90/007,981 Filed: March 23, 2006 For: US Patent No. 6,201,232	: : : : :	DECISION DENYING PETITION UNDER 37 CFR 1.181

This is a decision on the June 15, 2006, "Petition Under 37 CFR 1.181. Petitioner, the Patent Owner, requests that the decision denying the request for reexamination of US Patent 6,201,232 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 March 23, 2006, the patent owner requested ex parte reexamination of U.S. Patent No. 6,201,232.

2. On may 12, 2006, 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 request does not adequately set forth the pertinency and manner of applying the cited prior art to the claims for which reexamination is sought.

3. On June 15, 2006, the present petition was filed.

Decision

A petition filed under 37 CFR 1.181, 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 Director's review will be *de novo.*

The requester alleges that the request meets the requirements of MPEP 2200-24 and 37 CFR 1.510(b) (2) with respect to the claims 1-9. With respect to claims 1, 6, and 7, the petition recites in addition to the claim charts cited in the initial request, that the teachings of Solomonson 8.5 pages of discussion with respect to the claims. While the number of pages of explanation may in fact be correct, it is not the volume of pages that determines a substantial new question, it is the content and explanation for how specifically the detailed explanation justifies reexamination of the claims for which the requester seeks reexamination.

The petition filed under 37 CFR 1.181 further does not point to any specific language for claims 2-5, 8, and 9 in the petition request. As such, there is no specific language to support the argument that the request is sufficient to present a substantial new question of patentability with respect to these claims.

The petition filed under 37 CFR 1 .181 has failed to point out any specific error in which the claims have been specifically addressed in the request. As such, the petition is denied.

Conclusion

No substantial new question of patentability affecting at least one claim of U.S. patent 6,201,232 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.

MRenhart for
Mark Renhart
SPE 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

Patent No. : 6,201,232 C1
Ser. No. : 90/007,981
Inventor(s) : Carlisle
Issued : Dec. 23, 2008
Title : IMAGING SYSTEM WITH A TWO-AXIS-GIMBAL MIRROR SCAN SYSTEM APPARATUS AND METHOD
Docket No. : MIT.8003REX

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
40l Dulany Street
Alexandria, VA 22314

By fax: (571) 273-0025
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.

Ennis Young
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) **756-1542** or (703) 756-1814

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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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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. 90/007,983 Filed: March 24, 2006 For: US Patent No. 6,172,464	:	

This is a decision on the July 6, 2007, petition for "Petition for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed May 17, 2007, be extended by one month.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed May 17, 2007, which set a two month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on July 6, 2007, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is met by reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner notes the large number of rejections and other proceedings whose time for response is very close to the instant proceeding for which a response is required.

The petition request is **granted**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated May 17, 2007 is **granted**.

2. The Patent Owner's response is due **August 17, 2007**.

3. Response may be submitted as follows:

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

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

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

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

MReinhart for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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CENTRAL REEXAMINATION UNIT

Ole K. Nilssen
200 N. Harrison St., Suite 103
Algonquin IL 60102

(Patent Owner)

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue NW
Washington, DC 20025-3934

(For Requester)

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,480 and 90/007,930
Filed: March 25, 2005 and February 13, 2006
For: U.S. Patent No.: 5,233,270

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,983
Filed: March 24, 2006
For: U.S. Patent No.: 6,172,464

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,470
Filed: March 18, 2005
For: U.S. Patent No.: 4,857,806

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,864
Filed: January 4, 2006
For: U.S. Patent No.: 5,343,123

DECISION ON PETITION UNDER 37 CFR 1.182 REGARDING EXTENDED EXAMINER INTERVIEW

This is a decision on the September 26, 2007 patent owner petition filed in each of the above-identified proceedings to conduct an extended personal interview with the Examiner for the duration of five hours to discuss each of the above-identified proceedings.

The petition is before the Office of Patent Legal Administration for consideration of whether the request for an extended interview should be granted.

The petition is dismissed.

REVIEW OF SALIENT FACTS

1. On September 25, 2007, the patent owner contacted Examiner Escalante and requested a personal interview for the above-identified proceedings. The examiner granted the initial request and indicated that the duration of the interview would not exceed one hour.

2. The patent owner filed a petition on Sept. 26, 2007, in each of the above identified proceedings "to confirm that Owner is entitled to interview the Examiner for a duration of one hour per patent at issue, or a total of five (5) hours for the above five (5) captioned reexamination proceedings."

3. Payment of the petition fees required for each proceeding was completed on October 4, 2007, thus affecting entry of the petitions in each respective proceeding on this date.

4. The status of each proceeding is as follows:

(a) Control nos. 90/007,480 & 90/007,930 have been merged. A final office action was mailed July 3, 2007. An amendment in response to the final office action was filed Sept. 7, 2007.

(b) Control nos. 90/007,518 & 90/007,823 have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

(c) Control no. 90/007,983 received a non-final office action mailed on May 17, 2007. An amendment in response to the non-final office action was filed July 19, 2007.

(d) Control no. 90/007,470 received a final office action mailed June 29, 2007. An amendment in response to the final office action was filed Sept. 4, 2007, and a Notice of Appeal was filed Oct. 1, 2007.

(e) Control no. 90/007,864 received a non-final office action mailed May 29, 2007. An amendment in response to the non-final office action was filed July 2, 2007.

5. Each proceeding has received at least one office action and has had a response* filed therein by patent owner awaiting action.

6. Each proceeding has claims rejected on different grounds based on different prior art references.

DISCUSSION

Interviews in *ex parte* reexamination proceedings are governed by 37 CFR 1.560, which reads:

Interviews in *Ex Parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner 's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

---

* It is noted that merged proceeding control no. 90/007,480 does not have a amendment filed therein, but has a petition awaiting decision to accept a late response.

As explained in MPEP 2281:

> In the case where the patent owner desires to initiate an interview, the patent owner should initially contact the examiner in charge of the proceeding to indicate what issues are sought to be discussed, and to determine if an interview will be granted. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview, and a copy of any proposed claims to be discussed, unless examiner waives this requirement. This provision will provide structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> The duration of the interview will not exceed one hour, unless the patent owner files a petition under 37 CFR 1.182 showing sufficient cause where more time is needed. In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied, to the extent such is deemed necessary. An hour of time in a structured planned interview should be sufficient to accomplish this, and in those rare instances where it is not, a patent owner may show cause to extend the time. During the interview, the examiner is always free to extend the duration of the interview to discuss issues that the examiner deems appropriate for (further) discussion. Such an extension of the duration of the interview is permitted at the examiner's sole discretion.
>
> Only one interview may be requested after an Office action and prior to filing the response to that action, absent a showing of good cause to conduct a second interview during this period.

DECISION

Interviews are ***permitted*** during reexamination proceedings and are granted at the discretion of the examiner if they are deemed to facilitate prosecution with special dispatch. Interviews may be requested after an Office action, prior to filing a response to that action, in order to define the claims over the applied prior art. As the interview must be conducted in a structured and planned manner, one hour of time should be sufficient to accomplish this.

The patent owner has requested that five different reexamination proceedings be discussed during one personal interview and that one hour be allotted to each proceeding to result in a personal interview with a duration of five hours.

Each of the proceedings is at a different stage of prosecution. Each of the proceedings has different prior art rejections applied against the claims, with a total of at least ten (10) different prior art references being at issue. Responses have already been filed in the proceedings and are awaiting action.

An extended interview in this case, which would raise numerous different issues, involve proceedings at various stage of prosecution, and be conducted over a lengthy period of time, would not be productive and would not facilitate the handling of these cases with special dispatch. The patent owner acknowledges in the petition that there are "a multitude of issues to be discussed" and that additional issues relating to priority particular to only two of the proceedings will be raised.

The goal of conducting a targeted, planned interview to define the claims over the prior art would not be accomplished by combining five different sets of claims and over ten different prior art references along with a variety of other issues in a single discussion. Moreover, none of these proceedings are at an appropriate stage of prosecution during which interviews are normally granted. Further, such a lengthy interview would not be an efficient use of Office resources and would not serve the public interest.

It is also noted that the petition states the patent owner is entitled to an interview in each proceeding and is entitled to one hour for each interview. Interviews are *permitted* at the discretion of the examiner; interviews are not entitlements. Further, the manual states that an interview *will not exceed one hour*. Interviews are not guaranteed to last one hour and may be held for less than one hour at the discretion of the examiner in the interest of expediting prosecution in an efficient manner.

The patent owner has not provided a sufficient showing of good cause as to why additional time, especially for a time period of five hours, in which to conduct an interview should be permitted in this situation. The petition states that patent owner's request is for reasons of efficiency, to conserve resources, and to lessen the amount of travel time. Economic and time considerations for the patent owner do not give rise to an adequate showing as there are other means of communication, including the telephone, available to the patent owner to interact with the examiner.

CONCLUSION

1. The petition requesting an extended personal examiner interview conducted at one time for all of the above identified proceedings is dismissed.

2. The patent owner is required to identify which one of the above proceedings will be the subject of the personal interview and indicate what issues are sought to be discussed so that the examiner can determine if an interview will be granted.

3. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview along with a copy of any proposed claims to be discussed unless the examiner waives this requirement.

4. The duration of the interview for an individual proceeding, if granted, will not exceed one hour.

5. The patent owner is reminded that merged proceedings require papers to be filed in each proceeding within the merged proceeding. In this case, patent owner filed a single petition in each of the merged proceedings, which is not in accordance with the guidelines set forth in the merger decision. The petition must be filed in each proceeding in the merged proceedings. In this instance, the Office has waived this procedure, but this is not to be construed as a waiver as to future filings. A paper must be filed in each proceeding within the merged proceedings going forward.

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

cdd
October 4, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OLE K. NILSSEN
200 N. Harrison Street
Suite 103
Algonquin, IL 60102

(For Patent Owner)

MAILED

NOV 30 2006

CENTRAL REEXAMINATION UNIT

OLE K. NILSSEN
408 Caesar Drive
Barrington, IL 60010

(For Patent Owner)

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue, NW
Washington, DC 20005

(For Third Party Requester)

Linda E. Alcorn
STERNE KESSLER ET AL
1100 New York Avenue, NW
Washington, DC 20005-3934

(For Third Party Requester)

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

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,499
Filed: April 1, 2005
For U.S. Patent No. 5,510,680

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,984
Filed: March 23, 2006
For U.S. Patent No. 5,510,680

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of reexamination control number 90/007,499 and the reexamination control number 90/007,984 pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,510,680 issued on April 23, 1996.

2. The 90/007,499 reexamination proceeding was filed on April 1, 2005 by a third party requester.

3. The proceeding Order granting reexamination for control number 90/007,499 was mailed on May 24, 2005.

4. A non-final Office action was mailed November 18, 2005 in proceeding 90/007,499.

5. An amendment was filed by the patent owner on January 18, 2006.

6. A non-final Office action was mailed May 19, 2006 in proceeding 90/007,499.

7. A response from the patent owner was received July 24, 2006 without further amendment to the claims.

8. The 90/007,984 reexamination proceeding was filed March 23, 2006 by a third party requester.

9. The proceeding Order granting reexamination for control number 90/007,984 was mailed on May 12, 2006.

10. There are no amendments to the 90/007,984 proceeding at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior

> *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/007,499 and 90/007/984 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, the claims have been amended in the 90/007,499 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,499 and 90/007/984 are **merged**. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

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

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Ole K. Nilssen 408 Caesar Drive Barrington IL 60010	:	(Patent Owner)
OLE K. NILSSEN 200 N. HARRISON STREET SUITE 103 ALGONQUIN IL 60102	:	(Patent Owner)
Virgil L. Beaston STERNE KESSLER GOLDSTEIN & FOX PLLC 1100 New York Avenue NW Washington, DC 20025-3934	:	(For Third Party Requester)
Linda E. Alcom STERNE KESSLER ET AL 1100 New York Avenue, NW Washington, DC 20005	:	(For Third Party Requester)
	:	DECISION GRANTING IN PART PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,499 Filed: April 1, 2005 For: US Patent No. 5,510,680	:	
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,984 Filed: March 23, 2005 For: US Patent No. 5,510,680	:	

This is a decision on the August 9, 2007, petition for "Petition for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed June 14, 2007, be extended by one months.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed June 14, 2007, which set a one month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on August 9, 2007, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is met by reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner notes the large number of rejections and other proceedings whose time for response is very close to the instant proceeding for which a response is required. A sufficient cause in the patent owner's petition is shown to justify a one-month extension of time.

The petition request is **Granted**

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated June 14, 2007 is **granted .**

2. The Patent Owner's response is due **September 14, 2007**.

3. Response may be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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

9/19/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CLEMENT CHENG

LAW OFFICE OF CLEMENT CHENG

17220 NEWHOPE STREET, SUITE 127

FOUNTAIN VALLEY, CA 92708

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007986

PATENT NO. 6,988,920

ART UNI 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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.
90/007,986	03/23/2006	6988920		5668

25864 7590 09/19/2007

CHARLES C.H. WU
98 DISCOVERY
IRVINE, CA 92618-3105

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/19/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Charles C. H. Wu
98 Discovery
Irvine, California 92618-3105

(For Patent Owner)

MAILED

SEP 19 2007

CENTRAL REEXAMINATION UNIT

Clement Cheng
Law Office of Clement Cheng
17220 Newhope Street, Suite 127
Fountain, California 92708

(For Requester)

In re: Tzong In Yeh
Reexamination Proceeding
Control No.: 90/007,986
Filed: March 24, 2006
For: U.S. Patent No.: 6,988,920

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner petition, filed the October 2, 2006, and denominated "PETITION FOR REQUEST FOR CONTINUED REEXAMINATION UNDER 37 C.F.R. 1.182."

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182, as authorized in the Fee Transmittal form accompanying the petition, has been charged to petitioner's Deposit Account No. 50-0314.

For the reasons set forth below, the petition under 37 CFR 1.182 is dismissed as moot.

REVIEW OF FACTS

1) U.S. Patent No. 6,988,920 (the '920 patent) issued on January 24, 2006.

2) On March 24, 2006, a third party requester filed a request for *ex-parte* reexamination of the '920 patent, and the resulting proceeding was assigned control No. 90/007,986 (the '7986 reexamination proceeding).

3) On April 12, 2006, the Office mailed an Order [1] granting reexamination for the '7986 reexamination proceeding. The order stated that all claims of the '920 patent would be reexamined.

[1] This order was remailed on May 12, 2006 because the initial mailing was not properly addressed to the requester.

4) On June 9, 2006, patent owner filed a statement under 37 CFR 1.530 in response to the order granting reexamination.

5) On July 3, 2006, third party requester filed a reply under 37 CFR 1.535 in response to the patent owner's statement of June 9, 2006.

6) On August 2, 2006, the Office mailed a first action on the merits rejecting some of the pending claims and setting a 2-month period for response.

7) On October 2, 2006, the patent owner timely filed a response to the Office action of August 2, 2006. The response consisted solely of arguments with respect to the patentability of claims under rejection. No claim amendments were made in this response.

8) Also, on October 2, 2006, patent owner filed the present petition requesting continued reexamination. 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 response received in the Office on October 2, 2006, 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." [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 a 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 denied entry 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.

[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

In this instance, a final Office action has not been issued and prosecution is not closed. Accordingly, the 37 CFR 1.182 petition requesting continued prosecution is premature. Patent owner's submission of October 2, 2006 is entered as a matter of right. Therefore the petition is dismissed as moot.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed.

2) The response submitted October 2, 2006 is timely and is entitled to entry insofar as it complies with the requirements of submissions in reexamination proceedings. Such compliance will be determined by the examiner in due course.

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

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 Schor
Senior Legal Advisor
Office of Patent Legal Administration

September 18, 2007
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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.
90/007,987	03/28/2006	6669823	037768-0112	1091

26689 7590 07/11/2006
WILDMAN HARROLD ALLEN & DIXON
225 WEST WACKER DRIVE, SUITE 2800
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/11/2006

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

7/11/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

STEPHEN B. MAEBIUS

FOLEY & LARDNER LLP

3000 K STREET, NW

WASHINGTON, DC 20007

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007987

PATENT NO. 6,669,823

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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Alexandria, VA 22313-1450
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Mailed :

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JUL 11 2006

CENTRAL REEXAMINATION UNIT

Douglas S. Rupert
Wildman Harrold Allen & Dixon
225 West Wacker Drive, Suite 2800
Chicago, IL 60606

(for Patent Owner)

Sean A. Passino
Foley & Lardner LLP
3000 K Street NW Suite 500
Washington, DC 20007

(for Third Party Requester)

In re Sarkas et al
Reexamination Proceeding
Control No.: 90/006,946
Filed: February 23, 2004
For: U.S. Patent 6,669,823

Stephen B. Maebius
Foley & Lardner LLP
3000 K Street NW
Washington, DC 20007

(for Third Party Requester)

In re Sarkas et al
Reexamination Proceeding
Control No.: 90/007,987
Filed: March 28, 2006
For: U.S. Patent 6,669,823

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 6,669,823, issued December 30, 2003, is the subject of Reexamination Control Nos. 90/006,946 and 90/007,987.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,946, was filed February 23, 2004 by Sean Passino of Foley & Lardner in Washington DC. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed process for the preparation of stoichiometric-nanostructured materials or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/006,946 on April 23, 2004.

4. A Patent Owner statement was submitted on June 23, 2004.

5. A first non-final Office action was issued on July 18, 2005.

6. Patent Owner filed a response on September 14, 2005

7. A personal interview was held on February 16, 2006 which resulted in a supplemental response filed on February 27, 2006.

8. A subsequent request for re-examination, assigned Reexamination Control No. 90,007,987, was filed March 28, 2006 by Stephen Maebius of Foley & Lardner in Washington DC. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed process for the preparation of stoichiometric-nanostructured materials or are so close as to establish a case of obviousness.

9. Reexamination was ordered for 90/007,987 on April 12, 2006.

10. A Patent Owner statement was submitted on June 15, 2006.

11. 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 90/006,946 and 90/007,987 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. 90/006,946 and 90/007,987 as:

Douglas S. Rupert
Wildman Harrold Allen & Dixon
225 West Wacker Drive, Suite 2800
Chicago, IL 60606

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/006,946 as:

Sean A. Passino
Foley & Lardner LLP
3000 K Street NW Suite 500
Washington, DC 20007

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,987 as:

Stephen B. Maebius
Foley & Lardner LLP
3000 K Street NW Suite 500
Washington, DC 20007

CONCLUSION

Reexamination Control Nos. 90/006,946 and 90/007,987 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

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

Andrew D. Meikle
Birch, Stewart, Kolasch, & Birch, LLP
8110 Gatehouse Road,
Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747

For Patent Owner

MAILED

JUN 04 2007

CENTRAL REEXAMINATION UNIT

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

For Requestor

Ex Parte Reexamination Proceeding
Control No. 90/007,990
Filed: April 3, 2006
For: US Patent No. 56,709,694

DECISION ON
EXTENSION OF TIME
[37 CFR 1.550(c)]

This is a decision on the petition filed May 23, 2007 to request a two-week extension of time pursuant to 37 CFR 1.550 for responding to the Final Office action dated April 30, 2007.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Final Office action dated April 30, 2007, which set a one-month date for filing a response thereto. The request is timely filed and includes authorization to debit deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The petition for extension of time states that a new reference has been cited in the final Office action that requires additional review and feedback from the inventors who are located in Germany. In view of the shortened period for response and the fact that counsel will be out of the country from May 28 through June 1, Patent Owner requests a two-week extension of time to present the proposed response to the inventors for review and comment.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Patent Owner's showing is adequate to justify the grant of a two-week extension of time in which to file a response the outstanding office action. Accordingly, the period of time for filing a reply to the Office action dated April 30, 2007 is extended to run one month and two weeks from the date of the Office action. Patent Owner should expect additional requests for extensions of time would not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time of to weeks in which to file a response to the Office action dated April 30, 2007 is **granted**.

2. The Patent Owner's response is due June 13, 2007.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, 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

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,996	04/05/2006	5841512	167160000007	5633

7590 07/02/2008

SEAN A. LUNER
DOVEL & LUNER LLP
201 SANTA MONICA BLVD.
SUITE 600
SANTA MONICA, CA 90401

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID L. FEHRMAN
MORRISON & FOERSTER LLP
555 WEST FIFTH STREET
LOS ANGELES, CA 90013

MAILED
JUL 0 2 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007996
PATENT NO. 5,841,512
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

SEAN A. LUNER DOVEL & LUNER LLP 201 SANTA MONICA BLVD. SUITE 600 SANTA MONICA CA 90401	:	(For Patent Owner)
DAVID L. FEHRMAN MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024	:	(For Third Party Requester)
	:	DECISION, *SUA SPONTE,* MERGING REEXAMINATION PROCEEDINGS PURSUANT TO 37 C.F.R. § 1.565(c)
In re: Goodhill *Ex Parte* Reexamination Proceeding Control No. 90/007,996 Deposited: 5 April 2006 For U.S. Patent No. 5,841,512	:	
In re: Goodhill *Ex Parte* Reexamination Proceeding Control No. 90/009,092 Deposited: 25 March 2008 For U.S. Patent No. 5,841,512	:	

MAILED

JUL 0 2 2008

CENTRAL REEXAMINATION UNIT

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,996 and the reexamination control number 90/009,092 pursuant to 37 C.F.R. § 1.565(c).

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 reexamination proceedings identified by control numbers 90/007,996 and 90/009,092 are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

Patent owner is required to maintain the same claims and specification in all merged files. If either of the proceedings were amended the patent owner would be 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.

Reexamination Control Nos. 90/007,996 and 90/009,092 are hereby **merged**. Since there are no amendments in either proceeding, no "housekeeping" amendment is necessary. The proceedings are thus returned to the examiner in charge of the proceedings for s first Office action on the merits.

CONCLUSION

1. Reexamination Control Nos. 90/007,996 and 90/009,092 are hereby **merged**.

2. The proceedings are thus returned to the examiner in charge of the proceedings for a first Office action on the merits.

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
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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, 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
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,996	04/05/2006	5841512	167160000007	5633

7590 01/05/2009

SEAN A. LUNER
DOVEL & LUNER LLP
201 SANTA MONICA BLVD.
SUITE 600
SANTA MONICA, CA 90401

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2009

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,092	03/25/2008	5,841,512	167160000007	9834

7590 01/05/2009

SEAN A. LUNER, DOVEL & LUNER LLP
201 SANTA MONICA BLVD.
SUITE 600
SANTA MONICA, CA 90401

EXAMINER

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SEAN A. LUNER DOVEL & LUNER LLP 201 SANTA MONICA BLVD. SUITE 600 SANTA MONICA CA 90401	:	(For Patent Owner)
DAVID L. FEHRMAN MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024	:	(For Third Party Requester)
	:	DECISION DISMISSING PETITION UNDER 37 CFR § 1.59 (b) TO EXPUNGE INFORMATION
In re: Goodhill *Ex Parte* Reexamination Proceeding Control Number 90/007,996 Deposited: 5 April 2006 For U.S. Patent No. 5,841,512	:	
In re: Goodhill *Ex Parte* Reexamination Proceeding Control No. 90/009,092 Deposited: 25 March 2008 For U.S. Patent No. 5,841,512	:	

This is a decision on the 16 April 2007, Patent Owner requested petition titled "Petition to Expunge Pursuant to 37 CFR § 1.59 and MPEP § 724.005."

This petition considers under 37 CFR 1.59 (b) a request to expunge materials submitted by the Patent Owner with the Information Disclosure Statement (IDS) filed 16 April 2008.

The petition was filed in a timely manner with the authorization for the appropriate fee from a deposit account pursuant to 37 CFR § 1.17 (g).

The petition is hereby dismissed as premature.

REVIEW OF RELEVENT FACTS

1. US Patent No 5,841,512 was granted on 24 November 1998.

2. On 5 April 2006 a third party requester requested *ex parte* reexamination of US Patent No. 5,841,512 which is identified under control no. 90/007,996.

3. The Order was granted for reexamination on 12 May 2006.

4. Documents were filed Under Seal on 16 April 2007.

5. A petition filed under 37 CFR 1.59 (b) to expunge information was timely filed 16 April 2007 with authorization to charge the appropriate fee under 37 CFR § 1.17(g).

6. On 25 March 2008 a third party requester requested *ex parte* reexamination of US Patent No. 5,841,512 which is identified under control no. 90/009,092.

7. On 2 July 2008 the proceedings identified by Control Nos. 90/007,997 and 90/009,092 were merged.

CITATION OF APPROPRIATE PROCEDURE

37 CFR § 1.59 (in-part)
Expungement of information or copy of papers in application file.
(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 § 724.04

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR § 1.11(d) will be treated in the following manner:

(A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.
(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.
(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.
(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.
(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).
(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

DECISION

The petitioner requests that the documents submitted under seal on 16 April 2007 are subject to court ordered protective order from the record of these proceedings. MPEP § 724.02 directs the handling of papers. MPEP 724.02(a) in-part "The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable."

The transmittal letter identifies the "Each of the forgoing documents was produced to Patentee during the pending litigation in the Central District of California as confidential and subject to a protective order in that litigation." In addition, the patent owner states that the "Patentee commits to retain copies of each of the cited documents for the duration of the term of the reexamined patent." Further the petition fee pursuant to 37 CFR § 1.17(g) is has been paid.

The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material." "Materiality being defined as any information which the examiner considers as being important to a determination of patentability of the claims. The determination is based upon consideration as to whether or

not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable. Thus the petition to expunge must be dismissed as premature at this time.

During the prosecution on the merits, the examiner has determined the identified documents are not "material" at this time to the patentability of the claims before the examiner. The examiner has issued a Office action and made a determination on the issue of importance of the sealed information in the Office action on the merits as not "material" at this time only. "Materiality" as to claim language which may become amended further in the prosecution of this proceeding is not determined at this time.

The petition to expunge may be renewed by the patent owner of a petition submitted pursuant to 37 CFR § 1.59 to expunge information with no further fee required. The patent owner desiring expungement is cautioned to ensure that a petition under 37 CFR §1.59 is re-submitted for consideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination and is done no later than immediately after the time when a Notice of Intent to Issue a Reexamination Certificate (NIRC) is issued.

CONCLUSION

1. The petition to expunge documents submitted by the patent owner under seal on 16 April 2007 is hereby **dismissed** as premature.

2. The patent owner may re-submit the petition expungement for consideration of materiality to claims at the termination of the proceeding. The patent owner is cautioned to ensure that a petition under 37 CFR §1.59 is re-submitted for consideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate.

3. The documents filed under seal are hereby returned with this petition decision.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

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

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

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

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, Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

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COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Dinsmore & Shohl, LLP
One Dayton Centre, One South Main Street
11800 Sunrise Valley Drive
Suite 1300
Dayton, OH 45402-2023

(For Patent Owner)

MAILED

MAR 13 2008

CENTRAL REEXAMINATION UNIT

ATTN: William G. James
1500 K Street NW
Suite 700
Washington, DC 20005-1257

(For Third Party Requester)

In re Thermo Separation Products Inc.
Ex Parte Reexamination Proceeding
Control No.: 90/008,000
Filed: July 26, 2006
For: U.S. Patent No.: 5,385,654

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the October 3, 2007 patent owner petition entitled PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUING REEXAMINATION.

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

FEES

A petition under 37 CFR 1.182 requires a petition fee of $ 400.00 (37 CFR 1.17(f)). The $400.00 petition fee has been charged to petitioner's credit card.

For the reasons set forth below the petition is dismissed as being moot.

REVIEW OF FACTS

1. Patent number 5,385,654 (the '654 patent) issued January 31, 1995.

2. A request for *ex parte* reexamination, was deposited on April 10, 2006, assigned control No. 90/008,000 (the '8000 reexamination proceeding), and was accorded a filing date of April 10, 2006.

3. On July 10, 2006, the Office mailed a Decision, *Sua Sponte*, vacating the filing date of the '8000 reexamination proceeding.

4. On July 26, 2006, patent owner filed a paper that addressed the issues raised in the July 10, 2006 decision and resulted in the '8000 reexamination proceeding being accorded a filing date of July 26, 2006.

5. On August 10, 2006, reexamination was ordered in '8000 *ex parte* reexamination proceeding for patent claims 11, 15 and 18.

6. Prosecution on the patentability of the claims in the '8000 *ex parte* reexamination proceeding ultimately resulted in a final rejection of patent claims 11, 15 and 18 that was mailed on August 31, 2007.

7. On October 3, 2007, patent owner filed a response to the final rejection that included a request for reconsideration of the final rejection, a verified statement pursuant to 37 CFR 1.132 addressing the final rejection, and the present petition.

8. On October 29, 2007, an advisory action was mailed in which patent owner was informed that the 37 CFR 1.132 verified statement had been entered and considered, but although the verified statement was deemed to overcome one ground of rejection, patent claims 11, 15 and 18 nevertheless remained subject to various grounds of rejection that had been set forth in the final rejection.

9. Patent owner thereafter filed a notice of appeal and an appeal brief and the fees therefor. The appeal brief is presently before the examiner for consideration and appropriate action.

10. It is noted that the '654 patent has expired for failure to pay the maintenance fee due not later than January 31, 2003. However, the '654 patent is still in its period of enforceability and the '654 patent is currently in litigation.

DECISION

In the paragraph bridging pages 2-3 of the present petition, patent owner appears to state that to the extent that the present petition requests "continuing reexamination," the requested relief being sought is the entry of the verified showing submitted after final rejection. Stated differently, patent owner appears to have filed the present petition in order to "continue" this reexamination proceeding by obtaining entry and consideration of the verified statement, in the event that consideration and entry of the verified statement was refused by the examiner pursuant to 37 CFR 1.113 and 1.116.

On March 1, 2005, the Office published a notice entitled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending" ("the Notice"). The Notice was published at 1192 OG 20. The Notice principally discusses a change to reexamination practice whereby a second or subsequent request for *ex parte* reexamination of a patent for which a pending reexamination proceeding had been ordered would <u>not</u> be granted unless the second or subsequent request was based on one or more substantial new questions of patentability that differed from the substantial new question(s) of patentability upon which the pending reexamination was based.

The Notice also established a practice to address the situation in which a patent owner in a pending *ex parte* reexamination proceeding that had received a final rejection might now be prevented from obtaining entry and consideration of an amendment and/or evidence filed after the final rejection that was refused entry pursuant to 37 CFR 1.113 and 1.116 by merely filing a new request for *ex parte* reexamination. The Notice pointed out that unless the patent owner

could demonstrate a "new" substantial new question of patentability in the newly filed request for *ex parte* reexamination, the newly filed request for *ex parte* reexamination would not be ordered. Therefore, the amendment and/or evidence would not receive consideration with respect to claim patentability in the newly filed reexamination proceeding. The Notice addressed this issue by establishing the practice to continue prosecution in a reexamination proceeding. The practice provides that a patent owner may request "continued prosecution" in an existing *ex parte* reexamination proceeding based upon entry of an amendment and/or other evidence that had been denied entry after a final rejection had closed prosecution in an existing *ex parte* reexamination proceeding. The practice requires a that patent owner file a petition under 37 CFR 1.182 requesting relief not otherwise provided by the rules, (*i.e.*, entry of the material that had been denied entry after a final rejection), by demonstrating how such entry would materially advance prosecution to a final disposition.

In the present proceeding, the examiner has not denied entry of the 37 CFR 1.132 verified statement filed by patent owner after final rejection. Rather, the 37 CFR 1.132 verified statement was entered into the record and considered by the examiner. Although the 37 CFR 1.132 verified statement was deemed to overcome one ground of rejection, it was not determined to render the finally rejected claims patentable. However, the 37 CFR 1.132 has verified statement has been entered by the examiner for purposes of appeal. Accordingly, the practice described in the Notice is inapplicable in the present '8000 *ex parte* reexamination proceeding, because patent owner has effectively been accorded the relief that would ordinarily be the subject of a 37 CFR 1.182 petition filed pursuant to the Notice in order to obtain entry of material that the examiner had refused to enter after final rejection. It is considered that the present petition is moot, because the '8000 reexamination is continuing in the form of an appeal that will be based on a record that includes the 37 CFR 1.132 verified statement that has been filed and entered after final rejection.

CONCLUSION

1. The patent owner petition requesting "continuing reexamination" is dismissed.

2. Jurisdiction of the '8000 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit for such action as is appropriate.

2. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

sm
March 12, 2008

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DEC 0 4 2008

CENTRAL REEXAMINATION UNIT

MCNAIR LAW FIRM, P.A.
P.O. BOX 10827
GREENVILLE SC 29603-0827
: (For Patent Owner)

Stanley Green, Exquire
CONNOLLY BOVE LODGE AND HUTZ, LLP
1875 I STREET NW, LBBY LL-2
WASHINGTON, DC 20006-5405
: (For Third-Party Requester)

In re LANG *et alia*
Reexamination Proceeding
Control No. 90 / 008,006
Request Deposited: April 14, 2006
For: U.S. Patent No. 5,196,965
: DECISION ON
: REQUEST FOR
: RE-MAILING OF
: OFFICE ACTION

This is a decision on the request filed on November 9, 2007 by which Patent owner requests that that the Office Action mailed August 13, 2007 be re-issued to the correct address with a new response date that will provide a two month time period to prepare a reply to the office action. The request is construed as a petition and is considered pursuant to 37 CFR 1.181; No fee is required.

The petition is granted with alternate relief as explained hereinbelow.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 5,196,965 was ordered in the Determination mailed June 1, 2006.

2. A non-final rejection was mailed August 13, 2007. The action set a two month period for response.

3. On November 9, 2007 the instant request for remailing was received. The request is accompanied by evidence the Office action of August 13, 2007 was improperly mailed.

4. On November 5, 2008 a response to the outstanding Office action was received from Owner.

DECISION

Owner has provided convincing evidence that the Office action of August 13, 2007 was improperly mailed. Ordinarily the request would be granted and the Office action remailed. However, as a reply to the outstanding Office action has been received from Owner, to remail the office action at this time would be contrary to the mandate of Reexamination proceedings being conducted with 'special dispatch'. In the alternative, the Office grants Owner the relief of acceptance of the November 5, 2008 response as being timely and responsive to the outstanding Office action.

CONCLUSION

1. Petitioner's request is **GRANTED** with alternate relief. The November 5, 2008 response is considered timely and has been entered and forwarded to the examiner of record. An Office action on the merits will follow this decision in a timely manner.

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, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.

J Harrison 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.
90/008,007	04/14/2006	6966651	100424-001RX	7829

570 7590 02/11/2009

PANITCH SCHWARZE BELISARIO & NADEL LLP
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,007	04/14/2006	6966651	100424-001RX	7829

570 7590 02/11/2009

EXAMINER

Haynes and Boone LLP
IP Section
2323 Victory Avenue
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ART UNIT	PAPER NUMBER

DATE MAILED: 02/11/2009

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Panitch Schwarze Belisario & Nadel LLP (For Patent Owner)
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Philadelphia, PA 19103-7013

Haynes and Boone LLP (For Requester)
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

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CENTRAL REEXAMINATION UNIT

In re Lonnie G. Johnson :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,007 : **GRANTING**
Filed: April 14, 2006 : **PETITION UNDER**
For: U.S. Patent No. 6,966,651 : **37 CFR 1.137(b)**

This is a decision on the November 4, 2008 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Interview Summary and revive the present terminated reexamination proceeding ("the November 4, 2008 patent owner petition to revive").[1]

The November 4, 2008 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The small entity petition fee of $810.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

SUMMARY

The November 4, 2008 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

[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 August 26, 2008.

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 305 provides, in pertinent part:

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

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*
*

(d) *Terminal disclaimer.*

*
*

(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 1.560(b) provides:

In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), *>subsection< III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required

response from the due date of the response to the filing of a grantable petition was unintentional. A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the November 4, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), the prosecution of this reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the August 26, 2008 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until October 24, 2008, which was untimely. However, for the purpose of evaluating whether the November 4, 2008 patent owner petition to revive is a grantable petition, the submission of the statement under 37 CFR 1.560(b) on October 24, 2008, satisfies item (1).

Accordingly, the November 4, 2008 patent owner petition to revive is **granted**.

CONCLUSION

1. The November 4, 2008 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for action on patent owner's October 6, 2008 filing of a Request for Reconsideration and Applicant Initiated Interview Request Form.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Lynne Browne, of CRU Art Unit 3992, at (571) 272-3670.

4. Any inquiry concerning 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 0 9 2007

CENTRAL REEXAMINATION UNIT

MURABITO, HAO & BARNES, LLP TWO NORTH MARKET STREET, THIRD FLOOR SAN JOSE CA 95113	:	For Patent Owner
Kenneth H. Ohriner PERKINS COLE LLP P. O. Box 1208 Seattle, WA 98111	:	For Third Party Requester
Fulghum, Roger BAKER BOTTS LLP 910 Louisiana St. One Shell Plaza Houston, TX 77002	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Lin *Ex Parte* Reexamination Proceeding Control No. 90/008,009 Filed: April 13, 2006 For: US Patent No. 6,259,615	:	
In re: Lin *Ex Parte* Reexamination Proceeding Control No. 90/008,380 Filed: December 15, 2006 For: US Patent No. 6,259,615	:	

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. 6,259,615 issued on July 10, 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,009 was requested by a third party requester on April 13, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,009 on May 15, 2006

4. There are currently no amendments proceeding control number 90/008,009.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,380 was requested by a third party requester filed on December 15, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,380 on January 26, 2007.

7. There are currently no amendments proceeding control number 90/008,380.

8. Proceedings control numbers 90/008,009 and 90/008,380 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 90/008,009 and 90/008,380 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. 90/008,009 and 90/008,380 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

MWhe for

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
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,011	07/24/2006	6044062	10568.0002	3037

40401 7590 07/15/2010
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
IP GROUP OF DLA PIPER LLP (US)
ONE LEBERTY PLACE
1650 MARKET ST., SUITE 4900
PHILADELPHIA, PA 19103

Date:
MAILED

JUL 15 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008011
PATENT NO. : 6044062
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 DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90008011	7/24/06	6044062	10568.0002

EXAMINER

TS/IPCO
TROUTMAN SANDERS LLP
600 PEACHTREE STREET
5200 BANK OF AMERICA PLAZA
ATLANTA, GA 30308

ART UNIT	PAPER
3999	201

MAILED

DATE MAILED: JUL 15 2010

CENTRAL REEXAMINATION UNIT

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

Commissioner for Patents

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

TS/IPCO
Troutman Sanders LLP
600 Peachtree Street
5200 Bank of America Plaza
Atlanta, GA 30308

(For Patent Owner)

MAILED

JUL 15 2010

CENTRAL REEXAMINATION UNIT

IP Group of DLA Piper LLP (US)
One Liberty Place
1650 Market St., Suite 4900
Philadelphia, PA 19103

(For Requester)

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

(Courtesy Copy)

In re Brownrigg et al
Ex Parte Reexamination Proceeding
Control No. 90/008,011
Filed: July 24, 2006
For: U.S. Patent No. 6,044,062

: **DECISION DISMISSING**
: **PETITION**

This is a decision on the May 17, 2010 patent owner petition under 37 CFR 1.182, entitled "Petition Under 37 CFR 1.182 and PTO Official Gazette of March 1, 2005 to Enter Declaration and Reply Brief" (the May 17, 2010 petition).

This decision also addresses the April 9, 2010 change of correspondence address filed by the patent owner.

The May 17, 2010 petition, the April 9, 2010 change of correspondence address, and the proceeding record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee pursuant to 37 CFR 1.17(f) for the May 17, 2010 petition under 37 CFR 1.183 has been received.

DECISION

The patent owner states that "[t]his petition under 37 CFR 1.182 is being filed concurrently *in the event that* the Examiner refuses to enter the Expert Declaration and the Reply Brief which are being submitted concurrently herewith" (emphasis added). Accordingly, this petition is **dismissed as premature**, pending the decision by the Office whether to enter the reply brief.

The patent owner requests that the declaration and reply brief be considered by the examiner under "the Official Gazette Notice" of March 1, 2005.[1] If the declaration and reply brief are not entered, such a request should be timely submitted under 37 CFR 1.182/1.183. The entry of evidence after the date of filing an appeal is prohibited, pursuant to 37 CFR 41.33(d)(2). Thus, if the patent owner desires the rule to be waived, an extraordinary circumstance must be shown under 37 CFR 1.183.

Attention is also drawn to *Streamlined Procedure for Appeal Brief Review in Ex Parte Reexamination Proceedings,* 75 Fed. Reg. 29321 (May 25, 2010).

The April 9, 2010 Change of Correspondence Address is Ineffective

The change of correspondence address, filed by the patent owner on April 9, 2010, is **ineffective**. The address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file.* See MPEP 2222 and 37 CFR 1.33(c). In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 08/760,895, is shown in the caption of this decision

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. A. Hershkovitz. Absent the filing of a proper change of correspondence address in the patent file, application no. 08/760,895, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

CONCLUSION

- The May 17, 2010 petition under 37 CFR 1.182 is **dismissed as premature**.
- The April 9, 2010 change of correspondence address of the patent owner is **ineffective**. A courtesy copy of this decision will be mailed to the practitioner who submitted the present petition, Mr. A. Hershkovitz. Absent the filing of a proper change of correspondence address in the patent file, application no. 08/760,895, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.
- Jurisdiction over the proceeding is being returned to the Central Reexamination Unit for appropriate action.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

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[1] See *Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending,* 1292 *Off. Gaz. Pat. Office* 20 (March 1, 2005).

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

cn

7/15/10
Kenappeal\decisions\entry issues

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,012	04/17/2006	6854876	46264.0024	7112

57600 7590 04/03/2007

HOLLAND & HART LLP
60 E. SOUTH TEMPLE
SUITE 2000
SALT LAKE CITY, UT 84111

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/03/2007

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

Holland & Hart LLP
60 E. South Temple
Suite 2000
Salt Lake City, UT 84111

(For Patent Owner)

MAILED

MAR 03 2007

CENTRAL REEXAMINATION UNIT

In re K-Tec, Inc.
Ex Parte Reexamination Proceeding
Control No. 90/008,012
Filed: April 17, 2006
For: U.S. Patent No. 6,854,876 B2

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the patent owner PETITON UNDER 37 CFR § 1.182 TO PLACE DOCUMENTS UNDER SEAL filed March 16, 2007.

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

The patent owner petition is dismissed for the reasons set forth below.

FEES

The $400.00 petition fee under 37 CFR 1.17(f) required by 37 CFR 1.182 will be charged to Deposit Account No. 08-2623 as authorized by patent owner.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,854,876 B2 (the '876 patent) issued on February 15, 2005, from an application filed on June 10, 2003.

2. A request *for ex parte* reexamination of the '876 patent was filed on April 17, 2006 and assigned control number 90/008,012 (the '012 ex *parte* reexamination proceeding).

3. Reexamination was ordered in the '012 ex *parte* reexamination proceeding on May 25, 2006.

4. An initial Office action on the merits was mailed on December 14, 2006.

5. On February 14, 2007, patent owner filed a timely response to the December 14, 2006 Office action, including a paper styled as "Declaration of Mark Miller" (the Miller Declaration) which includes Exhibits A-C as attachments.

6. On March 16 2007, patent owner filed the present petition requesting (a) that the Miller declaration and Exhibits A-C as attached thereto be placed under seal, and (b) that all references to the Miller declaration and Exhibits A-C appearing on pages 40-42 of the February 14, 2007 response also be placed under seal.

APPLICABLE REGULATIONS AND PRACTICE

37 CFR 1.59 provides, in part:

"(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."

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 1.550(d) provides:

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

37 CFR 1.555(a) provides, in part:

A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective reexamination occurs when, at the time a reexamination proceeding is being conducted, the Office is aware of and evaluates the teachings of all information material to patentability in a reexamination proceeding. Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled."

MPEP § 724.04(c) provides in part:

> "Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:
>
> ...
>
> (C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public."

DECISION

In response to the Office action dated December 14, 2006, patent owner filed papers on February 14, 2007 which include the Miller declaration, exhibits A-C referenced in that declaration, and pages 4-44 comprising patent owner's remarks. Pursuant to 37 CFR 1.550(d), the response patent owner's response was required to be both timely and appropriate in order to avoid termination of the reexamination prosecution, which would then result in publication of a reexamination certificate. Further, it is to be noted that 37 CFR 1.555(a) requires, *inter alia*, that a patent owner submit all information known to patent owner, and all information known to any individual associated with the patent owner, that is material to the patentability of any claim pending in the '012 *ex parte* reexamination proceeding.

In the present petition, patent owner alleges that the Miller declaration and Exhibits A-C attached thereto were submitted and discussed in the February 14, 2007 patent owner response in accordance with the requirements of 37 CFR 1.555(a). However, patent owner has now determined that Exhibits B and C are subject to a Protective Order issued by the District Court in litigation styled *K-Tech, Inc. v. Vita-Mix Corp.*, No. 2:06-cv-00108-TC-PMW (U.S. District Court for the District of Utah, Central Division).

37 CFR 1.59 relates to expunging information from an "application, "and MPEP § 724.04(c) addresses expunging information from the record of a reexamination proceeding. MPEP § 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the application is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but, in no event, later than the close of prosecution.

To date, there has been no determination by the examiner as to the materiality the Miller declaration and the exhibits attached thereto. It is not appropriate to make, in this decision, a final determination of whether or not the material requested to be expunged is "important to a reasonable examiner in deciding whether or not a claim is patentable." Rather, such a decision is issued by the examiner, and it is issued no later than the close of prosecution. Thus, the decision as to expunging information subject to the District Court's Protective Order would be premature, and such must be held in abeyance at this time. After the examiner has issued a determination on the issue of importance of the sealed information in

an Office action on the merits (as discussed above), a petition to expunge may be filed by patent owner. If a petition to expunge is filed by patent owner, the requirements of MPEP 724.05 should be carefully reviewed to make certain that the petition to expunge is complete as to all requirements for same.

Inasmuch as the regulations do not expressly provide for relief other than expungement, patent owner has requested, pursuant to 37 CFR 1.182, that the Miller declaration, exhibits A-C, and pages 40-42 of the remarks contained in the March 16, 2007 response to the outstanding Office action be sealed.

The '012 *ex parte* reexamination proceeding is contained in an electronic Image File Wrapper (IFW). Although it is possible to seal the Miller declaration and attached exhibits A-C as complete papers so that these documents are not available for public viewing in the otherwise publicly accessible IFW, patent owner has not alleged that the Miller declaration and attached exhibits A and C each consists entirely of confidential material, (*e.g.*, all pages of the given document contain protective material). [1] Further, it is not clear why exhibit A [2] is considered by patent owner to include confidential material. The Office does not determine, *sua sponte*, whether any given document, or part of it, is subject to the District Court's Protective order; the petitioner must provide an averment as to same, since patent owner has access to the court to resolve any issue as to what is protected (or not) by the order. Patent owner has also not alleged that each of pages 40-42 of the February 14, 2007 patent owner response consists entirely of confidential material so as to subject to the District Court's Protective Order. If any part of the February 14, 2007 patent owner response does not recite confidential material, which appears to be the case since only pages 40-42 are identified as confidential, patent owner must provide a redacted copy of the response to substitute in the IFW public file for the copy of the response which is requested to be sealed. If any part of response pages 40-42 does not recite confidential material, that part is to be included in the redacted submission; clearly a part of a specified page entered into the IFW cannot be sealed without sealing the rest of that page.

For each of the foregoing reasons, the relief requested in patent owner's petition cannot presently be granted. Therefore, after cursory review of the petition papers, the Miller declaration, exhibits A-C attached thereto, and pages 4-44 of the February 14, 2007 patent owner response have been provisionally "sealed" in the IFW on an interim basis by being designated as "closed" and "non-public." **The provisionally sealed papers will remain sealed on a provisional basis for a period of THIRTY (30) DAYS from the date of the present petition decision.**

Patent owner may, within the thirty (30) day time limit, file a renewed petition without additional fee, requesting that these papers remain sealed, pending a determination of whether the papers are deemed by the examiner to contain information "important to a reasonable examiner in deciding whether or not a claim is patentable" as to any claim pending in this proceeding. With respect to **each document** that patent owner wishes to have sealed, patent owner must submit a statement certifying either (1) that the entire document contains material subject to the District Court's Protective Order and requesting that the entire document remain sealed, or (2) that only a portion of the substance of a given document contains material subject to the District Court's Protective Order and requesting

[1] Exhibit B is a single sheet.
[2] Exhibit A is the Protective Order itself.

that such document remained sealed and replaced with a redacted version of the document that will be submitted with any such renewed petition. Thus, for any document not consisting entirely of material that is subject to the District Court's Protective Order, patent owner must provide, as an attachment to the renewed petition, a version of the document having the protected material redacted. Therefore, patent owner must, of necessity, attach to the renewed petition a version of pages 4-44 of patent owner's response as filed on February 14, 2007 in which the portions of pages 40-42 that contain material that is subject to the District Court's Protective Order have been redacted. To the extent that portions of the Miller declaration and/or exhibits A-C attached thereto do not contain material that is subject to the District Court's Protective Order, accurate copies of those papers in which the protected material has been redacted must also be attached to the renewed petition.

CONCLUSION

1. The petition to seal the Miller declaration, exhibits A-C attached thereto, and pages 42-44 of the patent owner response filed on March 16, 2007 is dismissed.

2. The Miller declaration, exhibits A-C attached thereto, and pages 4-44 of patent owner's February 14, 2007 response, are provisionally sealed on an interim basis for a period not to exceed **THIRTY (30) DAYS** from the mailing date of the present decision.

3. **If a renewed petition under 37 CFR 1.182 to seal is not filed within THIRTY (30) DAYS from the date of the present decision, then the provisionally sealed papers will be unsealed.**

4. Jurisdiction over the present reexamination proceeding is being retained in the Office of Patent Legal Administration. After the issue of proprietary materials is resolved, jurisdiction will be returned to the examiner, via the Central Reexamination Unit 3991 Special Program Examiner, for appropriate action on the response filed on March 16, 2007

5. Telephone inquires 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 22, 2007

March 30, 2007
C:\KIVA\KENPET4\Sealexpn\8012_Petition to Seal_1_182.doc

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

Holland & Hart LLP
60 E. South Temple
Suite 2000
Salt Lake City, UT 84111

(For Patent Owner)

MAILED

MAY 22 2007

CENTRAL REEXAMINATION UNIT

In re K-Tec, Inc.
Ex Parte Reexamination Proceeding
Control No. 90/008,012
Filed: April 17, 2006
For: U.S. Patent No. 6,854,876 B2

: **DECISION GRANTING RENEWED PETITION**

This is a decision on the patent owner paper entitled RENEWED PETITION UNDER 37 CFR § 1.182 TO PLACE DOCUMENTS UNDER SEAL filed by facsimile transmission on May 2, 2007.

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

The patent owner petition is granted for the reasons set forth below.

FEES

No additional fee is required for the renewed petition.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,854,876 B2 (the '876 patent) issued on February 15, 2005, from an application filed on June 10, 2003.

2. A request *for ex parte* reexamination of the '876 patent was filed on April 17, 2006 and assigned control number 90/008,012 (the '012 ex *parte* reexamination proceeding).

3. Reexamination was ordered in the '012 *ex parte* reexamination proceeding on May 25, 2006.

4. An initial Office action on the merits was mailed on December 14, 2006.

5. On February 14, 2007, patent owner filed a timely response to the December 14, 2006 Office action, including a paper styled as "Declaration of Mark Miller" (the Miller Declaration) which includes Exhibits A-C as attachments. These documents were submitted pursuant to patent owner's 37 CFR 1.555 duty to disclose information material to patentability in the '012 *ex parte* reexamination proceeding.

6. On March 16 2007, patent owner filed a petition requesting (a) that the Miller declaration and Exhibits A-C as attached thereto be placed under seal, and (b) that all references to the Miller declaration and Exhibits A-C appearing on pages 40-42 of the February 14, 2007 response also be placed under seal, because these documents had been determined to be confidential information subject to a Protective Order of the United States District Court for the District of Utah ("the District Court").

7. On April 3, 2007, the Office mailed a Decision Dismissing Petition ("Decision") in which the relief requested was dismissed, *inter alia*, because a determination by the examiner as to whether some or all of the information in the papers mentioned in Fact 6 was "important to a reasonable examiner in deciding whether or not a claim is patentable" [1] had not yet been made.

8. The April 3, 2007 Decision nevertheless granted provisional relief in the form of sealing the papers in question for thirty (30) days in order to allow the examiner to make a determination as to the importance, or lack thereof, of the information in question, and to permit patent owner to file a redacted copy of any papers that were not alleged to consist entirely of confidential information.

9. On May 2, 2007, patent owner filed the present renewed petition, together with redacted a version of the response filed by patent owner on February 14, 2007, in which those portions of the response containing confidential information have been redacted.

10. On May 16, 2007, a Notice of Intent to Issue Reexamination Certificate ("NIRC"), accompanied by the examiner's statement of Reasons for Confirmation/Patentability, was mailed.

APPLICABLE REGULATIONS AND PRACTICE

37 CFR 1.59 provides, in part:

> "(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."

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)."

---

[1] See MPEP § 724.04(c).

37 CFR 1.550(d) provides:

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

37 CFR 1.555(a) provides, in part:

> A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective reexamination occurs when, at the time a reexamination proceeding is being conducted, the Office is aware of and evaluates the teachings of all information material to patentability in a reexamination proceeding. Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled."

MPEP § 724.04(c) provides in part:

> "Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:
>
> ...
>
> (C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public."

DECISION

In response to the Office action dated December 14, 2006, patent owner filed papers on February 14, 2007, that included the Miller declaration, exhibits A-C referenced in that declaration, and pages 4-44 comprising patent owner's remarks. Pursuant to 37 CFR 1.550(d), patent owner's response was required to be both timely and appropriate in order to avoid termination of the reexamination prosecution, which would then result in publication of a reexamination certificate. Further, it is to be noted that 37 CFR 1.555(a) requires, *inter alia*, that a patent owner submit all information known to patent owner, and all information known to any individual associated with the patent owner, that is material to the patentability of any claim pending in the '012 *ex parte* reexamination proceeding.

In the original petition filed on March 16, 2007, patent owner alleged that the Miller declaration and Exhibits A-C attached thereto were filed to satisfy patent owner's duty of disclosure pursuant to 37 CFR 1.555(a). These documents were discussed in the remarks portion of the February 14, 2007 patent owner response. However, from the contents of the petition, it appears that the patent owner subsequently determined that Exhibits B and C are subject to a Protective Order issued by the District Court. Patent owner also determined that the remarks portion of the response contained confidential information that was also subject to the Protective Order.

37 CFR 1.59 relates to expunging information from an "application, "and MPEP § 724.04(c)

addresses expunging information from the record of a reexamination proceeding. MPEP § 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the application is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but, in no event, later than the close of prosecution.

The April 3, 2007 decision dismissed the March 16, 2007 patent owner petition, but nevertheless provided provisional relief by sealing the papers in question for a limited time to permit the examiner to review the papers in order to determine whether the papers in question contain information important to a reasonable examiner in deciding whether or not a claim is patentable. This determination by the examiner is a necessary predicate to granting the relief requested by patent owner, whether in whole or in part, because - notwithstanding that information contained in these papers was subject to the District Court's Protective Order, such information cannot remain sealed, and cannot be expunged, if it is determined to be important to a reasonable examiner in deciding whether or not a claim is patentable.

The specific provisional relief provided by the April 3, 2007 Decision was predicated upon patent owner undertaking to file a renewed petition:

1. Again requesting that confidential information in the February 14, 2007 papers be permanently sealed; [2]

2. Identifying which of the February 14, 2007 papers consists entirely of confidential information;

3. Identifying which of the February 14, 2007 papers includes confidential information but does not entirely consist of confidential information; and

4. Be accompanied by a redacted version of any of the February 14, 2007 papers that were identified as including, but not consisting entirely of, confidential information.

On May 2, 2007, patent owner filed the present renewed petition. The renewed petition satisfies the requirements for further action by patent owner that were set forth in the Decision on Petition dated April 3, 2007. Patent owner has now averred that both the Miller declaration itself and Exhibit A attached thereto do not contain confidential information, and need not be sealed. Further, patent owner has now also stated that Exhibits B and C attached to the Miller declaration each consists entirely of confidential information. Patent owner has now also identified pages 40-42 of the February 14, 2007 response as containing <u>some</u> confidential information, while the balance of the response contains no confidential

[2] The '012 *ex parte* reexamination proceeding is contained in an electronic Image File Wrapper (IFW), from which data base, documents cannot be removed. However, an entire document can be sealed, *i.e.*, rendered inaccessible to the public, by being marked as a "closed" and "non-public" document.

information. Patent owner has submitted a redacted version of the February 14, 2007 response, in which the confidential information has been omitted and replaced by a statement indicating that certain information has been redacted.

In the NIRC mailed on May 16, 2007, the examiner has included a statement that the information contained in Exhibits B and C to the Miller declaration, and the information appearing on pages 40-42 of the February 14, 2007 response (remarks) is not important to a reasonable examiner in deciding whether or not the confirmed/patentable claims are patentable. Therefore, this information may properly be permanently sealed (and thereby expunged) in accordance with 37 CFR 1.59 and the practice in MPEP § 724.02(c) that implements the rule. Accordingly, the relief requested by patent owner in the present renewed petition will be granted as follows:

1. The Miller declaration and Exhibit A thereto will be marked as "active" and "public" documents in the IFW of the '012 *ex parte* reexamination proceeding, to make them available to the public.

2. Exhibits B and C to the Miller declaration will remain marked as "closed" and "non-public" in the IFW of the '012 *ex parte* reexamination proceeding, such that they will remain unavailable to the public. This status will be maintained permanently, unless a party with standing subsequently demonstrates that the information contained therein is no longer subject to a protective order issued by a court of competent jurisdiction.

3. The redacted version of the patent owner's response that was originally filed on February 14, 2007 will be entered into the active IFW record as a public document, replacing the unredacted copy of the February 14, 2007 patent owner's response (see immediately below paragraph).

4. The unredacted version of the February 14, 2007 patent owner's response will remain marked as "closed" and "non-public" in the IFW of the '012 *ex parte* reexamination proceeding, such that it is not available to the public. This status will be maintained permanently unless a party with standing subsequently demonstrates that the information contained therein is no longer subject to a protective order issued by a court of competent jurisdiction.

CONCLUSION

1. The renewed petition to seal the Miller declaration and exhibits B and C attached thereto, and to substitute a redacted version of pages 4-44 of the patent owner response filed on February 14, 2007, is granted.

2. The unredacted version of pages 4-44 of patent owner's February 14, 2007 response is also to remain sealed.

3. Jurisdiction over the present reexamination proceeding is being forwarded to the Central Reexamination Unit for mailing this decision and ensuring that the treatment of the papers discussed in this decision is/has been carried out pursuant to the guidelines set forth in this decision. In due course, jurisdiction will be forwarded to the Office of Patent Legal Administration for screening of the '012 *ex parte* reexamination proceeding pursuant to MPEP 2289, second paragraph, prior to forwarding the proceeding to the Office of Patent Publication.

4. Telephone inquires 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
May 21, 2007

May 21, 2007
C:\KIVA\KENPET6\expunge\8012_Renewed Petition to Seal_1.182.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,014	04/19/2006	6396722	38616.8910	6063

41066 7590 08/09/2007

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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8/10/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

KENNETH H. OHRINER

PERKINS COIE LLP

P. O. BOX 1208

SEATTLE WA 98111-1208

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008014

PATENT NO. 6,396,722

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
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CENTRAL REEXAMINATION UNIT

MURABITO, HAO & BARNES, LLP TWO NORTH MARKET STREET, THIRD FLOOR SAN JOSE CA 95113	For Patent Owner
Kenneth H. Ohriner PERKINS COIE LLP P. O. Box 1208 Seattle, WA 98111	For Third Party Requester
Fulghum, Roger BAKER BOTTS LLP 910 Louisiana St. One Shell Plaza Houston, TX 77002	For Third Party Requester
FINNEGAN, HENDERSON, FARABOW GARRETT & DUNNER LLP 901 New York Avenue, NW Washington, DC 20001-4413	For Third Party Requester
	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/008,014
Filed: April 19, 2006
For: US Patent No. 6,396,722

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/008,381
Filed: December 15, 2006
For: US Patent No. 6,396,722

In re: Lin

Ex Parte Reexamination Proceeding :
Control No. 90/008,586 :
Filed: April 11, 2007 :
For: US Patent No. 6,396,722 :

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. 6,396,722 issued on May 28, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,014 was requested by a third party requester on April 19, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,014 on June 1, 2006.

4. There are currently no amendments proceeding control number 90/008,014.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,381 was requested by a third party requester filed on December 15, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,381 on January 26, 2007.

7. There are currently no amendments proceeding control number 90/008,381.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,586 was requested by a third party requester filed on April 11, 2007.

9. The Reexamination Order was granted in proceeding, control no. 90/008,586 on May 8, 2007.

10. There are currently no amendments proceeding control number 90/008,586.

11. Proceedings control numbers 90/008,014; 90/008,381 and 90/008,586 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 90/008,014; 90/008,381 and 90/008,586 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. 90/008,014; 90/008,381 and 90/008,586 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

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

Lissi M. Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Jeffrey Schwartz
Schwartz Law Firm, PC
South Park Towers
Suite 53
Fairview Road
Charlotte, NC 28210

(For Patent Owner)

Michael B. Brooks
Michael Blaine Brooks, PC
1445 Los Angeles Avenue
Suite 206
Simi Valley, CA 93065

(For Requester)

In re Brown
Ex Parte Reexamination Proceeding
Control No. 90/008,015
Filed: April 21, 2006
For: U.S. Patent No. 7,025,020

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

The paper filed by requester on July 6, 2006 entitled "Petition To The Director Request for Reconsideration of Denial of Request for Ex Parte Reexamination, which is being treated as a petition Under 37 CFR 1.181 and 1.515(c)," (hereinafter Petition) is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated June 7, 2006.

The Petition is GRANTED.

REVIEW OF FACTS

1. U.S. Patent No. 7,025,020 (hereinafter, the '020 patent) issued on April 11, 2006.

2. A request for *ex parte* reexamination was filed by Michael Blaine Brooks, P.C., a third party requestor, on April 21, 2006. The resulting reexamination proceeding was assigned Control No. 90/008,015 (hereinafter, the '015 proceeding).

3. Reexamination was requested for claims 1-6 of the '020 patent.

4. A Notice of Reexamination Request Filing Date was issued on April 25, 2006.

5. An order denying the request for reexamination for claims 1-6 was issued on June 7, 2006.

6. On July 6, 2006, the third party requester filed the Petition under 37 CFR §§ 1.515(c) and 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges several grounds for which petitioner feels the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the following three main arguments:

1. The examiner failed to give appropriate weight to the fact that the applicant for the '020 patent filed said application as a continuation-in-part application, thus admitting that new matter was disclosed therein.

2. The examiner incorrectly construed the claim term "food product" in the '020 patent and improperly eliminated U.S. Patent Application Publication No. 2005/0233028 as prior art.

3. The examiner failed to give "food product" its broadest reasonable construction based on the disclosure of the '020 patent.

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-6 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-6 of the '020 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC § 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

III. Summary of the prior prosecution:

The '020 patent contains claims 1-6.

In the Notice of Allowability, dated November 17, 2005 the examiner indicated that the claims were allowed in view of the preliminary amendment and the filing of a terminal disclaimer. No art rejections were made in the prosecution of the '020 patent.

The '020 patent is a continuation-in-part of U.S. Patent No. 6,886,496 (hereinafter the '496 patent). Claims 1-6 of the '020 patent are similar to claims 1-6 of the '496 patent except that in independent claim 1 of the '020 patent the terminology "meat product" was amended to "food product" and the phrase "formed of multiple layers" was amended to "comprising multiple layers".

In the non-final Office action, dated September 23, 2004, of the '496 patent, the examiner rejected claim 1 under 35 U.S.C. § 102 based on U.S. Patent No. 6,584,938 to Sherrill et al. The applicant amended claim 1 to include "multiple layers" of dried "pork" skin and argued that Sherrill et al. failed to disclose multiple layers of dried pork skin. The examiner issued a Notice of Allowability.

IV. Analysis of the Request for Reexamination

The Request set forth the following substantial new questions (SNQ's) of patentability:

(1) Claims 1 and 4 are unpatentable under 35 U.S.C. §102(b) and/or §103(a) over Weinberg, taken alone or in view of Anderson and Chong.

(2) Claims 2 and 5 are unpatentable under 35 U.S.C. §103(a) over Weinberg in view of Anderson and Chong, and further in view of Spanier.

(3) Claim 3 is unpatentable under 35 U.S.C. §103(a) over Weinberg in view of Anderson, Chong and Spanier, and further in view of Lin.

(4) Claim 6 is unpatentable under 35 U.S.C. § 103(a) over Weinberg in view of Anderson, Chong and Spanier, and further in view of Leo.

The Request was denied on June 7, 2006 in the Order Denying Request for Ex Parte Reexamination wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. With regard to the Weinberg publication, the examiner determined that this publication was not prior art and thus could not raise a SNQ.

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director reviews the request *de novo* in response to the Petition.

Turning to the request, it states that the Weinberg publication, the Anderson patent, the Chong publication, the Spanier Patent and the Lin and Leo publications raise substantial new questions of patentability. The Director has reviewed the entire request, and has determined that there is at least one substantial new question of patentability presented by the teachings of the Weinberg publication for reasons set forth below. Accordingly, the denial of the request for reexamination mailed on June 7, 2006 is hereby withdrawn. The Anderson and Spanier patents as well as the Chong, Lin and Leo publications will not be addressed in this decision because it is not

necessary since the order denying reexamination is withdrawn. As mentioned above, this decision will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-6 of the '020 patent

The Weinberg publication: According to the request and Petition, the Weinberg publication raises a substantial new question of patentability regarding claims 1-6 of the '020 patent (see pages 2-5 of the request, and pages 5-13 of the Petition).

The Weinberg publication was not cited in the prior prosecution. As explained on pages 2-5 of the request, the Weinberg publication is prior art with respect to the claim language in the '020 patent that is not supported by the filing date of the "496 patent. Claim 1 of the '020 patent was amended by changing the terminology "meat product" to the terminology "food product" and by changing the phrase "formed of multiple layers" to "comprising multiple layers". Both of these amendments broadened the scope of claim 1 of the '020 patent with respect to claim 1 of the '496 patent.

Review of the specification and prosecution history of the '496 patent clearly indicates that the invention of the '496 patent is directed to a meat product encapsulated by an outer shell formed of multiple layers of dried and shaped pork skin. The specification of the '496 patent does not use the broader terminology "food product" and is directed solely to meat products. There is no indication that applicant in the '496 patent intended to broaden the scope of the invention to include other food products. Thus, the claim terminology "food product" in the '020 patent is not fully supported by the disclosure of the '496 patent and is not afforded the benefit of the filing date of the '496 patent.

Accordingly, the Weinberg publication is prior art with respect to claims 1-6 of the '020 patent. The Weinberg publication teaches, among other things, a vegetable jerky corresponding to the "food product" of claim 1. Since this teaching is directly related to subject matter considered as the basis for allowability of the claims in the application that issued as the '020 patent, a reasonable examiner would consider evaluation of the Weinberg publication as important in determining the patentability of claims 1-6. As such, it is agreed that the Weinberg publication raises a substantial new question of patentability with respect to claims 1-6 of the '020 patent.

Because it is agreed that the Weinberg publication raises a SNQ with respect to claims 1-6 of the '020 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision as it not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination.

CONCLUSION

1. Given the facts involved in this proceeding, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claims 1-6 of the '020 patent is GRANTED.

3. **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 and publications cited in the request, 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 37 CFR 1.550(c).

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 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.

4. Telephone inquiries related to this decision should be directed to Lynne Browne, Acting Supervisory Patent Examiner, at (571) 272-3670, or in her absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,017	04/25/2006	5688688	4145-31	5642

27476 7590 10/02/2007

NOVARTIS VACCINES AND DIAGNOSTICS INC.
INTELLECTUAL PROPERTY R338
P.O. BOX 8097
Emeryville, CA 94662-8097

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2007

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

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NOVARTIS VACCINES AND DIAGNOSTICS INC. (For Patent Owner)
INTELLECTUAL PROPERTY R338
P.O. BOX 8097
EMERYVILLE CA 94662-8097

GARY R. TANIGAWA (For Third Party Requester)
NIXON & VANDERTHYE, PC
901 NORTH GLEBE ROAD
ARLINGTON, VA 22203-1808

In re Reexamination Proceeding	:
P. Luciw et al.	:
Control No. 90/008,017	: DECISION DISMISSING PETITION
Filed: June 25, 2006	:
U.S. Patent No. 5,688,688	:
Attorney Docket No. 223002819000	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on September 7, 2007, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states, in part:

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

The present petition under 37 CFR 1.137(b) includes, inter alia, 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.

A review of the record reveals the following: On May 29, 2007, a Notice of Appeal was filed. On July 23, 2007 and September 7, 2007, supplemental amendments after final office action were filed. There is no record that an appeal brief and fee has been submitted Upon review of the supplemental amendments by the examiner, it has determined that outstanding issues still

remain and all existing claims are not patentable. A grantable petition under 37 CFR 1.137(b) requires a proper response, which in this instance is either an appeal brief and fee set forth in 37 CFR 41.20(b)(2) (37 CFR 41.37), or an amendment resulting in all existing claims being patentable with no outstanding issues remaining. Therefore, either an appeal brief along with the fee set forth in 37 CFR 41.20(b)(2) (37 CFR 41.37), or an amendment resulting in all claims being patentable with no outstanding issues remaining is required.

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

CONCLUSION

1. In view of the above, the present petition under 37 CFR 1.137(b) is **dismissed**.

2. $1,500.00 has been charged to counsel's deposit account no. 03-1952 in accordance with the present petition.

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

   a. Either an appeal brief along with the fee set forth in 37 CFR 41.20(b)(2) (37 CFR 41.37), or an amendment resulting in all claims being patentable with no outstanding issues remaining; and

   b. A Certificate that any request for reconsideration has been served on the third party requester.

4. The submissions should be included in a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

5. Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. An extension of time to file a request for reconsideration may be requested **only** under 37 CFR 1.550(c), extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

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

   By mail: Attn: Mail Stop "Ex Parte Reexam"
   Central Reexamination Unit
   Commissioner for Patents
   United States Patent and Trademark Office
   P. O. Box 1450
   Alexandria VA 22313-1450

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

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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

Fred A. Silverberg
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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,017	04/25/2006	5688688	4145-31	5642

27476 7590 04/30/2008

NOVARTIS VACCINES AND DIAGNOSTICS INC.
INTELLECTUAL PROPERTY R338
P.O. BOX 8097
Emeryville, CA 94662-8097

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/30/2008

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CENTRAL REEXAMINATION UNIT

NOVARTIS VACCINES AND DIAGNOSTICS INC. (For Patent Owner)
INTELLECTUAL PROPERTY R338
P.O. BOX 8097
EMERYVILLE CA 94662-8097

GARY R. TANIGAWA (For Third Party Requester)
NIXON & VANDERTHYE, PC
901 NORTH GLEBE ROAD
ARLINGTON, VA 22203-1808

In re Reexamination Proceeding	:	
P. Luciw et al.	:	
Control No. 90/008,017	:	DECISION GRANTING
Filed: June 25, 2006	:	RENEWED PETITION
U.S. Patent No. 5,688,688	:	
Attorney Docket No. 223002819000	:	

This is a decision on the Renewed Petition Under 37 CFR 1.137(b) ("Renewed Petition") filed November 2, 2007, in response to the Decision Dismissing Petition mailed October 2, 2007, in the above-identified reexamination proceeding, for entry of late papers based upon unintentional delay.

The Renewed Petition has just been forwarded to the Office of Patent Legal Administration (OPLA) for decision. Any delay in considering the Renewed Petition is regretted.

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 Renewed Petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (Appeal Brief and Appeal Brief fee - item 1), an authorization to charge counsel's deposit account for any fees due in connection with the filing of this Renewed Petition (item 2) and a Certificate of Service on the Third Party Requester.

The petition filed September 7, 2007, included, *inter alia*, an authorization to charge counsel's deposit account for a $1,500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

This decision hereby ratifies, *nunc pro tunc*, the prosecution in this reexamination proceeding that occurred between October 2, 2007 (the mail date of the decision dismissing petition) and the mail date of this decision.

As a grantable petition was not filed until November 2, 2007, the petition fee due for the present renewed petition under 37 CFR 1.137(b) is the fee in effect on November 2, 2007. The petition fee is therefore $1,540.00, the petition fee in effect on November 2, 2007. As $1,500.00 has been previously charged to counsel's deposit account for the petition fee, the $40.00 balance due for the petition fee will be charged to counsel's deposit account.

$40.00 has been charged to counsel's deposit account no. 03-1952 in accordance with the present Renewed Petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further handling of the reexamination proceeding.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Bennett Celsa, in CRU Art Unit 3991, who can be reached at 571-272-0807.

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

Fred A. Silverberg

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,017	04/25/2006	5688688	4145-31	5642

27476 7590 10/01/2009

NOVARTIS VACCINES AND DIAGNOSTICS INC.
INTELLECTUAL PROPERTY- X100B
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EXAMINER

ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Gary R. Tanigawa

Nixon & Vanderhye PC

901 N. Glebe Road

Arlington, VA 22203

MAILED

OCT 01 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008017

PATENT NO. 5,688,688

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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Novartis Vaccines and Diagnostics, Inc.
Intellectual Property – X100B
P.O. Box 8097
Emeryville, CA 94662-8097

For Patent Owner

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CENTRAL REEXAMINATION UNIT

Nixon & Vanderhye, PC
901 North Glebe Road, 11th Floor
Arlington, VA 2203

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,017
Filed: June 25, 2006
For: US Patent No. 5,688,688

DECISION ON
PETITION UNDER
37 C.F.R. 1.181

This is a decision on the petition filed March 7, 2008 under 37 CFR 1.181 to request designation of a rejection in the examiners answer as a new grounds of rejection under 37 CFR 1.181(a).

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

The petition is dismissed for the reasons stated herein.

REVIEW OF FACTS

On October 15, 2008 this reexamination was electronically forwarded to the Board of Patent Appeals and Interferences. A review of the file revealed that Appellant(s) had filed a Petition to Request Designation of a Rejection as a New Ground of Rejection under 37 CFR 1.181(a) on March 7, 2008 that had not been decided. Accordingly, the file was returned to the Examiner for consideration of the petition and such further action as appropriate.

Upon reconsideration of the arguments filed in the Appeal Brief submitted November 2, 2007 and the Reply Brief filed March 7, 2008, the prior art of record, taken alone or in combination, is not seen to teach or fairly suggest the claims as presently amended. All rejections are therefore withdrawn and claims 1-24 are allowed.

Accordingly, this petition is dismissed as moot. A Notice of Intent to Issue a Reexamination Certificate has been mailed on September 25, 2009.

Conclusion

The Patent Owner's petition to request designation of a rejection in the examiners answer as a new grounds of rejection under 37 CFR 1.181(a)I **dismissed** as moot.

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

for Deborah Jones

Gregory Morse,
Director, Central Reexamination Unit

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MICHAEL B. FEIN

COZEN O'ONNOR PC

1900 MARKET STREET

PHILADELPHIA, PA 19103

MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008018

PATENT NO. 5,393,843

ART UNI 3993

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,018	04/24/2006	5393843	146800-343	3673

30522 7590 03/06/2009

KRATON POLYMERS U.S. LLC
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3333 HIGHWAY 6 SOUTH
HOUSTON, TX 77082

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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KRATON POLYMERS U.S. LLC
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(For Patent Owner)

MICHAEL B. FEIN
COZEN O'CONNOR, PC
1900 MARKET STREET
PHILADELPHIA, PA 19103

(For Requester)

MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

In re Handlin, Jr. et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,018
Filed: April 24, 2006
For: U.S. Patent No. 5,393,843

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 14, 2009, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

A review of the present petition reveals that it includes, *inter alia*, a response to the outstanding Office action. 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 large entity was made (item 2). The petition contains the proper statement for unintentional delay in filing the required response (item 3). The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer (item 4). 37 CFR 1.137(d)(3) .

Since the present petition under 37 CFR 1.137(b) includes the requisite response (item 1),[1] the $1620.00 petition fee under 37 CFR 1.17(m) (item 2), and the requisite statement (item 3), the petition will be granted.

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).

3. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster at 571-272-7711.

Kenneth M. Schor

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

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,018	04/24/2006	5393843	146800-343	3673

30522 7590 06/19/2009
KRATON POLYMERS U.S. LLC
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HOUSTON, TX 77084

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MICHAEL B. FEIN

COZEN O'ONNOR PC

1900 MARKET STREET

PHILADELPHIA, PA 19103

MAILED

JUN 19 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008018

PATENT NO. 5,393,843

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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KRATON POLYMERS U.S. LLC
16400 PARK ROW
HOUSTON, TX 77084 : (For Patent Owner)

MAILED

JUN 19 2009

CENTRAL REEXAMINATION UNIT

MICHAEL B. FEIN
COZEN O'CONNER PC
1900 MARKET STREET
PHILADELPHIA, PA 19103 : (For Requester)

In re Handlin Jr. et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,018
Filed: April 24, 2006
For: U.S. Patent No. 5,393,843

DECISION
GRANTING PETITION
UNDER 1.182

This is a decision on the June 11, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATOIN AND ENTRY OF SUBMISSION AFTER FINAL REJECTION IN AN EX PARTE REEXAMINATION PROCEEDING."

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

The petition fee of $400.00 under 37 CFR 1.17(f) has been charged to deposit account 14-1437, as authorized at page 7 of the instant petition.

The petition is **granted to the extent set forth below**.

BACKGROUND

- On April 24, 2006, a request for *ex parte* reexamination was filed by the third party requester for all of the claims of U.S. Patent Number 5,393,843; the resulting reexamination proceeding was given a filing date and assigned control number 90/008,018 ("the '018 proceeding").

- On May 15, 2007, a non-final Office action was mailed.

- On May 27, 2008, patent owner submitted a timely response to the outstanding Office action, including amendments and new claims 28-38.

- On September 26, 2008, a final Office action was mailed, rejecting all of the pending claims.

- On January 14, 2009, a Notice of appeal was submitted by patent owner accompanied by a petition for revival under 37 CFR 1.137(b). Also submitted on January 14, 2009, was a proposed response to the Office action of September 26, 2008.

- On March 6, 2009, the January 14, 2009 petition for revival under 37 CFR 1.137(b) was granted.

- On March 13, 2009, an advisory action was mailed by the Office, stating that the proposed response filed January 14, 2009 failed to overcome all of the rejections in the final rejection of September 26, 2008.

- On April 7, 2009, an interview was held between patent owner and Office personnel, stating that further evidence would be required and may be persuasive.

- On April 24, 2009, the Office granted an April 13, 2009 patent owner petition for a one month extension of time, setting the due date for the patent owner's appeal brief at June 6, 2009.

- On May 20, 2009, patent owner filed a "Supplemental Submission After Filing of Notice of Appeal", including remarks and evidence.

- On June 5, 2009, an advisory action was mailed, indicating that the evidence provided as part of the "Supplemental Submission" would not be entered.

- On June 8, 2009, the Office granted a June 5, 2009 patent owner petition for an extension of time, to the extent that the due date for the patent owner's brief would be extended to June 20, 2009.

- On June 11, 2009, patent owner filed the instant "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATOIN AND ENTRY OF SUBMISSION AFTER FINAL REJECTION IN AN EX PARTE REEXAMINATION PROCEEDING."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

The June 11, 2009 patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of an evidence submission previously denied. 37 CFR 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 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 [emphasis added].

The § 1.182 petition procedure was created to address a need for an amendment or evidence submission, the need for which was not 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 CFR 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, by better defining the 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 submission could not have been presented earlier.

In the instant case, a notice of appeal was filed on January 14, 2009, to keep the proceeding pending. The examiner conducted an interview with the patent owner on April 7, 2009, and a timely follow up submission including evidence, noted in the April 7 interview to be "required and may be persuasive," was then filed on May 20, 2009. An advisory action refusing entry of the proposed May 20, 2009 evidence was mailed June 5, 2009. On June 11, 2009, the patent owner timely filed the instant § 1.182 petition. Thus, this case provides a unique set of circumstances. The § 1.182 petition meets the technical requirements set forth in the Notice, including the fact that the petition was filed after final rejection in an *ex parte* reexamination proceeding to seek entry of the after-final evidence that was denied entry in an advisory action. At the current stage of the proceedings, no regulation specifically provides for the entry of patent owner's submission. With respect to reasons why the need for the evidence could not have been anticipated earlier, patent owner states that the evidence was in response to language in the final rejection, and in response to the April 7, 2009 interview with the examiner. Furthermore, the May 20, 2009 submission includes evidence directed towards the disputed functionality language intended to address the issue first raised in the final rejection and discussed in an interview with the examiner, in which the examiner indicated "may be persuasive." This statement by the examiner is evidence that the entry of the evidence would further prosecution. In this instance, based on the totality of the circumstances, the patent owner has met the burden of presenting evidence why the need for the submission could not have been anticipated earlier. While the

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

patent owner has filed a notice of appeal, neither an appeal brief nor an examiner's answer has been filed. Therefore, any delay caused by the submission of the January 14, 2009 notice of appeal is not significant enough to outweigh the benefit to be obtained by consideration of the proffered amendment. The facts in this case indicate that continuation of examination through entry of the May 20, 2009 evidence submission would best satisfy the overall needs of special dispatch. Furthermore, the prosecution history shows a pattern of responsiveness on the part of the patent owner through the use of interviews with the examiner to better define the claims over the applied art. On balance, the entry of the May 20, 2009 amendment would best serve the efficient resolution of the question of patentability arising from the art of record.

In view of the above, the closing of prosecution rendered via the September 26, 2008 final Office action is withdrawn, and prosecution of the proceeding is reopened to the following extent:

The May 20, 2009 response will be entered 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.

CONCLUSION

- The petition is **granted to the extent set forth herein**.
- The prosecution of the present '8018 *ex partes* reexamination proceeding is continued. **No further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances.**
- The closing of prosecution rendered via the September 26, 2008 final Office action is withdrawn, and prosecution of the proceeding is reopened.
- The May 20, 2009 response will be entered 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.
- 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

_____

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

June 19, 2009
C:\Kiva\Kenpet7\RCR\

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,018	04/24/2006	5393843	146800-343	3673

30522 7590 12/31/2009

KRATON POLYMERS U.S. LLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/31/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MICHAEL B. FEIN
COZEN O'ONNOR PC
1900 MARKET STREET
PHILADELPHIA, PA 19103

Date:
MAILED
DEC 3 1 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008018
PATENT NO. : 5393843
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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KRATON POLYMERS, U.S. LLC
16400 Park Row
Houston, TX 77082

: FOR PATENT OWNER

MAILED

DEC 3 1 2009

CENTRAL REEXAMINATION UNIT

Michael B. Fein
Cozen O'Connor PC
1900 Market Street
Philadelphia, PA 19103

: FOR THIRD PARTY
: REQUESTER

In re Handlin, Jr. et al.

Reexamination Proceeding
Control No. : 90/008,018
Filed : April 24, 2006
Patent No. 5,393,843

: DECISION ON PATENT
: OWNER'S PETITION UNDER
: 37 CFR 1.181

This is a decision addressing Patent Owner's submission, filed October 28, 2009 and entitled "PETITION UNDER 37 CFR § 1.181 TO WITHDRAW FINALITY OF THE OFFICE ACTION OF OCTOBER 20, 2009 AND CHANGE STATUS TO NON-FINAL."

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

SUMMARY

Patent Owner's petition is DENIED.

BACKGROUND

1. On April 24, 2006, a request for *ex parte* reexamination was filed by the third party requester for all of the claims of U.S. Patent Number 5,393,843; the resulting reexamination proceeding was given a filing date and assigned control number 90/008,018 ("the '018 proceeding").

2. On May 15, 2007, a non-final Office action was mailed.

3. On May 27, 2008, Patent Owner submitted a timely response to the outstanding Office action, including amendments and new Claims 28-38.

4. On September 26, 2008, a final Office action was mailed, rejecting all of the pending claims.

5. On January 14, 2009, a Notice of appeal was submitted by Patent Owner accompanied by a petition for revival under 37 CFR 1.137(b). Also submitted on January 14, 2009, was a proposed response to the Office action of September 26, 2008.

6. On March 6, 2009, the January 14, 2009 petition for revival under 37 CFR 1.137(b) was granted.

7. On March 13, 2009, an advisory action was mailed by the Office, stating that the proposed response filed January 14, 2009 failed to overcome all of the rejections in the final rejection of September 26, 2008.

8. On April 7, 2009, an interview was held between Patent Owner and Office personnel, stating that further evidence would be required and may be persuasive.

9. On April 24, 2009, the Office granted an April 13, 2009 Patent Owner petition for a one month extension of time, setting the due date for the Patent Owner's appeal brief at June 6, 2009.

10. On May 20, 2009, Patent Owner filed a "Supplemental Submission After Filing of Notice of Appeal", including remarks and evidence.

11. On June 5, 2009, an advisory action was mailed, indicating that the evidence provided as part of the "Supplemental Submission" would not be entered.

12. On June 8, 2009, the Office granted a June 5, 2009 Patent Owner petition for an extension of time, to the extent that the due date for the Patent Owner's brief would be extended to June 20, 2009.

13. On June 11, 2009, Patent Owner filed a petition under 37 CFR § 1.182 requesting continued reexamination and entry of submission after final rejection.

14. On June 19, 2009, the Office granted the petition under § 1.182, directing that the response of May 20, 2009 be treated as a response after a first Office action.

15. On October 20, 2009, a final rejection was mailed, rejecting all pending claims.

16. On October 28, 2009, the instant petition was filed by Patent Owner.

DECISION

The final Office action of September 26, 2008 included a rejection of claims 18, 20-22, 24, 25, 27, 35, 37 and 38 as obvious over the Bouchal reference. Patent Owner's response of May 20, 2009 alleges that the functionality of the Bouchal polymer is 1.80 after hydrogenation, based on data found in the Bouchal reference. In the final rejection of October 20, 2009 the examiner recalculates this value after pointing out an error in Patent Owner's calculation. The petition alleges that this amounts to a new ground of rejection.

Patent Owner cites portions of MPEP 706.07 in support of its position. MPEP 706.07(e) refers the reader to MPEP 1207.03 for a discussion of what may constitute a new ground of rejection. MPEP 1207.03(III) states, in part:

> 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....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.

In this case, the statutory basis (35 USC § 103) and the evidence relied upon (Bouchal) each remain the same. The rationale supporting the rejection is also unchanged; the examiner has done nothing more than reply to Patent Owner's response, explaining why Patent Owner's calculations are not persuasive. This is not a new ground of rejection.

The petition argues that Patent Owner seeks to prevent prosecution from being cut off prematurely. This argument is not persuasive. Patent Owner has already been granted a continuation of the current reexamination proceeding. The petition decision mailed June 19, 2009 stated that no further continuation of this proceeding would be granted absent a showing of "extraordinary circumstances." The facts presented in the petition do not rise to the level of such a showing.

CONCLUSION

1. Patent Owner's petition filed October 28, 2009 is **DENIED** for the reasons discussed above. This decision is without prejudice to a request for reconsideration or higher-level review. See MPEP 1002.02.

2. The present *ex parte* reexamination proceeding is being returned to the examiner for consideration of Patent Owner's response filed December 21, 2009.

3. 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
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GIBBONS P.C.
ONE GATEWAY CENTER
NEWARK NJ 07102

(For Patent Owner)

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APR 27 2009

OFFICE OF PETITIONS

VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 S. 17TH STREET
PHILADELPHIA, PA 19103

(For Requester)

In re Tharalson et al.	:	
Reexamination Proceeding	:	
Control No. 90/008,020	:	DECISION DISMISSING PETITION
Request Deposited: April 26, 2006	:	
Attorney Docket No. R166-P-REI	:	
For: U.S. Patent No. 6,578,211	:	

This is a decision on the "Renewed Reference Requested By 35 U.S.C. §120 and 37 C.F.R. §1.78," filed July 8, 2008, to accept an unintentionally delayed claim under 35 U.S.C. 120, 365(c) and 119(e) for the benefit of the prior-filed international applications, nonprovisional applications, and provisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**

Petitioners are seeking to claim the benefit under 35 U.S.C. 120, 365(c) or 119(e) of the prior-filed international applications, nonprovisional applications, and provisional application set forth in the amendment filed July 8, 2008. After reviewing the entire chain of prior filed applications, the Office has determined that the benefit claims to the prior-filed applications do not comply with the requirement of 35 U.S.C. 120, 365(c) and 119(e), and therefore, are improper.

The Office notes that any nonprovisional application or international application designating the United States of America claiming the benefit under 35 U.S.C. 120, 121 or 365(c) of one or more prior-filed copending applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number, or by international application number and international filing date, and indicating the relationship between the applications. See 37 CFR 1.78(a)(2)(i); MPEP 201.11(III). Where an application claims a benefit under 35 U.S.C. 120, 121 or 365(c) of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962); see also MPEP 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP 201.06(b). The status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application.

The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional or international application. See MPEP 201.11. An example of a proper benefit claim is "this application is a continuation of prior Application No. ---, filed ---." A benefit claim that merely states that "this application claims the benefit of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 because the relationship between the applications is not stated. In addition, a benefit claim that merely states that "this application is a continuing application of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 since the proper relationship, which includes the type of continuing (i.e., continuation, divisional, or continuation-in-part) application, is not stated. Moreover, if the benefit of more than one nonprovisional or international application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications. For example, a statement that "this application claims the benefit of Application Nos. C, B, and A" or "this application is a continuing application of Application Nos. C, B, and A" is improper. Applicant instead must state, for example, that "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which is a continuation of Application No. A, filed ---. MPEP 201.11(III)(A). Any benefit claim that does not both identify a prior application by its application number (or international application number and international filing date) and specify the relationship between the applications will not be considered to contain a specific reference to a prior-filed application.

In this instance, before petitioners are entitled to claim the benefit of the prior-filed applications, petitioners must correct the deficiencies in each of the following applications.

1. Application No. PCT/US97/15282, filed August 29, 1997

Application No. PCT/US97/15282 does not make reference to Application No. 08/903,640 or indicate the relationship between the applications. 35 U.S.C. § 120 permits entry of a subsequent amendment to an abandoned application in applications filed prior to November 29, 2000 to include the benefit of an earlier filing date for purposes other than prosecution. See Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136 (D.D.C. 1976).

Petitioners must file a petition under 37 CFR 1.182[1] in Application No. PCT/US97/15282, accompanied by a $400.00 petition fee, and a replacement sheet of the specification (first page) or Supplemental Box of the Request form (PCT/RO/101) providing the relationship (i.e., continuation, divisional, or continuation-in-part) to Application No. 08/903,640, which claims benefit to provisional Application No. 60/039,728.

For example, a proper benefit claim could be: "This application is a continuation-in-part of Application No. 08/903,640, filed July 31, 1997, which claims benefit to provisional Application No. 60/039,728, filed February 19, 1997." **(Note: if the application is not a continuation-in-part, petitioners must state the correct relationship as either a continuation or divisional).**

2. Application No. 09/244,140, filed February 4, 1999, now Patent No. 6,112,347, issued September 5, 2000

It is noted that the Certificate of Correction issued in Patent No. 6,112,347 is incorrect. The Certificate of Correction does not indicate the international filing date of Application No. PCT/US97/15282 or the application number (series code and serial number) for Application No. 08/903,640. Additionally, the Certificate of Correction does not contain a reference to Application No. 60/039,728.

As Application No. 09/244,140 was filed before November 29, 2000, a Certificate of Correction can be used to correct these errors. Therefore, petitioners must submit a Certificate of Correction in Application No. 09/244,140 (now Patent No. 6,112,347), a $100.00 fee, and an amendment to the first sentence of the specification or an Application Data Sheet (ADS) providing the relationship to Application No. PCT/US97/15282, including its international filing date, and the relationship to Application No. 08/903,640, which claims benefit to provisional Application No. 60/039,728.

---

[1] The petition under 37 CFR 1.182 should be directed to PCT Legal at:

Mail Stop PCT
Attention: PCT Legal
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

For example, a proper benefit claim is: "This application is a continuation-in-part of Application No. PCT/US97/15282, filed August 29, 1997, which is a continuation-in-part of Application No. 08/903,640, filed July 31, 1997, which claims benefit to provisional Application No. 60/039,728, filed February 19, 1997."

3. Application No. 09/552,331, filed April 19, 2000, now Patent No. 6,148,456, issued November 21, 2000.

It is noted that the Certificate of Correction issued in Patent No. 6,148,456 is incorrect. The Certificate of Correction does not indicate the international filing date of Application No. PCT/US97/15282 or the application number (series code and serial number) for Application No. 08/903,640. The Certificate of Correction does not make reference to Application No. 60/039,728. Lastly, the Certificate of Correction does not indicate the relationships to Application Nos. 09/244,140, PCT/US97/1582 and 08/903,640.

As Application No. 09/552,331 was filed before November 29, 2000, a Certificate of Correction can be used to correct these errors. Therefore, petitioner must file a Certificate of Correction in Application No. 09/552,331 (now Patent No. 6,148,456), a $100.00 fee, and an amendment or ADS, which provides the relationships to Application Nos. 09/244,140 and PCT/US97/15282, including its international filing date, and the relationship to Application No. 08/903,640, identifying it by its application number, which claims benefit to provisional Application No. 60/039,728.

For example, a proper benefit claim could be: "This application is a continuation-in-part of Application No. 09/244,140, filed February 4, 1999, now Patent No. 6,112,347, issued September 5, 2000, which is a continuation-in-part of Application No. PCT/US97/15282, filed August 29, 1997, which is a continuation-in-part of Application No. 08/903,640, filed July 31, 1997, which claims benefit to provisional Application No. 60/039,728, filed February 19, 1997."

4. Application No. PCT/US00/14086, filed May 22, 2000

Application No. PCT/US00/14086 does not make reference to Application Nos. 09/244,140, PCT/US97/15282, 08/903,640 or 60/039,728 or indicate the relationships to Application Nos. 09/244,140, PCT/US97/15282, or 08/903,640.

Petitioners must file a petition under 37 CFR 1.182[2] in Application No. PCT/US00/14086, accompanied by a $400.00 fee, and a replacement sheet of the specification (first page) or

[2] The petition under 37 CFR 1.182 should be directed to PCT Legal at:

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Supplemental Box of the Request form (PCT/RO/101) providing the relationships to Application Nos. 09/244,140 and PCT/US97/15282, including its international filing date, and the relationship to Application No. 08/903,640, which claims benefit to provisional Application No. 60/039,728.

For example, a proper benefit claim could be: "This application is a continuation-in-part of Application No. 09/552,331, filed April 19, 2000, now Patent No. 6,148,456, issued November 21, 2000, which is a continuation-in-part of Application No. 09/244,140, filed February 4, 1999, now Patent No. 6,112,347, issued September 5, 2000, which is a continuation-in-part of Application No. PCT/US97/15282, filed August 29, 1997, which is a continuation-in-part of Application No. 08/903,640, filed July 31, 1997, which claims benefit to provisional Application No. 60/039,728, filed February 19, 1997."

5. Application No. 10/797,933, filed March 10, 2004, now Patent No. RE39,136, issued June 20, 2006

Application No. 10/797,933 (now Patent No. RE39,136), does not make reference to Application Nos. 09/552,331, 09/244,140, PCT/US97/15282, 08/903,640 or 60/039,728 or indicate the relationships to Application Nos. 09/552,331, 09/244,140, PCT/US97/15282, or 08/903,640.

Pursuant to Section 2258(IV)(E) of the Manual of Patent Examining Procedure:

> Under no circumstances can a reexamination proceeding be employed to add or correct a benefit claim under 35 U.S.C. 119(e) for a patent matured from a utility or plant application filed on or after November 29, 2000.
>
> Section 4503 of the American Inventor's Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:
>
>> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section during the pendency of the application.
>
> 35 U.S.C. 119(e)(1), as amended by the AIPA, clearly prohibits the addition or correction of benefit claims under 35 U.S.C. 119(e) when the application is no longer pending, e.g., an issued patent. Therefore, a reexamination is not a valid mechanism for adding or correcting a benefit claim under 35 U.S.C. 119(e) after a patent has been

granted (for a patent matured from a utility or plant application filed on or after November 29, 2000).

Nevertheless, the filing of a reissue application is a proper mechanism to add or correct a benefit claim under 35 U.S.C. 119(e) for a patent matured from a utility or plant application filed on or after November 29, 2000. See MPEP 1402.

Petitioner must filed a reissue application, a petition under 37 CFR 1.78(a)(3) and (a)(6),[3] a $1,410.00 petition fee, and an amendment to the first sentence of the specification or an ADS making reference to and providing the relationships between the first (earliest) application and every intermediate application.[4]

For example, a proper benefit claim could be: "This is a reissue application of Application No. 10/797,933, filed March 10, 2004, now Patent No. RE39,136, issued June 20, 2006, which is a reissue of Application No. 09/833,041, filed April 20, 2001, now Patent No. 6,578,211, issued June 17, 2003, which is a continuation-in-part of Application No. PCT/US00/14086, filed May 22, 2000, which is a continuation-in-part of Application No. 09/552,331, filed April 19, 2000, now Patent No. 6,148,456, issued November 21, 2000, which is a continuation-in-part of Application No. 09/244,140, filed February 4, 1999, now Patent No. 6,112,347, issued September 5, 2000, which is a continuation-in-part of Application No. PCT/US97/15282, filed August 29, 1997, which is a continuation-in-part of Application No. 08/903,640, filed July 31, 1997, which claims benefit to provisional Application No. 60/039,728, filed February 19, 1997."

Further correspondence with respect to this matter, unless otherwise indicated, should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

---

[3] A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. 120, 365(c) and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

[4] As petitioners are claiming the benefit of multiple prior-filed applications, the reference to the prior applications may be in a continuous string of multiple sentences at the beginning of the specification. MPEP 201.11(IV)(D). The multiple sentences must begin as the first sentence after the title, and any additional sentence(s) including a benefit claim must follow the first sentence and not be separated from the first sentence by any other sentence not making a benefit claim. Id.

By hand: Customer Service Window
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401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Christina Tartera Donnell at (571) 272-3211.

Anthony Knight
Supervisor
Office of Petitions

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,021	04/26/2006	6931677	SIM2-2D	7068

26345 7590 08/21/2007

GIBBONS P.C.
ONE GATEWAY CENTER
NEWARK, NJ 07102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/21/2007

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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8/21/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Volpe and Koenig, P.C.
United Plaza Suite 1600
30 S. 17th Street
Philadelphia, PA 19103

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008021
PATENT NO. 6,931,677
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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GIBBONS P.C.
ONE GATEWAY CENTER
NEWARK, NJ 07102

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

ANTHONY VOLPE
VOLPE AND KOENIG, PC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

(For Third Party Requester)

In re Reexamination Proceeding :
Douglas Tharalson et al. :
Control No. 90/008,021 : DECISION GRANTING PETITION
Filed: April 26, 2006 :
U.S. Patent No. 6,931,677 :
Attorney Docket No. SIM2-2D :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on July 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 (amendment - item 1), an authorization to charge counsel's deposit account for the $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.

$750.00 has been charged to counsel's deposit account no. 03-3839 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 July 20, 2007 amendment, 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, M. Graham, in CRU Art Unit 3993, who can be reached at 571-272-7116.

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

Fred A. Silverberg

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

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	Tharalson, et al.	**Group Art Unit:**	CRU
U.S. Application No:	90/008,021	**Examiner:**	Graham, Matthew C.
Filing Date:	April 26, 2006	**Attorney Docket No.:**	SIM2-2D
For:	COMBINATION CO-SLEEPER AND CHANGING TABLE		

PETITION UNDER 37 C.F.R. § 1.137(b)

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

Dear Sir:

Applicant respectfully requests to reinstate the *ex parte* reexamination proceeding in the above identified application, under 37 C.F.R. § 1.137(b), without prejudice, inasmuch as the response to the May 14, 2007 Office Action was unintentionally delayed.

An Office Action was mailed in the subject application on May 14, 2007. A shortened statutory period of two (2) months for response was assigned, making the last day for reply July 14, 2007.

Applicant respectfully submits that a docketing error mistakenly led Applicant to believe the last day for response to the outstanding Office Action was August 14, 2007, exactly one month past the actual due date. Applicant became aware of the docketing error on July 19, 2007, while preparing to respond to the outstanding Office Action.

Applicant is further providing a copy of the relevant portion of the docket illustrating the error. These docket sheets have been redacted only to remove all privileged information not pertaining to the above identified *ex parte* reexamination.

Provided in Exhibit A are those portions of the docket representing the present application as of July 10, 2007. The first page illustrates that the docket incorrectly posts only a 1 month reminder to respond to the present Office Action on July 14, 2007. The second page of the docket of Exhibit A correspondingly and incorrectly states the response to the present Office Action is due on August 14, 2007.

Provided in Exhibit B is the portion of the docket representing the present application as of July 19, 2007 (the date the docketing error was recognized). Exhibit B illustrates that the docket still incorrectly states the response to the present Office Action is due on August 14, 2007.

Provided in Exhibit C is an affidavit from Tracie Hibbits, who was responsible for entering the information relating to the present application into the docketing system for Applicant. Tracie Hibbits avers that the docket incorrectly states the due date for response to the present Office Action, and that the information entered into the docketing system was unintentionally entered incorrectly. Tracie Hibbits also avers that she was not aware of the errors entered into the docketing system until July 20, 2007.

Applicant respectfully petitions the Commissioner, without prejudice, to reinstate the *ex parte* reexamination proceeding under 37 C.F.R. §1.137(b) for unintentional delay, and accept the currently filed Amendment and Response as a timely reply to the Office Action dated on May 14, 2007.

This application was unintentionally abandoned and Applicant submits 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. Applicant has further enclosed a copy of the required responsive filing to the outstanding action, namely Applicant's Response Pursuant to 37 CFR 1.530, attached hereto as Appendix A.

The Commissioner is hereby authorized to charge the Petition fee for a Small Entity under 37 C.F.R. 1.17(m), and any other deficiencies, or credit any overpayment in the enclosed amount to deposit account #03-3839.

CONCLUSION

Accordingly, for the foregoing reasons, Applicant respectfully petitions the Commissioner under § 1.137 (b), without prejudice, to reinstate the *ex parte* reexamination proceeding for the above-referenced application, and accept the currently filed Amendment and Response as a timely reply to the outstanding Office Action dated on May 14, 2007.

Respectfully Submitted,

Gibbons P.C.

Date: July 20, 2007

Abhik Huq
Registration No. 40,656
1700 Two Logan Square
18th & Arch Street
Philadelphia, PA 19103
Phone 215.446.6268

Attorneys for Applicant

#1212890 v1
099998-00014

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Commissioner for Patents
United States Patent and Trademark Office
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JUN 03 2009

CENTRAL REEXAMINATION UNIT

GIBBONS P.C.
ONE GATEWAY CENTER
NEWARK, NJ 07102

In re Application of	:	
THARALSON, et al.	:	
Control No. 90/008,021 (U.S. Patent 6,931,677)	:	DECISION ON PETITION
Filed: April 26, 2006	:	TO WITHDRAW
Attorney Docket No. SIM2-2D	:	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 May 14, 2009.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to GIBBONS P.C. has been revoked by the assignee of the patent application 10/448,538 on March 20, 2009. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

P Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: BEYERS COSTIN, P.C.
RICHARD O'HARE
POST OFFICE BOX 878
SANTA ROSA, CA 95402-0878

cc: VOLPE AND KOENIG (Third Party Requester)
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on May 14, 2009 and Power of Attorney or revocation of power of attorney and change of correspondence address filed on May 20, 2009 in US Application Number 10/448,538.

There is no indication the documents were served on the 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,021	04/26/2006	6931677	SIM2-2D	7068

7590 08/21/2009

BEYERS COSTIN, P.C.
RICHARD O'HARE
POST OFFICE BOX 878
SANTA ROSA, CA 95402-0878

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/21/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Volpe and Koenig, P.C.
United Plaza Suite 1600
30 S. 17th Street
Philadelphia, PA 19103

Date:
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AUG 21 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008021
PATENT NO. : 6931677
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)).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/498,914	08/03/2006	Douglas Tharalson	6245-08	9931

7590 08/21/2009
BEYERS COSTIN, P.C.
Post Office Box 878
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EXAMINER
LAGMAN, FREDERICK LYNDON

ART UNIT	PAPER NUMBER
3672	

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

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

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In re Reissue Application of
Douglas Tharalson et al.
Application No.: 11/498,914
Filed: August 3, 2006
For: U.S. Patent No. 6,931,677

In re Douglas Tharalson et al.
Reexamination Proceeding
Control No.: 90/008,021
Filed: April 26, 2006
For: U.S. Patent No.: 6,931,677

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. 6,931,667 ("the '667 patent") issued on August 23, 2005.

2. A request for reexamination of the '667 patent, assigned control No. 90/008,021

("the '8021 reexamination proceeding"), was filed by a third party requester on April 26, 2006.

3. Reexamination was ordered for the '8021 reexamination proceeding on July 10, 2006.

4. An application for reissue of the '667 patent, assigned application No. 11/498,914 ("the '914 reissue application"), was filed by the patent owner on August 3, 2006.

5. The filing of the '914 reissue application was announced in the *Official Gazette* on May 5, 2009.[1]

6. A patent owner's statement under 37 CFR 1.530 was not received in the '8021 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 '914 reissue application and the '8021 reexamination proceeding are currently pending. The order to reexamine has been mailed in the '8021 reexamination proceeding, and notice of the '914 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 to merge the two proceedings, consideration is given to the status of each proceeding. *See*: MPEP § 2285.

In order to provide efficient and prompt handling of the reissue and reexamination

[1] Prosecution of the '914 reissue application was significantly delayed due to multiple legal issues that arose and needed to be resolved on petition before notification of the application could be made and the application forwarded to the corps for examination on the merits.

proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the present reissue application and the present reexamination proceeding 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.* In addition, **if a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed**, and the reissue application may then be suspended. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination under 37 CFR 1.114 (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

1. A review of the '914 reissue application file shows:

   (a) Original claims 1-25 of the '914 reissue patent are present.

   (b) None of the original claims has been amended.

   (c) No new claims have been added.

   (d) The Related Application section of the specification was amended by the February 28, 2008 paper titled "Renewed Reference Requested By 35 U.S.C. § 120 and 37 C.F.R. § 1.78."

2. A review of the file of the '8021 reexamination proceeding shows:

   (a) Original claims 1-25 of the '667 patent are present.

   (b) None of the original claims has been amended.

   (c) No new claims have been added.

   (d) The Related Application section of the specification was amended by the July 9, 2008 paper titled "Patent Owner Response After Non-Final Action Filed Under 1.111." The July 9, 2008 amendment to the specification in the '8021 reexamination proceeding is identical to the February 28, 2008 amendment to the specification in the '914 reissue application.

3. Accordingly, the claims and specification are identical in both proceedings.

4. The patent owner is reminded of the requirement 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).

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

1. Upon receipt of the merged proceeding, the examiner should promptly prepare an Office action.

2. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 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 are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

3. 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

CONCLUSION

1. Reissue application No. 11/498,914 and reexamination control No. 90/008,021 are merged into a single proceeding.

2. Patent owner is required to file an appropriate change of correspondence address of record in the '667 patent file, if the current address is not correct.

3. Periods for response for the merged proceeding are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination. In addition, **if a final rejection Office action should be issued in this merged proceeding**, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.

4. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed.** Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination under 37 CFR 1.114 (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution as per 37 CFR 1.550(d).

5. The address of Reed Smith LLP, 2500 One Liberty Place, 1650 Market Street, Philadelphia, PA 19103, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '667 patent file is made in accordance with 37 CFR 1.33(c).

6. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 3672, 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 '667 patent (e.g., by preparing/signing an action). *See*: MPEP 2236.

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

8. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759 or Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

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MAILED
OCT 10 2006
CENTRAL REEXAMINATION UNIT

Daniel M. Cislo
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233 Wilshire Boulevard, Suite 900
Santa Monica, CA 90401

(Third Part Requester)

In re Berrian	:
Reexamination Proceeding	: **DECISION**
Control No.: 90/008,022	: **DISMISSING**
Filed: April 28, 2006	: **PETITON**
For: U.S. Patent No.: Re. 36,200	:

This is a decision on the September 25, 2006 third party requester paper entitled "PETITION TO EXPEDITE REEXAMINATION IN VIEW OF THE PATENT OWNER'S INTENTIONAL DELAY OF PROCEEDINGS AND REQUEST THAT THE PATENT OWNER FORFEIT ANY RIGHT TO FILE A PATENT OWNER'S STATEMENT; STATEMENT OF FACTS BY THE REEXAMINATION REQUESTOR IN SUPPORT THEREFOF."

The third party requester petition paper is before the Office of Patent Legal Administration.

The petition is dismissed.

The third party requester petition paper is an improper paper. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the third party requester. Thus, the present petition paper will be marked "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

BACKGROUND

1. Patent No. Re. 36,200 (the '200 patent) issued on April 27, 1999.

2. A request for reexamination, assigned Control No. 90/008,022 (the '8022 proceeding), was filed by a third party requester on April 28, 2006.

3. Reexamination was ordered in the '8022 reexamination proceeding on June 22, 2006.

4. The order mailed on June 22, 2006, was returned to the Office as undeliverable.

5. The order was remailed in the '8022 reexamination proceeding to the appropriate address on August 3, 2006.

6. On September 25, 2006, the third party requester filed the present petition paper, which is the subject of this decision.

DISCUSSION

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).

DECISION

I. The present petition is being "returned" to the requester, by closing the petition paper from the record.

As noted, *supra*, the present request for reexamination of the '200 patent was filed on April 28, 2006, and reexamination was ordered on June 22, 2006. Due to the June 22, 2006 mailing being to an undeliverable address, a supplemental mailing was effected on August 3, 2006, thereby extending the date for a patent owner's statement pursuant to 37 CFR 1.530 to October 3, 2006. The record does not reveal that the patent owner filed a statement prior to third party requester's filing of the present petition on September 25, 2006. 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 in which the patent owner was permitted to file a patent owner's statement expired October 3, 2006. No patent owner statement has been found to have been filed

in the present reexamination proceeding by October 3, 2006; thus, 37 CFR 1.535 prohibits the consideration of any further third party requester submission in this proceeding.

Further, the present petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, is not a reply to a patent owner's statement pursuant to 37 CFR 1.535, and 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.

In view of the above, the present petition does not have an entry right under the rules.

II. The petition is filed under 37 CFR 1.183; however, the rules cannot be waived to provide the third party requester the right to file a paper directed to how the Office should conduct the proceeding, or as to the patent owner's conduct.

Neither the rules nor any provision of the statute provide authority for a third party requester of a reexamination proceeding requested under 35 U.S.C. § 302 to file a paper directed to the issues and merits of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent are clear that the examination and prosecution in a reexamination proceeding requested under 35 U.S.C. § 302 must be *ex parte*. In the present instance, the third party requester has filed a petition discussing patent owner conduct and requesting that the Office take certain action in the proceeding based on same. The petition, therefore, attempts to convert the instant reexamination proceeding into other than an *ex parte* proceeding, at a point in the proceeding beyond which the active participation of the requester has ended. Thus, the petition seeks to go beyond the reexamination statute. Relief cannot, therefore, be provided.

The discussion and procedure proffered by the third party requester at this stage are precluded, since a reexamination proceeding requested under 35 U.S.C. 302 is an ***ex parte*** proceeding (after the expiration of the statement/reply period under 37 CFR §§ 1.530 and 1.535). The waiver/suspension of the rules requested in the present instance to permit the third party submission via the petition would not be justified in view of the legislation and implementing rules which make reexamination under 35 U.S.C. 302 - 307 an *ex parte* proceeding. See *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the Court said (paragraph bridging pages 1868 & 1869):

> "If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination. *See* 35 U.S.C. § 305 **("[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination")**. Thus, a reexamination is conducted *ex parte* after it is instituted. *See In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1 , 5-6 n.6 (Fed. Cir.), *cert.* denied, 474 U.S. 828 (1985)." [Emphasis added in bold]

To the extent that the requested relief requires waiver, pursuant to 37 CFR 1.183, of the rules barring entry of the petition, § 1.183 provides for waiver of a "requirement of the regulations... which is not a requirement of the statutes." In the present instance, the waiver requested would contravene the intent and content of the statute. Thus, the petition cannot be granted under 37 CFR 1.183. 37 CFR 1.182 provides for relief not addressed by the regulations, provided that such relief is within the statute. The petition cannot, therefore, be granted based upon 37 CFR 1.182.

In addition, the petition addresses matters other than patents and printed publications. As pointed out, the petition contains a discussion of the conduct of patent owner. Issues of conduct are not proper in *ex parte* reexamination proceedings, as 35 U.S.C. §§ 301-30 clearly limit *ex parte* reexamination proceedings to a consideration of prior art patents and printed publications. The petition requests consideration of matters that are outside of the Office's jurisdiction to conduct reexamination proceedings created by the statute. On this independent basis alone, the third party requester petition cannot be considered and the request relief cannot be granted pursuant to 37 CFR 1.183.

Accordingly, the petition is dismissed.

As a final point, it is noted that the requested relief to eliminate or reduce the patent owner's time to file a statement appears to be moot, as the period for filing the statement has expired as pointed out above, without the filing of a patent owner's statement.

III. In view of the above, the present petition will not be retained of record in the reexamination file, and it is being "returned" to the third party requester ***without consideration of the substance of the petition***. Because the present reexamination proceeding is contained in an electronic Image File Wrapper (IFW) and the present petition has been scanned into the IFW, the petition paper cannot be physically returned to the third party requester. However, the present petition paper will be marked "closed" and "non-public", and will not constitute part of the record of the present reexamination proceeding. The present decision will be made of record in the reexamination file. See also MPEP 2267.

CONCLUSION

1. The petition is dismissed.

2. The petition paper filed by the third party requester on September 25, 2006 is being "returned" to the third party requester with this decision as not having an entry right. The "return" will take the form of closing the petition document in the IFW file of the '8022 *ex parte* reexamination proceeding and marking the document "not public."

3. No copy of the petition papers will be maintained of record in the electronic Image File Wrapper for the proceeding, 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 M. 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

October 10, 2006
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