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(For Patent Owner)

ROBERT C. LAURENSON
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IRVINE, CA 92614

(For Third Party Requester)

MAILED

SEP 19 2006

CENTRAL REEXAMINATION UNIT

In re Broadcom Corporation
Ex Parte Reexamination Proceeding
Control No.: 90/008,033
Filed: May 22, 2006
For: U.S. Patent No. 5,425,051

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

This is a decision on the August 16, 2006 third party requester petition entitled "PETITION TO DIRECTOR UNDER 37 CFR 1.181."

The third party requester petition and the present record are before the Office of Patent Legal Administration for consideration.

The third party requester petition is dismissed for the reasons set forth below.

FEES

No fee is required for a petition filed under the provisions of 37 CFR 1.181.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,425,051 (the '051 patent) issued to Ronald L. Mahany on June 13, 1995, and is currently assigned to Broadcom Corporation.

2. On May 18, 2005, the patent owner filed suit against Qualcomm Incorporated in the United States District Court for the Central District of California. *Broadcom Corporation v Qualcomm Incorporated,* C.A. No. 8:05CV00467 (May 18, 2005).

3. A request for *ex parte* reexamination of the '051 patent was filed by a third party requester, Qualcomm Incorporated, on May 22, 2006. The request was assigned Control No. 90/008,033 (the '033 *ex parte* reexamination proceeding) and a filing date of May 22, 2005.

4. In the May 22, 2006 request for *ex parte* reexamination of the '051 patent, third party requester requested reexamination of claims 1, 5, 6 and 10 of the '051 patent.

5. In the May 22, 2006 request for *ex parte* reexamination of the '051 patent, third party requester alleged that a substantial new question of patentability (SNQ) existed for claims 1, 5, 6 and 10 of the '051 patent based upon a Fischer *et al* publication, a Dixon publication and United States Patent No. 4,984,247 to Kaufmann *et al* (the Kaufmann patent).

6. Reexamination was ordered for the '033 *ex parte* reexamination proceeding on July 27, 2006 based upon the existence of an SNQ for claims 1, 5, 6 and 10 of the '051 patent. [1]

7. The July 27, 2006 order granting *ex parte* reexamination reflected the Primary Examiner's determination that the Dixon publication and the Fischer et al publication raised a substantial new question of patentability for claims 1, 5, 6 and 10 of the '051 patent. [2]

8. The July 27, 2006 order granting *ex parte* reexamination also set forth the Primary Examiner's determination that the Kaufmann patent did not raise an SNQ for any of claims 1, 5, 6 and 10 of the '051 patent. The Primary Examiner held that "[T]he Kaufmann reference was previously cited, considered and applied by the Examiner to the instant claims under reexamination. Thus any question of patentability raised solely by the Kaufmann reference is not new." [3]

9. There has been no further action by the Office on the '033 *ex parte* reexamination proceeding.

12. On August 16, 2006, third party requester filed the present petition.

RELEVANT STATUTES, REGULATIONS AND PROCEDURE

35 U.S.C. § 303 provides:

> "(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.
> (b) A record of the Director's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.
> (c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title."

---

[1] Order Granting Request for *Ex Parte* Reexamination, July 27, 2006.
[2] *Id.*, at page 2, paragraph 8
[3] *Id.*, at page 3, paragraph 9.

37 CFR 1.515(c) provides:

> "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." [Emphasis supplied.]

MPEP § 2248 provides in pertinent part:

> "The requester may seek review of a *denial* of a request for reexamination only by petitioning the Director of the USPTO under 37 CFR 1.515(c) and 1.181 within 1 month of the mailing date of the decision denying the request for reexamination. Additionally, any request for an extension of the time period to file such a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR 1.183 with appropriate fee to waive the time provisions of 37 CFR 1.515(c). [Emphasis in the original.]
>
> ...
>
> **37 CFR 1.515(c) applies only where reexamination is denied; it does not apply to a grant of reexamination where either the patent owner or the requester is not satisfied with one or more findings made in a decision granting reexamination.** Except for the limited exception described in MPEP § 2246, no petition may be filed requesting review of a decision granting a request for reexamination, even if the decision grants the request for reasons other than those advanced by the requester or as to claims other than those for which the requester sought reexamination. No right to review exists if reexamination is ordered in such a case because all claims will be reexamined in view of all prior art during the reexamination under 37 CFR 1.550." [Emphasis added.]

DECISION

In the present third party requester petition, third party requester asks that the Primary Examiner's holding that the Kaufmann patent does not raise an SNQ for claims 1, 5, 6 and 10 of the '051 patent be reversed. Alternatively, third party requester asks that the Order Granting Reexamination be vacated and remanded for reconsideration in light of third party requester's analysis of the "correct legal standard" for determining the existence of an SNQ.

Petitioner's requested relief cannot be granted. 35 U.S.C. § 303(c) is directed to a finding by the Office that "no" substantial new question of patentability has been raised. 37 CFR 1.515(c) implements 35 U.S.C. § 303(c). [4] The regulation provides that a third party requester may file a petition seeking review only with respect to an "examiner's determination refusing *ex parte* reexamination." As explained in MPEP § 2248, there is no provision in the regulations that permits a third party requester to seek review of one or more findings made by an examiner in an examiner's order that otherwise grants *ex parte* reexamination.

A review of the record shows that the Primary Examiner did <u>not</u> deny or refuse the request for *ex parte* reexamination filed on May 22, 2006 as to any claim; rather, reexamination was granted as to all of requested claims 1, 5, 6 and 10. Stated differently, the Primary Examiner's Order did not find that the request for *ex parte* reexamination failed to raise a substantial new question of patentability as to any of the requested claims. Rather, the request for *ex parte* reexamination was granted as to all requested claims, based upon the existence of a SNQ raised as to each claim requested.

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[4] 37 CFR 1.515(c) provides a petition right for review of an examiner's decision to deny a request for *ex parte* reexamination. The decision on petition will result in a final nonappealable decision by the USPTO Director to order *ex parte* reexamination of to deny *ex parte* reexamination, thereby implementing the provision of 35 U.S.C. §303(c).

Accordingly, the relief requested in the present third party requester petition is not provided for in the reexamination statutes, regulations, or practice. The requested relief is not a request to review a refusal to order reexamination based upon the failure of the request for *ex parte* reexamination to establish the existence of any SNQ for a requested claim. Rather, the requested relief is simply a request to review a finding within the Primary Examiner's Order Granting *Ex Parte* Reexamination, as to one of the references, with which the third party requester is dissatisfied. As there is no provision for such review in the reexamination statutes, or in the regulations implementing the reexamination statutes, the present third party petition cannot be granted.

ADDITIONAL DISCUSSION

I. Further Discussion Regarding The Kaufmann Patent

Each of the requested claims will now be given an examination, and the examiner may apply any prior art appropriate to rejection of the claims. When the Primary Examiner begins examination of claims 1, 5, 6 and 10 on the issue of whether these claims are patentable, the Primary Examiner will have the ability to again review the prosecution history of the Kaufmann patent. If such review shows that the Kaufmann patent may, when viewed in a new light, [5] then the patent would be eligible for application, by itself, against any of the original (non-amended) patent claims that are being reexamined. [6] The Kaufmann patent would also be eligible for application, by itself, against amended patent claims or newly presented claims, as well as being eligible for application against any claim if considered together with prior art that was not discussed or considered on the record. [7]

In light of the fact that the '051 patent is currently involved in litigation, the examiner should clarify the record by expressly setting forth the rationale for considering the Kaufmann patent to be, or not to be, eligible for application against any of the original (non-amended) patent claims.

With regard to the examiner's final determination as to whether the Kaufmann patent is applied, the *ex parte* reexamination statute does not provide the requester with any further rights in commenting on the examiner's decisions in the examination stage of the proceeding. In the event that examiner fails to apply Kaufmann, the requester is free to file a further request for *ex parte* reexamination directed solely to Kaufmann, providing new information as to why that reference is being viewed in a new light, [8] despite its previous citation, consideration and application by the Examiner to the claims under reexamination.

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[5] A comparison of the discussion of the Kaufmann patent in the Request for Reexamination filed May 22, 2006 with the manner in which the Kaufmann patent was discussed and applied during the prosecution of the patent applications resulting in the issuance of the Kaufmann patent may or may not indicate that the analysis set forth in the request for reexamination viewed the Kaufmann patent in a new light. See also *Ex parte Chicago Rawhide Manufacturing Company*, 1984 Pat. App. LEXIS 22, 223 USPQ 351 (Appeal No. 552-5 BPAI 1984)

[6] See 35 U.S.C. 303(a), last sentence.

[7] See *In re Hiniker*, 150 F.3d 1362, 1367 (Fed. Cir. 1998). See also MPEP § 2258.01

[8] Again, see *Ex parte Chicago Rawhide Manufacturing Company*, 1984 Pat. App. LEXIS 22, 223 USPQ 351 (Appeal No. 552-5 BPAI 1984)

II. Additional Prosecution In The Present Reexamination Proceeding

It is noted that the patent owner and third party requester are adverse parties with respect to the present *ex parte* reexamination proceeding, and are currently engaged in litigation involving the underlying patent. The parties are reminded that an *ex parte* reexamination proceeding is an administrative proceeding conducted within, and under the regulations promulgated by, the Office. *Ex parte* reexamination proceedings are not district court litigation. While counsel should represent the respective parties zealously, and are entitled to benefit of all of the regulations implementing the *ex parte* reexamination statutes and the examining practice promulgated with respect to those regulations, counsel for parties are reminded of their ongoing obligations to the Office as set forth in Part 10 of Title 37 of the Code of Federal Regulations. In particular, the provisions of 37 CFR 10.18(b)(2) and (c) should be noted. In addition, the submission of duplicative and extraneous materials (as, for example, copies Office actions and references already part of the record), serves to greatly increase the handling of papers within the Office, resulting in a delay of the proceedings in the Office, and may tend to obfuscate the record and the substantive consideration thereof. Adherence to the provisions of Part 10, and the filing of only those papers that are necessary and not previously of record in the IFW of the '033 *ex parte* reexamination proceeding, will greatly assist the Office in conducting this *ex parte* reexamination proceeding with special dispatch, as is required by 35 U.S.C. § 305.

CONCLUSION

1. The third party petition filed on August 16, 2006 is dismissed as to the relief requested.

2. Jurisdiction over the '033 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit.

3. Telephone inquiries related to the present 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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September 1, 2006

9-15-06
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,033	05/22/2006	5425051	05920.0041.RXUS01	8062

7590 01/31/2007

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2007

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

1/31/07

ROBERT C. LAURENSON
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IRVINE, CA 92614

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008033
PATENT NO. 5,425,051
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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William M. Wesley MCANDREWS, HELD & MALLOY, LTD 500 West Madison Street, 34th Floor Chicago, IL 60661	(for patent owner)
Robert C. Laurenson HOWREY LLP 2020 Main Street, Suite 1000 Irvine, CA 92614	(for requestor)
In re MAHANY Reexamination Proceeding Control No. 90/008,034 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	DECISION MERGING REEXAMINATION PROCEEDINGS
In re MAHANY Reexamination Proceeding Control No. 90/008,033 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	
In re MAHANY Reexamination Proceeding Control No. 90/008,108 Filed: July 18, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	

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

BACKGROUND

1. Patent No. 5,425,051 issued on June 13, 1995.

2. A first request for reexamination, Reexamination Control No. 90/008,033, was filed by the third party requester on May 22, 2006. This request was directed to claims 1, 5, 6, and 10.

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. A request for reexamination, Reexamination Control No. 90/008,034, was filed by the third party requester on May 22, 2006. This request was directed to claims 24 and 26-28.

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. A request for reexamination, Reexamination Control No. 90/008,108, was filed by the same third party requestor on July 18, 2006. This request was directed to claims 24 and 26-28.

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. <u>Merger of Proceedings</u>.

In accordance with 37 C.F.R. § 1.565(c), the '8033, '8034 and '8018 reexamination proceedings are <u>merged</u>. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/008,033; 90/008,034 and 90/008,108 are merged. Since there are no amendments to any of the above proceedings a housekeeping amendment/response is not required from the Patent Owner for the proceedings

Patent owner is required to maintain the same claims and specification in all files.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

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

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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FEB 12 2007

CENTRAL REEXAMINATION UNIT

William M. Wesley MCANDREWS, HELD & MALLOY, LTD 500 West Madison Street, 34th Floor Chicago, IL 60661	(for patent owner)
Robert C. Laurenson HOWREY LLP 2020 Main Street, Suite 1000 Irvine, CA 92614	(for requestor)
In re MAHANY Reexamination Proceeding Control No. 90/008,034 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	*SUA SPONTE* DECISION MERGING REEXAMINATION PROCEEDINGS
In re MAHANY Reexamination Proceeding Control No. 90/008,033 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	
In re MAHANY Reexamination Proceeding Control No. 90/008,108 Filed: July 18, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	

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

BACKGROUND

1. Patent No. 5,425,051 issued on June 13, 1995.

2. A first request for reexamination, Reexamination Control No. 90/008,033, was filed by the third party requester on May 22, 2006. This request was directed to claims 1, 5, 6, and 10.

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. A request for reexamination, Reexamination Control No. 90/008,034, was filed by the third party requester on May 22, 2006. This request was directed to claims 24 and 26-28.

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. A request for reexamination, Reexamination Control No. 90/008,108, was filed by the same third party requestor on July 18, 2006. This request was directed to claims 24 and 26-28.

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8033, '8034 and '8018 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/008,033; 90/008,034 and 90/008,108 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

Patent owner is required to maintain the same claims and specification in all files.

All correspondence regarding these proceedings should be submitted as follows:

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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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,033	05/22/2006	5425051	05920.0041.RXUS01	8062

23446 7590 08/22/2008

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EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,034	05/22/2006	5425051	05920.0041.RXUS00	8332

23446 7590 08/22/2008

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EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,108	07/18/2006	5425051		2404

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
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EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,102	04/02/2008	5,425,051		6470

23446 7590 08/22/2008

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CHICAGO, IL 60661

EXAMINER

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CENTRAL REEXAMINATION UNIT

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Chicago, IL 60661

(For Patent Owner)

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 Mahany
Reexamination Proceeding
Control No. 90/008,033
Request Deposited: May 22, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/008,034
Request Deposited: May 22, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/008,108
Request Deposited: July 18, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/009,102
Request Deposited: April 2, 2008
For: U.S. Patent No. 5,425,051

DECISION *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,425,051 (hereinafter, the '051 patent), issued to Mahany, on June 13, 1995.

2. A first request for reexamination was filed by a third-party requester on May 22, 2006 and assigned Control No. 90/008,033 ("the '8033 reexamination proceeding").

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. On May 22, 2006, a second request for reexamination of the '051 patent was filed by a third-party requester, and was assigned Control No. 90/008,034 ("the '8034 reexamination proceeding).

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. On July 18, 2006, a third request for reexamination of the '051 patent was filed by a third-party requester. The request was assigned Control No. 90/008,108 ("the '8108 reexamination proceeding).

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

8. The '8033, '8034 and '8018 reexamination proceedings were merged into a single, combined reexamination proceeding on February 12, 2007.

9. A Non-final action on the merits was issued for the merged reexamination on December 7, 2007.

10. Patent owner timely filed a reply to the Non-final office action for the merged reexamination proceeding on February 5, 2008. Said reply included an amendment.

11. A fourth request for reexamination of the '051 patent was filed on April 2, 2008, by a third-party requester. The request was assigned Control No. 90/009,102 ("the '9102 proceeding").

12. Reexamination was ordered in the '9102 reexamination proceeding on June 30, 2008.

13. Patent Owner filed a statement waiving the right to file a Patent Owner's Statement on August 19, 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 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 '8033, '8034, '8108 and the '9102 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, the claims have been amended in the '8033, '8034, and '8108 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in quadruplicate, 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. 90/008,033, 90/008,034, 90/008,108, and 90/009,102 are **merged**.

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

3. Responses may be submitted via EFS or as follows:

By fax:	(571) 273-9900 Central Reexamination Unit
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

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.
90/008,034	05/22/2006	5425051	05920.0041.RXUS00	8332

7590 01/31/2007

WILLIAM M. WESLEY
MCANDREWS,HELD & MALLOY, LTD.
500 WEST MADISON STREET., 34TH FLOOR
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

1/31/07

ROBERT C. LAURENSON
HOWREY LLP
2020 MAIN STREET SUITE 1000
IRVINE, CA 92614

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008034
PATENT NO. 5,425,051
ART UNI 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JAN 31 2007

CENTRAL REEXAMINATION UNIT

William M. Wesley
MCANDREWS, HELD & MALLOY, LTD
500 West Madison Street, 34th Floor
Chicago, IL 60661

(for patent owner)

Robert C. Laurenson
HOWREY LLP
2020 Main Street, Suite 1000
Irvine, CA 92614

(for requestor)

In re MAHANY
Reexamination Proceeding
Control No. 90/008,034
Filed: May 22, 2006
Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**

In re MAHANY
Reexamination Proceeding
Control No. 90/008,033
Filed: May 22, 2006
Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**

In re MAHANY
Reexamination Proceeding
Control No. 90/008,108
Filed: July 18, 2006
Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**

DECISION MERGING REEXAMINATION PROCEEDINGS

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

BACKGROUND

1. Patent No. 5,425,051 issued on June 13, 1995.

2. A first request for reexamination, Reexamination Control No. 90/008,033, was filed by the third party requester on May 22, 2006. This request was directed to claims 1, 5, 6, and 10.

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. A request for reexamination, Reexamination Control No. 90/008,034, was filed by the third party requester on May 22, 2006. This request was directed to claims 24 and 26-28.

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. A request for reexamination, Reexamination Control No. 90/008,108, was filed by the same third party requestor on July 18, 2006. This request was directed to claims 24 and 26-28.

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8033, '8034 and '8018 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/008,033; 90/008,034 and 90/008,108 are merged. Since there are no amendments to any of the above proceedings a housekeeping amendment/response is not required from the Patent Owner for the proceedings

Patent owner is required to maintain the same claims and specification in all files.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

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

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William M. Wesley MCANDREWS, HELD & MALLOY, LTD 500 West Madison Street, 34th Floor Chicago, IL 60661	(for patent owner)
Robert C. Laurenson HOWREY LLP 2020 Main Street, Suite 1000 Irvine, CA 92614	(for requestor)
In re MAHANY Reexamination Proceeding Control No. 90/008,034 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	*SUA SPONTE* DECISION MERGING REEXAMINATION PROCEEDINGS
In re MAHANY Reexamination Proceeding Control No. 90/008,033 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	
In re MAHANY Reexamination Proceeding Control No. 90/008,108 Filed: July 18, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	

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

BACKGROUND

1. Patent No. 5,425,051 issued on June 13, 1995.

2. A first request for reexamination, Reexamination Control No. 90/008,033, was filed by the third party requester on May 22, 2006. This request was directed to claims 1, 5, 6, and 10.

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. A request for reexamination, Reexamination Control No. 90/008,034, was filed by the third party requester on May 22, 2006. This request was directed to claims 24 and 26-28.

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. A request for reexamination, Reexamination Control No. 90/008,108, was filed by the same third party requestor on July 18, 2006. This request was directed to claims 24 and 26-28.

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. <u>Merger of Proceedings</u>.

In accordance with 37 C.F.R. § 1.565(c), the '8033, '8034 and '8018 reexamination proceedings are <u>merged</u>. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/008,033; 90/008,034 and 90/008,108 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

Patent owner is required to maintain the same claims and specification in all files.

All correspondence regarding these proceedings should be submitted as follows:

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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, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

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

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,034	05/22/2006	5425051	05920.0041.RXUS00	8332

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,033	05/22/2006	5425051	05920.0041.RXUS01	8062

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,108	07/18/2006	5425051		2404

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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

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United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,102	04/02/2008	5,425,051		6470

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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

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AUG 22 2008

CENTRAL REEXAMINATION UNIT

McAndrews, Held & Malloy, Ltd.
500 W. Madison St., Ste. 3400
Chicago, IL 60661

(For Patent Owner)

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 Mahany
Reexamination Proceeding
Control No. 90/008,033
Request Deposited: May 22, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/008,034
Request Deposited: May 22, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/008,108
Request Deposited: July 18, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/009,102
Request Deposited: April 2, 2008
For: U.S. Patent No. 5,425,051

DECISION *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,425,051 (hereinafter, the '051 patent), issued to Mahany, on June 13, 1995.

2. A first request for reexamination was filed by a third-party requester on May 22, 2006 and assigned Control No. 90/008,033 ("the '8033 reexamination proceeding").

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. On May 22, 2006, a second request for reexamination of the '051 patent was filed by a third-party requester, and was assigned Control No. 90/008,034 ("the '8034 reexamination proceeding).

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. On July 18, 2006, a third request for reexamination of the '051 patent was filed by a third-party requester. The request was assigned Control No. 90/008,108 ("the '8108 reexamination proceeding).

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

8. The '8033, '8034 and '8018 reexamination proceedings were merged into a single, combined reexamination proceeding on February 12, 2007.

9. A Non-final action on the merits was issued for the merged reexamination on December 7, 2007.

10. Patent owner timely filed a reply to the Non-final office action for the merged reexamination proceeding on February 5, 2008. Said reply included an amendment.

11. A fourth request for reexamination of the '051 patent was filed on April 2, 2008, by a third-party requester. The request was assigned Control No. 90/009,102 ("the '9102 proceeding").

12. Reexamination was ordered in the '9102 reexamination proceeding on June 30, 2008.

13. Patent Owner filed a statement waiving the right to file a Patent Owner's Statement on August 19, 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 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 '8033, '8034, '8108 and the '9102 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, the claims have been amended in the '8033, '8034, and '8108 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in quadruplicate, 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. 90/008,033, 90/008,034, 90/008,108, and 90/009,102 are **merged**.

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

3. Responses may be submitted via EFS or as follows:

By fax:	(571) 273-9900 Central Reexamination Unit
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

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Quarles & Brady LLP
Firstar Plaza, One South Pinckney Street
P.O. Box 2113, Suite 600
Madison, WI 53701-2113

(For Patent Owner)

MAILED

FEB 12 2007

CENTRAL REEXAMINATION UNIT

In re Raines
Reexamination Proceeding
Control No. 90/008,037
Filed: May 30, 2006
For: U.S. Patent No. 5,973,112

DECISION GRANTING PETITION

This is a decision on the February 7, 2007 patent owner PETITION UNDER 37 C.F.R. §§ 1.181 or 1.182 (A DECISION ON A QUESTION NOT SPECIFICALLY PROVIDED FOR BY THE RULES) requesting entry and consideration of an amendment filed subsequent to the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed January 26, 2007. The petition was supplemented by a filing on February 8, 2007.

The rules do not provide for an amendment to be filed in a reexamination proceeding after prosecution of the proceeding has been terminated. [1] Accordingly, any amendment filed after prosecution has been terminated by the issuance of a NIRC must be accompanied by a petition under 37 CFR 1.182 [2] to have the amendment considered. See MPEP 2287. Therefore, the present PETITION UNDER 37 C.F.R. §§ 1.181 or 1.182 is taken as a petition under 37 CFR 1.182.

---

[1] The provisions of 37 CFR 1.312 do not apply in reexamination.

[2] 37 CFR 1.182 states:
"All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f)."

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to petitioner's Deposit Account No. 17-0055, in accordance with petitioner's authorization on the last page of the instant petition.

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

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,973,112 (the '112 patent) issued to Raines on October 26, 1999.

2. On May 30, 2006, a request for reexamination of the '112 patent was filed by patent owner, and was assigned Control No. 90/008,037 (the '8037 proceeding).

3. On July 17, 2006, reexamination was ordered for the '8037 proceeding.

4. The prosecution and examination has progressed for the '8037 proceeding to the point where a Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed on January 26, 2007.

9. On February 7, 2007, the patent owner filed the present PETITION UNDER 37 C.F.R. §§ 1.181 or 1.182, requesting entry and consideration of an amendment filed subsequent to the NIRC. The petition was supplemented on February 8, 2007.

DECISION

Petitioner proposes to amend the claims by cancelling patent claim 9 as a duplicate of patent claim 8, and replacing it with new claim 12 to depend from claim 10. Also included are claim revisions requested by the examiner, Gary Kunz, in a telephone interview which was conducted on February 7, 2007, between the examiner and patent owner's counsel, Sara D. Vinarov.

The examiner has indicated that the amendment does not raise any substantive new issues, and will serve to correct an Office error which occurred during the original prosecution of the '112 patent. Based upon the facts and circumstances of this proceeding, the petition is being granted.

The amendment:

The proposed amendment which accompanied the present original petition is not in conformance with the amendment format for reexamination proceedings, which is set forth in 37 CFR 1.530. For example, new claim 12 was not underlined. Accordingly, the undersigned telephoned patent owner's counsel, and discussed re-submission of the amendment with her. The petition was supplemented on February 8, 2007 by a re-submission of the amendment.

In the February 8, 2007 re-submission of the amendment, "Insert new claim 12" has been added before the presentation of the claim, and the addition initialed and dated by the undersigned. In addition, it is noted that the re-submission reproduces the May 30, 2006 amendment of claim 6. Finally, it is not clear from the record why claims 3 and 10 need to be represented as original claims. The provisions of 37 CFR 1.530 are hereby waived to permit entry of the February 8, 2007 re-submission of the amendment, to facilitate addressing the changes made with special dispatch, as is required by statute. However, the examiner is directed to carefully review the amendment for compliance with 37 CFR 1.530, upon return of jurisdiction the proceeding to the examiner.

CONCLUSION

1. The petition is **GRANTED**.

2. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for consideration of the proposed amendment and either the reopening of prosecution or the issuance of a supplemental NIRC.

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

February 9, 2007
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C:\kiva\kenpet6\8037_1.182-amdt-after-NIRC-grnt.wpd

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,040	06/08/2006	4934831	060191RE	3899

757 7590 06/12/2008

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/12/2008

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
MARK G. KNEDEISEN
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP
535 SMITHFIELD STREET
PITTSBURGH, PA 15222

Date:
MAILED
JUN 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008040
PATENT NO. : 4934831
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.
90/008,904	10/26/2007	4934831	060191RE2	9847

757 7590 06/12/2008

BRINKS HOFER GILSON & LIONE
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/12/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Mark G. Knedeisen
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535 Smithfield Street, Henry W. Oliver Bldg.
Pittsburgh, PA 15222-2312

Date:
MAILED
JUN 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008904
PATENT NO. : 4934831
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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BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO IL 60610	:	(For Patent Owner)
KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP Attn: MARK KNEDEISEN 535 SMITHFIELD STREET PITTSBURGH, PA 15222	:	(For Third Party Requester)
	:	DECISION, *SUA SPONTE,* MERGING REEXAMINATION PROCEEDINGS PURSUANT TO 37 C.F.R. § 1.565(c)
In re: Volbrecht *Ex Parte* Reexamination Proceeding Control No. 90/008,040 Deposited: 8 June 2006 For U.S. Patent No. 4,934,831	:	
In re: Volbrecht *Ex Parte* Reexamination Proceeding Control No. 90/008,904 Deposited: 26 October 2007 For U.S. Patent No. 4,934,831	:	

MAILED

JUN 12 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 90/008,040 and the reexamination control number 90/008,904 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 90/008,040 and 90/008,904 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

Patent owner is required to maintain the same claims and specification in 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. 90/008,040 and 90/008,904 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. 90/008,040 and 90/008,904 are **merged**.

2. The proceedings are thus returned to the examiner in charge of the proceedings for s 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
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, 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
SPE ~~SPRE~~-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica. Marquis,
Director,
Central Reexamination Unit

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APR 10 2008

CENTRAL REEXAMINATION UNIT

In re Patent No. 6971476
Issue Date :December 6, 2005
Appl No.: 90/008,045
Filed: June 02, 2006
For: Safety Harness

DECISION GRANTING PETITION
37 CFR 1.324

This is a decision on the petition filed June 2, 2006 to correct inventorship under 37 CFR 1.324.

The petition is granted.

The change of inventorship will be reflected in the reexamination certificate that will ultimately issue upon the conclusion of the instant reexamination proceedings.

Andres Kashnikow
Supervisory Patent Examiner
Central Reexam Art Unit 3993

IPLM GROUP, P.A.
POST OFFICE BOX 18455
MINNEAPOLIS, MN 55418

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.
90/008,049	05/31/2006	5407944	065401-0002	7409

38939 7590 02/16/2007

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2007

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Dykema Gossett PLLC
10 S. Wacker Dr., STE. 2300
Chicago, IL 60606

For Patent Owner

MAILED
FEB 16 2007
CENTRAL REEXAMINATION UNIT

In re Boris E. Goldman
Ex Parte Reexamination Proceeding
Control No. 90/008,049
Filed: May 31, 2006
For: US Patent No. 5,407,944

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

This is a decision on the Janary 18, 2007, Patent Owner "Request Under 37 CFR 1.550(c)" requesting that the time for responding to the Office action dated November 25, 2006 be extended by one month.

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

The Office action was remailed on January 25, 2007, which reset the period for response. The new period runs two months from the mailing date of January 25, 2007. Accordingly, the instant petition is **dismissed** as moot.

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

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,148	11/22/2006	6783054	18796/101795-00	5255

23329 7590 12/11/2007

KEAN, MILLER, HAWTHORNE, D'ARMOND,
MCCOWAN & JARMAN, L.L.P.
ONE AMERICAN PLACE, 22ND FLOOR
P.O. BOX 3513
BATON ROUGE, LA 70821

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2007

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,050	06/01/2006	6783054	16102-17	7407

23329 7590 12/11/2007

KEAN, MILLER, HAWTHORNE, D'ARMOND,
MCCOWAN & JARMAN, L.L.P.
ONE AMERICAN PLACE, 22ND FLOOR
P.O. BOX 3513
BATON ROUGE, LA 70821

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2007

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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Kean, Miller, Hawthorne
D'Armond, McCowan & Jarman, LLP
One American Place, 22nd Floor
Baton Rouge, LA 70809

(For Patent Owner)

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DEC 11 2007

CENTRAL REEXAMINATION UNIT

Jones Walker Waechter
Poitevant Carrere LLP
5th Floor Four United Plaza
8555 United Plz. Blvd.
Baton Rouge, LA 70809

(For *Inter Partes* Requester)

In re Pregeant, Jr. et al.
Ex parte Reexamination
Proceeding
Control No. 90/008,050
Filed: June 1, 2006
For: U.S. Patent No. 6,783,054

In re Weber et al.
Inter partes Reexamination
Proceeding
Control No. 95/000,148
Filed: November 22, 2006
For: U.S. Patent No. 6,784,054

DECISION 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 the time.

REVIEW OF THE FACTS

1. United States Patent Number 6,783,054 B1 issued August 31,2004.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/008,050 was filed June 1, 2006, by the patent owner.

3. A request for *inter partes* reexamination, assigned Reexamination Control Number 95/000,148 was filed November 22, 2006 by Safezone Safety Systems LLC, the real party in interest.

4. An order for reexamination of *ex partes* reexamination Control Number 90/008,050 was mailed on August 8, 2006.

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5. On On August 27, 2006, patent owner filed, in the '050 proceeding, filed a patent owner statement in response to the Office order.

6. On November 26, 2006 patent owner filed, in the '050 proceeding, a notice pursuant to 37 CFR 1.565(a) of the filing of the *inter partes* reexamination.

7. On July 10, 1006 and August 17, 2006 submitted requests for *inter partes* that were not granted because the requirements of 37 CFR 1.915 were not met. Requester filed a grantable *inter partes* reexamination on November 22, 2006.

7. On February, 16, 2007, the Office, in the '148 proceeding, mailed a order for *inter partes* reexamination.

8. On August 30, 2007 requester filed a status inquiry with the Office.

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. 90/008,050),a request for reexamination was filed by patent owner on June 1, 2006 and an order for reexamination was mailed on August 8, 2006. On November 26, 2006, the

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patent owner filed a statement in the *ex parte* reexamination pursuant to 37 CFR 1.565(a). An *inter partes* reexamination (Control No. 95/000,148) request was filed on November 22, 2006 and the order granting the reexamination was mailed on February 16, 2006. 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. 95/000,148) filed on August 17, 2006.[1] Accordingly, the two proceedings are ripe for a consolidated examination thereof.

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 95/000,148 and 90/008,050 reexamination proceedings **are merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*. If the claims in both files are not the same, a "housekeeping amendment" will be needed. If the claims are the same, a "housekeeping" amendment will not be needed. In the two proceedings, the claims are not the same and accordingly, a "housekeeping" amendment is necessary. On August 27, 2006 patent owner filed an amendment in reexamination proceeding control number 90/008,050. The patent owner has not amended the claims in reexamination proceeding control number 95/000,148. Accordingly, the claims are not the same in the two proceedings that are being merged.

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 of the *ex parte* reexamination 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

[1]It is noted that the notice of concurrent proceedings was filed with the August 17, 2006 request for *inter partes* reexamination that did not meet the requirements of 37 CFR 1.915.

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

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

By hand: **Customer Service Window**
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

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,

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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. 95/000,148 and *ex parte* Reexamination Control No. 90/008,050 are *sua sponte* merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

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

3. The examiner should not issue an office action for the present merged proceeding until after the earlier of :(a) the submission of the required 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.

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4. 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

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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.
90/008,050	06/01/2006	6783054	16102-17	7407

23329 7590 12/02/2008

KEAN, MILLER, HAWTHORNE, D'ARMOND,
MCCOWAN & JARMAN, L.L.P.
ONE AMERICAN PLACE, 22ND FLOOR
P.O. BOX 3513
BATON ROUGE, LA 70821

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ART UNIT	PAPER NUMBER

DATE MAILED: 12/02/2008

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

Kean, Miller, Hawthorne, D'Armond, McCowan & Jarman, LLP
One American Place, 22nd Floor
Baton Rouge, LA 70809

(For Patent Owner)

Jones Walker Waechter Poitevant Carrere LLP
5th Floor Four United Plaza
8555 United Plaza Blvd.
Baton Rouge, LA 70809

(For Third Party Requester)

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DEC 02 2008

CENTRAL REEXAMINATION UNIT

In re *Ex Parte* Reexamination Proceeding	:	
Control No. 90/008,050	:	
Filed: June 1, 2006	:	DECISION
For: U.S. Patent No. 6,783,054	:	DISMISSING
	:	PETITION
In re *Inter Partes* Reexamination Proceeding	:	
Control No. 95/000,148	:	
Filed: November 22, 2006	:	
For: U.S. Patent No. 6,784,054	:	

This is a decision addressing the October 10, 2008 third party requester paper entitled "Request to Reconsider" and the October 27, 2008 third party requester petition entitled "Petition to the Director." This decision also considers the November 24, 2008 patent owner opposition paper pursuant to 37 CFR 1.183.

The above described requester and patent owner papers, *ex parte* reexamination control number 90/008,050 and *inter partes* reexamination control number 95/000,148 are before the Office of Patent Legal Administration for decision on the requester petition.

Summary: The third party papers have been carefully considered. The relief requested in the third party requester petition is granted to the extent that the October 10, 2008 and October 27, 2008 papers have been considered Office decision, but the underlying relief requested in the October 10, 2008 "Request" and the October 27, 2008 "Petition" is dismissed.

FEES

Petitioner third party requester has filed the October 27, 2008 petition pursuant to 37 CFR 37 CFR 1.181 and 1.182. The $400.00 fee for a petition under 37 CFR 1.182 that is

established by 37 CFR 1.17(f) has been charged to Deposit Account No. 50-1896 as authorized as authorized by third party requester, and will also serve to support consideration of the requester petition under 37 CFR 1.183. Patent owner has authorized a charge against Deposit Account No. 11-2045 of the $400.00 fee for its opposition paper, which paper will also be considered under 37 CFR 1.182 and 1.183.

REVIEW OF FACTS

1. United States Patent Number 6,783,054 ("the '054 patent) issued on August 31, 2004.

2. A request for *ex parte* reexamination of the '054 patent, was filed on June 1, 2006 by the patent owner, and assigned reexamination control No. 90/008,050 ("the '050 *ex parte* reexamination proceeding").

3. A request for *inter partes* reexamination of the '054 patent was deposited on July 10, 2006 by a third party requester, naming Safezone Safety Systems LLC as the real party in interest, and was assigned Reexamination Control Number 95/000,148 (the '148 *inter partes* reexamination proceeding). Papers filed by the *inter partes* reexamination requester on behalf of the real party in interest will hereinafter be referred to as having been filed by "requester."

4. On August 8, 2006, an order for reexamination was mailed in the '050 *ex parte* reexamination proceeding.

5. On August 10, 2006, a Notice was mailed in the '148 *inter partes* reexamination proceeding notifying requester that the July 10, 2006 request papers were not entitled to a filing date.

6. On August 17, 2006, requester filed corrected request papers for the '148 *inter partes* reexamination proceeding, and the correct papers were accorded a filing date of August 17, 2006.

7. On August 27, 2006, patent owner filed, in the '050 *ex parte* reexamination proceeding, a patent owner statement in response to the Office order.

8. On October 17, 2006, the Office mailed a Notice vacating the August 17, 2006 filing date of the '148 *inter partes* reexamination proceeding based upon a discovery of defects in the corrected request papers filed on August 17, 2006.

9. On November 22, 2006, second corrective request papers were deposited in the '148 *inter partes* reexamination proceeding, and proceeding was accorded a filing date of November 22, 2006.

10. On November 26, 2006, patent owner filed, in the '050 *ex parte* reexamination proceeding, a notice pursuant to 37 CFR 1.565(a) of the filing of the *inter partes* reexamination.

11. On February, 16, 2007, the Office mailed, in the '148 *inter partes* proceeding, an order for *inter partes* reexamination.

12. On December 11, 2007, the Office mailed a Decision ("the merger decision") that, *sua sponte*, merged the '050 *ex parte* reexamination proceeding and '148 *inter partes* reexamination proceedings into a single combined proceeding to be conducted in accordance with the rules governing the prosecution of an *inter partes* reexamination proceeding. The merger decision required a housekeeping amendment, to place the same amendments in both of the merged proceedings.

13. On January 10, 2008 patent owner filed a housekeeping amendment as required by the merger decision. In that amendment, patent owner canceled patent claims 2, 3, 6, 8 and 13-17, and amended patent claims 1, 5, 7 and 18.

14. On April 9, 2008, the Office mailed a non-final Office action in the merged proceeding. In the Office action, claims 1 and 4-5 were found patentable, while claims 7, 9-12 and 18 were rejected as being unpatentable. Patent Owner was provided with a period of two months in which to file a response to the April 9, 2008 Office action. Patent Owner did not file any response to the non-final Office action

15. On June 24, 2008, requester filed a paper entitled "Request," asking for relief in the form of withdrawal of the April 9, 2008 Office action in the merged proceeding, and that a period of time be set to allow requester to submit a response to the Patent Owner's statement in the *ex parte* reexamination proceeding pursuant to 37 CFR 1.530.

16. On August 27, 2008, the Office issued a decision refusing the relief requested by the third party requester, and also expunging the June 24, 2008 "Request" from the record as being an unauthorized and improper paper.

17. On September 3, 2008, the Office mailed an Action Closing Prosecution ("ACP") in the merged reexamination proceeding.

18. On October 10, 2008, requester filed the present paper entitled "Request to Reconsider" seeking review and reversal of the August 27, 2008 decision.

19. On October 27, 2008, requester filed the present petition.

20. On November 24, 2008, patent owner filed the present opposition paper.

RELEVANT AUTHORITY

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments

addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

35 U.S.C. § 315(b) and (c) provide:

THIRD-PARTY REQUESTER.— A third-party requester—

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

(c) CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.510(e) provides:

A request filed by the patent owner may include a proposed amendment in accordance with § 1.530.

37 CFR 1.530 provides, in part:

(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, and it will be returned or discarded (at the Office's option).

...

(d) Making amendments in a reexamination proceeding. A proposed amendment in an *ex parte* or an *inter partes* reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with § 1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted, during the prosecution of the reexamination proceeding pursuant to § 1.550(a) or § 1.937.

...

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183 provides:

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

37 CFR 1.947 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 1.951 provides:

(a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

37 CFR 1.953 provides:

(a) Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an *inter partes* reexamination, or upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice, unless the examiner reopens prosecution and issues another Office action on the merits.

(b) Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an *inter partes* reexamination, the patent owner and all third party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third party requesters present in the proceeding and must identify all of the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued.

(c) The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the *inter partes* reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate under § 1.997 in accordance with the Right of Appeal Notice.

37 CFR 1.957(c) provides:

If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

37 CFR 1.989(b) provides:

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.

37 CFR 1.995 provides:

When a third party requester is involved in one or more proceedings, including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve the third party requester's right to participate to the extent specifically provided for in these regulations. In merged proceedings involving different requesters, any paper filed by one party in the merged proceeding shall be served on all other parties of the merged proceeding.

37 CFR 41.61(a)(2) provides:

Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, **including** any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

37 CFR 41.67(c)(1)(vi) provides:

(vi) Issues to be reviewed on appeal. A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. [Emphasis added.]

DECISION

I. Synopsis of Prosecution of the Reexamination Proceedings

Patent owner filed a request for *ex parte* reexamination of the '054 patent on June 1, 2006. An order granting reexamination of claims 1-18 of the '054 patent, (*i.e.*, all of the patent claims), was mailed on August 8, 2006. As permitted by 37 CFR 1.530(a), patent owner filed a patent owner's statement pursuant to on August 27, 2008. As permitted by 37 CFR 1.530(d), patent owner also filed an amendment on August 27, 2008 in which patent claims 1, 5, 7 and 18 were amended and patent claims 2, 3, 6, 8 and 13-17 were cancelled.

Requester filed a request for *inter partes* reexamination of the '054 patent on July 10, 2006. On August 10, 2006, a Notice holding the July 10, 2006 request to be defective so that a filing date could not be granted was mailed by the Office. Requester filed a response to that Notice on August 17, 2006 in the form of a replacement attachment to the reexamination request. The corrected request papers were accorded a filing date of August 17, 2006. However, on October 26, 2006, the August 17, 2006 filing date was vacated by the Office because it was determined that the corrected request papers failed to comply with the filing date requirements. On November 22, 2008, requester filed a second replacement attachment, and the twice corrected request papers were then accorded a filing date of November 22, 2006. *Inter partes* reexamination was ordered for claims 1-18 of the '054 patent on February 16, 2007. A first Office action on patentability of the claims did not accompany the *Order Granting Request for* Inter Partes *Reexamination.*

After both the '050 *ex parte* reexamination proceeding and the '148 *inter partes* reexamination proceeding were ordered, the Office mailed a merger decision on

December 11, 2007 that *sua sponte* merged the proceedings into a single combined proceeding. In accordance with 37 CFR 1.989(b), the merger decision provided that the merged proceeding would be conducted under the rules governing *inter partes* reexamination. The merger decision also required that patent owner file a housekeeping amendment, placing the same amendments in both the '050 *ex parte* reexamination proceeding had and the '148 *inter partes* reexamination proceeding. After the housekeeping amendment was filed on January 10, 2008, the Office mailed a non-final Office action in the merged proceeding on April 9, 2008. That action addressed the patent claims as amended in light of the rejections proposed by requester in the '148 *inter partes* reexamination proceeding, as well as in light of the prior patents and printed publications that accompanied the filing of both the '050 *ex parte* reexamination proceeding and the '148 *inter partes* reexamination proceeding. Claims 1, 4 and 5 were determined to be patentable, while claim 7 as amended and claims 9-12 and 18 were rejected.

Patent owner did not file a response to the April 9, 2008 non-final Office action. In accordance with 37 CFR 1.957, this is a course of prosecution permitted to the patent owner. Absent a response by patent owner to the April 9, 2008 non-final Office action, the Office issued an ACP. The ACP informed the parties that, under the provisions 37 CFR 1.957(c), prosecution would thereafter be limited only to claims 1, 4 and 5 which had been found patentable. Patent claims 7, 9-12 and 18 were withdrawn from the prosecution until the prosecution in the merged proceeding is terminated, at which point those claims would be canceled. (Patent claims 3, 6, 9 and 13-17 had previously been canceled by patent owner.)

II. Basis for the Relief Requested by Requester

Requester asserts in the present petition that an extraordinary situation exists in that requester has not been given an opportunity to offer any argument concerning the patentability of claims 1, 4 and 5, or to respond to the declaration evidence that was filed by patent owner in support of patentability. Requester seeks relief that would permit requester to respond to the examiner's finding that those claims are patentable. Requester believes that the extraordinary situation is such that in the interest of justice, it should be permitted to petition for relief, and be granted relief in the form of either permitting requester a period of time in which to respond to the patent owner's statement or requiring patent owner to amend the claims in the '148 *inter* partes reexamination proceeding back to their original form and then requiring patent owner to file its housekeeping amendments in the *ex parte* reexamination proceeding.

Requester alleges it is entitled to the requested relief, because it has been denied due process since it was precluded from commenting on claims 1, 4 and 5, and the evidence relied on to find those claims to be patentable. Requester basis that conclusion on the following arguments:

a. *Inter partes* reexamination is intended to provided increased requester participation as compared to *ex parte* reexamination, yet in this instance, requester's participation rights are more limited, because in an *ex parte* reexamination proceeding, a requester is permitted by 37 CFR 1.535 to file a reply to a patent owner's statement under 37 CFR 1.530, including any amendment that accompanies that statement, requester has not been permitted to respond to that amendment in the merged proceeding.

b. Requester's rights as third party requester were not preserved in the merged proceeding because requester lacks the right to address the patentability of claims 1, 4 and 5 in the merged proceeding.

c. Patent owner's housekeeping amendment, in which the amended claims then of record in the '050 *ex parte* reexamination proceeding were filed in the '148 *inter partes* reexamination proceeding, violated the provisions of 37 CFR 1.939 and MPEP § 2667(I)(A)(1).

d. Requester has lost the "rights" given to it under 35 U.S.C. § 314 and 37 CFR 1.995 to participate in the *inter partes* reexamination proceeding at the examiner level.

e. The provisions of 37 CFR 41.67(c)(1(vi) may preclude requester from proposing a new ground of rejection during the appeal stage of the merged proceeding.

III. Patent Owner's Opposition to Granting Relief to Requester

Patent owner opposes granting the relief requested by requester. The bases for patent owner's opposition are that:

a. Requester's petition was not timely filed.

b. Requester has no interest protected by the Due Process Clause and so cannot complain that it has been deprived of due process in the present merged proceeding.

c. Requester seeks relief not provided for by the rules.

d. Requester has not requested suspension of the rules.

e. Granting the relief sought by requester would prejudice patent owner.

IV. Analysis

Requester's arguments will be considered herein; *i.e.*, the October 10, 2008 "Request" and October 27, 2008 petition will be fully considered. Those arguments are addressed as follows:

a. The Reexamination Statute Precludes Requester Responses to an Office Action Absent a Patent Owner Response to that Office Action.

The reexamination statute clearly provides, at 35 U.S.C. § 314(b)(2), that requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response to such action, each time that the patent owner first files a response to an action on the merits from the Office. Accordingly, 37 CFR 1.947, (the regulation that implements the provisions of 35 U.S.C. § 314(b)(2) with respect to Office actions that are not an action closing prosecution (ACP)), provides that the requester may file written comments limited to issues raised by the Office action or the patent owner's response to the Office action, each time the patent owner files a response to the Office action. Similarly 37 CFR 1.951, (the regulation that implements the provisions of 35 U.S.C. § 314(b)(2) with respect to Office actions that are an ACP), provides that a requester may file comments directed to a patent owner's response to the ACP, when the patent owner first files comments to the ACP. The reexamination statute does not provide for a requester to file a response to an Office action unless patent owner has first filed a response to that Office action. Patent owner has not filed a response in the merged proceeding. Accordingly, 35 U.S.C. § 314 precludes patent owner from filing a response in the merged proceeding to either the April 4, 2008 non-final Office action or the September 3, 2008 ACP. The Office lacks authority to waive a provision of the reexamination statute.

Further, it is not uncommon in *inter partes* reexamination that a requester finds itself in the position of having to comment on claim patentability for the first time at the appeal stage. If, for example, an examiner determines in the first Office action on patentability in an *inter partes* reexamination proceeding that all patent claims that are subject to reexamination are patentable, the Office will then promulgate an ACP. If patent owner elects to not file comments on directed to the ACP, the requester will not be able to comment on the allowance by the Office. Ultimately, the first comments directed to the examiner's holding of claim patentability, and or the examiner's refusal to adopt any of requester's proposed rejection, will not be made by the requester until the appeal stage, following the filing of a Right of Appeal Notice (RAN) and a notice of appeal by requester. This is a result required by the statute, and the statute cannot be waived.

b. Requester is Not Entitled to the Rights of a Third Party Requester in an *Ex Parte* Reexamination

Requester's arguments regarding the right of a third party requester to respond under 37 CFR 1.535 to an amendment filed by a patent owner with a 37 CFR 1.530 owner's statement in an *ex parte* reexamination proceeding is not relevant here, because requester in the '148 *inter partes* reexamination proceeding was not a requester in the '050 *ex parte* reexamination proceeding.

Instead, requester's rights in the present merged proceeding are those of a requester in an *inter partes* reexamination proceeding. As discussed in Section III.a., *supra*, the

reexamination statute conditions any right to file comments directed to an examiner's action on claim patentability and/or patent owner's amendments filed in response to an Office action of a third party requester in an *inter partes* reexamination proceeding on the prior filing by patent owner of a response to that Office action. In the present merged proceeding, patent owner has not filed any response to the April 9, 2008 Office action on claim patentability, or to the September 9, 2008 ACP, which are the only Office actions on claim patentability promulgated in the merged proceeding.

c. Patent Owner's Housekeeping Amendment did Not Violate the Rules or *Inter Partes* Reexamination Practice

Patent owner's housekeeping amendment, by which the claims that had been amended in the '050 *ex parte* reexamination proceeding were placed in the '148 *inter partes* reexamination proceeding, was required to by made in the December 11, 2007 merger decision. That decision was promulgated pursuant to the provisions of 37 CFR 1.995. Placement of the amended claims in both proceedings was a requirement of that merger decision, in order to avoid having claims in the merged proceeding that were not identical. To the extent that requester argues that patent owner violated the provisions of 37 CFR 1.939 and MPEP § 2667(I)(A)(1) by filing amendments in the '148 *inter partes* reexamination proceeding prior to the initial Office action on the merits, the record fails to support requester's position. The amendments in question were filed by patent owner in the *ex parte* reexamination proceeding in accordance with the provisions of 37 CFR 1.530. A housekeeping amendment was subsequently filed in the '148 *inter partes* reexamination proceeding as required by the December 11, 2007 merger decision. To the extent necessary, the December 11, 2007 merger decision is regarded as constituting a waiver pursuant to 37 CFR 1.183 of the provisions of 37 CFR 1.939.

It should further be noted that providing a decision to merge multiple reexamination proceedings with a requirement for the filing of housekeeping amendments placing the latest amendments in each of the files that are being placed into the merged proceeding is necessary in order to permit reexamination to proceed with special dispatch. The alternative, to first require that the claims in the two proceedings not include any amendment, then issue an Office action addressing the non-amended claims that sets a period of time for filing a response that may include amended claims in each of the files of the merged reexamination proceedings, would delay the proceedings and not be in aid of special dispatch. It should also be noted that merger of reexamination proceedings may take place where Office actions have brought about multiple claim amendments in at least one of the reexamination proceedings. It is clear that first requiring a "clean" housekeeping amendment containing no amendments in each proceeding, followed by an Office action addressing the non-amended version of the claims notwithstanding that prosecution has already taken place and has resulted in amendments, and then requiring housekeeping amendments, would be unduly burdensome on the Office and the parties, and also would impeded treatment of the proceedings with special dispatch.

d. Requester's Participation Rights Have Been Increased in the Merged Reexamination Proceeding Relative to a Requester's Rights in an *Ex Parte* Reexamination Proceeding

In the present merged reexamination proceeding, requester enjoys a right of appeal in which requester may appeal from the examiner's indication of claim patentability. No such right exists in an *ex parte* reexamination proceeding. The right to appeal from the refusal to reject the pending amended patent claims, which will be based on a Right of Appeal Notice that tracks the September 3, 2008 ACP, (an Office action that included a detailed consideration of the rejections proposed by requester in the '148 *inter partes* reexamination proceeding), is a substantial right going far beyond the right afforded a third party requester in an *ex parte* reexamination proceeding. In addition, the requester may address, at the appellant brief stage, any new findings of patentability made during the proceeding, that requester did not have a right (an opportunity) to address prior to appeal.

With respect to the specific circumstances that exist in this merged proceeding, it must again be noted that as discussed in Section IV.a., it is not uncommon that during the prosecution of an *inter partes* reexamination proceeding, a patent owner fails to respond to an Office action on claim patentability. Again, it is to be noted that 35 U.S.C. § 314(b)(2) expressly precludes any third party comments on an Office action in which there has been no patent owner response to that Office action. The Office cannot create a practice that would, in effect, waive the requirements of the statute.

e. Requester May Appeal the Refusal to Adopt any of the Rejections That Were Proposed by Requester in the '148 *Inter Partes* Reexamination Proceeding

Requester has cited 37 CFR 41.67(c)(1)(vi) for the proposition that requester "may" be precluded from proposing any new ground of rejection for patent owner's amended claims on appeal. Nevertheless, the requester in that circumstance will have an appeal right. In the present merged proceeding, requester has the right to file an appellant brief, and a rebuttal brief in response to any examiner's answer mailed by the Office.

35 U.S.C. § 315(b) expressly provides that requester may appeal to the Board of Patent Appeals and Interferences ("Board") "with respect to <u>any</u> final decision favorable to the patentability of any original or proposed amended or new claim of the patent." [Emphasis added.] In the present merged proceeding, the examiner considered not only the rejections proposed by requester in the '148 *inter partes* reexamination request, but also all of the prior patents and printed publications of record in the merged reexamination proceeding (*i.e.*, the prior patents and publications that had been cited in both the '148 *inter partes* reexamination proceeding, and the '050 *ex parte* reexamination proceeding). Thus, requester may certainly appeal the examiner's refusal to reject patent claims 1, 4 and 5. Also, requester may contest, in the appeal, the examiner's treatment of the Gaudin verified statement, which was accepted by the examiner in the

September 3, 2008 ACP as evidence supporting the patentability of claims 1, 4 and 5. Thus, requester's appeal rights are not insubstantial.

35 U.S.C. § 315(b)(2) would not normally preclude the proposal of a new ground of rejection of the amended patent claims, where requester did not have the opportunity to address the amended patent claims prior to the appeal stage. In this case, however, as set forth in MPEP § 2642, requester could have filed in its second corrected request for *inter partes* reexamination, (which was directed to a request for a second reexamination of the '054 patent) "information raising a substantial new question of patentability with respect to any new or amended claim which [had] been proposed under 37 CFR 1.530(d)" in the earlier filed '050 *ex parte* reexamination proceeding. See MPEP § 2642. Therefore, requester in fact did have an opportunity to address the amended patent claims that had been entered in the '050 *ex parte* reexamination proceeding on August 27, 2007, because the second corrected request was filed subsequent to August 27, 2007.

V. Patent Owner's Opposition

Patent owner argues that the requester petition is untimely. The record shows, however, that requester could not have known that patent owner would not file a response to the April 9, 2008 non-final Office action in the merged proceeding, until after the expiration of two months from the date of the action. Therefore, the time for filing a petition for relief began to run from June 9, 2008. Requester's first filed paper directed to obtaining relief was filed on June 24, 2008, and accordingly, was clearly timely filed. That the Office returned the paper as being nonenterable without considering it on the merits does not disturb the fact that requester asserted its rights in a timely fashion. Requester is clearly permitted to pursue such rights by the present requester petition.

Patent owner argues that requester lacks an interest that is protected by the Due Process Clause, and so cannot have been deprived of due process in this proceeding. The short answer to this argument is that, as pointed out in section IV, *supra*, it appears that requester has not been deprived of any due process rights that may exist. Further, patent owner has not supported its allegation that requester lacks a protected property interest in the present reexamination proceeding with any citation/authority, and accordingly, it is presently unnecessary to discuss this issue further.

Patent owner argues that the relief sought by requester is not in accordance with the rules. However, it is actually the statute that precludes relief to requester, as also discussed in Section IV, *supra*. Thus, it is unnecessary to discuss patent owner's contention regarding the rules further.

Patent owner argues that requester has not sought suspension of the rules. It is noted that the present requester petition is being considered pursuant to both 37 CFR 1.182 and 37 CFR 1.183. However, as the relief sought by requester is precluded by the reexamination statute, which precludes the filing of a requester response to an Office action if the patent owner fails to first file a response to that action, and also requires

treatment of reexamination proceedings with special dispatch, waiver of the rules to accord relief to requester is not an option.

Patent owner argues that it would be prejudiced if relief is granted to requester. The issue of prejudice to owner would not be a basis for denying relief to requester, if requester were in fact entitled to relief.

VI. Findings

For the reasons discussed in Section IV., *supra*, third party requester has not established that it is entitled to the relief requested. Specifically, third party requester has not been denied due process in the merged reexamination proceeding. Rather, the December 11, 2007 merger decision followed existing regulations and examining procedure, to treat the '148 *inter partes* reexamination proceeding and the '050 *ex parte* reexamination that are both directed to '054 patent as a single merged proceeding that would be examined with special dispatch. As a result of the merger decision, requester enjoys substantial appeal rights that would not exist in an *ex parte* reexamination proceeding. Requester also has the ability to file an additional request for reexamination if requester is not successful on appeal and a new substantial question of patentability can be raised.

It has also been noted that pursuant to MPEP § 2642, requester could have filed in second corrected request for *inter partes* reexamination, (which was the second request for reexamination of the '054 patent) "information raising a substantial new question of patentability with respect to any new or amended claim which [had] been proposed under 37 CFR 1.530(d)" in the earlier filed '050 *ex parte* reexamination proceeding. Although the later filed '148 request for reexamination would have been decided based only on the original claims of the '050 patent, requester could have provided information amounting to comments on the amended claims filed on August 27, 2006 in the second corrected request for *inter partes* reexamination, filed by requester on November 22, 2006. See MPEP § 2642, at page 2600-49, last paragraph.

CONCLUSION

1. The requester paper filed on October 10, 2008 to reconsider the August 27, 2008 Decision expunging the June 24, 2008 requester paper seeking to withdraw the August 9, 2008 has been considered, but is dismissed with respect to the requested relief.

2. The October 27 2008 petition has been granted to the extent that it has been considered, but is dismissed as to the relief requested therein.

3. The November 24, 2008 patent owner opposition paper has been considered, but is dismissed in light of the refusal to grant the relief sought by requester on other grounds.

4. The merged reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit for further treatment not inconsistent with this decision.

5. Telephone inquiries related to this decision should be directed to the 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

Nov. 26, 2008
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MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

John L. Welsh WELSH & FLAXMAN LLC 2000 DUKE STREET, SUITE 100 ALEXANDRIA, VA 22314	: : : :	(For Third Party Requester)

In re: Ronald A. Katz *Ex Parte* Reexamination Proceeding Control No. 90/008,051 Deposited ON: 02 June 2006 For: US Patent No. 6,434,223 B2	: : : : :	DECISION DISMISSING PETITION

This is a decision on patent owner petition, filed on 18 March 2010, denominated "Petition to the Director Under 37 CFR § 1.181" requesting the Director review the actions of Examiner Kielin in (1) dismissing the Petitioner's Appeal, (2) canceling claim 80 (the only claim on appeal), and (3) mailing a Notice of Intent to Issue *Ex Parte* Reexamination Certificate.

The proceeding and petition is before the Director of the Central Reexamination Unit for decision.

The request for review and the petition under 37 CFR § 1.181 are **dismissed**, because the Office lacks jurisdiction over U.S. Patent 6,434,223 B2, since reexamination proceeding control no. 90/008,051 has now been concluded by the issuance and publication of a reexamination certificate.

SUMMARY OF RELEVANT FACTS

- On 13 August 2002 US Patent No. 6,434,223 B2 was granted to Ronald A. Katz.
- On 02 June 2006 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,051.
- On 21 July 2006 the Order was granted for *ex parte* reexamination in control number 90/008,051.
- On 13 June 2008 a first Office action on the merits was mailed.
- On 20 March 2009 a Final Office action was mailed.
- On 27 July 2009 a Notice of Appeal was submitted by the patent owner.
- On 28 September 2009 the patent owner's Appeal Brief was submitted.
- On 13 November 2009 a Notice of Non Compliant Appeal Brief was mailed.
- On 17 December 2010 a supplemental patent owner's Appeal Brief was submitted
- On 21 January 2010 a Notice of Intent to Issue Reexamination Certificate was mailed with an explanation as to how the defects were not corrected and the termination of the proceeding pursuant to 37 CFR § 41.37(d) .
- On 18 March 2010 the instant petition was submitted.
- On 25 May 2010 the Certificate Issued for *ex parte* reexamination proceeding control number 90/008,051; US 6,434,223 C1.

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.

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. An examiner does not have jurisdiction to act on a reexamination proceeding after the reexamination certificate has issued. 37 CFR 1.181 provides that, in appropriate circumstances, a petition may be filed/granted to invoke the supervisory authority of the director. However, relief under this provision is limited to ensuring compliance with appropriate policies. As the examiner now has no authority to act on this proceeding, this petition is dismissed.

In this case, the Notice of Intent to Issue the Reexamination Certificate was issued on 21 January 2010. The patent owner filed a petition on 18 March 2010. Although the petition requests that the Director review the actions of the Examiner and the Notice of Intent to Issue the Reexamination Certificate, as evidenced by the publication process, insufficient time remained to review the petition prior to issuance of the Certificate. As a result of the issuance of the Certificate, 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 Petition to the Director Under 37 CFR § 1.181 submitted 18 March 2010 is **dismissed** for lack of jurisdiction.

2. The E*x Parte* Reexamination proceeding control no. 90/008,051 has concluded, and the *Ex Parte* Reexamination Certificate U.S. 6,434,223 C1 has issued on 25 May 2010.

Gregory Morse
Director,
Central Reexamination Unit 3900

ADDITIONAL DISCUSSION

In this proceeding, there was a focused dispute over the meaning of several method step elements in Claim 80. (second "receiving calls" step; "processing calls.. with preliminary operations of... second interface format"; "coupling the calls...with certain common operations") The identification of the support in the specification that corresponds to a claim element is an important requirement even in a reexamination where 35 USC 112 rejections are not imposed. See, for example, the decision of 5/26/2010 in 90/008,373, where identification of structure is apparently required.

The rule requirements for an ex parte appeal brief indicate that patent owner must identify the claimed subject matter in the specification of the patent under reexamination. From 37 CFR 41.37:

> (v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

A review of the "Notice of Non-Compliant Appeal Brief" of 13 November 2009 indicates that the examiner found insufficient identification of identified method steps. The specific elements which were not sufficiently identified were highlighted on page 3 of that action.

A review of the corrected appeal brief of 17 December 2009 shows that the steps identified by the examiner are not addressed with any specificity (corrected brief, page 6, steps b, c and e which were highlighted by the examiner provide no link to the specification). Given the specificity with which the examiner has identified claim elements that are not identified in the summary, and the generic nature of the structure and lack of tie to specific claim steps identified in the appeal brief, the decision of the examiner to require identification of support for the claimed steps appears to be appropriate.

Options open to petitioner at this point include filing a petition under 37 CFR 1.137(b) to accept an unavoidably or unintentionally delayed response (if such is the case) together with a compliant response. Petitioner may wish to include as part of that compliant response either (a) a specific identification of the steps highlighted in bold in the paper of 13 November 1999; (b) a clear statement that there is no better showing in the specification of the steps; or (c) a petition to waive the requirements to identify claimed subject matter in rule 41.37. This is not a suggestion that a

waiver of rule 41.37 is likely to be granted; but rather an indication that a grantable petition to do so would make the brief of 17 December 2009 compliant.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	:	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	:	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	:	For Third Party Requester
HAYNES AND BOONE LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202	:	For Third Party Requester
DAVID J. MCKENZIE FOR ENC Technology Corp.: 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Freeny *Ex Parte* Reexamination Proceeding Control No. 90/008,052 Filed: June 6, 2006 For: US Patent No. 6,360,253	:	

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,262 :
Filed: February 2, 2007 :
For: US Patent No. 6,360,253 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,265 :
Filed: October 6, 2006 :
For: US Patent No. 6,360,253 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,272 :
Filed: October 6, 2006 :
For: US Patent No. 6,360,253 :

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. 6,360,253 issued on March 19, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,052 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,052 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,052.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,262 was requested by a third party requester filed on February 2, 2007.

6. The Reexamination Order was granted in proceeding, control no. 90/008,262 on March 23, 2007.

7. There are currently no amendments proceeding control number 90/008,262.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,265 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,265 on January 3, 2007.

10 There are currently no amendments proceeding control number 90/008,265.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,272 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,272 on December 8, 2006.

13. There are currently no amendments proceeding control number 90/008,272.

14. Proceedings control numbers 90/008,052; 90/008,262; 90/008,265; and 90/008,272 await 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 90/008,052; 90/008,262; 90/008,265; and 90/008,272 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. 90/008,052; 90/008,262; 90/008,265; and 90/008,272 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

MRichu 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.
90/008,052	06/06/2006	6360253	LMI 001	7415

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,265	10/06/2006	6360253	38653.2.14	3829

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,272	10/06/2006	6360253	2231.7.1	8070

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,262	02/02/2007	6360253	077482.0101	7010

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Dunlap, Codding, & Rogers PC
PO Box 16370
Oklahoma City, OK 73113 (For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Law Office of David H. Judson
15455 Dallas Parkway
Addison, TX 75001 (For First Requester)

Baker Botts LLP
910 Louisiana
Houston, TX 77005 (For Second Requester)

Haynes and Boone LLP
901 Main Street, Suite 3100
Dallas, TX 75202 (For Third Requester)

ENC Technology Corp.
8 East Broadway, Suite 600
Salt Lake City, UT 84111 (For Fourth Requester)

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,052
Filed: June 6, 2006
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,262
Filed: February 2, 2007
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,265
Filed: October 6, 2006
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,272
Filed: October 6, 2006
For: U.S. Patent No. 6,360,253 B1

DECISION DISMISSING

PETITION UNDER

37 CFR § 1.183

This is a decision on the November 1, 2007 patent owner petition entitled "PETITION TO WAIVE THE SUBMISSION REQUIREMENTS OF 37 CFR §1.98 (37 CFR 1.183)" The petition requests waiver of the formal submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in a related case.

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

The petition is dismissed as moot.

REVIEW OF FACTS

1. U.S. Patent No. 6,360,253 (the '253 patent) issued on March 19, 2002.

2. A request for *ex parte* reexamination of the '253 patent was filed on June 6, 2006. The request was assigned control No. 90/008,052 (the '8052 reexamination proceeding).

3. Reexamination was ordered for the '8052 proceeding on August 11, 2006.

4. A second request for *ex parte* reexamination of the '253 patent was filed on February 2, 2007. The request was assigned control No. 90/008,262 (the '8262 reexamination proceeding).

5. Reexamination was ordered for the '8262 proceeding on March 23, 2007.

6. A third request for *ex parte* reexamination of the '253 patent was filed on October 6, 2006. The request was assigned control No. 90/008,265 (the '8265 reexamination proceeding).

7. Reexamination was ordered for the '8265 proceeding on January 3, 2007.

8. A fourth request for *ex parte* reexamination of the '253 patent was filed on October 6, 2006. The request was assigned control No. 90/008,272 (the '8272 reexamination proceeding).

9. Reexamination was ordered for the '8272 proceeding on December 8, 2006.

10. On August 3, 2007, the Office issued a decision entitled "*Sua Sponte* Merging Reexamination Proceedings," which merged the '8052, '8262, '8265 and '8272 reexamination proceedings (hereinafter, the merged proceeding).

11. On November 1, 2007, patent owner filed an Information Disclosure Statement (IDS) under 37 CFR 1.555, 1.97 and 1.98 in the merged proceeding.

12. Concurrent with the IDS submissions of November 1, 2007, patent owner filed a petition under 37 CFR 1.183 requesting waiver of the formal submission requirements for an IDS under 37 CFR 1.555 and 1.98 in terms of supplying copies for all four reexamination proceeding.

DECISION

37 CFR 1.555(a) states (in part):

> . . . .
> Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.98 states (in part):

> (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.
> . . . .
> (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.
> . . . .

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that a separate IDS with copies of certain types of references must be provided in each separate application/proceeding to constitute a proper IDS. By filing an IDS with all necessary copies after the merger of the four previously separate proceedings, patent owner has satisfied this formal requirement. Accordingly, the petition is moot.

It is to be noted that this decision is not an acknowledgement that patent owner's November 1, 2007 submission complies with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of this decision.

A fee o f $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's November 1, 2007 petition submission. A review of Office records indicates that one fee has been charged, which is proper as the proceedings were merged at the time of the November 1, 2007 submission. If additional petition fees related to the November 1, 2007 petition filing occur, in the other listed but now merged proceedings, patent owner may wish to seek a refund of those fees at that time.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is dismissed as moot.

2. The requirement for providing copies of IDS information of 37 CFR 1.98(a) is satisfied by the single submission of the copies, since the four reexamination proceedings have been merged into one consolidated proceeding.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers at the point when 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 Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	For Third Party Requester
DAVID J. MCKENZIE FOR ENC Technology Corp.: 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	For Third Party Requester
J Andrew Lowes, Esq. HAYNES AND BOONE LLP 901 Main Street Suite 3100 Dallas, TX 75202	For Third Party Requester
	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Freeny
Ex Parte Reexamination Proceeding
Control No. 90/008,053
Filed: June 6, 2006

For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,263 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,273 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,264 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

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. 7,016,943 issued on March 21, 2006.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,053 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,053 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,053.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,263 was requested by a third party requester filed on October 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,263 on December 8, 2006.

7. There are currently no amendments proceeding control number 90/008,263.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,273 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,273 on December 8, 2006

10 There are currently no amendments proceeding control number 90/008,273.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,264 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,264 on December 8, 2006

13 There are currently no amendments proceeding control number 90/008,264.

14. Proceedings control numbers 90/008,053; 90/008,263; 90/008,264 and 90/008,273 await 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 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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. 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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

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

Lissi M. Marquis,
Director,
Central Reexamination Unit

mas

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

Marcia J. Rodgers (For Patent Owner)
Shugart Thomson & Kilroy, PC
120 West 12th Street
Kansas City, MO 64105

MAILED

OCT 18 2006

CENTRAL REEXAMINATION UNIT

Paul M. Reznick (For Requester)
The Webb Law Firm, PC
700 Koppers Building
436 Seventh Avenue
Pittsburg, PA 15219

In re Reissue Application of Baker Application No. 11/197,724 Filed: August 4, 2005 For: U.S. Patent No. 6,631,461	:	**DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS**
In re Gray Automotive Products Reexamination Proceeding Control No. 90/008,054 Filed: June 16, 2006 For: U.S. Patent No. 6,631,461	:	

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. 6,631,461 (the '461 patent) issued on October 21, 2003, with 49 claims.

2. An application for reissue, assigned application No. 11/197,724 (the '724 application), was filed by the patent owner on August 4, 2005.

3. The filing of the '724 reissue application was announced in the *Official Gazette* on October 11, 2005.

4. A request for reexamination was filed by a third party requester on June 16, 2006, and was assigned control No. 90/008,054 (the '054 proceeding).

5. Reexamination was ordered for the '054 proceeding on July 31, 2006.

6. A notice of concurrent proceeding was filed by the patent owner on August 22, 2006, in each of the '724 and the '054 proceedings, notifying the Office that the '054 proceeding and the '724 application, respectively, had been previously filed.

7. A patent owner's statement under 37 CFR 1.530 has not been received in the '054 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. 11/197,724 and reexamination control No. 90/008,054 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the file for reexamination control No. 90/008,054 shows:

   (a) Original patent claims 1-49 are present.

   (b) No amendments have been made.

   A review of reissue application No. 11/197,724 shows:

   (a) Original patent claims 1-49 are present.

   (b) Original claim 43 was amended on August 8, 2005.

   At least claim 43 in the reexamination is not identical to claim 43 as it was amended in the reissue application.

   Accordingly, the claims are not identical in both proceedings.

   An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in both proceedings, specifically, Application No. 11/197,724 and Control Number 90/008,054. 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 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 that are not applicable under reexamination would be withdrawn (e.g., based on public use or on sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 11/197,724 and reexamination control No. 90/008,054 **are merged** into a single proceeding.

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

3. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 2800 in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '461 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 Karen Hastings, Legal Advisor, at (571) 272-7717.

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

kmh
13 October 2006

October 17, 2006
C:\kiva\kenpetmerger\8054_Merge_cls-diff_3PR_.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

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Robert J. Brill
Ziolkowski Patent Solutions Group, SC
14135 N. Cedarburg Road
Mequon, WI 53097

For Patent Owner

MAILED

OCT 20 2006

CENTRAL REEXAMINATION UNIT

In re: Polzin et al.
Ex Parte Reexamination Proceeding
Control No. 90/008, 055
Filed: June 26, 2006
For: US Patent No. 6,967,479

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

This is a decision on the October 11, 2006, Patent Owner "Petition for Extension of Time Under 37 CFR 1.550(c)" requesting that the time for filing its Patent Owner's Statement in response to the Order granting reexamination be extended by one month.

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

The petition is dismissed as incomplete for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file its statement in response to the Order granting reexamination of August 11, 2006, which set a two month time limit for filing the statement. The present petition for extension of time was timely filed on October 11, 2006, together with the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...
>
> The reasons stated in the request will be evaluated by the TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

The present request is incomplete in that it fails to include a complete statement of "sufficient cause" as to why the requested extension is needed and warranted. The request does not include (a) a statement of what action the patent owner has taken thus far as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period, and (b) why, in spite of the action taken thus far, the additional one month is needed.

As its reason for requesting an extension of time, Patent Owner notes counsel has been unable to obtain the inventor's assistance due to the inventor's schedule, which assistance counsel deems necessary due to the complexity of the application and references cited in the Order. However, the references discussed in the Order are precisely those which Patent Owner itself cited in its request for reexamination. It is reasonable to presume that Patent Owner has sufficiently analyzed an application and references *before* requesting reexamination of that application based on those references. Thus no sufficient cause is seen for any extension of time to respond to the Order.

In order to complete the present petition for extension, the patent owner must renew the petition and provide sufficient reasons information to enable the Director of the Central Reexamination Unit to determine whether there is "sufficient cause" to grant the patent owner's request for an extension.

Conclusion

1. The Patent Owner's petition for extension of time filed on October 11, 2006 is <u>dismissed</u> as incomplete.

2. The Patent Owner is invited to file a renewed petition for extension of time, without additional fee, addressing the matters raised above. The renewed petition would be directed to the following:

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

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

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

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

Lissi Mojica Marquis,
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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MJ

Robert J. Brill
Ziolkowski Patent Solutions Group, SC
14135 N. Cedarburg Road
Mequon, WI 53097

For Patent Owner

MAILED

OCT 20 2006

CENTRAL REEXAMINATION UNIT

In re: Polzin et al.
Ex Parte Reexamination Proceeding
Control No. 90/008, 056
Filed: June 26, 2006
For: US Patent No. 6,707,300

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

This is a decision on the October 11, 2006, Patent Owner "Petition for Extension of Time Under 37 CFR 1.550(c)" requesting that the time for filing its Patent Owner's Statement in response to the Order granting reexamination be extended by one month.

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

The petition is dismissed as incomplete for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file its statement in response to the Order granting reexamination of August 11, 2006, which set a two month time limit for filing the statement. The present petition for extension of time was timely filed on October 11, 2006, together with the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...
>
> The reasons stated in the request will be evaluated by the TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

The present request is incomplete in that it fails to include a complete statement of "sufficient cause" as to why the requested extension is needed and warranted. The request does not include (a) a statement of what action the patent owner has taken thus far as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period, and (b) why, in spite of the action taken thus far, the additional one month is needed.

As its reason for requesting an extension of time, Patent Owner notes counsel has been unable to obtain the inventor's assistance due to the inventor's schedule, which assistance counsel deems necessary due to the complexity of the application and references cited in the Order. However, the references discussed in the Order are precisely those which Patent Owner itself cited in its request for reexamination. It is reasonable to presume that Patent Owner has sufficiently analyzed an application and references *before* requesting reexamination of that application based on those references. Thus no sufficient cause is seen for any extension of time to respond to the Order.

In order to complete the present petition for extension, the patent owner must renew the petition and provide sufficient reasons information to enable the Director of the Central Reexamination Unit to determine whether there is "sufficient cause" to grant the patent owner's request for an extension.

Conclusion

1. The Patent Owner's petition for extension of time filed on October 11, 2006 is <u>dismissed</u> as incomplete.

2. The Patent Owner is invited to file a renewed petition for extension of time, without additional fee, addressing the matters raised above. The renewed petition would be directed to the following:

By Mail to: Mail Stop *Ex Parte* Reexam
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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

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,058	06/08/2006	6076094	571872800100	6714

7055 7590 08/29/2008

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/29/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RICHARD KIM
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE SUITE 100
SAN DIEGO CA 92130

Date:

MAILED

AUG 29 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008058
PATENT NO. : 6076094
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
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AUG 29 2008

CENTRAL REEXAMINATION UNIT

GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON VA 20191	:	(For Patent Owner)
MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040	:	(For Third Party Requester)
	:	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.550(c)]
In re: Cohen *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,058 Deposited on: 8 June 2006 For: US Patent No. 6,076,094	:	

This is a decision on the 27 August 2008 , petition for "Request for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed 7 June 2008 be extended by one-month.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 7 June 2008, 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 27 August 2008, together with the $200.00 petition fee required by 37 CFR § 1.515(c) and § 1.17(g).

The patent owner has provided sufficient cause to support a two-week extension of time. The petition request for one-month extension of time is thus granted-in-part.

37 CFR § 1.550 (c) states:

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

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

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

Analysis and Findings

The Office must weigh the decision to grant additional time to respond based upon the balance of providing the patent owner a fair opportunity to present an argument with the need for special dispatch. The patent owner has presented a statement that there was a need to review a number of documents, coordinate with a number of individuals located in different countries and different time zones, as well as an interview with the examiner in charge of the proceeding. On balance, it should first be noted that examiner's interviews are not considered to constitute sufficient cause and justification for additional response time. Further, the references were all of record in the last Office action preceding the non-final mailed 7 July 2007. With due consideration of the differences in time zones and countries there are few specifics given as to why this additional time is needed, the petition request is hereby granted-in-part. The patent owner is hereby granted an additional two weeks to respond to the Office action dated 7 June 2008.

The petition request is hereby **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 7 June 2008 is **granted-in-part**.

2. A **two-week** (fourteen-days) extension of time is hereby granted.

3. The two week extension of time has a response date falling on Sunday, 21 September 2008, as such the Patent Owner's response is due **22 September 2008**.

4. Response may be submitted as follows:

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner at (571) 272-1611, Art Unit 3992 or Erik Keasel, Supervisory Patent Examiner at (571) 272-4929 Art Unit 3992 in the Central Reexamination Unit.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Westerman, Hattori, Daniels & Adrian, LLP
1250 Connecticut Avenue, NW
Suite 700
Washington, DC 20036

(For Patent Owner)

MAILED

AUG 15 2007

CENTRAL REEXAMINATION UNIT

Stoel Rives LLP
900 SW Fifth Avenue
Suite 2600
Portland, OR 97204

(For 3rd Party Requester)

Reexam Control No.: 90/007,475
Filed : March 23, 2005
For U.S. Patent No. : 5,575,925

Reexam Control No.: 90/008,060
Filed : May 17, 2006
For U.S. Patent No. : 5,575,925

DECISION MERGING REEXAMINATION PROCEEDINGS

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

Reexamination in application control No. 90/007,475 was ordered in a decision mailed May 27, 2005. Prosecution proceeded to the mailing of a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) on April 3, 2006. An amendment to the claims was filed on January 23, 2006. The NIRC took into consideration the amended claims. A decision vacating the NIRC was mailed August 14, 2007.

Reexamination in application control No. 90/008,060 was ordered in a decision mailed July 31, 2006. Patent Owner filed a Patent Owner's statement under the provisions of 37 CFR § 1.530 (c) and (d) on October 2, 2006 (timely as September 30th fell on a Saturday). Third Party Requester filed a reply to Patent Owner's statement under the provisions of 37 CFR §1.53. No Office action has been issued in this proceeding. There have been no amendments to the claims, specification and drawings in this reexamination proceeding.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR § 1.565(c)). In view of the above, merger is appropriate and is hereby ordered.

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

As noted above, the claims have been amended in the '475 reexamination proceeding by virtue of the amendment filed January 23, 2006. No amendments have been filed in the '060 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, Patent Owner is hereby**

required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

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

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

Conclusion

Reexamination Control Nos. 90/007,475 and 90/008,060 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files.** Upon receipt of the response, an Office action will issue in due course.

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

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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MAR 2 6 2007

CENTRAL REEXAMINATION UNIT

PAMELA S. MERKADEAU
MANATT PHELPS AND PHILLIPS
1001 PAGE MILL ROAD
BUILDING 2
PALO ALTO, CA 94304

In re Application of	:	
Daniel J. **MENDEZ**	:	
Control No. 90/008,062 (U.S. Patent 6,085,192)	:	DECISION ON PETITION
Filed: June 23, 2006	:	TO WITHDRAW
Attorney Docket No. 6082-007.RXUS	:	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 20, 2007.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). While the reasons may be provided by referencing a specific portion of 37 CFR 10.40, the reasons must deal with actions by the client. The reasons set forth in the request, "Attorneys are no longer representing Applicant" are not appropriate since it is not clear that the client initiated the transfer, or that the client knowingly or freely assents to the transfer to new counsel.

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

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

Patricia Volpe for

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: **SCOTT MCKEOWN**
OBLON, SPIVAK, MCCLELLAND, MAIER
& NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314-3412

cc: **NOVAK DRUCE & QUIGG, LLP** (Third Party Requester)
1300 Eye Street, NW
Suite 1000 West Tower
Washington, DC 20005

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on March 20, 2007. There is no indication it was served on 3rd Party Requester.

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.
90/008,062	06/23/2006	6085192	306303US91RX	6058

22850 7590 10/03/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/03/2008

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

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PAMELA S. MERKADEAU
MANATT PHELPS AND PHILLIPS
1001 PAGE MILL ROAD, BUILDING 2
PALO ALTO, CA 94304

(For Patent Owner)

NOVAK, DRUCE DeLUCA & QUIGG, LLP
1300 EYE STREET, N.W.
SUITE 400 EAST TOWER
WASHINGTON, DC 20005

(For Third Party Requester)

MAILED

OCT 03 2008

CENTRAL REEXAMINATION UNIT

SCOTT MCKEOWN
OBLON, SPIVAK, MCCLELLAN
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

(Courtesy Copy)

In re Mendez *et al.*	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No.: 90/008,062	:	**DISMISSING AND**
Filed: June 23, 2006	:	**EXPUNGING PETITION**
For: U.S. Patent No. 6,085,192	:	

This is a decision on the September 10, 2008 third party requester paper entitled "PETITION UNDER 37 CFR § 1.182 AND/OR 1.183."

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 is being expunged by being be marked "closed" and "non-public" in the IFW, and will not constitute part of the record of the present reexamination proceeding. [1]

REVIEW OF FACTS

1. U.S. Patent No. 6,085,192 ("the '192 patent") issued to Mendez *et al.* on July 4, 2000.

[1] *See* MPEP 2267.

2. On June 23, 2006, a request for *ex parte* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 90/008,062 ("the '8062 proceeding").

3. On August 22, 2006, an order granting *ex parte* reexamination in the '8062 proceeding was mailed.

4. On September 5, 2007, a first Office action on the merits was mailed.

5. The present proceeding has progressed until, on September 10, 2008, the third party requester filed the present petition paper entitled "PETITION UNDER 37 CFR § 1.182 AND/OR 1.183," which is the subject of this decision.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

35 U.S.C. § 304 provides:

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

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).

DECISION

The September 10, 2008 third party requester petition paper is filed under 37 CFR 1.182 and/or 1.183; however, the rules cannot be waived/suspended to provide the third party requester the right to file a paper at the present stage in the '8062 proceeding. Waiver/suspension of the rules to permit the third party requester submission via the petition is not 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 Federal Circuit stated (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].

Pursuant to 35 U.S.C. § 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends either: (1) upon expiration of the patent owner's time for filing a statement in response to the order for reexamination, or (2) if the patent owner files such a statement, upon expiration of the third party requester's time for filing a reply to the patent owner's statement (i.e., within two months from the date of service of the patent owner's statement).

On its face, the third party requester's September 10, 2008 petition paper was filed after the statutory statement and reply period ended in the '8062 proceeding. The statutory statement and reply period ended in the '8062 proceeding when the patent owner did not file a statement in response to the August 22, 2006 order granting reexamination within the two-month response period set forth in the order for filing such a statement. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's September 10, 2008 petition paper, and the petition is **dismissed**.

CONCLUSION

1. The petition is dismissed.

2. The petition paper filed by the third party requester on September 10, 2008 is being expunged as not having an entry right. This will be carried out by closing the petition paper (document) in the IFW of the '8062 proceeding and marking the paper "closed" and "non-public."

3. No copy of the petition papers will be maintained of record in the IFW for the '8062 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 this decision should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

October 2, 2008
C:\kiva\kimpropa\3PR\8062 improper 1.183 pet for 3PR participation-dismiss.doc

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

(For Patent Owner)

MAILED

OCT 06 2008

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Requester)

In re Mendez *et alia*	:
Reexamination Proceeding	: DECISION DISMSSING
Control No. 90/008,062	: PETITION UNDER
For: U.S. Patent No. 6,085,192	: 37 CFR 1.59(b)

This is a decision on the April 22, 2008 "PETITION FOR EXPUNGMENT OF PROTECTIVE ORDER MATERIALS UNDER 37 C.F.R. §1.59(B)".

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

The petition to expunge is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,085,192 (hereinafter, the '192 patent), issued to Mendez *et alia*, on July 4, 2000.

2. On June 23, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '192 patent. The reexamination proceeding was assigned Control No. 90/008,062 (hereinafter, the '8062 proceeding).

3. The reexamination order was granted in the '8062 proceeding on August 22, 2006.

4. Later in prosecution, on April 22, 2008, Patent Owner filed an after-final response, an IDS containing information that was labeled confidential and information that was labeled non-confidential, and a petition to expunge the information "to avoid the public disclosure of confidential materials".

5. On August 1, 2008, a revocation of the petition to expunge was filed.

DECISION

MPEP 724.05 states, in part:

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP §724.02...must contain:
(A) a clear identification of the information to be expunged without disclosure of the details thereof;
(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
(E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

The petition of April 22, 2008 lacks at least items (B), (C), and (D).

On August 1, 2008, Patent Owner filed a paper entitled "REVOCATION OF PETITION TO EXPUNGE", which states, in part, "[i]t is Patent Holder's intention to moot the Petition for Expungement."

The petition to expunge, filed April 22, 2008 is <u>dismissed as moot</u>, as per the revocation filed August 1, 2008.

The materials submitted on April 22, 2008 will not be expunged, will be unsealed, and will be made available to the public after the mailing of this decision.

CONCLUSION

1. The petition to expunge filed April 22, 2008 is dismissed as moot, as per the revocation filed August 1, 2008.

2. The materials submitted on April 22, 2008 will not be expunged, will be unsealed, and will be made available to the public after the mailing of this decision.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Gregory Morse
Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100104

DATE : January 4, 2010

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,085,192 C2

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

please note, this is a certificate of correction of the reexamination certificate issued April 28, 2009

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

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.
90/008,063	08/07/2006	6480710	027952-001701US	8900

20350 7590 06/24/2010

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2010

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JEFFERY L. CAMERON
BROOKS & CAMERON PLLC
1221 NICOLLET AVENUE, SUITE 500
MINNEAPOLIS, MN 55403

Date:

MAILED

JUN 24 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008063
PATENT NO. : 6480710
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

(For Patent Owner)

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JUN 24 2010

CENTRAL REEXAMINATION UNIT

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

(For Requester)

Brooks & Cameron, PLLC
1221 Nicollet Avenue, Suite 500
Minneapolis, MN 55403

In re Laybourn *et alia*	:
Reexamination Proceeding	: **DECISION**
Control No. 90/008,063	: **DISMISSING**
Corrected Request Deposited: August 7, 2006	: **PETITION**
For: U.S. Patent No. 6,480,710	:

The *ex parte* reexamination is before the Central Reexamination Unit for consideration of a petition filed October 28, 2009 entitled "PETITION TO DIRECTOR UNDER 37 CFR §1.181" requesting "to enter the Amendment filed May 5, 2009".

The petition is **DISMISSED** as untimely.

BACKGROUND and DECISION

After non-final rejection, Patent Owner (PO) did not amend the claims.

The examiner issued a final rejection on March 5, 2009.

PO proposed an amendment to the claims in an after-final response filed May 5, 2009.

The examiner did not enter the proposed amendment in the advisory action of June 4, 2009.

PO filed a Notice of Appeal on July 1, 2009.

An interview was conducted on August 28, 2009.

An appeal brief was filed on September 1, 2009.

Another interview was held on September 11, 2009.

A Notice of non-compliant appeal brief was September 24, 2009.

An amended appeal brief was filed on October 26, 2009.

The present petition was filed on October 28, 2009.

37 CFR 1.181(f) states, in part:
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.

Since the advisory action of June 4, 2009 was the action from which relief is requested, the petition of October 28, 2009 is untimely.

Therefore, the petition is **dismissed** as untimely.

PO points to 37 CFR 1.181(c) to explain the belatedness of the petition:

"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."

However, PO has not filed a reply under 37 CFR 1.111 requesting reconsideration; therefore, the argument is unpersuasive.

A review of the record indicates that two interviews were held and PO has not submitted written statements of the substance of the interviews.

37 CFR 1.560(b) states:

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 2281 states, in part:
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. 37 CFR 1.560(b). The written statement must be filed either as a separate paper within one month after the date of the interview, or as a separate part of a response to an outstanding Office action, whichever is later.
The requirement for a patent owner's statement of the interview cannot be waived by the examiner. It should be noted that, pursuant to 37 CFR 1.550(d), the failure to file a written statement of an interview as required under 37 CFR 1.560(b) will result in the termination of the reexamination prosecution (in the same way that failure to timely respond to an Office action results in the termination of the reexamination prosecution).

CONCLUSION

1. Petitioner's petition is **dismissed** as untimely.

2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUN 24 2010

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

TOWNSEND AND TOWNSEND AND CREW, LLP
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EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

(For Requester)

Brooks & Cameron, PLLC
1221 Nicollet Avenue, Suite 500
Minneapolis, MN 55403

In re Laybourn *et alia*	:
Reexamination Proceeding	: **DECISION**
Control No. 90/008,065	: **DISMISSING**
Corrected Request Deposited: August 7, 2006	: **PETITION**
For: U.S. Patent No. 6,625,439	:

The *ex parte* reexamination is before the Central Reexamination Unit for consideration of a petition filed October 28, 2009 entitled "PETITION TO DIRECTOR UNDER 37 CFR §1.181" requesting "to enter the Amendment filed May 5, 2009".

The petition is **DISMISSED** as untimely.

BACKGROUND and DECISION

After non-final rejection, Patent Owner (PO) did not amend the claims.

The examiner issued a final rejection on March 5, 2009.

PO proposed an amendment to the claims in an after-final response filed May 5, 2009.

The examiner did not enter the proposed amendment in the advisory action of June 4, 2009.

PO filed a Notice of Appeal on July 1, 2009.

An appeal brief was filed on September 1, 2009.

Another interview was held on September 11, 2009.

A Notice of non-compliant appeal brief was September 24, 2009.

An amended appeal brief was filed on October 26, 2009.

The present petition was filed on October 28, 2009.

37 CFR 1.181(f) states, in part:
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.

Since the advisory action of June 4, 2009 was the action from which relief is requested, the petition of October 28, 2009 is untimely.

Therefore, the petition is **dismissed** as untimely.

PO points to 37 CFR 1.181(c) to explain the belatedness of the petition:

"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."

However, PO has not filed a reply under 37 CFR 1.111 requesting reconsideration; therefore, the argument is unpersuasive.

A review of the record indicates that an interview was held and PO has not submitted a written statement of the substance of the interview.

37 CFR 1.560(b) states:

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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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. 37 CFR 1.560(b). The written statement must be filed either as a separate paper within one month after the date of the interview, or as a separate part of a response to an outstanding Office action, whichever is later.
The requirement for a patent owner's statement of the interview cannot be waived by the examiner. It should be noted that, pursuant to 37 CFR 1.550(d), the failure to file a written statement of an interview as required under 37 CFR 1.560(b) will result in the termination of the reexamination prosecution (in the same way that failure to timely respond to an Office action results in the termination of the reexamination prosecution).

CONCLUSION

1. Petitioner's petition is **dismissed** as untimely.

2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS MN 55415-1002

(For Patent Owner)

MAILED

MAY 17 2007

CENTRAL REEXAMINATION UNIT

Bradley J. Thorson
PATTERSON, THUENTE, SKAAR &
CHRISTENSEN, PA
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402

(For Requester)

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

In re: Braun *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,066
Filed: June 27, 2006
For U.S. Patent No. 6,416,482

In re: Braun *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,440
Filed: 440March 1, 2005
For U.S. Patent No. 6,416,482

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number

90/008,066 (the '066 proceeding) and the reexamination control number 90/007,440 (the '440 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,416,482 issued on July 9, 2002.

2. The 90/007,440 reexamination proceeding was filed on March 1, 2005 by a third party requester.

3. The '440 proceeding Order granting reexamination was mailed on May 8, 2005.

4. A non-final Office action in the '440 proceeding was mailed on October 11, 2005.

5. Amendments to the claims in the '440 proceeding from the Patent Owner was received by the Office on May 5, 2006 and December 12, 2006 respectively.

6. The '440 proceeding is currently under non-final status

7. The 90/008,066 reexamination proceeding was filed June 27, 2006 by a third party requester.

8. The '066 proceeding Order granting reexamination was mailed on August 25, 2006.

9. There are no amendments to the '066 proceeding at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/007,440 and 90/008,066 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, the claims have been amended in the 90/007,440 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,440 and 90/008,066 are **merged**. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

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

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS MN 55415-1002

(For Patent Owner)

MAILED

MAY 17 2007

CENTRAL REEXAMINATION UNIT

Bradley J. Thorson
PATTERSON, THUENTE, SKAAR &
CHRISTENSEN, PA
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402

(For Requester)

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

In re: Braun *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,067
Filed: June 27, 2006
For U.S. Patent No. 5,811,681

In re: Braun *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,439
Filed: March 1, 2005
For U.S. Patent No. 5,811,681

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number

90/008,067 (the '067 proceeding) and the reexamination control number 90/007,439 (the '439 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,811,681 issued on Sept 22, 1998.

2. The 90/007,439 reexamination proceeding was filed on March 1, 2005 by a third party requester.

3. The '439 proceeding Order granting reexamination was mailed on May 8, 2005.

4. A non-final Office action in the '439 proceeding was mailed on October 11, 2005.

5. Amendments to the claims in the '439 proceeding from the Patent Owner was received by the Office on May 5, 2006, December 12, 2006 and August 21, 2006 respectively.

6. The '439 proceeding is currently awaiting examiner's action.

7. The 90/008,067 reexamination proceeding was filed June 27, 2006 by a third party requester.

8. The '067 proceeding Order granting reexamination was mailed on August 28, 2006.

9. There are no amendments to the '067 proceeding at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/007,439 and 90/008,067 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, the claims have been amended in the 90/007,439 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,439 and 90/008,067 are **merged**. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

MReinhart for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,069	06/29/2006	6389437	440261	3418

30954 7590 04/23/2009

LATHROP & GAGE LLP
2345 GRAND AVENUE
SUITE 2400
KANSAS CITY, MO 64108

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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APR 23 2009

CENTRAL REEXAMINATION UNIT

Lathrop & Gage
2345 Grand Blvd.
Kansas City, MO 63019

(For Patent Owner)

In re Reexamination Proceeding
Everett W. Stoub
Control No.: 90/008,069
Filed: June 9, 2006
For: U.S. Patent No.: 6,389,437

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

This is a decision on the March 13, 2009 patent owner petition under 37 CFR 1.182 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. 12-0600 in accordance with petitioner's authorization in the March 13, 2009 Payment Information section of their EFS-WEB Electronic Acknowledgement Receipt.

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

REVIEW OF THE FACTS

1. On May 14, 2002, U.S. Patent 6,389,437 (the '437 patent) issued to Stoub.

2. On June 9, 2006, a request for *ex parte* reexamination of the '437 patent was filed by patent owner. The resulting reexamination proceeding was assigned control number 90/008,069 (the '8069 proceeding).

3. On August 2, 2006, the Office denied patent owner's request for reexamination of the '437 patent.

4. On August 31, 2006, the patent owner petitioned requesting review of the denial of the request for reexamination of the '437 patent.

5. On November 28, 2006, a notice of the filing of the'8069 *ex parte* reexamination was published in the *Official Gazette*.

6. On July 30, 2007, the Office issued an order granting the'8069 *ex parte* reexamination request.

7. On March 21, 2008, patent owner submitted an amendment cancelling claims 1, 16, 24, 30 and 54, leaving claims 2-15, 17-23, 25-29, 31-53 and 55-77 pending. The amendment also amended claims 2-8, 10-15, 17-20, 22-23, 25-26, 31-32, 34-38, 40-44, 46-51, 55-63, 67, 70-71 and 75.

8. On July 3, 2008, a first Office action on the merits issued rejecting all pending claims as unpatentable over (1) ENEWS Reference Manual in view of Orr et al. (USPN 5,895,476).

9. On September 2, 2008, patent owner filed a response amending the claims and providing only remarks alleging patentability over the prior art of record. No additional evidence was provided in support of the remarks alleging patentability.[1] The amendment failed to comply with 37 CFR 1.530(f) because the deletion of a portion of the claimed subject matter (see, e.g., claims 51 and 62) was reflected by striking out the subject matter rather than using brackets as required by the rule. .

10. On September 3, 2008, patent owner *sua sponte* filed a supplemental response correcting the formal error regarding deletions to the claims. Other than the proper presentation of deleted claim subject matter and an explanation of the need for the supplemental response, the supplemental response did not differ from the September 2, 2008 response.

11. On November 6, 2008, a final Office action was issued in the '8069 proceeding maintaining the rejection of all pending claims as unpatentable over ENEWS Reference Manual in view of U.S. Patent No. 5,895,476 to Orr et al. ("the Orr '476 patent).

12. On January 6, 2009, patent owner filed an after-final amendment and a declaration under 37 CFR 1.132 by Michael C. Eubanks in the '8069 proceeding. Patent owner provided remarks alleging patentability of the pending claims.

13. On February 13, 2009, the Office issued an advisory action responding to patent owner's remarks. The Eubanks declaration, which was filed after a final action, but before the filing of a notice of appeal, was not entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit is necessary and was not earlier presented in accordance with 37 CFR 1.116(e).

14. On March 13, 2009, patent owner filed a notice of appeal in the '8069 proceeding.

15. Also on March 13, 2009, patent owner filed a petition under 37 CFR 1.182 requesting continued reexamination in the '8069 proceeding. This petition is the subject of the instant decision, which addresses petitioner's request for reopening of prosecution and entry of affidavit evidence.

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[1] The amendment failed to comply with 37 CFR 1.530(f) because the deletion of a portion of the claimed subject matter (see, e.g., claims 51 and 62) was reflected by striking out the subject matter rather than using brackets as required by the rule. .

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '8069 reexamination proceeding to provide consideration of the Eubanks declaration filed with the January 6, 2009 after-final amendment to the November 6, 2008 final 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." [2] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. 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. 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.

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 which mandates that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

Based on the facts and circumstances of the present case, petitioner patent owner's response in the form of a request to enter evidence after final rejection, i.e., the January 6, 2009 Eubanks declaration, that fails to comply with the requirements of 37 CFR 1.116(e), is not a *bona fide* effort to advance prosecution and as such, the granting of the present petition is inconsistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner's sole argument to justify the granting of the ***extraordinary*** relief of a request for continued reexamination is that maintenance of a rejection of all pending claims using the Orr '476 patent could not have been anticipated in light of the arguments submitted by applicant,[3]

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[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

[3] Petitioner appears to be referring to arguments made in patent owner's September 3, 2008 response to the July 3, 2008 Office action.

and that petitioner believes that it is now necessary to submit evidence in the form of the Eubanks declaration. As an introduction to petitioner's sole argument for granting the requested ***extraordinary*** relief, petitioner appears to imply that a request for the granting of the request for continuing reexamination under these circumstances is in accord with Office policy. However, the granting of ***extraordinary*** equitable relief under ordinary circumstances where the petitioner was in control of the prosecution of the proceeding in the normal course of examination, particularly after the first Office action, when the petitioner failed to submit the Eubanks declaration with his response to the first Office action as the current facts of record reflect, is completely contrary to Office policy as it would undermine the policy intent of the relevant Office rule, *e.g.* 37 CFR 1.116(e).[4] Petitioner/patent owner's only statement to justify the existence of a need for ***extraordinary*** equitable relief is that petitioner "could not have anticipated" that the examiner would maintain the rejection using the Orr '476 patent in light of the arguments presented. Contrary to petitioner's assertion, it is reasonably foreseeable that an examiner, after citing the Orr '476 patent in a rejection of the claims, may not be persuaded by attorney argument and thus maintain the rejection citing the Orr '476 patent. Petitioner has provided no other reason why the Eubanks declaration was not earlier presented. Therefore, the argument is not persuasive. In view of the above and the fact situation presented by the record, the petition is dismissed.

ADDITIONAL DISCUSSION

Furthermore, the patent owner states that he "respectfully requests entry of the Eubanks opinion into the record for further action by the examiner and for purposes of appeal." 37 CFR 1.116(e) permits the submission of an affidavit or other evidence after a final rejection in an *ex parte* reexamination, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. The patent owner, however, fails to provide any reason why the Eubanks declaration is necessary and was not earlier presented. For example, the declaration appears to be directed to the rejection of claim(s) 2-51, 17-23, 25-29, 31-53 and 55-77 over ENEWS Reference Manual in view of the Orr '476 patent, which was applied by the examiner in the first Office action dated July 3, 2008. The patent owner clearly had an opportunity to present the Eubanks declaration in response to the first Office action, and did not do so. The patent owner argues that "applicant had absolutely no reason to believe that the examiner would maintain those rejections after applicant's first response was filed." This argument, however, is not persuasive because the patent owner has failed to present any reason why the Eubanks declaration could not have been submitted with patent owner's response to the first Office action, as the patent owner clearly was on notice that the examiner believed that claims 2-51, 17-23, 25-29, 31-53 and 55-77 were not patentable over the ENEWS Reference Manual in view of the Orr '476 patent. Patent owner, therefore, has failed to provide good and sufficient reasons why the Eubanks declaration should be entered on appeal.

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[4] See also MPEP 714.13 (II) Amendments and Other Replies After Final Rejection or Action, Procedure Followed; ENTRY NOT A MATTER OF RIGHT

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The two-month period to submit an appeal brief from the March 13, 2009 filing date of the notice of appeal in the '8069 *ex parte* reexamination proceeding continues to run.

3. Jurisdiction for the '8069 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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AUG 03 2007

CENTRAL REEXAMINATION UNIT

BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS TX 75201-2980	:	For Patent Owner
Lawrence G. Kurland BRYAN CAVE LLP 1290 Avenue of the Americas New York, NY 10104	:	For Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Ozawa *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/007,546 Filed: May 18, 2005 For: US Patent No. RE 36,769	:	
In re: Ozawa *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,071 Filed: February 18, 2005 For: US Patent No. RE 36,769	:	

The above-identified reexamination files are before the Director of the Central Reexam Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. RE 36,769 reissued on July 11, 2000.

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

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

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

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

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

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

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

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/007,546 and 90/008,071 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,546 and 90/008,071 are **MERGED**.

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

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

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

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

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

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

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

Lissi M. Marquis,
Director,
Central Reexamination Unit

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

(For Patent Owner)

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NOV 29 2007

CENTRAL REEXAMINATION UNIT

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

(For Third-Party Requester)

In re: Ozawa *et alia* Reexamination Proceeding Control No. 90/007,546 Request Deposited: May 18, 2005 For: U.S. Patent No. RE 36,769	DECISION GRANTING ONE MONTH PETITION FOR EXTENSTION OF TIME [37 CFR 1.550(c)]
In re: Ozawa *et alia* Reexamination Proceeding Control No. 90/008,071 Request Deposited: June 28, 2006 For: U.S. Patent No. RE 36,769	

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

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

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

REVIEW OF RELEVANT FACTS

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

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

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

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

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

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

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

DECISION

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

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor ....

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

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

Analysis and Findings

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

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

CONCLUSION

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

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Irvine, CA 92614

(For Patent Owner)

MAR - 6 2007

Norman H. Zivin
Cooper & Dunham, LLP
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(For 3rd Party Requester)

Stefan J. Kirchanski
Liner Yankelevitz Sunshine & Regenstreif LLP
1100 Glendon Ave., 14th Floor
Los Angeles, CA 90024

(For 3rd Party Requester)

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

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

DECISION MERGING REEXAMINATION PROCEEDINGS

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

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

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

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR § 1.565(c)). In view of the above, merger is appropriate and is hereby ordered.

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

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

Conduct of Proceedings

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

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

Conclusion

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

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

Andres Kashnikow

for Lissi Mojica Marquis, Director
Central Reexamination Unit

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MAR - 6 2007 AIL

Orrick, Herrington & Sutcliffe, LLP (For Patent Owner)
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Norman H. Zivin (For 3rd Party Requester)
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Stefan J. Kirchanski (For 3rd Party Requester)
Liner Yankelevitz Sunshine & Regenstreif LLP
1100 Glendon Ave., 14th Floor
Los Angeles, CA 90024

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

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

DECISION MERGING REEXAMINATION PROCEEDINGS

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

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

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

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

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR § 1.565(c)). In view of the above, merger is appropriate and is hereby ordered.

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

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

Conduct of Proceedings

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

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

Dual Correspondence

Currently, Patent Owner appears to be represented by two different representatives. Under 37 CFR 1.33(a), the Office will not engage in double correspondence with more than one registered attorney or agent except as deemed necessary by the Director. Accordingly, the Patent Owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision.

Conclusion

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

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

Andrés Kashnikow

for Lissi Mojica Marquis, Director
Central Reexamination Unit

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AUG 10 2008

CENTRAL REEXAMINATION UNIT

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1122B
4417 LANCASTER PIKE
WILMINGTON DE 19805

In re Reexamination Proceeding	:
P. Preishuber-Pfluegl	:
Control No. 90/008,080	: DECISION GRANTING PETITION
Filed: June 13, 2006	:
U.S. Patent No. 6,900,153	:
Attorney Docket No. CL1786USNA	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on July 28, 2008, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination 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 May 13, 2008 Notice ...(Amendment) - item 1), an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

No terminal disclaimer and disclaimer fee are required for a period of termination in a reexamination proceeding.

$1,540.00 has been charged to counsel's deposit account no. 04-1928 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the Amendment filed July 28, 2008, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jerry Johnson, in CRU Art Unit 3991, who can be reached at 571-272-1448.

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

Fred A. Silverberg

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,080	06/13/2006	6900153	CL1786USNA	6619

23906 7590 05/12/2009

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1122B
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2009

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

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Legal Patent Records Center
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4417 Lancaster Pike
Wilmington, DE 19805

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MAY 12 2009

CENTRAL REEXAMINATION UNIT

In re Peter Preishuber-Pfluegl
Ex Parte Reexamination Proceeding
Control No. 90/008,080
Filed: June 13, 2006
For: U.S. Patent No. 6,900,153
Practitioner Docket No.: CL1786USNA

: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b) AND**
: **DISMISSING PETITION**
: **UNDER 37 CFR 1.183**
:

This is a decision on: (i) the March 16, 2009 petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination, as supplemented on April 24, 2009 ("the supplemented March 16, 2009 petition to revive"); and (ii) the March 16, 2009 petition under 37 CFR 1.183 to open the present terminated reexamination and reissue the final Office action due to nonreceipt ("the March 16, 2009 1.183 petition").

The appropriate petition fees of $400.00 and $1,620.00 set forth in 37 CFR 1.17(f) and 37 CFR 1.17(m), respectively, for the March 16, 2009 petitions have been paid.

The petitions are before the Office of Patent Legal Administration (OPLA) for consideration.

The supplemented March 16, 2009 petition to revive is **granted**. The March 16, 2009 1.183 petition is **dismissed**.

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 1.183 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 1.550 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)(I)(A) provides, in pertinent part:

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence

such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions)

MPEP 711.03(c)(II)(A)(2)(b) provides, in pertinent part:

A reply under 37 CFR 1.113 to a final action must include ... cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, ... the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee; [or]

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance;
*
*

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).
*
*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Patent owner submitted a Notice of Appeal as part of the April 24, 2009 supplement to the March 16, 2009 petition to revive and paid the corresponding fee of $540.00 on April 24, 2009, thereby satisfying item (1).[1] A petition fee of $1,620.00 was submitted on March 16, 2009, thereby satisfying item (2). A proper statement under 37 CFR 1.137(b)(3) was submitted as part of the March 16, 2009 petition to revive, thereby satisfying item (3). The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Accordingly, the supplemented March 16, 2009 petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 6,900,153 issued for the present proceeding on March 24, 2009. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate issued on December 30, 2008, and the reexamination certificate are hereby **vacated**. Jurisdiction over the proceeding is being forwarded to the examiner for action consistent with this decision, at which point the examination and prosecution in the reexamination proceeding will be resumed.

In due course, the following *erratum* will be duly published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 6,900,153 to Preishuber-Pfluegl of Ludwiggshafen (DE) for SUPPORTED OLEFIN POLYMERIZATION CATALYSTS, appearing in the *Official Gazette* of March 24, 2009 should be deleted, since the reexamination certificate has been vacated.

The Petition Under 37 CFR 1.183 is Dismissed

In the March 16, 2009 1.183 petition, patent owner states that "neither the Patentee nor [counsel for the patent owner] received the Office Action in first place." However, MPEP 711.03(c)(I)(A) describes in detail the showing required to establish nonreceipt of an Office action. The March 16, 2009 1.183 petition fails to make any such showing.

---

[1] See: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[2] See: 37 CFR 1.137(d)(3).

Patent owner's unsupported statement therein that the September 26, 2008 final Office action was never received is insufficient.

Accordingly, the March 16, 2009 1.183 petition is **dismissed**.

CONCLUSION

1. The petition to revive under 37 CFR 1.137(b) is **granted**.

2. The petition under 37 CFR 1.183 is **dismissed**.

3. The termination of prosecution rendered via the December 30, 2008 NIRC, and the NIRC itself, are **vacated**.

4. The *Ex Parte* Reexamination Certificate issued March 24, 2009 is **vacated**. Jurisdiction over the '153 patent is forwarded to the Office of Patent Publication for further processing consistent with this decision.

5. Jurisdiction of the reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU), Art Unit 3991, for further processing in view of the April 24, 2009 Notice of Appeal, and for consideration of the April 24, 2009 amendment after final Office action in due course.

6. 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).

7. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jerry Johnson, of CRU Art Unit 3991, at (571) 272-1448.

8. 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

5-11-09

C:\kiva\kenWD\ 8080 grant 137(b) _ vacate Certif + dismiss non-receipt183.doc

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Dickstein Shapiro LLP
1825 Eye Street NW
Washington, DC 20006-5403

(For Patent Owner)

MAILED

JAN 29 2008

CENTRAL REEXAMINATION UNIT

Jon L. Roberts
Roberts Mardula & Wertheim, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191

(For 3rd Party Requester)

Reexam Control No.: 90/008,088
Filed : July 12, 2006
For U.S. Patent No. : 6,112,772

Reexam Control No.: 90/008,808
Filed : August 17, 2007
For U.S. Patent No. : 6,112,772

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. 90/008,088 was ordered in a decision mailed September 22, 2006. Prosecution proceeded to the mailing of a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) on February 24, 2007. The NIRC indicated that claims 1-7, all of the claims in the patent, were confirmed. A decision vacating the NIRC was mailed January 28, 2008. There were no amendments made to the claims, specification and/or drawings in this proceeding.

Reexamination in application control No. 90/008,808 was ordered in a decision mailed October 13, 2007 indicating that claims 1-7 will be reexamined. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/008,088 and reexamination control No. 90/008,808 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-7, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,088 and 90/008,808 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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.
90/008,089	07/13/2006	6813742	40162/00101	5726

30734 7590 03/07/2008

BAKER & HOSTETLER LLP
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WASHINGTON, DC 20036-5304

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/07/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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SUITE 702
NEW YORK,NY 10038

Date:
MAILED
MAR 07 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008089
PATENT NO. : 6813742
ART UNIT : 3900

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

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

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CENTRAL REEXAMINATION UNIT

BAKER & HOSTETLER LLP
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WASHINGTON DC 20036-5304

(For Patent Owner)

FAY KAPLUN & MARCIN, LLP
150 BROADWAY, SUITE 702
NEW YORK, NY 10038

(For Third Party Requester)

In re Reexamination Proceeding	:
Quang Nguyen	:
Control No. 90/008,089	: DECISION GRANTING PETITION
Filed: July 13, 2006	:
U.S. Patent No. 6,813,742	:
Attorney Docket No. 40473.1500	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on February 14, 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 (Response To Ex Parte Office Action - item 1), an authorization to charge counsel's deposit account for the $770.00 petition fee under 37 CFR 1.17(m) (item 2) and a Certificate of Service on the Third Party Requester.

Regarding the requisite statement (item3), 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a

grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement in the petition is being construed as the required statement. Petitioner must notify the Office if this is not a correct reading of the statement appearing in the petition.

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

$770.00 has been charged to counsel's deposit account no. 50-236 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3992 for further examination and consideration of the Response To Ex Parte Office Action filed February 14, 2008, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Majid A. Banankhah, in CRU Art Unit 3992, who can be reached at 571-272-3770.

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

Fred A. Silverberg

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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8484 Westpark Dr. 9th Floor
McLean VA 22102

(For Paten Owner)

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

(For Requestor)

MAILED

OCT 26 2006

CENTRAL REEXAMINATION UNIT

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

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

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

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

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

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

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

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

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

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

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,247 and 90/008,096 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,247 and 90/0078,096 as:

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

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

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

CONCLUSION

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

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

for Lissi M. Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,096	05/18/2006	6573099	023004.0103X2US	4110

32042 7590 10/21/2008
PATTON BOGGS LLP
8484 WESTPARK DRIVE
SUITE 900
MCLEAN, VA 22102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/21/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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OCT 2 1 2008

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008096

PATENT NO. 6,573,099

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
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(For Patent Owner)

MAILED

OCT 21 2008

CENTRAL REEXAMINATION UNIT

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

(For *Ex Parte* Requester)

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

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

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

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

The petition is granted.

REVIEW OF FACTS

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

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

§ 1.321 Statutory disclaimers, including terminal disclaimers.

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

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

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

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

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

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

(1) Be signed:

(i) By the applicant, or

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

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

(iv) By an attorney or agent of record;

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

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

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

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

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

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

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

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

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

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

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

The Manual of Patent Examining Procedure section 306 states:

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

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

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

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

(A) are filed by the same inventive entity;

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

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

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

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

II. DISCUSSION

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

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

Additional discussion:

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

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

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

CONCLUSION

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

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

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

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

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

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

By Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

By Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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

Kenneth M. Schor

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

C:\kiva\kenTD+SD\ 7247+8096 dec_pet_withdraw_TD
October 20, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 25 2009

CENTRAL REEXAMINATION UNIT

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For Patent Owner

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For Requester

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

DECISION ON
PETITION UNDER
37 CFR 1.181

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

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

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

Analysis and Findings

37 CFR 1.116 states in pertinent part:

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

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

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

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

filing of an appeal provided:

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

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

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

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

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

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

Conclusion

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

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

Conclusion

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

2. Any future response may be submitted as follows:

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

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

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

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

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

Gregory ~~Morris~~ Morse
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/008,096	05/18/2006	6573099	023004.0103X2US	4110

23432 7590 06/25/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/25/2009

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

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

23432 7590 06/25/2009

EXAMINER

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

ART UNIT	PAPER NUMBER

DATE MAILED: 06/25/2009

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

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
30 Rockefeller Plaza
2oth Floor
New York, NY 10112

(For Patent Owner)

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

(For Third Party Requester)

MAILED

JUN 25 2009

CENTRAL REEXAMINATION UNIT

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

: DECISION
: ON
: PETITIONS

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

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

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

FEES

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

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

REVIEW OF THE FACTS

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

DECISION ON PETITION UNDER 37 CFR 1.182

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

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

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

CONCLUSION

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

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

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

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

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

6-24-09
Kendpet7/RCR

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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ERIC A. LAMORTE (For Patent Owner)
LAMORTE & ASSOCIATES, PC
P.O. BOX 434
YARDLEY, PA 19067

MAILED

FEB 07 2008

CENTRAL REEXAMINATION UNIT

ROY J. COLEMAN (For Third Party Requester)
IANDIORIO & TESKA
260 BEAR HILL ROAD
WALTHAM, MA 02451

In re Reexamination Proceeding	:
Zuzelo et al.	:
Control No. 90/008,100	: DECISION GRANTING PETITION
Filed: June 16, 2006	:
U.S. Patent No. 6,651,644	:
Attorney Docket No. NED-105	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on December 26, 2007, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states, 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 in Ex Parte Reexamination - item 1), a $770.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester.

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit

(CRU) Art Unit 3993 for further examination and consideration of the Amendment in Ex Parte Reexamination filed December 26, 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, Jimmy Foster, in CRU Art Unit 3993, who can be reached at 571-272-4554.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,101	06/20/2006	5517628	33142.19	4940

20277 7590 11/12/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID M. O'DELL, HAYNES AND BOONE, LLP

901 MAIN STREET

SUITE 3100

DALLAS, TX 75202

MAILED

NOV 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008101

PATENT NO. 5,517,628

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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McDermott, Will & Emery LLP
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(For Patent Owner)

MAILED

NOV 12 2008

CENTRAL REEXAMINATION UNIT

David M. O'Dell
Haynes and Boone, LLP
901 Main Street, Suite 3100
Dallas, TX 75202

(For Requester)

In re Morrison *et al.*
Reexamination Proceeding
Control No.: 90/008,101
Filed: June 20, 2006
For: U.S. Patent No.: 5,517,628

RETURN OF IMPROPER PAPERS AND DECISION DISMISSING PETITION

This is a decision on the September 26, 2008 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The IDS filed September 26, 2008, is improper, will not be entered for consideration by the examiner and is being EXPUNGED.

Accordingly petition requesting entry of the IDS is dismissed as moot.

BACKGROUND

1. Patent number 5,517,628 (the '628 patent) issued on May 14, 1996.

2. A request for reexamination, assigned control No. 90/008,101 (the '8101 proceeding), was filed on June 20, 2006 by a third party requester.

3. On August 18, 2006 the Office issued an order granting the '8101 reexamination request.

4. The '8101 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on September 12, 2008.

5. On September 26, 2008, the instant petition was submitted with an IDS containing several references, which the patent owner requests post NIRC entry and consideration by the Office.

6. The '8101 reexamination proceeding is in the final phase of being prepared for publication of the reexamination certificate, i.e. it is in its printing cycle.

RELEVANT LAW AND PROCEDURE

35 U.S.C. § 305 provides (in part):

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

37 CFR 1.4(c) states:

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

37 CFR 1.550(g) provides:

The active participation of the *ex parte* reexamination requester ends with the reply pursuant to §1.535, and no further submissions **on behalf of the reexamination requester** will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:

(1) in accordance with §1.510 or §1.535; or

(2) entered in the patent file prior to the date of the order for ex parte reexamination pursuant to §1.525. (Emphasis added.)

37 CFR 1.565(a) provides:

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

MPEP § 2282 provides:

It is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing *ex parte* reexamination is or was involved, such as interferences, reissues, *inter partes* reexaminations, other *ex parte* reexaminations or litigations, and any results of such proceedings. In accordance with 37 CFR 1.565(a), the patent owner is required to provide the Office with information regarding the existence of any such proceedings, and the results thereof, if known. Ordinarily, no submissions of any kind by third parties filed after the date of the order are entered into the reexamination or patent file while the reexamination proceeding is pending. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. **Further, papers filed in the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments**, such as a memorandum in support of summary judgment. If the argument has an entry

right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right. It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. **Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office.** It is to 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. (Emphasis added.)

MPEP § 2254 provides, (in part):

Once *ex parte* reexamination is ordered pursuant to 35 U.S.C. 304 and the times for submitting any responses to the order have expired, no further active participation by a third party reexamination requester is allowed, and no third party submissions will be acknowledged or considered unless they are in accordance with 37 CFR 1.510. The reexamination proceedings will be ex parte, even if ordered based on a request filed by a third party, because this was the intention of the legislation. *Ex parte* proceedings preclude the introduction of arguments and issues by the third party requester which are not within the intent of 35 U.S.C. 305 ("reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title").

The patent owner may not file papers on behalf of the requester and thereby circumvent the intent of the ex parte reexamination legislation and the rules. The Court of Appeals for the Federal Circuit held in *Emerson Elec. Co. v. Davoil, Inc.,* 88 F.3d 1051, 39 USPQ2d 1474 (Fed. Cir. 1996) that a federal district court does not have the authority to order a patent owner to file papers prepared by a third party in addition to the patent owner's own submission in a patent reexamination proceeding. Such papers prepared by the third party and filed by the patent owner will not be entered, and the entire submission will be returned to the patent owner as an inappropriate response. See MPEP § 2266 and § 2267. (Emphasis added)

MPEP § 2256 provides (in part):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

MPEP § 2266 states (in part):

The patent owner in an *ex parte* reexamination proceeding must not file papers on behalf of a third party. 37 CFR 1.550(g). If a third party paper accompanies, or is submitted as part of a timely filed response, the response and the third party paper are considered to be an improper submission under 37 CFR 1.550(g), and **the entire submission shall be returned to the patent owner, since the Office will not determine which portion of the submission is the third party paper. The third party paper will not be considered.** The decision returning the improper response and the third party paper should provide an appropriate extension of time under 37 CFR 1.550(c) to refile the patent owner response without the third party paper. See MPEP § 2254 and § 2267. (Emphasis added)

DECISION

I. DIFFERENT MATTERS SUBMITTED IN A SINGLE PAPER

The September 26, 2008 submission of a single submission styled as an IDS containing both prior art patents and printed publication and further containing court documents from a related legal proceeding that are not prior art patents and printed publications is improper. IDS submissions of patents and printed publication are governed by 37 CFR 1.97-98 and MPEP § 609 whereas the submission of a notice of prior or concurrent proceedings and providing papers from that proceeding is governed by 37 CFR 1.565 and MPEP § 2282. Therefore by melding the two separate and distinct sets of information into a single paper that purports to be an IDS submission mechanism runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for each separately distinct and different matter, prior art submissions verses court notification. Therefore, the filing of a single IDS submission to serve as both a prior art submission and to serve as concurrent proceeding notification is improper, as it will render the record unclear and possibly result in non-prior art patents and printed publications, *e.g.* contemporaneously generated court papers, being considered in the proceeding. According the submission is <u>improper.</u>

II. MPEP 2254 & 2282 SUBMISSION OF THIRD PARTY ARGUMENTS

The September 26, 2008, IDS papers are improper, because upon review of the submission, it is noted that the patent owner is attempted to submit, via an IDS, third party court documents as "notification" of concurrent proceedings. In addition to being improperly submitted as noted above, the submission is improper under 37 CFR 1.565(a) and MPEP § 2282 because the third party court documents contain impermissible third party arguments in support of the third party's legal defence to patent owner's legal claim they infringed the '628 patent. Therefore, the submission is an improper submission of notification of concurrent proceedings. The submission will only be permitted on the record if there is vehicle by which the documents have a right of entry. The provisions of 37 CFR 1.5.65(a) cannot be waived, because there is no provision of the statute providing authority for a third party paper directed to the issues of the reexamination proceeding during the examination-prosecution stage of a an *ex parte* reexamination proceeding. *In re Amp,* 212 USPQ 826 (Comr. Pats. 1981). To the contrary, the *ex parte* reexamination legislation made the examination-prosecution stage of a reexamination proceeding under 35 U.S.C. 302 - 307 an *ex parte* proceeding. 35 U.S.C. 305 provides (in part):

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination **will be conducted** according to the procedures established for initial examination under the provisions of **sections 132 and 133** of this title. . . . (Emphasis added.)

The examination under the provisions of 35 U.S.C. 132 and 133 is *ex parte* examination. 35 U.S.C. 305 unequivocally requires such *ex parte* examination, and third party input (by a requester or ***any other party***) is thus prohibited after the times for filing the statement and reply provided for by section 304. See also *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office,* 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the court said (paragraph bridging pages 1868 & 1869):

> "If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination. *See* 35 U.S.C. § 305 **("[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination")**. Thus, a reexamination is conducted *ex parte* after it is instituted. *See In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1, 5-6 n.6 (Fed. Cir.), *cert.* denied, 474 U.S. 828 (1985)." (Emphasis added in bold)

Accordingly, materials authored/prepared by a third party are precluded during the examination-prosecution stage of a reexamination proceeding, because a reexamination proceeding requested under 35 U.S.C. 302 is an ***ex parte*** proceeding after the expiration of the statement/reply period under 37 CFR §§ 1.530 and 1.535.

To safeguard this statutory preclusion, MPEP § 2254 provides materials that are prepared by a third party cannot obtain entry by way of the patent owner submitting them.

Accordingly, the September 26, 2008 IDS submission lacks an entry right in the present '8101 reexamination proceeding because 1) patent owner is submitting arguments made by a third party that does not have any right of entry; and/or 2) any right of entry in regards to the third party requester expired once the examination phase of the proceeding commenced. While the September 26, 2008, submission was filed by the patent owner, patent owner's petition merely

points to the third party's arguments and rationales regarding the relevancy of the contain of the materials/documents in those documents authored/prepared by a third party in concurrent and related litigation, which do not have an entry right as an IDS submission nor a notification of concurrent proceedings as outlined above. * These materials contain third party arguments that go to the merits of the proceeding and provide unauthorized third party participation in the proceeding. See patent owner's petition under 37 CFR 1.182 requesting entry of an IDS after NIRC, documents cited in the accompanying IDS Form PTO/SB/08 "Other Art" section entitled: (1) Expert Report of Dr. M. Ray Mercer, PH.D., Regarding Patent Invalidity, (Sep. 19, 2008); (2) Supplemental Expert Report of Dr. M. Ray Mercer, PH. D., Regarding Patent Invalidity (Sep. 24, 2008); and (3) Defendant Sun Microsystems Inc.'s P.R. 3-3 Disclosures (Sep. 6, 2007). The assertions made in these cited papers are, as noted above, not prior art patents or printed publications, they are directed to the merits of the reexamination proceeding, as they are commenting on the patentability of claims subject to the instant reexamination in light of prior art patents and printed publications. The assertions are clearly sourced from a third party or parties who do not have a right to comment on the merits in the present *ex parte*, and having their opinions, arguments and assertions considered on the record by the examiner is contrary the reexamination rules and the statute.

In view of the above, the September 26, 2008, IDS papers have been reviewed only to the extent needed to find that they contain impermissible third party materials, and discussions of same, which touch upon the merits of the merged proceeding.

Because the September 26, 2008, IDS submission contains improper papers, the IDS submission is not being made a part of the record of the present proceeding. The copy of the September 26, 2008, papers filed for the '8,101 reexamination proceeding are being expunged from the record. As the improper papers have been scanned into the electronic Image File Wrapper (IFW) the papers cannot be physically returned to the patent owner. Rather, the improper papers are being expunged by closing the submission documents in the IFW file of the'8101 proceeding and marking the documents "not public." They will not constitute part of the record of the present reexamination proceeding. In accordance with MPEP § 2266 all papers in the IDS submission will be expunged as the Office will not determine which portion of the submission is the third party paper. A copy of this decision will be made of record in the '8101 proceeding.

As the IDS submission is being expunged because it lacks an entry right, the petition requesting entry of the IDS after NIRC is dismissed as moot.

III. ADDITIONAL DICUSSION REGARDING THE POST NIRC IDS PETITION

As patent owner/petitioner's request of entry after NIRC is improper and being returned, the petition is rendered moot. However, the following additional discussion is provided as guidance regarding the merits of the petition if the IDS submission had been otherwise been entitled to an entry right.

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* Furthermore, the September 26, 2008, submission, containing third party authored/prepared materials, is not an owner's statement pursuant to 37 CFR 1.530, nor a reply pursuant to 37 CFR 1.535 in accordance with 35 USC 305 and it may not even be from the third party requester who initiated the instant *ex parte* proceeding. The September 26, 2008, submission is not a request for reexamination in compliance with the requirements of 37 CFR 1.510 (it not in the proper format for a request for reexamination, and the reexamination filing fee has not been paid). Nor do the third party prepared court papers in the September 26, 2008 submission qualify as a prior art citation under 37 CFR 1.501. Therefore, based on 37 CFR 1.550(e), the September 26, 2008, submission does not have an entry right.

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present merged proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 C.F.R. 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2656 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the examination of the reexamination, and petitioner/patent owner fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. To the contrary, patent owner merely cites to impermissible third party allegations in the court papers of a related proceeding which state that certain references support an invalidity defense against infringement. Patent owner/petitioner does not provide a discussion of the substance of any of the prior art patents or printed publication and has not applied the teachings of the same to the claim limitations in the present merged reexamination proceeding.

Furthermore, there is no factual accounting providing an explanation as to why the prior art patents or printed publications submitted could not have been submitted earlier. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed, even if the IDS had been submitted before the proceeding entered the publication cycle.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." It is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory provision for special dispatch, and such criteria must certainly be complied with for a

reexamination proceeding *where there is a statutory mandate for special dispatch.* This is explicitly set forth in the MPEP, as set forth above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on September 12, 2008, and the proceeding has now entered the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure to identify a question of patentability of the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the '8101 reexamination proceeding will <u>not</u> be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is <u>dismissed</u> as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

Therefore, even if the IDS submission was proper, the petition requesting entry of the IDS after NIRC could no be granted.

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

CONCLUSION

1. The September 26, 2008 IDS submission is an improper paper, and therefore will NOT be made a part of the record of the '8101 proceeding.

2. The September 26, 2008 IDS submission has been scanned into the electronic Image File Wrapper (IFW) of the '8101 proceeding. Thus the copy cannot be physically returned to the third party requester. Rather, the submission paper is expunged by closing the submission documents in the '8101 reexamination proceeding's IFW file and marking them as "non-public."

3. The petition is dismissed as moot.

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

5. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor Office of Patent Legal Administration at (571) 272-7759 or the undersigned at (571) 272-7710.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID M. O'DELL, HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202

Date:

MAILED
DEC 03 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008101
PATENT NO. : 5517628
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,101	06/20/2006	5517628	33142.19	4940

20277 7590 12/03/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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McDermott, Will & Emery LLP
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(For Patent Owner)

David M. O'Dell
Haynes and Boone, LLP
901 Main Street, Suite 3100
Dallas, TX 75202

(For Requester)

MAILED

DEC 03 2008

CENTRAL REEXAMINATION UNIT

In re Morrison *et al.*
Reexamination Proceeding
Control No.: 90/008,101
Filed: June 20, 2006
For: U.S. Patent No.: 5,517,628

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

This is a decision on the September 26, 2008 patent owner petition under 37 CFR 1.182 to enter information, as supplemented on October 1, 2008, and to reopen prosecution of the reexamination proceeding.

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

The petition requesting reopening of prosecution of the reexamination proceeding is dismissed.

BACKGROUND

1. Patent number 5,517,628 (the '628 patent) issued on May 14, 1996.

2. A request for reexamination, assigned control No. 90/008,101 (the '8101 proceeding), was filed on June 20, 2006, by a third party requester.

3. On August 18, 2006, the Office issued an order granting the '8101 reexamination request.

4. The'8101 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on September 12, 2008.

5. On September 26, 2008, patent owner submitted the instant petition to reopen prosecution of the '8101 reexamination proceeding. Concurrently with the instant petition, patent owner submitted a first post NIRC Information Disclosure Statement (IDS) containing several references along with another petition requesting entry and consideration of the first post NIRC IDS.

6. On October 1, 2008, patent owner submitted a petition supplementing the September 26, 2008 petition requesting reopening of prosecution of the '8101 reexamination proceeding. Concurrently with the supplemental petition patent owner submitted a second post NIRC IDS containing additional references, but without a petition requesting

entry of the second post NIRC IDS.

7. On November 12, 2008, the Office issued a decision expunging patent owner's September 26, 2008 IDS as improper and dismissing patent owner's petition to enter and consider the contents of the first post NIRC IDS.

8. Concurrently with this decision the Office is issuing a decision expunging patent owner's second post NIRC IDS as untimely as it was not accompanied with a petition under 37 CFR 1.182.

9. The '8101 reexamination proceeding is in the final phase of being prepared for publication of the reexamination certificate, i.e. it is in its printing cycle.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, patent owner petitioner is requesting that the Office continue the prosecution of the '8101 reexamination proceeding to permit entry of additional evidence and provide consideration of such additional evidence and permit patent owner to respond to any commentary the Office may make of record in regards to the submitted evidence. The petition is not seeking reopening prosecution in order to respond to matters that are already of record, e.g. to respond to an issue raised in an Office Action issued by the Office.

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. 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 mandates that *ex parte* reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner was required to make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the

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

issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The present submission did not do so. Rather, based on the facts and circumstances of the present case, it is found that petitioner patent owner's presentation of an amendment and argument directed to the determination of patentability is not a *bona fide* effort to advance prosecution toward appeal, or toward the issuance of a reexamination certificate. As such, the granting of the present petition is inconsistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner presents a single basis to justify the granting of the relief requested for continued reexamination in light of on going litigation: Additional evidence may arise that could bring into question the patentability of the claims resulting from the '8101 reexamination proceeding and thus implicate the underlying polices of 37 CFR 1.555, the duty to disclose information that is material to patentability and the public interest in having such claims vetted in light of any newly found art. Such would be a basis for filing a new request for reexamination, if a substantial new question of patentability is raised, but is not a basis for granting the present petition.

Petitioner is not attempting to respond to an unforeseeable matter that was raised by the examiner in an Office action during the prosecution of the reexamination proceeding, and for which patent owner did not have an opportunity to respond.

In addition, it is observed that petitioner has submitted documents from litigation, and has not indicated how these documents are "material to patentability." Of those documents that are patents or printed publications, petitioner is not alleging that the information is material to patentability, but instead is relying upon allegations of unpatentability from impermissible third party commentary. (See the Petition decision of November 12, 2008, section III, page 7 where the Office found the patent owner merely pointing to impermissible third party allegations regarding unpatentability of the claims at issue.) None of the documents currently submitted can be entered on the record, let alone serve as a basis for reopening prosecution of a reexamination proceeding.

In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the fact that reopening is based on a submission that does not address issues raised in this proceeding, and includes improper papers, the '8101 reexamination proceeding will <u>not</u> be reopened at this late date. Accordingly, in view of the above and the fact situation presented by the record, the petition is <u>dismissed</u>, prosecution will not be reopened and the '8101 reexamination proceeding will continue to progress towards publication.

If, however, the patent owner in fact believes that one or more of the prior art patents and printed publications submitted along with the improper third party papers 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).

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The '8101 *ex-parte* reexamination proceeding will continued towards publication.

3. Jurisdiction for the '8101 reexamination proceeding is returned to the Office of Publications.

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

Dec. 2, 2008
C:\Kiva\Kenpet7\RCR\ 8101_RCR_dismiss-IDS+ct documents

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.
90/008,196	08/28/2006	6009488	17774-010LL1	7379

26568 7590 10/12/2007

COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD
SUITE 2850
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CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/12/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,106	06/30/2006	6009488	0298-0001.03	9951

26568 7590 10/12/2007

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/12/2007

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200 West Adams Street, Suite 2850
Chicago, IL 60606

(For Patent Owner Requester)

MAILED

OCT 12 2007

CENTRAL REEXAMINATION UNIT

Fish & Richardson P.C.
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Minneapolis, MN 55440-1022

(For Third Party Requester)

In re Kavipurapu Reexamination Proceeding Control No. 90/008,106 Request Deposited: June 30, 2006 For: U.S. Patent No. 6,009,488	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Kavipurapu Reexamination Proceeding Control No. 90/008,196 Request Deposited: August 28, 2006 For: U.S. Patent No. 6,009,488	

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. 6,009,488 (hereinafter, the '488 patent), issued to Kavipurapu, on December 28, 1999.

2. On June 30, 2006, Patent Owner deposited a Request for *Ex Parte* Reexamination of claims 1-13 of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,106 (hereinafter, the '8106 proceeding).

3. The Reexamination Order was granted in the '8106 proceeding on August 22, 2006.

4. There are currently no amendments in the '8106 proceeding.

5. On August 28, 2006, a third party deposited a Request for *Ex Parte* Reexamination of claims 1, 2, 3, and 6 of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,196 (hereinafter, the '8196 proceeding).

6. The Reexamination Order was granted in the '8196 proceeding on October 20, 2006.

7. There are currently no amendments in the '8196 proceeding.

8. The '8106 and the '8196 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 '8106 and the '8196 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. 90/008,106 and 90/008,196 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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUN 19 2008

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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P.O. Box 1022
Minneapolis, MN 55440-1022

(For Third Party Requester)

Perkins Coie LLP
Patent-Sea
P.O. Box 1247
Seattle, WA 98111-1247

(For Third Party Requester)

In re Kavipurapu
Reexamination Proceeding
Control No. 90/008,106
Request Deposited: June 30, 2006
For: U.S. Patent No. 6,009,488

In re Kavipurapu
Reexamination Proceeding
Control No. 90/008,196
Request Deposited: August 28, 2006
For: U.S. Patent No. 6,009,488

In re Kavipurapu
Reexamination Proceeding
Control No. 90/009,098
Request Deposited: March 26, 2008
For: U.S. Patent No. 6,009,488

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. 6,009,488 (hereinafter, the '488 patent), issued to Kavipurapu, on December 28, 1999.

2. On June 30, 2006, patent owner deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,106 (hereinafter, the '8106 proceeding).

3. The Reexamination Order was granted in the '8106 proceeding on August 22, 2006.

4. On August 28, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,196 (hereinafter, the '8196 proceeding).

5. The Reexamination Order was granted in the '8196 proceeding on October 20, 2006.

6. The '8106 and the '8196 proceedings were merged on October 12, 2007.

7. A non-final office action was mailed on October 29, 2007.

8. A response was filed on December 27, 2007, and a supplemental response was filed on January 21, 2008, including an amendment to the claims.

9. On March 26, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/009,098 (hereinafter, the '9098 proceeding).

10. The Reexamination Order was granted in the '9098 proceeding on May 15, 2008.

11. Patent Owner waived the right to file a statement under 37 CFR 1.530 on June 2, 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 '8106, '8196, and '9098 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.

As noted above, the claims have been amended in the '8106 and '8196 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

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. 90/008,106, 90/008,196, and 90/009,098 are **merged**.

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

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

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Eric Keasel For

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.
90/008,108	07/18/2006	5425051		2404

7590 01/31/2007

WILLIAM M. WESLEY
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON ST.
34TH FLOOR
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

1/31/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ROBERT C. LAURENSON
HOWREY LLP
2020 MAIN STREET SUITE 1000
IRVIN,CA 92614

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008108
PATENT NO. 5,425,051
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

William M. Wesley MCANDREWS, HELD & MALLOY, LTD 500 West Madison Street, 34th Floor Chicago, IL 60661	(for patent owner)
Robert C. Laurenson HOWREY LLP 2020 Main Street, Suite 1000 Irvine, CA 92614	(for requestor)
In re MAHANY Reexamination Proceeding Control No. 90/008,034 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	DECISION MERGING REEXAMINATION PROCEEDINGS
In re MAHANY Reexamination Proceeding Control No. 90/008,033 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	
In re MAHANY Reexamination Proceeding Control No. 90/008,108 Filed: July 18, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	

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

BACKGROUND

1. Patent No. 5,425,051 issued on June 13, 1995.

2. A first request for reexamination, Reexamination Control No. 90/008,033, was filed by the third party requester on May 22, 2006. This request was directed to claims 1, 5, 6, and 10.

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. A request for reexamination, Reexamination Control No. 90/008,034, was filed by the third party requester on May 22, 2006. This request was directed to claims 24 and 26-28.

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. A request for reexamination, Reexamination Control No. 90/008,108, was filed by the same third party requestor on July 18, 2006. This request was directed to claims 24 and 26-28.

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8033, '8034 and '8018 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/008,033; 90/008,034 and 90/008,108 are merged. Since there are no amendments to any of the above proceedings a housekeeping amendment/response is not required from the Patent Owner for the proceedings

Patent owner is required to maintain the same claims and specification in all files.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

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

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William M. Wesley MCANDREWS, HELD & MALLOY, LTD 500 West Madison Street, 34th Floor Chicago, IL 60661	(for patent owner)
Robert C. Laurenson HOWREY LLP 2020 Main Street, Suite 1000 Irvine, CA 92614	(for requestor)
In re MAHANY Reexamination Proceeding Control No. 90/008,034 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	*SUA SPONTE* DECISION MERGING REEXAMINATION PROCEEDINGS
In re MAHANY Reexamination Proceeding Control No. 90/008,033 Filed: May 22, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	
In re MAHANY Reexamination Proceeding Control No. 90/008,108 Filed: July 18, 2006 Title: **RADIO FREQUNCY COMMUNICATION NETWORK HAVING ADAPTIVE PARAMETERS**	

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

BACKGROUND

1. Patent No. 5,425,051 issued on June 13, 1995.

2. A first request for reexamination, Reexamination Control No. 90/008,033, was filed by the third party requester on May 22, 2006. This request was directed to claims 1, 5, 6, and 10.

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. A request for reexamination, Reexamination Control No. 90/008,034, was filed by the third party requester on May 22, 2006. This request was directed to claims 24 and 26-28.

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. A request for reexamination, Reexamination Control No. 90/008,108, was filed by the same third party requestor on July 18, 2006. This request was directed to claims 24 and 26-28.

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8033, '8034 and '8018 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/008,033; 90/008,034 and 90/008,108 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

Patent owner is required to maintain the same claims and specification in all files.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,108	07/18/2006	5425051		2404

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,033	05/22/2006	5425051	05920.0041.RXUS01	8062

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,034	05/22/2006	5425051	05920.0041.RXUS00	8332

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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.
90/009,102	04/02/2008	5,425,051		6470

23446 7590 08/22/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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AUG 22 2008

CENTRAL REEXAMINATION UNIT

McAndrews, Held & Malloy, Ltd.
500 W. Madison St., Ste. 3400
Chicago, IL 60661

(For Patent Owner)

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 Mahany
Reexamination Proceeding
Control No. 90/008,033
Request Deposited: May 22, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/008,034
Request Deposited: May 22, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/008,108
Request Deposited: July 18, 2006
For: U.S. Patent No. 5,425,051

In re Mahany
Reexamination Proceeding
Control No. 90/009,102
Request Deposited: April 2, 2008
For: U.S. Patent No. 5,425,051

DECISION *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,425,051 (hereinafter, the '051 patent), issued to Mahany, on June 13, 1995.

2. A first request for reexamination was filed by a third-party requester on May 22, 2006 and assigned Control No. 90/008,033 ("the '8033 reexamination proceeding").

3. Reexamination was ordered in the '8033 reexamination proceeding on July 26, 2006.

4. On May 22, 2006, a second request for reexamination of the '051 patent was filed by a third-party requester, and was assigned Control No. 90/008,034 ("the '8034 reexamination proceeding).

5. Reexamination was ordered in the '8034 reexamination proceeding on July 26, 2006.

6. On July 18, 2006, a third request for reexamination of the '051 patent was filed by a third-party requester. The request was assigned Control No. 90/008,108 ("the '8108 reexamination proceeding).

7. Reexamination was ordered in the '8108 reexamination proceeding on September 29, 2006.

8. The '8033, '8034 and '8018 reexamination proceedings were merged into a single, combined reexamination proceeding on February 12, 2007.

9. A Non-final action on the merits was issued for the merged reexamination on December 7, 2007.

10. Patent owner timely filed a reply to the Non-final office action for the merged reexamination proceeding on February 5, 2008. Said reply included an amendment.

11. A fourth request for reexamination of the '051 patent was filed on April 2, 2008, by a third-party requester. The request was assigned Control No. 90/009,102 ("the '9102 proceeding").

12. Reexamination was ordered in the '9102 reexamination proceeding on June 30, 2008.

13. Patent Owner filed a statement waiving the right to file a Patent Owner's Statement on August 19, 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 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 '8033, '8034, '8108 and the '9102 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, the claims have been amended in the '8033, '8034, and '8108 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in quadruplicate, 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. 90/008,033, 90/008,034, 90/008,108, and 90/009,102 are **merged**.

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

3. Responses may be submitted via EFS or as follows:

By fax:	(571) 273-9900 Central Reexamination Unit
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

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.
90/008,110	07/07/2006	7053666	123034-06071887	4726

22429 7590 12/02/2009

LOWE HAUPTMAN HAM & BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/02/2009

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

MAYER BROWN LLP (For Patent Owner)
P.O. Box 2828
Chicago, IL 60690

MAILED
DEC 0 2 2009
CENTRAL REEXAMINATION UNIT

LOWE HAUPTMAN HAM & BERNER, LLP (Courtesy Copy)
1700 Diagonal Road
Suite 300
Alexandria, VA 22314

In re Tak et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,110
Filed: July 7, 2006
For: U.S. Patent No. 7,053,666

DECISION GRANTING PETITION UNDER 37 CFR 1.137(b), AND VACATING CERTIFICATE

This is a decision on the September 4, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination ("the September 4, 2009 petition to revive").

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

The petition to revive is **granted**.

Reexamination Certificate No. C1 7,053,666 issued July 28, 2009, for the present proceeding and the March 10, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) for the present proceeding are hereby **vacated**.

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).

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 $270.00 on September 4, 2009, thereby satisfying item (1).[1]

A petition fee of $810.00 was submitted on September 4, 2009, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted as part of the September 4, 2009 petition to revive. Therefore, item (3) is deemed to have been satisfied.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Accordingly, the September 4, 2009 petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 7,053,666 issued for the present proceeding on July 28, 2009. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued on March 10, 2009, and the reexamination certificate are hereby **vacated**. Jurisdiction over the proceeding is being forwarded to the Central Reexamination Unit (CRU) for action consistent with this decision, at which point the examination and prosecution of the reexamination proceeding will be resumed.

In due course, the following *erratum* will be duly published in the *Official Gazette*:

---

[1] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[2] *See*: 37 CFR 1.137(d)(3).

All reference to Reexamination Certificate No. C1 7,053,666 to Tak et al. of Seoul (KR) for PHASE FREQUENCY DETECTOR, appearing in the *Official Gazette* of July 28, 2009, should be deleted, since the reexamination certificate has been vacated.

PATENT OWNER'S CORRESPONDENCE ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 7,053,666 patent file is that of Mayer Brown LLP, P.O. Box 2828, Chicago, IL 60690.

As a courtesy, this decision is being mailed to the address of Lowe Hauptman Ham & Berner, LLP, 1700 Diagonal Road, Suite 300, Alexandria, VA 22314, in view of the April 22, 2008 Power of Attorney and the April 28, 2009 Notice of Acceptance of Power of Attorney present in the file of the '8110 reexamination proceeding.

The address of Mayer Brown LLP, P.O. Box 2828, Chicago, IL 60690, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '666 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the March 10, 2009 NIRC, and the NIRC itself, are **vacated**.

3. The *Ex Parte* Reexamination Certificate issued July 28, 2009, is **vacated**.

4. Jurisdiction over the 7,053,666 patent is forwarded to the Office of Patent Publication for further processing consistent with this decision.

5. Jurisdiction over the 90/008,110 reexamination proceeding (the '8110 proceeding) is forwarded to the Central Reexamination Unit (CRU), Art Unit 3992, for further processing in view of the September 4, 2009 Notice of Appeal.

6. The address of Mayer Brown LLP, P.O. Box 2828, Chicago, IL 60690, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '666 patent file is made in accordance with 37 CFR 1.33(c).

7. The time period for filing an appeal brief in the '8110 proceeding 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).

8. Any inquiry concerning the examination of the '8110 proceeding should be directed to the primary examiner, Matthew Heneghan, of CRU Art Unit 3992, at (571) 272-3834.

9. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

/Kenneth M. Schor/

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

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12-1-09

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.
90/008,113	09/07/2006	6711615	1904-001	2543

45274 7590 09/23/2008

SRI INTERNATIONAL
333 RAVENSWOOD AVENUE
MENLO PARK, CA 94025

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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.
90/009,127	04/25/2008	6711615	1904-001	7612

45274 7590 09/23/2008

SRI INTERNATIONAL
333 RAVENSWOOD AVENUE
MENLO PARK, CA 94025

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RENEE D. BROWN
DAY, CASEBEER,MADRID&BATCHELDER LLP
20300 STEVENS CREEK BLVD. SUITE 400
CUPERTINO, CA 95014

Date:
MAILED

SEP 23 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008113
PATENT NO. : 6711615
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAY CASEBEER MADRID & BATCHELDER LLP
ATTN: RENEE DUBORD BROWN
20300 STEVENS CREEK BOULEVARD SUITE 400
CUPERTINO, CA 95014

Date:
MAILED

SEP 23 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009127
PATENT NO. : 6711615
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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United States Patent and Trademark Office
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SEP 23 2008

CENTRAL REEXAMINATION UNIT

SRI INTERNATIONAL 333 RAVENSWOOD AVENUE MENLO PARK CA 94025	:	(For Patent Owner)
Renee DuBord Brown DAY CASEBEER MADRID & BATCHELDER LLP 20300 Stevens Creek Boulevard Suite 400 Cupertino, CA 95014	:	(for Third Party Requester)
	:	DECISION, MERGING REEXAMINATION PROCEEDINGS 37 C.F.R. § 1.565(c)
In re: Porras *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,113 Deposited: 7 September 2006 For: US Patent No. 6,711,615	:	
In re: Porras *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,127 Deposited: 25 April 2008 For: US Patent No. 6,711,615	:	

The above-identified reexamination files are before the Director of the Central Reexamination Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,711,615 issued on 23 March 2004.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,113 was requested by a third party requester on 7 September 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,113 on 22 November 2006.

4. There are currently no amendments proceeding control number 90/008,113.

5. *Ex Parte* Reexamination Proceeding, control no. 90/009,127 was requested by a third party requester filed on 25 April 2008.

6. The Reexamination Order was granted in proceeding, control no. 90/009,127 on 19 July 2008.

7. There are currently no amendments proceeding control number 90/009,127.

8. Proceedings control numbers 90/008,113 and 90/009,127await action 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.

2283 Multiple Copending Ex Parte Reexamination Proceedings (in part)

In order for a second or subsequent request for ex parte reexamination to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. MPEP § 2240 provides a discussion as to whether a substantial new question of patentability is raised by the prior art cited in a second or subsequent request for reexamination filed while a reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to combine the proceedings will be made by the Central Reexamination Unit (CRU)

Director where the reexamination is pending. The CRU Director may delegate this to the Special Program Examiner (SPRE). No decision on combining the reexaminations should be made until reexamination is actually ordered in the later filed request for reexamination.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. While merger is at the discretion of the Director of the CRU, given the facts noted above, 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 90/008,113 and 90/009,127 reexamination proceedings are hereby 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. 90/008,113 and 90/009,127 are hereby **MERGED**.

2. The reexamination files are being forwarded to the examiner for further 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, at (571) 272-1611, or Eric Keasel, at (571) 272-4929, Supervisory Patent Examiners, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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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.
90/008,113	09/07/2006	6711615	1904-001	2543

26181 7590 12/04/2008
FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/04/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RENEE D. BROWN
DAY, CASEBEER,MADRID&BATCHELDER LLP
20300 STEVENS CREEK BLVD. SUITE 400
CUPERTINO, CA 95014

Date:
MAILED
DEC 04 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008113
PATENT NO. : 6711615
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 04 2008

CENTRAL REEXAMINATION UNIT

Thomas A. Rozylowicz
FISH & RICHARDSON, P.C.
PO Box 1022
MINNEAPOLIS, MN 55440-1022

: (For Patent Owner)

Renee DuBord, Esq.
DAY, CASEBEER MADRID
& BATCHELDER LLP
20300 STEVENS CREEK BLVD
SUITE 400
CUPERTINO, CA 95014

: (For Third-Party Requester)

In re PORRAS *et alia*
Reexamination Proceeding
Control No. 90 / 008,113
For: U.S. Patent No. 6,771,615

In re PORRAS *et alia*
Reexamination Proceeding
Control No. 90 / 009,127
For: U.S. Patent No. 6,771,615

: DECISION DISMISSING
: PETITION FOR
: ADMISSION OF EVIDENCE
: UNDER 37 CFR 1.116

This is a decision on patent owner's petition for admission of evidence under 37 CFR 1.116 filed on November 21, 2008. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 6,771,615 was ordered in the Determination mailed November 22, 2006.

2. The proceeding was merged with Reexamination proceeding 90/009,127 on September 23, 2008.

3. Prosecution was closed with the final rejection mailed September 30, 2008. The action set a two month period for response.

4. A petition for an extension of time was filed on November 21, 2008.

4. The petition for extension of time was granted on November 25, 2008. The period for response has been extended to the date requested by Owner. Patent owner's response to the Office action dated September 24, 2008 is due December 5, 2008.

37 CFR 1.116 states in pertinent part:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

*(a) An amendment after final action must comply with § **1.114** or this section.*

*(b) After a final rejection or other final action (§ **1.113**) in an application or in an ex parte reexamination filed under § **1.510**, or an action closing prosecution (§ **1.949**) in an inter partes reexamination filed under § **1.913**, but before or on the same date of filing an appeal (§ **41.31** or § **41.61** of this title):*

.

.

.

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

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[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

DECISION

37 CFR 1.116 provides for the admission of amendments affidavits or other evidence after final action and prior to appeal. Here, it appears petitioner is asking for an indication that the showing of good and sufficient reasons why the evidence is necessary and was not earlier presented passes approval prior to the formulation of a complete response to the outstanding final rejection. Petitioner states "this evidence is necessary to formulate a complete response to the outstanding final office action" indicating the petition is not to be construed as a complete response. It is apparent that petitioner hopes to be persuasive in some manner via the presentation of the evidence and it is not be submitted merely to be made "of record". However the paper has not been presented as an "amendment after final rejection" or "submission of evidence after final rejection": the paper is stylized as a "petition" for admission of evidence under 37 CFR 1.116.

37 CFR 1.116 provides no basis for granting the relief sought. Judgment on the propriety of any response submitted after final rejection is passed upon by the primary examiner and is reviewed in the total context of the complete response including the showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Simply, this judgment can not be made separate from and absent the proposed actions or arguments provided by a complete response. Further, 37 CFR 1.116 nowhere authorizes any "petition".

The petition can not be construed as a petition filed under 37 CFR 1.181 as no adverse action related to the admission of evidence has been made by the examiner. Should applicant submit a complete response and believe it to be improperly denied entry by the examiner; relief may be sought under this regulation.

The following observations are noted. As it is stated the evidence resulted from cross-examined trial testimony, it would be helpful if any showing after Final included an indication as to the source of the testimony. It would be reasonable to explain which side of the litigation the witnesses represented. If the witnesses were testifying on behalf of Owner, an explanation of why the positions of the witness(s) were not earlier presented via affidavit would be in order.

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running from the September 5, 2008 Office action as extended in the November 11, 2008 decision on petition for extension of time. Patent Owner's response is due December 5, 2008.

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.

for

Gregory Morse
Director, Central Reexamination Unit

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Alexandria, VA 22313-1450
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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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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.
90/009,117	04/21/2008	6113258	ARDT 1001-1	4597

22470 7590 04/01/2010
HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
HALF MOON BAY, CA 94019

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2010

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
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.
90/009,117	04/21/2008	6113258	ARDT 1001-1	4597

22470 7590 04/01/2010

GORDON & JACOBSON, P.C.
60 Long Ridge Rd
Suite 407
Stamford, CT 06902

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
HALF MOON BAY, CA 94019

(For Patent Owner)

MAILED

APR 01 2010

CENTRAL REEXAMINATION UNIT

GORDON & JACOBSON, P.C.
60 Long Ridge Rd
Suite 407
Stamford, CT 06902

(For Requester)

In re Mahany
Reexamination Proceeding
Control No. 90/009,117
For: U.S. Patent No. 5,425,051

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the September, 22, 2008 paper entitled "PETITION FOR REVIEW UNDER 37 C.F.R. §§ 1.515(c), 1.181". No fee is required. The petition is 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. 5,425,051 (hereinafter, the '051 patent) issued on June 13, 1995 to Mahany.

2. On June 10, 2008, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/009,177 (hereinafter, the '9177 proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on August 21, 2008. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

4. On September 22, 2008, the present petition was filed.

DECISION

Third party requester ("Petitioner") in the '9177 reexamination proceeding has petitioned seeking relief from the examiner's August 21, 2008 Order denying *ex parte* reexamination for all requested claims.

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for original claims 24 and 26-28 and newly proposed claims 44-89 was correct.

The following rules and procedures are applicable to this review:

> 35 U.S.C. § 303(c) provides:
>
> A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.
>
> 37 CFR § 1.515(c) provides:
>
> The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."
>
> MPEP § 2248 provides, in pertinent part:
>
> If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo*.
>
> For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of

patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '051 Patent

The '051 patent issued on June 13, 1995 to Mahany. During the prosecution, the examiner issued a notice of allowance stating that the reasons for allowance was that the prior art did not teach "selectively adjusting the length of the spreading code in response to an evaluation of the current system." This particular claim element is set forth in claim 1. Claim 24 is identical to claim 1 except that claim 24 substitutes "selecting a type of source encoding to be used in maintaining RF communication" for claim 1's "selectively adjusting the length of the spreading code in response to an evaluation of the current system." Thus, the record suggests that the Examiner believed the prior art teaches each claimed limitation of claim 24 except for the element of "selecting a type of source encoding to be used in maintaining RF communication."

Four prior reexamination requests have been received and assigned control numbers 90/008,033, 90/008,034, 90/008,108, and 90/009,102. These four reexaminations were then merged. In the prior reexaminations, original claims 24 and 26-28 and newly proposed claims 44-89 were reexamined. On August 29, 2008, a Notice of Intent to Issue a Reexamination Certificate ("NIRC") was issued that confirmed the patentability of original claims 24 and 26-28, allowed newly proposed claims 44-72, and canceled newly proposed claims 73-89.

III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination, taking into account the third party requester's position, as presented in the instant petition, has been made as to whether the June 10, 2008 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '051 patent filed in the '9177 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

Petitioner asserts that proposed SNQ#7, SNQ#3, and SNQ#4 of the request raise a SNQ. Each of those proposed SNQs are separately considered below. Petitioner further requests that the issuance of the reexamination certificate in merged control numbers 90/008,033, 90/008,034, 90/008,108, and 90/009,102 be stayed and the certificate withdrawn from publication. This request is denied. Petitioner has no standing to request to request a stay of proceedings

90/008,033, 90/008,034, 90/008,108, and 90/009,102 because Petitioner does not represent the patent owner in those *ex parte* proceedings.

I. SNQ#7

Petitioner first argues that the proposed rejection of claims 24 and 26-28 in view of Antonio and Acampora raises a SNQ. Petitioner asserts that the technical teachings of the references are new and non-cumulative and would be important to a reasonable examiner in determining patentability of at least one claim.

The request alleges that the distinguishing features are taught by Acampora as follows:

> This section shows (1) the symbol mapping that occurs in the 4-PSK and 32-PSK modulation levels described in Acampora '619 results in bandwidth efficient representations within the meaning of the '051 patent; (2)there are strong parallels between these 4-PSK and 32- PSK representations and the NRZ and PR encoding described in the '051 patent; and (3) these 5- PSK and 32-PSK representations are therefore distinct types of "source encoding" under the broadest reasonable construction. In one embodiment of Acampora '619, the symbol rate is fixed. (See Acampora '619, Col. 5:16-18 ("The channel symbol rate, in bauds, can..remain fixed.... ")). In this embodiment, the bandwidth, which is twice the symbol rate, is likewise fixed.35 The 4-PSK symbol representation results in a data rate that is twice the symbol rate, because each symbol carries 2 bits, and the 32-PSK symbol representation results in a data rate that is five times the symbol rate, because each symbol carries 5 bits. Thus, the bandwidth efficiency of the 32-PSK representation (2.5 times symbol rate) is 2.5 times the bandwidth efficiency of the 4-PSK representation (equal to symbol rate). The '051 patent teaches that NRZ and PR. encodings that vary the bandwidth efficiency between .3, .6 and 1 bps/Hz are multiple types of source encoding. (See Section XI(A)(2), supra). Therefore, so too here, the 4-PSK and 32-PSK symbol representations comprise multiple types of source encoding within the meaning of the '051 patent before they vary the bandwidth efficiency by a factor of 2.5. (Id.). *See Request for Reexamination, Page 173.*

Acompara's technical teachings are not new because they are cumulative to the teachings set forth by Goodman in the previous reexaminations. Acompara does teach the adaptive selection of a type of source encoding by teaching the varying of the symbol representations from 4 symbol to 32 symbol representation depending upon the fade conditions (Acompara *column 8 lines 23-44*). However, Goodman discloses similar technical features such as the varying of channel encoding by varying the number of symbols representing a sample (*Goodman, Page 212 – 3 bit or 2 bit encoding of speech transmissions depending upon conditions)*. These technical features of Goodman were considered and applied against the original claims of the '051 patent in previous reexamination 90/008033. Accordingly, Acompara's teachings are cumulative to those already on the record because the same question of patentability has been decided by the Office in a previous reexamination.

II. SNQ#3

Petitioner next argues that the proposed rejection of claims 24 and 26-28 in view of Paneth, Rydbeck, and Kaltenmeier raises a SNQ. Petitioner asserts that the technical teachings of the references are new and non-cumulative and would be important to a reasonable examiner in determining patentability of at least one claim.

The request alleges that the distinguishing feature is taught by Paneth and Rydbeck as follows:

> "In the system resulting from the obvious combination of Paneth '863 and Rydbeck ' 151, in response to the "evaluating means" indicating little or no deterioration of communication conditions, the transmitter in both the mobile terminal and base station would select format 1, source words without error protecting encoding, and bypass the adaptive encoder shown in Fig. 1 of Rydbeck '151, as Rydbeck '151 teaches at Col. 5:38-47 and Col. 4:40-43. In response to the "evaluating means" indicating a moderate deterioration of communication conditions, the base station and mobile terminal would utilize a format, such as formats 2 or 3, which add error protecting encoding without reducing the information transmission rate, as Rydbeck ' 151 teaches at Col. 2:36-40 and Col. 6:25-33. In response to the "evaluating means" indicating a more severe deterioration of communication conditions; the base station and mobile terminal would utilize a format, such as format 4, that adds error protecting encoding but reduces the information transmission rate, as Rydbeck '151 teaches at Col. 7:4-18. These coding formats are considered to be different types of source encoding. (See Section X, supra). Therefore, in selecting a coding format based on channel conditions, the transmitter would be selecting a type of source encoding, and, therefore, would meet this claim limitation." *See Request for Reexamination, Page 91.*
>
> "For digitized voice, the modulation level can vary between 4-ary or 16-ary PSK. (See Col. 13:54-57). *See Request for Reexamination, Page 76.*
>
> "Paneth '983 teaches that the modulation level is controlled by the base station. (Id. at Col. 7:23). Paneth '983 also teaches that the modulation level is "adjusted in accordance with signal error detection in the system." *See Request for Reexamination, Page 79.*

As described above, the request suggests that the distinguishing features of the '051 patent are taught by Paneth and Rydbeck, but does not rely on Kaltenmeier. However, the described features of Paneth do not teach the distinguishing feature of "selecting a type of source encoding to be used in maintaining RF communication" that distinguished the '051 patent over the prior art and Rydbeck's teachings are cumulative to those on the record.

Turning to Paneth, the '051 patent makes a distinction between adaptively selecting a data rate and selectively adapting a source encoding method (*'051 Patent, column 19 lines 29-33 – improvements...can be realized...by extending the concept of adaptively selecting data rate to*

include switching between source encoding methods). Thus, the claimed "type of source encoding" cannot merely be a change in modulation level or data rate. As an example, the '051 patent discloses two possible different encoding schemes, NRZ and PR. Paneth does not teach selecting a type of source encoding to be used in maintaining RF communication. Instead, Paneth teaches the varying of the modulation level or the varying data rate, but gives no indication that the source encoding method is adaptively modified.

Turning to Rydbeck, Rydbeck's technical teachings are not new because they are cumulative to the teachings set forth by Goodman. Rydbeck does teach the adaptive selection of a type of source encoding by varying the encoding of error correcting codes depending upon the quality of the transmission signals (*Rydbeck, column 5 line 42 – column 7 line 49*). However, Goodman discloses similar technical features such as the varying of channel encoding by incorporating additional error correcting codes (*Goodman, Abstract)*. These technical features of Goodman were considered and applied against the original claims of the '051 patent in previous reexamination 90/008033. Accordingly, Rydbeck's teachings are cumulative to those already on the record because the same question of patentability has been decided by the Office in a previous reexamination.

III. SNQ#4

Next, Petitioner argues that Paneth and Bolgiano raise a SNQ for original claims 24 and 26-28. Petitioner asserts that the technical teachings of the references are new and non-cumulative and would be important to a reasonable examiner in determining patentability of at least one claim.

The request alleges that the distinguishing feature is taught by Paneth and Bolgiano as follows:

> In particular, Paneth '863 clarifies that (i) the fixed "bit rate" referred to at Col. 6:10 of Bolgiano '450 is merely the bit rate for a particular frame slot (conversation) when averaged over a frame, and does not measure actual throughput of the channel, (Paneth '863, Col. 13:58-Col. 14:7); (2) the "data rate," which measures actual throughput of the channel, varies depending on the modulation level, (Paneth '863, Col. 13:27-30); and (3) the "symbol transmission" rate, that defines the bandwidth, is fixed at 16K symbols/see., regardless of modulation level, (Paneth '863, Col. 13:43-44).
>
> Based on these clarifications, the following conclusions can be drawn:
> • With a 4-ary modulation level, where each 4-PSK symbol carries 2 information bits, the data rate is 32 kbps (2 bits/symbol x symbol transmission rate of 16K symbols/sec.). (Paneth '863, Col. 13:68-Col. 14:2).
> • With a 16-ary modulation level, where each 16-PSK symbol carries 4 information bits, the data rate is 64 K bits/sec. ('Paneth '863, Col. 13:60-63).
> • Since the symbol transmission rate is fixed at 16 K symbols/see., the bandwidth is fixed at 32 kHz.

• Since the data rate for the 4-ary representation is 32 K bits/sec., the bandwidth efficiency for the 4-ary representation is 1 bps/Hz (32 Kbps/32 kHz).
• Since the data rate for the 16-ary representation is 64 Kbits/sec., the bandwidth efficiency for the 16-ary representation is 2 bps/Hz (64 Kbps/32 kHz).

As noted above, Paneth does not provide a new and non-cumulative teaching directed to the distinguishing features of the '051 patent and thus does not independently raise a SNQ. Similarly, Bolgiano does not provide a new, non-cumulative teaching directed to the distinguishing features of the '051 patent. Bolgiano describes varying modifying the symbol mapping between 4-ary and 16-ary modulation levels. However, these teachings are not new and non-cumulative because they are similar to the teachings set forth by Goodman in the previous reexaminations. Goodman discloses similar technical features such as the varying of channel encoding by varying the number of symbols representing a sample (*Goodman, Page 212 – 3 bit or 2 bit encoding of speech transmissions depending upon conditions)*. These technical features of Goodman were considered and applied against the original claims of the '051 patent in previous reexamination 90/008033. Accordingly, Bolgiano's teachings are cumulative to those already on the record because the same question of patentability has been decided by the Office in a previous reexamination.

The request does not raise a SNQ for any original claims of the '051 patent. As a result, no SNQ can be raised for any pending added or amended claims. *See MPEP 2242 and 37 CFR 1.515(a).*

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

2. 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.

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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AUG 03 2007

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	:	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	:	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	:	For Third Party Requester
J. ANDREW LOWES HAYNES AND BOONE LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202	:	For Third Party Requester
DAVID J. MCKENZIE 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Freeny
Ex Parte Reexamination Proceeding
Control No. 90/008,122
Filed: June 6, 2006
For: US Patent No. 6,999,945

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,286 :
Filed: October 6, 2007 :
For: US Patent No6,999,945 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,287 :
Filed: October 6, 2006 :
For: US Patent No. 6,999,945 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,288 :
Filed: October 6, 2006 :
For: US Patent No. 6,999,945 :

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. 6,999,945 issued on February 14, 2006.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,122 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,122 on October 20, 2006.

4. There are currently no amendments proceeding control number 90/008,122.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,286 was requested by a third party requester filed on October 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,286 on December 8, 2006.

7. There are currently no amendments proceeding control number 90/008,286.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,287 was requested by a third party requester on October 6, 2006, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,287 on December 8, 2006.

10 There are currently no amendments proceeding control number 90/008,287.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,288 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,288 on December 8, 2006.

13. There are currently no amendments proceeding control number 90/008,288.

14. Proceedings control numbers 90/008,122; 90/008,286; 90/008,287; and 90/008,288 await 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 90/008,122; 90/008,286; 90/008,287; and 90/008,288 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. 90/008,122; 90/008,286; 90/008,287; and 90/008,288 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

MRhu 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,123	07/07/2006	6321338	1904-001	3409

26181 7590 12/04/2008
FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/04/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAY CASEBEER MADRID & BACHELDER LLP
ATTN: RENEE DuBORD BROWN, ESQ
20300 STEVENS CREEK BLVD., SUITE 400
CUPERTINO, CA 95014

Date:
MAILED

DEC 04 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008123
PATENT NO. : 6321338
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
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DEC 04 2008

CENTRAL REEXAMINATION UNIT

Thomas A. Rozylowicz SRI INTRNTL 333 RAVENSWOOD AVE MENLO PARK, CA 94025	: (For Patent Owner)
Renee DuBord, Esq. DAY, CASEBEER MADRID & BATCHELDER LLP 20300 STEVENS CREEK BLVD SUITE 400 CUPERTINO, CA 95014	: (For Third-Party Requester)
In re PORRAS *et alia* Reexamination Proceeding Control No. 90 / 008,123 Request Deposited: July 7, 2006 For: U.S. Patent No. 6,321,338	: DECISION DISMISSING : PETITION FOR : ADMISSION OF EVIDENCE : UNDER 37 CFR 1.116

This is a decision on patent owner's petition for admission of evidence under 37 CFR 1.116 filed on November 4, 2008. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 6,321,338 was ordered in the Determination mailed September 5, 2006.

2. Prosecution was closed with the final rejection mailed September 5, 2008. The action set a two month period for response.

3. A petition for an extension of time was filed on November 4, 2008.

4. The petition for extension of time was granted on November 6, 2008. The period for response has been extended one month. Patent owner's response to the Office action dated September 5, 2008 is due December 5, 2008.

37 CFR 1.116 states in pertinent part:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

*(a) An amendment after final action must comply with § **1.114** or this section.*

*(b) After a final rejection or other final action (§ **1.113**) in an application or in an ex parte reexamination filed under § **1.510**, or an action closing prosecution (§ **1.949**) in an inter partes reexamination filed under § **1.913**, but before or on the same date of filing an appeal (§ **41.31** or § **41.61** of this title):*

.

.

.

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

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[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

DECISION

37 CFR 1.116 provides for the admission of amendments affidavits or other evidence after final action and prior to appeal. Here, it appears petitioner is asking for an indication that the showing of good and sufficient reasons why the evidence is necessary and was not earlier presented passes approval prior to the formulation of a complete response to the outstanding final rejection. Petitioner states "this evidence is necessary to formulate a complete response to the outstanding final office action" indicating the petition is not to be construed as a complete response. It is apparent that petitioner hopes to be persuasive in some manner via the presentation of the evidence and it is not be submitted merely to be made "of record". However the paper has not been presented as an "amendment after final rejection" or "submission of evidence after final rejection": the paper is stylized as a "petition" for admission of evidence under 37 CFR 1.116.

37 CFR 1.116 provides no basis for granting the relief sought. Judgment on the propriety of any response submitted after final rejection is passed upon by the primary examiner and is reviewed in the total context of the complete response including the showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Simply, this judgment can not be made separate from and absent the proposed actions or arguments provided by a complete response. Further, 37 CFR 1.116 nowhere authorizes any "petition".

The petition can not be construed as a petition filed under 37 CFR 1.181 as no adverse action related to the admission of evidence has been made by the examiner. Should applicant submit a complete response and believe it to be improperly denied entry by the examiner; relief may be sought under this regulation.

The following observations are noted. In addition to the information provided in the petition, it would be helpful if any showing after Final included an indication of the date of the trial and the date of the availability of the transcript which would provide factual support for the assertion the evidence was not earlier presented due to unavailability. Further, as it is stated the evidence resulted from cross-examined trial testimony, it would be reasonable to explain which side of the litigation the witnesses represented. If the witnesses were testifying on behalf of Owner, an explanation of why the positions of the witness(s) were not earlier presented via affidavit would be in order.

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running from the September 5, 2008 Office action as extended in the November 11, 2008 decision on petition for extension of time. Patent Owner's response is due December 5, 2008.

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

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SEP 23 2008

CENTRAL REEXAMINATION UNIT

SRI INTERNATIONAL 333 RAVENSWOOD AVENUE MENLO PARK CA 94025	:	(For Patent Owner)
Renée DuBord Brown, Esq DAY CASEBEER MADRID & BATCHELDER LLP 20300 Stevens Creek Boulevard Suite 400 Cupertino, CA 95014	:	(for Third Party Requester)
	:	DECISION, MERGING REEXAMINATION PROCEEDINGS 37 C.F.R. § 1.565(c)
In re: Porras *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,125 Deposited: 7 July 2006 For: US Patent No. 6,484,203	:	
In re: Porras *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,126 Deposited: 25 April 2008 For: US Patent No. 6,484,203	:	

The above-identified reexamination files are before the Director of the Central Reexamination Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,484,203 issued on 19 November 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,125 was requested by a third party requester on 7 July 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,125 on 31 August 2006.

4. There are currently no amendments proceeding control number 90/008,125.

5. *Ex Parte* Reexamination Proceeding, control no. 90/009,126 was requested by a third party requester filed on 25 April 2008.

6. The Reexamination Order was granted in proceeding, control no. 90/009,126 on 19 July 2008.

7. There are currently no amendments proceeding control number 90/009,126.

8. Proceedings control numbers 90/008,113 and 90/009,126 await action 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.

2283 Multiple Copending Ex Parte Reexamination Proceedings (in part)

In order for a second or subsequent request for ex parte reexamination to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. MPEP § 2240 provides a discussion as to whether a substantial new question of patentability is raised by the prior art cited in a second or subsequent request for reexamination filed while a reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to combine the proceedings will be made by the Central Reexamination Unit (CRU)

Director where the reexamination is pending. The CRU Director may delegate this to the Special Program Examiner (SPRE). No decision on combining the reexaminations should be made until reexamination is actually ordered in the later filed request for reexamination.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. While merger is at the discretion of the Director of the CRU, given the facts noted above, 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 90/008,125 and 90/009,126 reexamination proceedings are hereby 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. 90/008,125 and 90/009,126 are hereby **MERGED**.

2. The reexamination files are being forwarded to the examiner for further 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, at (571) 272-1611, or Eric Keasel, at (571) 272-4929, Supervisory Patent Examiners, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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DEC 03 2008

CENTRAL REEXAMINATION UNIT

Thomas A. Rozylowicz	: (For Patent Owner)
FISH & RICHARDSON, P.C.	:
PO Box 1022	:
MINNEAPOLIS, MN 55440-1022	:
Renee DuBord, Esq.	: (For Third-Party Requester)
DAY, CASEBEER MADRID	:
& BATCHELDER LLP	:
20300 STEVENS CREEK BLVD	:
SUITE 400	:
CUPERTINO, CA 95014	:
In re PORRAS *et alia*	: DECISION DISMISSING
Reexamination Proceeding	: PETITION FOR
Control No. 90 / 008,125	: ADMISSION OF EVIDENCE
For: U.S. Patent No. 6,484,203	: UNDER 37 CFR 1.116
In re PORRAS *et alia*	:
Reexamination Proceeding	:
Control No. 90 / 009,126	:
For: U.S. Patent No. 6,484,203	:

This is a decision on patent owner's petition for admission of evidence under 37 CFR 1.116 filed on November 21, 2008. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 6,484,203 was ordered in the Determination mailed August 31, 2006.

2. The proceeding was merged with Reexamination proceeding 90/009,126 on September 23, 2008.

4. A petition for an extension of time was filed on November 21, 2008.

4. The petition for extension of time was granted on November 25, 2008. The period for response has been extended to the date requested by Owner. Patent owner's response to the Office action dated September 24, 2008 is due December 5, 2008.

37 CFR 1.116 states in pertinent part:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

*(a) An amendment after final action must comply with § **1.114** or this section.*

*(b) After a final rejection or other final action (§ **1.113**) in an application or in an ex parte reexamination filed under § **1.510**, or an action closing prosecution (§ **1.949**) in an inter partes reexamination filed under § **1.913**, but before or on the same date of filing an appeal (§ **41.31** or § **41.61** of this title):*

.

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.

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

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[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

DECISION

37 CFR 1.116 provides for the admission of amendments affidavits or other evidence after final action and prior to appeal. Here, it appears petitioner is asking for an indication that the showing of good and sufficient reasons why the evidence is necessary and was not earlier presented passes approval prior to the formulation of a complete response to the outstanding final rejection. Petitioner states "this evidence is necessary to formulate a complete response to the outstanding final office action" indicating the petition is not to be construed as a complete response. It is apparent that petitioner hopes to be persuasive in some manner via the presentation of the evidence and it is not be submitted merely to be made "of record". However the paper has not been presented as an "amendment after final rejection" or "submission of evidence after final rejection": the paper is stylized as a "petition" for admission of evidence under 37 CFR 1.116.

37 CFR 1.116 provides no basis for granting the relief sought. Judgment on the propriety of any response submitted after final rejection is passed upon by the primary examiner and is reviewed in the total context of the complete response including the showing of good and sufficient

reasons why the affidavit or other evidence is necessary and was not earlier presented. Simply, this judgment can not be made separate from and absent the proposed actions or arguments provided by a complete response. Further, 37 CFR 1.116 nowhere authorizes any "petition".

The petition can not be construed as a petition filed under 37 CFR 1.181 as no adverse action related to the admission of evidence has been made by the examiner. Should applicant submit a complete response and believe it to be improperly denied entry by the examiner; relief may be sought under this regulation.

The following observations are noted. As it is stated the evidence resulted from cross-examined trial testimony, it would be helpful if any showing after Final included an indication as to the source of the testimony. It would be reasonable to explain which side of the litigation the witnesses represented. If the witnesses were testifying on behalf of Owner, an explanation of why the positions of the witness(s) were not earlier presented via affidavit would be in order.

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running from the September 5, 2008 Office action as extended in the November 11, 2008 decision on petition for extension of time. Patent Owner's response is due December 5, 2008.

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.

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
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,129	07/27/2006	6447027	29314-00001	5636

28886 7590 06/10/2009

CLARK HILL, P.C.
500 WOODWARD AVENUE, SUITE 3500
DETROIT, MI 48226

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/10/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DICKINSON WRIGHT PLLC
38525 WOODWARD AVENUE
SUITE 2000
BLOOMFIELD HILLS, MI 48304-2970

Date:

MAILED

JUN 10 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008129
PATENT NO. : 6447027
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
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Alexandria, VA 22313-1450
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JUN 10 2009

CENTRAL REEXAMINATION UNIT

CLARK HILL, P.C.
500 WOODWARD AVENUE
SUITE 3500
DETROIT, MI 48226

(For Patent Owner)

DICKINSON WRIGHT PLLC
38525 WOODWARD AVENUE
SUITE 2000
BLOOMFIELD HILLS, MI 48304-2970

(For Requester)

In re Lilley et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,129
Filed: July 27, 2006
For: U.S. Patent No. 6,447,027

DECISION
GRANTING PETITION
UNDER 1.182

This is a decision on the May 11, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION OR TO ENTER THE AMENDMENT AFTER FINAL FOR PURPOSE OF APPEAL."

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

The petition is **granted to the extent set forth below**.

BACKGROUND

- On July 27, 2006, a corrected request for *ex parte* reexamination was filed by the third party requester for claims 1-11; the resulting reexamination proceeding was given a filing date and assigned control number 90/008,129 ("the '129 proceeding").
- Prosecution progressed until, on March 26, 2008, a non-final Office action was mailed.
- On May 27, 2008, submitted a timely response to the outstanding Office action, including amendments and new claims 12-20, based upon an interview with the examiner conducted on May 8, 2008.
- On September 30, 2008, a final Office action was mailed.
- On October 30, 2008, a Notice of appeal was submitted by patent owner.

- On January 28, 2009, the examiner conducted an interview with the patent owner.
- On January 30, 2009, patent owner timely filed a proposed amendment, including amendments alleged to be in accordance with the January 28 interview.
- On January 30, 2009, patent owner also timely filed an appeal brief.
- On March 11, 2009, an advisory action was mailed, refusing entry of the proposed amendment filed on January 30, 2009.
- On May 11, 2009, patent owner filed the instant "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION OR TO ENTER THE AMENDMENT AFTER FINAL FOR PURPOSE OF APPEAL."

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 May 11, 2009 patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of an amendment 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 <u>a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding</u> **to seek entry of an amendment and/or evidence that was denied entry** <u>after a final rejection in an ex parte reexamination proceeding</u> [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

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

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, the examiner conducted an interview with the patent owner on January 28, 2009, and a follow up amendment was then filed January 30, 2009. Also, on January 30, 2009, patent owner had filed an appeal brief to keep the proceeding pending, and that appeal brief has not yet been considered by the examiner. An advisory action refusing entry of the proposed January 30, 2009 amendment was not mailed until March 11, 2009, on which date, the patent owner 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 amendment 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 amendment could not have been presented earlier, patent owner states that the amendment was in response to a January 28, 2009 interview with the examiner, and the amendment includes "seamless path" language which the examiner indicated "would appear to distinguish from the prior art." This statement by the examiner is evidence that the entry of the amendment would further prosecution. It is further noted that the final Office action was in response to an earlier amendment submitted in accordance with the substance of a May 8, 2008 interview with the examiner. 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 patent owner has filed an appeal brief, the examiner has not yet issued an examiner's answer, the filing of the brief was used to keep a proceeding pending, and the brief has not been considered by the examiner to the extent that re-work would be required. Therefore any delay caused by withdrawal of the 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 January 30, 2009 amendment would best satisfy the overall needs of special dispatch. Entry of the amendment will, according to the examiner, distinguish the claims over the prior art applied in the final rejection. 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 January 30, 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 30, 2008 final Office action is withdrawn, and prosecution of the proceeding is reopened to the following extent:

The January 30, 2009 response will be entered by the Central Reexamination Unit, and will then be considered by the examiner. <u>These papers will be treated as a response by patent owner received **after** a first Office action</u>.

CONCLUSION

- The petition is **granted to the extent set forth herein**.

- The prosecution of the present '8129 *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 30, 2008 final Office action is withdrawn, and prosecution of the proceeding is reopened.

- The January 30, 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, or in his absence, the undersigned at (571) 272-7710.

Kenneth M. Schor

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

June 9, 2009
C:\Kiva\Kenpet7\RCR\

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,130	07/26/2006	6378809	20317-002RX1	9332

7590 09/24/2008

EXAMINER

JOYCE E. KOSINSKI
K & A Assicuates
1407 Foothill Blvd.
SUITE 233
La Verne, CA 91750

ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2008

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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Joyce E. Kosinski
Loral Space and Communications :TD
Suite 303
655 Deep Valley Drive
Rolling Hills Estates, CA 90274

(For Patent Owner)

MAILED
SEP 24 2008
CENTRAL REEXAMINATION UNIT

John C. Phillips
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

(For Requester)

In re Pon
Ex Parte Reexamination Proceeding
Control No. 90/008,130
Filed: July 26, 2006
For: U.S. Patent No. 6,378,809

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the August 8, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the August 8, 2008 patent owner petition to revive").

The August 8, 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 8, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding . . .

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon . . . for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) . . . A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional . . .

*

*

(d) *Terminal Disclaimer.*

*

*

(3) The provisions of paragraph (d)(1) of this section do not apply to . . . reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 711.03(c) II A 2 (b) provides, in pertinent part:

Abandonment for Failure To Reply to a Final Action

A reply under 37 CFR 1.113 to a final action must include . . . cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, . . . the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee;

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance . . .

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted a notice of appeal and appeal fee on February 21, 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 8, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

[1] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (b).

Accordingly, the August 8, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[2] is **granted**.

CONCLUSION

- The August 8, 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 February 21, 2008 patent owner amendment/response to the March 6, 2008 final Office action and the April 21, 2008 appeal brief.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Peter English, of CRU Art Unit 3993, at (571) 272-6671.
- 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

[2] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of March 6, 2008.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 09 2007

CENTRAL REEXAMINATION UNIT

PAMELA S. MERKADEAU
MANATT PHELPS AND PHILLIPS
1001 PAGE MILL ROAD
BUILDING 2
PALO ALTO, CA 94304

In re Application of	:	
MENDEZ et al.	:	
Control No. 90/008,131 (U.S. Patent 6,708,221)	:	DECISION ON PETITION
Filed: July 27, 2006	:	TO WITHDRAW
Attorney Docket No. 25587-033-045RE1	:	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 27, 2007.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). While the reasons may be provided by referencing a specific portion of 37 CFR 10.40, the reasons must deal with actions by the client. The reasons set forth in the request, "Attorneys are no longer representing Applicant" are not appropriate since it is not clear that the client initiated the transfer, or that the client knowingly or freely assents to the transfer to new counsel.

Additionally the request cannot be approved because a review of the file indicates that the power of attorney of record in this application was not appointed by customer number. Accordingly, the request under 37 C.F.R. § 1.136(b) to withdraw attorneys/agents associated with customer number 36614 cannot be approved. A request for withdrawal as attorney or agent *by customer number* cannot be accepted unless the power of attorney of record in the application is to the same customer number.

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

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

Patricia Volpe for

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: **SCOTT MCKEOWN**
OBLON, SPIVAK, MCCLELLAND, MAIER
& NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314-3412

cc: **HOWREY LLP** (Third Party Requester)
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on March 27, 2007. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CENTRAL REEXAMINATION UNIT

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA VA 22314	:	For Patent Owner
Viola T. Kung, Ph. D. HOWREY LLP 2941 Fairview Park Drive, Suite 200 Falls Church, VA 22042-2924	:	For Third Party Requester
NOVAK DRUCE & QUIGG, LLP 1300 Eye Street NW 400 East Tower Washington, DC 20005	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Mendez *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,131 Filed: July 27, 2006 For: US Patent No. 6,708,221	:	
In re: Mendez *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,162 Filed: August 11, 2006 For: US Patent No. 6,708,221	:	

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. 6,708,221 issued on March 16, 2004.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,131 was requested by a third party requester on July 27, 2006

3. The Reexamination Order was granted in proceeding, control no. 90/008,131 on October 18, 2006.

4. There are currently no amendments proceeding control number 90/008,131.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,162 was requested by a third party requester filed on August 11, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,162 on October 18, 2006.

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

8. Proceedings control numbers 90/008,131 and 90/008162 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 90/008,131 and 90/008,162 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. 90/008,131 and 90/008,162 are **MERGED**.

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

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

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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OCT 03 2008

CENTRAL REEXAMINATION UNIT

SCOTT MCKEOWN
OBLON, SPIVAK, MCCLELLAN
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

(For Patent Owner)

VIOLA T. KUNG, PH.D.
HOWREY LLP
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

(For Third Party Requester)

NOVAK, DRUCE DeLUCA & QUIGG, LLP
1300 EYE STREET, N.W.
SUITE 400 EAST TOWER
WASHINGTON, DC 20005

(For Third Party Requester)

RESEARCH IN MOTION LIMITED
102 DECKER COURT
SUITE 180
IRVING, TX 75039

(Courtesy Copy)

In re Mendez *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,131
Filed: July 27, 2006
For: U.S. Patent No. 6,708,221

In re Mendez *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,162
Filed: August 11, 2006
For: U.S. Patent No. 6,708,221

DECISION DISMISSING AND EXPUNGING PETITION

This is a decision on the September 10, 2008 third party requester paper entitled "PETITION UNDER 37 CFR § 1.182 AND/OR 1.183."

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 is being expunged by being be marked "closed" and "non-public" in the IFW, and will not constitute part of the record of the present reexamination proceeding. [1]

REVIEW OF FACTS

1. U.S. Patent No. 6,708,221 ("the '221 patent") issued to Mendez *et al.* on March 16, 2004.

2. On July 27, 2006, a request for *ex parte* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 90/008,131 ("the '8131 proceeding").

3. On August 11, 2006, a request for *ex parte* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 90/008,162 ("the '8162 proceeding").

4. On October 18, 2006, an order granting *ex parte* reexamination in the '8131 proceeding was mailed, and an order granting *ex parte* reexamination in the '8162 proceeding was mailed.

5. On August 3, 2007, a "DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS" was mailed, merging the '8131 proceeding and the '8162 proceeding ("the merged proceeding").

6. On September 21, 2007, a first Office action on the merits was mailed in the merged proceeding.

7. The present merged proceeding has progressed until, on September 10, 2008, the third party requester filed the present petition paper entitled "PETITION UNDER 37 CFR § 1.182 AND/OR 1.183," which is the subject of this decision.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

---

[1] *See* MPEP 2267.

35 U.S.C. § 304 provides:

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

37 CFR 1.183 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).

DECISION

The September 10, 2008 third party requester petition paper is filed under 37 CFR 1.182 and/or 1.183; however, the rules cannot be waived/suspended to provide the third party requester the right to file a paper at the present stage in the merged proceeding. Waiver/suspension of the rules to permit the third party requester submission via the petition is not 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 Federal Circuit stated (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].

Pursuant to 35 U.S.C. § 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends either: (1) upon expiration of the patent owner's time for filing a statement in response to the order for reexamination, or (2) if the patent owner files such a statement, upon expiration of the third party requester's time for filing a reply to the patent owner's statement (i.e., within two months from the date of service of the patent owner's statement).

On its face, the third party requester's September 10, 2008 petition paper was filed after the statutory statement and reply periods ended in the '8131 and '8162 proceedings. The statutory statement and reply period ended in the '8131 proceeding when the patent owner did not file a statement in response to the October 18, 2006 order granting reexamination within the two-month response period set forth in the order for filing such a statement. Similarly, the statutory statement and reply period ended in the '8162 proceeding when the patent owner did not file a statement in response to the October 18, 2006 order granting reexamination within the two-month response period set forth in the order for filing such a statement. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's September 10, 2008 petition paper, and the petition is dismissed.

It is noted that the correspondence address of the third party requester in the merged proceeding is unclear. A copy of this decision is being sent to the two addresses of record for the third party requester, and a courtesy copy of this decision is being sent to Research in Motion Ltd. of Irving, TX. In the future, however, the Office will assume that the third party requester intends to keep using both of the correspondence addresses of record for the third party requester in the '8131 and '8162 proceedings, unless the third party requester provides the Office with a single correspondence address of record for the third party requester for the merged proceeding.

CONCLUSION

1. The petition is dismissed.

2. The petition paper filed by the third party requester on September 10, 2008 is being expunged as not having an entry right. This will be carried out by closing the petition paper (document) in the IFW of the '8131 and '8162 proceedings and marking the paper "closed" and "non-public."

3. No copy of the petition papers will be maintained of record in the IFW for the '8131 and '8162 proceedings, or elsewhere in the Office.

4. A copy of this decision will be made of record in the reexamination files.

5. Telephone inquiries related to this decision should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

October 2, 2008
C:\kiva\kimpropa\3PR\8062 improper 1.183 pet for 3PR participation-dismiss.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.
90/008,131	07/27/2006	6708221	13590.0007.RXUS00	3902

22850 7590 10/07/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/07/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
VIOLA T. KUNG, Ph.D.
HOWREY LLP
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042

Date:

MAILED

OCT 07 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008131
PATENT NO. : 6708221
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
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MAILED

OCT 07 2008

CENTRAL REEXAMINATION UNIT

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. (For Patent Owner)
1940 DUKE STREET
ALEXANDRIA, VA 22314

HOWREY LLP-CA (For Requester)
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

NOVAK DRUCE + QUIGG LLP (For Requester)
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON, DC 20005

In re Mendez *et alia* Reexamination Proceeding Control No. 90/008,131 For: U.S. Patent No. 6,708,221	DECISION DISMSSING PETITION UNDER 37 CFR 1.181
In re Mendez *et alia* Reexamination Proceeding Control No. 90/008,162 For: U.S. Patent No. 6,708,221	

This is a decision on the June 12, 2008 "PETITION UNDER 37 C.F.R. §1.181(a)(3)" requesting that the papers filed June 9, 2008 be returned/destroyed. No fee is required.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,708,221 (hereinafter, the '221 patent), issued to Mendez et al., on March 16, 2004.

2. On July 27, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '221 patent. The reexamination proceeding was assigned Control No. 90/008,131 (hereinafter, the '8131 proceeding).

3. On August 11, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '221 patent. The reexamination proceeding was assigned Control No. 90/008,162 (hereinafter, the '8162 proceeding).

4. The reexamination order was granted in the '8131 proceeding on October 18, 2006.

5. The reexamination order was granted in the '8162 proceeding on October 18, 2006.

6. The '8131 and '8162 proceedings were merged on August 3, 2007.

7. Later in prosecution, on April 25, 2008, the third party requester of the '8162 proceeding filed Litigation Papers that went beyond bare notice and contained further arguments or information. The papers of April 25, 2008 were closed from the file as noted in the paper mailed May 10, 2008.

8. On June 9, 2008, the third party requester of the '8162 proceeding filed a NOTICE OF CONCURRENT PROCEEDINGS.

9. On June 12, 2008, Patent Owner filed the present petition.

DECISION

Patent Owner argues that, in the third-party (of the '8162 proceeding) submission entitled "NOTICE OF CONCURRENT PROCEEDINGS" filed on June 9, 2008, the third party "has provided physical highlighting (bracketing of passages) of a [Patent Owner] reexamination response (identified as exhibit F...)".

While the paper of June 9, 2008 does contain bracketing in the margins of exhibit F (as well as other exhibits), it is unclear when the bracketing was made and for what purpose. These marking may have been made prior to their submission to the Court on May 30, 2008 and the bracketed passages were bracketed in the Court papers themselves. The petition is silent as to whether or not the submission of June 9, 2008 is merely a presentation of the Court papers in the form that they were presented to the Court.

Other papers submitted in this and related proceedings have similar bracketing of passages in Court papers. It appears that bracketing may be a convention that is used in these Court papers.

Therefore, with no clear indication that a third party added the bracketing to the Court papers of May 30, 2008 in the submission to the USPTO of June 9, 2008, the relief requested can not be granted.

Any request for reconsideration should be directed to the Central Reexamination Unit.

CONCLUSION

1. The petition to return/destroy the third party submission of June 9, 2008 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, 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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,133	09/07/2006	6024981	15514/40037	9856

57339 7590 01/08/2007

CIMA
LERNER, DAVID ET AL
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2007

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

1/8/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALAN H. NORMAN,
THOMPSON,COBURN,LLP
ONE US BANK PLAZA
ST.LOUIS, MO. 63101

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008133
PATENT NO. 6,024,981
ART UNI 3991

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mailed :

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MAILED
JAN 0 8 2007
CENTRAL REEXAMINATION UNIT

Michael H. Teschner
LERNER, DAVID, LITTENBERG,
KRUMHOLTZ & MENTLIK, LLP
600 South Avenue West
Wetfield, New Jersey 07090

(for Patent Owner)

Alan H. Norman
Thompson Coburn LLP
One US Bank Plaza
St. Louis, MO 63101-1611

(for Third Party Requester)

In re Khankari et al
Reexamination Proceeding
Control No.: 90/007,684
Filed: August 22, 2005
For: U.S. Patent 6,024,981

Alan H. Norman
Thompson Coburn LLP
One US Bank Plaza
St. Louis, MO 63101-1611

(for Third Party Requester)

In re Khankari et al
Reexamination Proceeding
Control No.: 90/0078,133
Filed: September 28, 2006
For: U.S. Patent 6,024,981

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 6,024,981, issued February 15, 2000, is the subject of Reexamination Control Nos. 90/007,684 and 90/008,133.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,624, was filed August 22, 2005 by Alan Norman of Thompson Coburn LLP in St. Louis MO. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed dosage form comprising an active ingredient and a matrix including a non-direct compression filler and a lubricant or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/007,684 on August 22, 2005.

4. A first non-final Office action was issued on February 24, 2006.

5. Patent Owner filed a response on April 27, 2006.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,133, was filed July 28, 2006 by Alan Norman of Thompson Coburn LLP in St. Louis MO. The request was deemed non-compliant and a corrected request was filed September 7, 2006. The request urged that a substantial new question of patentability was raised by the newly cited reference combinations that render obvious the claimed dosage form comprising an active ingredient and a matrix including a non-direct compression filler and a lubricant.

7. Reexamination was ordered for 90/008,133 on September 28, 2006.

8. No Office action has been issued in the later reexamination.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,684and 90/008,133 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS.

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office of filed by the patent owner will contain the identifying

data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,684 and 90/008,133 as:

Michael H. Teschner
LERNER, DAVID, LITTENBERG,
KRUMHOLTZ & MENTLIK, LLP
600 South Avenue West
Wetfield, New Jersey 07090

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/007,684 and 90/008,133 as:

Alan H. Norman
Thompson Coburn LLP
One US Bank Plaza
St. Louis, MO 63101-1611

CONCLUSION

Reexamination Control Nos. 90/007,684 and 90/008,133 are merged. **As stated above, Patent Owner has one month from the mailing date of this decision within which to submit a "housekeeping amendment" placing the same claims in both files and to name but a single representative.** Upon receipt of the response, as Office action will issue in due course.

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

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

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.
90/008,142	09/06/2006	6440457	0002717-00264	6540

23122 7590 02/11/2008
RATNERPRESTIA
P O BOX 980
VALLEY FORGE, PA 19482-0980

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/11/2008

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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMER CUTLER PICKERING HALE AND DORR LLP
1875 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20004

Date: MAILED
FEB 11 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008142
PATENT NO. : 6440457
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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Paul F. Prestia (For Patent Owner)
Phillip E. Gonzalez
RATNER & PRESTIA
1235 Westlakes Drive
P.O. Box 980
Valley Forge, PA 19482-0980

MAILED
FEB 11 2008
CENTRAL REEXAMINATION UNIT

Colleen Superko (For Third Party)
WILMER CUTLER PICKERING HALE AND DORR LLP
1875 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

In re Edgren et al.	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No. 90/008,142	:	**ON**
Filed: 06 September 2006	:	**PETITION**
For: U.S. Patent 6,440,457	:	

This is a decision on the October 24, 2007 Patent Owner "Petition Under 37 C.F.R. §1.59(b) to Expunge the Accompanying Information Submitted under MPEP §724.02" (Second Supplemental IDS with 1 entry).

This petition is before the Central Reexamination Unit of the United States Patent and Trademark Office.

FEES

The Patent Owner has paid the $400.00 petition fee under 37 CFR §1.17(f) as required by 37 CFR §1.182.

SUMMARY

This petition to expunge information under MPEP §724.06 and 37 CFR §1.59 is **dismissed** as premature.

The proceeding is **remanded** to the examiner for a determination as to whether or not any portion or all of the information submitted in this proceeding as

protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable."

BACKGROUND

1. U.S. Patent No. 6,440,457 to Edgren et al. (the '457 patent) issued on August 27, 2002.

2. On July 28, 2006 the Third Party Requester filed a request for *ex parte* reexamination of, which resulted in a reexamination proceeding assigned reexamination control number 90/008,142 (the '8142 proceeding).

3. On August 23, 2006 the Office mailed a "Notice of Failure to Comply with Ex Parte Reexamination Request Requirements."

4. On September 6, 2006 the Third Party Requester filed a corrected original *ex parte* request which was granted a filing date.

5. On October 5, 2006 the Office granted the Patent Owner's request and ordered reexamination.

6. On December 1, 2006 the Patent Owner filed an IDS with 159 entries.

7. On February 16, 2007 the Office mailed a non-final Office action.

8. On March 19, 2007 the Patent Owner filed a first supplemental IDS with 177 entries.

9. On March 26, 2007 the Patent Owner filed a second supplemental IDS with 29 entries along with a petition to expunge these documents under 37 CFR. §1.59(b) and MPEP §724.02.

10. On March 30, 2007 the Patent Owner filed a third supplemental IDS with 5 entries.

11. On July 2, 2007 the Patent Owner filed a fourth supplemental IDS with 482 entries.

12. On July 23, 2007 a fifth supplemental IDS was filed with 505 entries and a petition to expunge these documents under 37 CFR §1.59(b) and MPEP §724.02.

13. On July 24, 2007 the Patent Owner filed a second supplement IDS with 16 entries which Patent Owner also called the fifth supplemental IDS and a

petition to expunge these documents under 37 CFR §1.59(b) and MPEP §742.02

14. On July 26, 2007 the Patent Owner filed a seventh supplemental IDS with 4 entries.

15. On October 24, 2007 the Patent Owner filed an eighth supplemental IDS with a single entry and a petition to expunge these documents under 37 CFR §1.59(b) and MPEP §742.02.

DECISION

37 CFR §1.59(b) provides in part:

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section of §41.7(a) of this title:

(2) Information forming the part of the original disclosure (i.e., written specification including 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.

The information submitted with the petition was appropriately submitted under MPEP §724.02, and it accordingly was **provisionally sealed.**
As to the petition itself, MPEP §724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR §1.11(d)." When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." Upon a review of the file history, it does not appear that the requisite determination has been made. Therefore, a decision on the petition at this time is premature, because any information submitted in confidence but found to be "important to a reasonable examiner in deciding whether or not a claim is patentable" cannot be expunged. Accordingly, it is not appropriate at this time to make a determination to expunge. Thus the petition to expunge is **dismissed**, and is held in abeyance pending the determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The dismissal is subject to renewal at a later point in this proceeding, when the issue becomes ripe for decision. After a determination on the issue of importance of the sealed information is made of record (as discussed above), the petition to expunge may be renewed by Patent Owner. Patent Owner is cautioned that a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.

Remand

The proceeding is remanded to the examiner for a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." Upon receipt of jurisdiction of the proceeding, the examiner will, pursuant to MPEP §724.04(c), promptly make such a determination and issue an Office action, which may be a supplemental Notice of Intent to Issue a Reexamination Certificate, if appropriate.

CONCLUSION

1. The petition to expunge under MPEP §724.06 and 37 CFR §1.59 is **dismissed**, subject to renewal at a later point in the proceeding. It is held in abeyance, pending renewal of it by Patent Owner at an appropriate time.

2. As pointed out above, the Patent Owner is cautioned that **a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

3. The present proceeding is **remanded** to the examiner of record for a prompt determination as to whether or not any portion or all of the information submitted as protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable."

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

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REEXAMINATION CONTROL NO. : 90008142
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CENTRAL REEXAMINATION UNIT

Colleen Superko (For Third Party)
WILMER CUTLER PICKERING HALE AND DORR LLP
1875 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

In re Edgren et al.	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No. 90/008,142	:	**ON**
Filed: 06 September 2006	:	**PETITION**
For: U.S. Patent 6,440,457	:	

This is a decision on the March 26, 2007 Patent Owner "Petition Under 37 C.F.R. §1.59(b) to Expunge the Accompanying Information Submitted under MPEP §724.02" (Second Supplemental IDS with 29 entries).

This petition is before the Central Reexamination Unit of the United States Patent and Trademark Office.

FEES

The Patent Owner has paid the $400.00 petition fee under 37 CFR §1.17(f) as required by 37 CFR §1.182.

SUMMARY

This petition to expunge information under MPEP §724.06 and 37 CFR §1.59 is **dismissed** as premature.

The proceeding is **remanded** to the examiner for a determination as to whether or not any portion or all of the information submitted in this proceeding as

protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable."

BACKGROUND

1. U.S. Patent No. 6,440,457 to Edgren et al. (the '457 patent) issued on August 27, 2002.

2. On July 28, 2006 the Third Party Requester filed a request for *ex parte* reexamination of, which resulted in a reexamination proceeding assigned reexamination control number 90/008,142 (the '8142 proceeding).

3. On August 23, 2006 the Office mailed a "Notice of Failure to Comply with Ex Parte Reexamination Request Requirements."

4. On September 6, 2006 the Third Party Requester filed a corrected original *ex parte* request which was granted a filing date.

5. On October 5, 2006 the Office granted the Patent Owner's request and ordered reexamination.

6. On December 1, 2006 the Patent Owner filed an IDS with 159 entries.

7. On February 16, 2007 the Office mailed a non-final Office action.

8. On March 19, 2007 the Patent Owner filed a first supplemental IDS with 177 entries.

9. On March 26, 2007 the Patent Owner filed a second supplemental IDS with 29 entries along with a petition to expunge these documents under 37 CFR. §1.59(b) and MPEP §724.02.

10. On March 30, 2007 the Patent Owner filed a third supplemental IDS with 5 entries.

11. On July 2, 2007 the Patent Owner filed a fourth supplemental IDS with 482 entries.

12. On July 23, 2007 a fifth supplemental IDS was filed with 505 entries and a petition to expunge these documents under 37 CFR §1.59(b) and MPEP §724.02.

13. On July 24, 2007 the Patent Owner filed a second supplement IDS with 16 entries which Patent Owner also called the fifth supplemental IDS and a

petition to expunge these documents under 37 CFR §1.59(b) and MPEP §742.02

14. On July 26, 2007 the Patent Owner filed a seventh supplemental IDS with 4 entries.

15. On October 24, 2007 the Patent Owner filed an eighth supplemental IDS with a single entry and a petition to expunge these documents under 37 CFR §1.59(b) and MPEP §742.02.

DECISION

37 CFR §1.59(b) provides in part:

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section of §41.7(a) of this title:

(2) Information forming the part of the original disclosure (i.e., written specification including 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.

The information submitted with the petition was appropriately submitted under MPEP §724.02, and it accordingly was **provisionally sealed.**
As to the petition itself, MPEP §724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR §1.11(d)." When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." Upon a review of the file history, it does not appear that the requisite determination has been made. Therefore, a decision on the petition at this time is premature, because any information submitted in confidence but found to be "important to a reasonable examiner in deciding whether or not a claim is patentable" cannot be expunged. Accordingly, it is not appropriate at this time to make a determination to expunge. Thus the petition to expunge is **dismissed**, and is held in abeyance pending the determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The dismissal is subject to renewal at a later point in this proceeding, when the issue becomes ripe for decision. After a determination on the issue of importance of the sealed information is made of record (as discussed above), the petition to expunge may be renewed by Patent Owner. Patent Owner is cautioned that a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.

Remand

The proceeding is remanded to the examiner for a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." Upon receipt of jurisdiction of the proceeding, the examiner will, pursuant to MPEP §724.04(c), promptly make such a determination and issue an Office action, which may be a supplemental Notice of Intent to Issue a Reexamination Certificate, if appropriate.

CONCLUSION

1. The petition to expunge under MPEP §724.06 and 37 CFR §1.59 is **dismissed**, subject to renewal at a later point in the proceeding. It is held in abeyance, pending renewal of it by Patent Owner at an appropriate time.

2. As pointed out above, the Patent Owner is cautioned that **a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

3. The present proceeding is **remanded** to the examiner of record for a prompt determination as to whether or not any portion or all of the information submitted as protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable."

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

for Lissi M. Marquis,
Director, Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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REEXAMINATION CONTROL NO. : 90008142
PATENT NO. : 6440457
ART UNIT : 3900

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CENTRAL REEXAMINATION UNIT

Colleen Superko (For Third Party)
WILMER CUTLER PICKERING HALE AND DORR LLP
1875 Pennsylvania Avenue, N.W.
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In re Edgren et al.	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No. 90/008,142	:	**ON**
Filed: 06 September 2006	:	**PETITION**
For: U.S. Patent 6,440,457	:	

This is a decision on the July 23, 2007 Patent Owner "Petition Under 37 C.F.R. §1.59(b) to Expunge the Accompanying Information Submitted under MPEP §724.02" (Fifth Supplemental IDS with 16 entries).

This petition is before the Central Reexamination Unit of the United States Patent and Trademark Office.

FEES

The Patent Owner has paid the $400.00 petition fee under 37 CFR §1.17(f) as required by 37 CFR §1.182.

SUMMARY

This petition to expunge information under MPEP §724.06 and 37 CFR §1.59 is **dismissed** as premature.

The proceeding is **remanded** to the examiner for a determination as to whether or not any portion or all of the information submitted in this proceeding as

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BACKGROUND

1. U.S. Patent No. 6,440,457 to Edgren et al. (the '457 patent) issued on August 27, 2002.

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15. On October 24, 2007 the Patent Owner filed an eighth supplemental IDS with a single entry and a petition to expunge these documents under 37 CFR §1.59(b) and MPEP §742.02.

DECISION

37 CFR §1.59(b) provides in part:

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section of §41.7(a) of this title:

(2) Information forming the part of the original disclosure (i.e., written specification including 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.

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CONCLUSION

1. The petition to expunge under MPEP §724.06 and 37 CFR §1.59 is **dismissed**, subject to renewal at a later point in the proceeding. It is held in abeyance, pending renewal of it by Patent Owner at an appropriate time.

2. 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.**

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ART UNIT : 3900

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paul F. Prestia (For Patent Owner)
Phillip E. Gonzalez
RATNER & PRESTIA
1235 Westlakes Drive
P.O. Box 980
Valley Forge, PA 19482-0980

MAILED
FEB 1 1 2008
CENTRAL REEXAMINATION UNIT

Colleen Superko (For Third Party)
WILMER CUTLER PICKERING HALE AND DORR LLP
1875 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

In re Edgren et al.	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No. 90/008,142	:	**ON**
Filed: 06 September 2006	:	**PETITION**
For: U.S. Patent 6,440,457	:	

This is a decision on the July ~~24~~ 23, 2007 Patent Owner "Petition Under 37 C.F.R. §1.59(b) to Expunge the Accompanying Information Submitted under MPEP §724.02" (Fifth Supplemental IDS with 505 entries).

This petition is before the Central Reexamination Unit of the United States Patent and Trademark Office.

FEES

The Patent Owner has paid the $400.00 petition fee under 37 CFR §1.17(f) as required by 37 CFR §1.182.

SUMMARY

This petition to expunge information under MPEP §724.06 and 37 CFR §1.59 is **dismissed** as premature.

The proceeding is **remanded** to the examiner for a determination as to whether or not any portion or all of the information submitted in this proceeding as

protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable."

BACKGROUND

1. U.S. Patent No. 6,440,457 to Edgren et al. (the '457 patent) issued on August 27, 2002.

2. On July 28, 2006 the Third Party Requester filed a request for *ex parte* reexamination of, which resulted in a reexamination proceeding assigned reexamination control number 90/008,142 (the '8142 proceeding).

3. On August 23, 2006 the Office mailed a "Notice of Failure to Comply with Ex Parte Reexamination Request Requirements."

4. On September 6, 2006 the Third Party Requester filed a corrected original *ex parte* request which was granted a filing date.

5. On October 5, 2006 the Office granted the Patent Owner's request and ordered reexamination.

6. On December 1, 2006 the Patent Owner filed an IDS with 159 entries.

7. On February 16, 2007 the Office mailed a non-final Office action.

8. On March 19, 2007 the Patent Owner filed a first supplemental IDS with 177 entries.

9. On March 26, 2007 the Patent Owner filed a second supplemental IDS with 29 entries along with a petition to expunge these documents under 37 CFR. §1.59(b) and MPEP §724.02.

10. On March 30, 2007 the Patent Owner filed a third supplemental IDS with 5 entries.

11. On July 2, 2007 the Patent Owner filed a fourth supplemental IDS with 482 entries.

12. On July 23, 2007 a fifth supplemental IDS was filed with 505 entries and a petition to expunge these documents under 37 CFR §1.59(b) and MPEP §724.02.

13. On July 24, 2007 the Patent Owner filed a second supplement IDS with 16 entries which Patent Owner also called the fifth supplemental IDS and a

petition to expunge these documents under 37 CFR §1.59(b) and MPEP §742.02

14. On July 26, 2007 the Patent Owner filed a seventh supplemental IDS with 4 entries.

15. On October 24, 2007 the Patent Owner filed an eighth supplemental IDS with a single entry and a petition to expunge these documents under 37 CFR §1.59(b) and MPEP §742.02.

DECISION

37 CFR §1.59(b) provides in part:

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section of §41.7(a) of this title:

(2) Information forming the part of the original disclosure (i.e., written specification including 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.

The information submitted with the petition was appropriately submitted under MPEP §724.02, and it accordingly was **provisionally sealed.**
As to the petition itself, MPEP §724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR §1.11(d)." When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." Upon a review of the file history, it does not appear that the requisite determination has been made. Therefore, a decision on the petition at this time is premature, because any information submitted in confidence but found to be "important to a reasonable examiner in deciding whether or not a claim is patentable" cannot be expunged. Accordingly, it is not appropriate at this time to make a determination to expunge. Thus the petition to expunge is **dismissed**, and is held in abeyance pending the determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The dismissal is subject to renewal at a later point in this proceeding, when the issue becomes ripe for decision. After a determination on the issue of importance of the sealed information is made of record (as discussed above), the petition to expunge may be renewed by Patent Owner. Patent Owner is cautioned that a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.

Remand

The proceeding is remanded to the examiner for a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." Upon receipt of jurisdiction of the proceeding, the examiner will, pursuant to MPEP §724.04(c), promptly make such a determination and issue an Office action, which may be a supplemental Notice of Intent to Issue a Reexamination Certificate, if appropriate.

CONCLUSION

1. The petition to expunge under MPEP §724.06 and 37 CFR §1.59 is **dismissed**, subject to renewal at a later point in the proceeding. It is held in abeyance, pending renewal of it by Patent Owner at an appropriate time.

2. As pointed out above, the Patent Owner is cautioned that **a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

3. The present proceeding is **remanded** to the examiner of record for a prompt determination as to whether or not any portion or all of the information submitted as protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable."

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 Deborah Jones

Lissi M. Marquis,
Director, Central Reexamination Unit

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.
90/008,143	08/03/2006	5926237		6948

30827 7590 11/24/2008

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/24/2008

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
BRUCE L LAGERMAN
11921 FREEDOM DRIVE,
SUITE 550
RESTON, VA 20190

Date: MAILED

NOV 24 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008143
PATENT NO. : 5926237
ART UNIT : 3900

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Yong S Choi MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON DC 20006	:	(For Patent Owner)
BRUCE K LAGERMAN 11921 Freedom Drive Suite 550 Reston, VA 20190	:	(For Third Party Requester)
In re Hee Young Yun *et alia* *Ex parte* Reexamination Proceeding Control No. 90/008,143 Deposited on: 3 August 2006 For: US Patent No. 5,926,237	:	DECISION DISMISSING PETITION UNDER 37 CFR § 1.59 (b) TO EXPUNGE INFORMATION

MAILED

NOV 24 2008

CENTRAL REEXAMINATION UNIT

This is a decision on the 23 June 2008, Patent Owner requested petition titled "Petition Under 37 CFR § 1.59(b) to Expunge Papers Filed in First Information Disclosure Statement filed on June 23, 2008 By, Or on Behalf of Hee Young Yun, *et al.*".

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 23 June 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 5,926,237 issued on 20 July 1999.

2. On 3 August 2006 a third party requester requested *ex parte* reexamination of US Patent No. 5,926,237 which is identified under control no. 90/008,143.

3. The Order was granted for reexamination on 31 August 2006.

4. A first Office action on the merits (non-final) was mailed on 21 March 2008 in proceeding 90/008,143.

5. Documents were filed Under Seal on 23 June 2008.

5. A petition filed under 37 CFR 1.59 (b) to expunge information was timely filed 23 June 2008 with authorization to charge the appropriate fee under 37 CFR § 1.17(g).

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 petitioner requests that the documents submitted under seal on 23 June 2008 are subject to court ordered protective order from the record. 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 "references, pleadings, reports and/or various documents Associated with a related litigation matter... Each of the submitted documents are subject to a protective order and the information has not been otherwise made public." In addition, the patent owner states that "[t]he information will be retained by the Applicants for a period of any patent with regard to which the information is submitted." Further the petition fee pursuant to 37 CFR § 1.17(g) is authorized to be paid from a deposit account.

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 23 June 2008 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/

Gregory Morse
Director,
Central Reexamination Unit 3999

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.
90/008,143	08/03/2006	5926237		6948

30827 7590 01/14/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/14/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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11921 FREEDOM DRIVE,
SUITE 550
RESTON, VA 20190

Date:

MAILED

JAN 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008143
PATENT NO. : 5926237
ART UNIT : 3900

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McKenna Long & Aldridge LLP
1900 K Street, N.W.
Washington, D.C. 20006

(For Patent Owner)

MAILED

JAN 14 2009

CENTRAL REEXAMINATION UNIT

Bruce K. Lagerman
Lagerman & Associates, PLLC
11921 Freedom Drive, Suite 550
Reston, VA 20190

(For Requester)

In re Hee Young Yun et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,143
Filed: August 3, 2006
For: U.S. Patent No. 5,926,237

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the December 24, 2008 patent owner petition under 37 CFR 1.137(b) to revive a terminated reexamination proceeding, based on unintentional delay ("the December 24, 2008 patent owner petition to revive").[1]

The December 24, 2008 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

SUMMARY

The December 24, 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:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file the written statement of interview required under 37 CFR 1.560(b) for the interview of September 5, 2008.

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. Patent owner submitted a paper titled "Statement of Substance of Interview Under 37 C.F.R. § 1.560(b)" on December 24, 2008, thereby satisfying item

(1). A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the December 24, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the December 24, 2008 patent owner petition to revive is **granted**.

CONCLUSION

1. The December 24, 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.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Woo Choi, of CRU Art Unit 3992, at (571) 272-4179.

4. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728, or in his absence, to the undersigned at (571) 272-7710.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,143	08/03/2006	5926237	8733.059.61	6948

30827 7590 05/15/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/15/2009

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SUITE 550
RESTON, VA 20190

Date:

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MAY 15 2009

CENTRAL REEXAMINATION UNIT

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REEXAMINATION CONTROL NO. : 90008143
PATENT NO. : 5926237
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United States Patent and Trademark Office

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ALEXANDRIA, VA 22313-1450
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MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

MAILED

MAY 15 2009

CENTRAL REEXAMINATION UNIT

BRUCE K. LAGERMAN
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11921 FREEDOM DRIVE, SUITE 550
RESTON, VA 20190

(For Requester)

In re Yun et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,143
Filed: August 3, 2006
For: U.S. Patent No. 5,926,237

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the April 30, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION."

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

The petition is **dismissed**.

BACKGROUND

- On August 3, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,143 ("the '161 proceeding").

- Prosecution progressed until, on February 2, 2009, patent owner filed a timely response, including declaration and exhibits, to a final Office action that was issued by the Office on October 31, 2008.

- On March 16, 2009, an advisory action was mailed by the Office, refusing entry of the earlier submitted declaration and exhibits, and setting a time period for response to run 6 months from the date of the final Office action.

- On April 30, 2009, patent owner filed a notice of appeal and a response entitled "REQUEST FOR RECONSIDERATION," requesting entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009.

- On April 30, 2009, patent owner also filed a petition entitled "PETITION UNDER 37 CFR 1.181," requesting entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009.

- On April 30, 2009, the patent owner also filed the instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.181 provides, in pertinent part:

(a) Petition may be taken to the Director:
(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

DECISION

A Petition Under 37 CFR 1.182 Will Not Be Granted Where Another Rule Applies

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 an action closing prosecution in an *inter partes* reexamination proceeding.

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

In this instance, the patent owner has concurrently pursued alternative relief via a 37 CFR 1.181 petition to request entry of the declaration, exhibits, and entirety of the response filed February 2, 2009. Since the concurrently filed April 30, 2009 petition under 37 CFR 1.181 to request entry of the amendment and response filed on October 30, 2008 has not yet been decided, the February 2, 2009 submission cannot be considered to have been denied entry after a final rejection, for the purpose of filing a §1.182 petition to request continued reexamination. Accordingly, the present § 1.182 petition to request continued reexamination filed to seek entry of the February 2, 2009 submission filed after final rejection is premature, and is dismissed as such.

In addition, the relief requested in the petition under 37 CFR 1.182 would be moot, should relief be granted under 37 CFR 1.181. Since the entry of the February 2, 2009 submission is currently in the process of being addressed through 37 CFR 1.181, consideration of this situation under 37 CFR 1.182 would be premature. Patent owner retains the option of filing a renewed petition under 37 CFR 1.182, if at some future date relief has not been granted under 37 CFR 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.182.

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

Additional discussion:

The April 30, 2009, patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009. 37 CFR 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 CFR 1.182 is, according to the terms of that regulation, not an appropriate mechanism for relief. Here, the petition under 37 CFR 1.182 shares a common statement of facts upon which relief is requested with the concurrently filed petition under 37 CFR 1.181 (pages 2 and 3 of each petition). Both petitions allege that the evidence of secondary considerations has not been given the proper consideration, and that the evidence and declaration submitted on February 2nd was not entered or considered. The instant petition under 37 CFR 1.182 further alleges that sufficient reasons for the Examiner's rejection were not given in the advisory action mailed March 16, 2009. Each of the allegations made in the instant 37 CFR 1.182 petition addresses alleged impropriety as to the final Office action and the advisory action. While such allegations of impropriety of an Office action are properly addressed under 37 CFR 1.181, they are not the basis for a petition requesting continued examination under 37 CFR 1.182. If a petition requesting continued examination under 37 CFR 1.182 is subsequently filed, it should focus on how entry of the February 3, 2009 submission would further the prosecution of the reexamination proceeding, by reducing issues, to define the issues for appeal, or the issuance of a reexamination certificate, and why it was not apparent until the issuance of the final rejection that the specifics of the February 3, 2009 submission would do so.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- The Central Reexamination Unit will consider the April 30, 2009 petition under 37 CFR 1.181 in due course.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, Pinchus M. Laufer at (571) 272-7726.

Kenneth M. Schor

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

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.
90/008,143	08/03/2006	5926237	8733.059.61	6948

30827 7590 09/11/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRUCE L LAGERMAN
11921 FREEDOM DRIVE,
SUITE 550
RESTON, VA 20190

Date: MAILED

SEP 1 1 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008143
PATENT NO. : 5926237
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
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MCKENNA, LONG & ALDRIDGE LLP : (For Patent Owner)
1900 K STREET, NW :
WASHINGTON DC 20006 :

MAILED
SEP 11 2009
CENTRAL REEXAMINATION UNIT

BRUCE K. LAGERMAN : (For Third-Party Requester)
LAGERMAN & ASSOCIATES PLLC :
1192 FREEDOM DRIVE, SUITE 550 :
RESTON VA 20190 :

In re YUN *et alia* : DECISION GRANTING
Reexamination Proceeding : PETITION FOR
Control No. 90 / 008,143 : EXTENSION OF TIME
Request Deposited: August 3, 2006 : [37 CFR 1.550(c)]
For: U.S. Patent No. 5,926,237 :

This is a decision on patent owner's petition for extension of time under 37 CFR 1.550(c) filed on September 4, 2009. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is granted to the extent indicated for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 5,926,237 was ordered in the Determination mailed August 31, 2006.

2. In response to the first office action, owner submitted evidence of secondary considerations evidenced by a declaration from Choi.

2. Prosecution was closed with the final rejection mailed October 30, 2008. The rejections set forth in the first office action were maintained and the Choi declaration found unpersuasive.

3. An after amendment was timely filed by owner on February 2, 2009 and denied entry in the advisory action of March 16, 2009. This proposed amendment included additional argument and evidence of secondary considerations evidenced by declarations from Choi, Varner and Phillips.

4. Owner petitions for entry of the February 2, 2009 submission on April 30, 2009.

5. Owner's period for response was extended to September 11, 2008 via grant of petition under 37 CFR 1.183 on July 28 2009. The extension was granted to allow for decision upon owner's April 30, 2009 decision and noted should said decision not be received prior to expiration, further extensions of time could be requested under 37 CFR 1.550(c).

6. On September 4, 2009 owner filed the instant petition requesting an additional 45 days to await decision on the April 30, 2009 petition and subsequently prepare a response.

DECISION

The Patent Owner requests an extension of time of 45 days in which to consider an expected decision on petition filed under 37 CFR 1.181 and prepare and file an Appeal Brief or take other appropriate action. The request for extension is the **fourth** request for an extension of time during the proceeding. The present petition for extension of time was timely filed on September 4, 2009, together with the requisite fee.

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 ....

> Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations...
>
> The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

The request notes what steps Owner has taken to date in preparation of a response to the Office action. Further, the request outlines why, in spite of the actions taken thus far, the requested additional time is believed necessary. Further, the reasoning outlined rises to the level of extraordinary sufficient to grant this subsequent request. Reference is made to the petition pages 1-6 for details of these issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" and "extraordinary circumstances " for an extension of time. It is clear Patent Owner requires some additional time to prepare an appropriate response to the final rejection. An extension of time of one month is considered sufficient.

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.

CONCLUSION

1. Petitioner's request is **granted** for one (1) month. The period during which Patent Owner may file a response to the final rejection remains running from the October 31, 2008 Office action and is extended an additional 30 days from its current September 11, 2009 expiration. Patent Owner's response is due October 11, 2009, absent further extension by grant of petition.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,143	08/03/2006	5926237	8733.059.61	6948

30827 7590 09/15/2009
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRUCE L LAGERMAN
11921 FREEDOM DRIVE,
SUITE 550
RESTON, VA 20190

Date: MAILED
SEP 15 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008143
PATENT NO. : 5926237
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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SEP 15 2009

CENTRAL REEXAMINATION UNIT

MCKENNA, LONG & ALDRIDGE LLP : (For Patent Owner)
1900 K STREET, NW :
WASHINGTON DC 20006 :

BRUCE K. LAGERMAN : (For Third-Party Requester)
LAGERMAN & ASSOCIATES PLLC :
1192 FREEDOM DRIVE, SUITE 550 :
RESTON VA 20190 :

In re YUN *et alia* : DECISION DISMISSING
Reexamination Proceeding : PETITION FOR
Control No. 90 / 008,143 : ADMISSION OF EVIDENCE
Request Deposited: August 3, 2006 : UNDER 37 CFR 1.116
For: U.S. Patent No. 5,926,237 :

This is a decision on patent owner's petition for admission of evidence under 37 CFR 1.116 filed on April 30, 2009. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 5,926,237 was ordered in the Determination mailed August 31, 2006.

2. In response to the first office action, owner submitted evidence of secondary considerations evidenced by a declaration from Choi.

3. Prosecution was closed with the final rejection mailed October 30, 2008. The rejections set forth in the first office action were maintained and the Choi declaration found unpersuasive.

4. An after amendment was timely filed by owner on February 2, 2009 and denied entry in the advisory action of March 16, 2009. This proposed amendment included additional argument and evidence of secondary considerations evidenced by declarations from Choi (unamended from first submission), Varner and Phillips.

5. Owner petitions for entry of the February 2, 2009 submission on April 30, 2009.

Applicable Statute or Regulation

37 CFR 1.116 states in pertinent part:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

*(a) An amendment after final action must comply with **§ 1.114** or this section.*

*(b) After a final rejection or other final action (**§ 1.113**) in an application or in an ex parte reexamination filed under **§ 1.510**, or an action closing prosecution (**§ 1.949**) in an inter partes reexamination filed under **§ 1.913**, but before or on the same date of filing an appeal (**§ 41.31** or **§ 41.61** of this title):*

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

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[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

DECISION

Owner petitions for relief and requests entry and consideration of the declaration and exhibits related to secondary considerations filed after final rejection on February 2, 2009. Owner begins his presentation by noting an affidavit or other evidence submitted after a final rejection in an *ex parte* reexamination may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Owner opines his evidence of secondary considerations has not been given the full attention or weight it deserves. Owner submits the final office action showed confusion and necessitated clarification, but fails to elaborate any impropriety within the action. Additionally, owner argues the after final submission should be entered because it directly addressed and responded to arguments first made by the Examiner in the final office action. Owner further submits his good and sufficient reasons why the additional declarations presented after final were not earlier presented include the examiner did not fully appreciate the evidence and owner could not have reasonably predicted the Office would not fully appreciate the evidence. Finally, owner posits the newly

presented evidence should be entered after final as there would be minimum burden upon the examiner.

Respectfully, owners points are not well taken. Owner's first point, that his evidence of secondary considerations has not been given the full attention or weight it deserves, is not persuasive in that review of the official record indicates the Choi declaration has been given full attention and weight. The final office actions devotes at least three pages to explanations of the full consideration given by the examiner and why the evidence presented was not found persuasive. Clearly the evidence was given full attention and consideration by the examiner.

Next, owner alleges the final office action showed confusion and necessitated clarification. Review of the final office action reveals a clear, thorough and complete action by the examiner. It is not clear what confusion owner is referring to and why any clarification on owners part was necessitated. No particular language offered by the examiner in the final rejection has been highlighted as confusing nor any relation to how or why the additional declarations submitted after final would clarify the record.

Continuing, owner argues the after final submission should be entered because it directly addressed and responded to arguments first made by the Examiner in the final office action. It is axiomatic that an examiner must reply to all arguments advanced by an applicant in response to a rejection. See 37 CFR 1.104 and 1.112; see also MPEP 707 *et seq*, and in particular, MPEP 707.07(f). It would also appear to be axiomatic that an examiner cannot anticipate an argument that will be advanced by an applicant but has not so been advanced. That an examiner's considered response to an argument advanced by owner enlightens owner to additional arguments that could have been advanced but were not does not entitle owner to continued prosecution and right of entry of that new argument after prosecution is closed. Owner has a responsibility to make all arguments in a timely manner.

Additionally, owner argues his good and sufficient reasons why the additional declarations presented after final were not earlier presented include (a) the examiner did not fully appreciate the evidence and (b) owner could not have reasonably predicted the Office would not fully appreciate the evidence. While it is not clear what owner means by arguing the office did not "fully appreciate" his evidence, it would appear by "fully appreciate" owner intends "persuaded by". However, the fact that an examiner is not persuaded by an evidentiary showing does not mean the evidence was not fully considered or fully appreciated by the examiner. The standards for an adequate showing of secondary considerations are found in MPEP 716 and were readily available to owner while preparing his evidentiary showing. Further, owner was clearly and fairly noticed in the first office action of March 21, 2008 :

> " In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action; which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced. "

Accordingly, all evidence related to secondary considerations should have been submitted by owner in response to the first office action. Only the declaration of Choi was submitted prior to final rejection. No explanation has been proffered as to why the declarations of Varner and Phillips were not also presented at that time.

Finally, owner offers the newly presented evidence should be entered after final as there would be minimum burden upon the examiner. Respectfully, such is not the standard for entry of evidence after final nor is such the case herein. As every file is considered on its own merits, the fact that similar evidence has been considered against similar claims has no bearing upon the effort expended in consideration herein, nor does it explain why the evidence was not earlier presented.

As a final observation, the proposed additional evidence submitted after final rejection does not appear to be solely directed to correcting the deficiencies noted by the examiner in the final rejection. In fact, it resubmits the previously considered Choi declaration verbatim and fails to explain why the examiner's consideration was improper or point out how the additional information provided by the additional declarations corrects those deficiencies. Nor does the after final submission explain why the additional evidence is necessary and was not earlier presented. In summary, the examiner's refusal to enter and consider the evidence presented after final rejection as lacking a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented appears to have been proper and no convincing basis for altering that decision has been advanced by petitioner.

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running from the October 31, 2008 Office action as extended in the July 28, 2009 decision on petition for extension of time. Patent Owner's response is due September 11, 2009, absent further extension by grant of petition.

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

By hand: Customer Service Window
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Alexandria, VA 22314

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3. Telephone inquiries related to this decision should be directed to Jessica Harrison at (571) 272-4449, Mark Reinhart at (571) 272-1611, or Eric Keasel, at (571) 272-4929.

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,143	08/03/2006	5926237	8733.059.61	6948

30827 7590 10/09/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRUCE L LAGERMAN
11921 FREEDOM DRIVE,
SUITE 550
RESTON, VA 20190

Date:
MAILED
OCT 09 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008143
PATENT NO. : 5926237
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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MCKENNA, LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

: (For Patent Owner)

MAILED

OCT 09 2009

CENTRAL REEXAMINATION UNIT

BRUCE K. LAGERMAN
LAGERMAN & ASSOCIATES PLLC
1192 FREEDOM DRIVE, SUITE 550
RESTON VA 20190

: (For Third-Party Requester)

In re YUN *et alia*
Reexamination Proceeding
Control No. 90 / 008,143
Request Deposited: August 3, 2006
For: U.S. Patent No. 5,926,237

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

This is a decision on patent owner's petition for extension of time under 37 CFR 1.550(c) filed on October 5, 2009. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is granted to the extent indicated for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 5,926,237 was ordered in the Determination mailed August 31, 2006.

2. In response to the first office action, owner submitted evidence of secondary considerations evidenced by a declaration from Choi.

2. Prosecution was closed with the final rejection mailed October 30, 2008. The rejections set forth in the first office action were maintained and the Choi declaration found unpersuasive.

3. An after amendment was timely filed by owner on February 2, 2009 and denied entry in the advisory action of March 16, 2009. This proposed amendment included additional argument and evidence of secondary considerations evidenced by declarations from Choi, Varner and Phillips.

4. Owner petitions for entry of the February 2, 2009 submission on April 30, 2009.

5. Owner's period for response was extended to September 11, 2008 via grant of petition under 37 CFR 1.183 on July 28 2009. The extension was granted to allow for decision upon owner's April 30, 2009 decision and noted should said decision not be received prior to expiration, further extensions of time could be requested under 37 CFR 1.550(c).

6. On September 4, 2009 owner filed the instant petition requesting an additional 45 days to await decision on the April 30, 2009 petition and subsequently prepare a response.

7. On September 15, 2009 owners petition under 37 CFR 1.181 requesting entry of evidence first submitted after final rejection was dismissed.

8. On October 1, 2009 owner renewed his petition under 37 CFR 1.182 requesting continued reexamination. This petition remains outstanding.

DECISION

The Patent Owner requests an extension of time of 30 additional days in which to receive and consider an expected decision on petition filed under 37 CFR 1.182. The request for extension is the **fifth** request for an extension of time during the proceeding. The present petition for extension of time was timely filed on October 5, 2009, together with the requisite fee.

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 ....
>
> Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations...
>
> The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

The request notes what steps Owner has taken to date in preparation of a response to the Office action. Further, the request outlines why, in spite of the actions taken thus far, the requested additional time is believed necessary. Further, the reasoning outlined rises to the level of extraordinary sufficient to grant this subsequent request. Reference is made to the petition pages 1-6 for details of these issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" and "extraordinary circumstances " for an extension of time. It is clear Patent Owner requires some additional time to prepare an appropriate response to the final rejection, given its dependence upon the decision on the outstanding petition. An extension of time of one month is considered sufficient.

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.

CONCLUSION

1. Petitioner's request is **granted** for one (1) month. The period during which Patent Owner may file a response to the final rejection remains running from the October 31, 2008 Office action and is extended an additional 1 month days from its current October 11, 2009 expiration. Patent Owner's response is due November 11, 2009, absent further extension by grant of petition.

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
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.
90/008,143	08/03/2006	5926237	8733.059.61	6948

30827 7590 10/27/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRUCE L LAGERMAN
11921 FREEDOM DRIVE,
SUITE 550
RESTON, VA 20190

Date:

MAILED

OCT 27 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008143
PATENT NO. : 5926237
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
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OCT 27 2009

CENTRAL REEXAMINATION UNIT

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

BRUCE K. LAGERMAN
LAGERMAN & ASSOCIATES PLLC
11921 FREEDOM DRIVE, SUITE 550
RESTON, VA 20190

(For Requester)

In re Yun et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,143
Filed: August 3, 2006
For: U.S. Patent No. 5,926,237

DECISION
GRANTING PETITION
UNDER 1.182

This is a decision on the October 1, 2009 patent owner petition entitled "RENEWED PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION."

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

The petition is **granted**.

BACKGROUND

- On August 3, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,143 ("the '161 proceeding").

- Prosecution progressed until, on October 31, 2008, a final Office action was mailed. The final Office action addressed arguments based upon secondary considerations of nonobviousness grounded in factual representations submitted to the Office in a declaration by Wonjun Choi on June 23, 2008.

- On February 2, 2009, patent owner filed a response, including declarations and exhibits, to the final Office action October 31, 2008.

- On March 16, 2009, an advisory Office action was mailed by the Office, refusing entry of the declarations and exhibits submitted on February 2, 2009, and setting a time period for response to run 6 months from the date of the final Office action.

- On April 30, 2009, patent owner filed a notice of appeal and a response entitled "REQUEST FOR RECONSIDERATION," requesting entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009.

- On April 30, 2009, patent owner also filed a petition entitled "PETITION UNDER 37 CFR 1.181," requesting entry and consideration of the declarations, exhibits, and entirety of the response filed February 2, 2009.

- On April 30, 2009, the patent owner also filed a petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the declarations, exhibits, and entirety of the response filed February 2, 2009.

- On May 8, 2009, the Office mailed an advisory Office action refusing entry and consideration of the proposed response filed April 30, 2009.

- On May 15, 2009, the Office dismissed as premature patent owner's petition under 37 CFR § 1.182 filed April 30, 2009.

- On June 26, 2009, the Office granted an extension of time as requested by patent owner on June 24, 2009, extending the time for filing an appeal brief until July 30, 2009.

- On July 28, 2009, the Office granted an extension of time as requested by patent owner on July 21, 2009, extending the time for filing an appeal brief to run 45 days from the date of the decision.

- On September 11, 2009, the Office granted an extension of time as requested by patent owner on September 4, 2009, extending the time for filing an appeal brief until October 11, 2009.

- On September 15, 2009, the Office dismissed patent owner's petition under 37 CFR § 1.181 filed April 30, 2009.

- On October 1, 2009, patent owner filed the instant petition entitled "RENEWED PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the declarations, exhibits, and entirety of the response filed February 2, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

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

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

37 CFR 1.525(a) provides, in pertinent part:

> If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for ex parte reexamination of the patent for **resolution of the question**. (emphasis added)

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the 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

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

denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* 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."

There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 CFR 1.182 can provide relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the requirement of special dispatch. 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 *ex parte* reexamination setting, where 35 U.S.C. 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the case without the amendment or evidence), since these are key factors in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution. And, the grant or dismissal of a § 1.182 petition depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request.

The first issue, then, is whether applicant's submission, if entered, would advance the issues towards resolution of the questions of patentability at issue in the proceeding. Patent owner states that the issues would be advanced because patent owner has "four co-pending reexaminations in a family of closely related patents," and that final resolution of all of the reexaminations would be best served by entry of the instant submission, which has "substantially similar" issues to those in the other reexaminations. However, since each proceeding must stand upon its own merits, entry of arguments and amendments is not justified by a desire to coordinate submissions between separate reexamination proceedings. Patent owner has not, through this argument, shown that any issues in the '143 proceeding would be advanced towards resolution through entry of the submission.

However, patent owner also argues that the evidentiary submission attempts to address deficiencies in an earlier evidentiary submission, which deficiencies were first made of record by the Office in the final Office action. On June 23, 2008, patent owner filed a response to a non-final Office action. The response alleged secondary considerations of nonobviousness, and an attempt to support the allegation was proffered by way of factual assertions made in a declaration by Wonjun Choi, submitted therewith. The Office considered the secondary considerations; however, in the final Office action of October 31, 2008, the secondary considerations were found unpersuasive due, in part, to an insufficient evidentiary showing. *See* the final Office action of

October 31, 2008, pages 27-28. The February 2, 2009 response to the final Office action included three declarations, including a more detailed declaration by Wonjun Choi. These declarations are directed to factual assertions pertaining to the same secondary considerations presented earlier; however, the content of the assertions attempts to address the deficiencies in the earlier Choi declaration that were made of record in the final Office action of October 31, 2008. Entry of the February 2, 2009 declarations, therefore, is found to further define the issues for appeal, or the issuance of a reexamination certificate.

For the above reasons, the petition is deemed to have shown that entry of the submission would advance the issues towards appeal or issuance of a reexamination certificate.

The second issue is whether the submission comports with the requirement of special dispatch, in that the need for such response could not have been anticipated earlier. Patent owner indicates that the need for such response could not have been presented earlier, because the arguments clarify previously submitted evidence in light of the final Office action. *See* the instant petition at 4. As discussed above, the evidentiary submissions have been submitted in an attempt to address the deficiencies in the earlier Choi declaration that were made of record in the final Office action of October 31, 2008. For this reason, patent owner's response is persuasive as to the reasons why the need for such evidentiary submissions could not have been anticipated earlier.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is 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 granted.

CONCLUSION

- The petition is **granted to the extent set forth herein**.
- The prosecution of the present '8143 *ex parte* 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 October 31, 2008 final Office action is hereby withdrawn, and prosecution of the proceeding is reopened.
- The February 2, 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

10-22-09
Kenpet7/RCR

UNITED STATES PATENT AND TRADEMARK OFFICE

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NOV 05 2008

CENTRAL REEXAMINATION UNIT

Yong S Choi MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON DC 20006	:	(For Patent Owner)
BRUCE K LAGERMAN 11921 Freedom Drive Suite 550 Reston, VA 20190	:	(For Third Party Requester)
	:	DECISION DISMISSING PETITION UNDER 37 CFR § 1.59 (b) TO EXPUNGE INFORMATION
In re Yun *et alia* *Ex parte* Reexamination Proceeding Control No. 90/008,145 Deposited on: 3 August 2006 For: US Patent No. 6,002, 457	:	

This is a decision on the 30 June 2008, Patent Owner requested petition titled "Petition Under 37 CFR § 1.59(b) to Expunge Papers Filed in Second Information Disclosure Statement Filed on June 30, 2008 By, Or on Behalf of Hee Young Yun, *et al.*".

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 30 June 2008.

The petition was filed in a timely manner with the authorization for the appropriate fee pursuant to 37 CFR § 1.17 (g).

The petition is hereby dismissed as premature.

REVIEW OF RELEVENT FACTS

1. US Patent No. 6,002,457 issued on 14 December 1999.

2. On 3 August 2006 a third party requester requested *ex parte* reexamination of US Patent No. 6,002,457 which is identified under control no. 90/008,145.

3. The Order was granted for reexamination on 15 September 2006.

4. A first Office action on the merits (non-final) was mailed on 28 March 2008 in proceeding 90/008,145.

5. Documents were filed Under Seal on 30 June 2008

5. A petition filed under 37 CFR 1.59 (b) to expunge information was timely filed 30 June 2008 with authorization to charge the appropriate fee under 37 CFR § 1.17(g).

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 petitioner requests that the documents submitted under seal on 30 June 2008 are subject to court ordered protective order from the record. 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 "references, reports and/or various documents [are] associated a related litigation matter... Each of the submitted documents are subject to a protective order and the information has not been otherwise made public." In addition, the patent owner states that "[t]he information will be retained by the Applicants for a period of any patent with regard to which the information is submitted." Further the petition fee pursuant to 37 CFR § 1.17(g) is authorized to be paid from a deposit account.

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 30 June 2008 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 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, 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

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,146	08/03/2006	6373537	8733.059.60	7795

30827 7590 11/24/2008

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/24/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRUCE L LAGERMAN
11921 FREEDOM DRIVE
SUITE 550
RESTON, VA 20190

Date:
MAILED
NOV 24 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008146
PATENT NO. : 6373537
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

Yong S Choi
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

MAILED

NOV 24 2008

CENTRAL REEXAMINATION UNIT

BRUCE K LAGERMAN
11921 Freedom Drive
Suite 550
Reston, VA 20190

(For Third Party Requester)

DECISION DISMISSING PETITION UNDER 37 CFR § 1.59 (b) TO EXPUNGE INFORMATION

In re Hee Young Yun *et alia*
Ex parte Reexamination Proceeding
Control No. 90/008,146
Deposited on: 3 August 2006
For: US Patent No. 6,373,537

This is a decision on the 30 June 2008, Patent Owner requested petition titled "Petition Under 37 CFR § 1.59(b) to Expunge Papers Filed in Second Information Disclosure Statement Filed on June 30, 2008 By, Or on Behalf of Hee Young Yun, *et al.*".

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 30 June 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 6,373,537 issued on 16 April 2002.

2. On 3 August 2006 a third party requester requested *ex parte* reexamination of US Patent No. 6,373,537 which is identified under control no. 90/008,1460.

3. The Order was granted for reexamination on 15 September 2006.

4. A first Office action on the merits (non-final) was mailed on 28 March 2008 in proceeding 90/008,146.

5. Documents were filed Under Seal on 30 June 2008.

5. A petition filed under 37 CFR 1.59 (b) to expunge information was timely filed 30 June 2008 with authorization to charge the appropriate fee under 37 CFR § 1.17(g).

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 petitioner requests that the documents submitted under seal on 30 June 2008 are subject to court ordered protective order from the record. 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 "references, pleadings, reports and/or various documents [are] associated a related litigation matter... Each of the submitted documents are subject to a protective order and the information has not been otherwise made public." In addition, the patent owner states that "[t]he information will be retained by the Applicants for a period of any patent with regard to which the information is submitted." Further the petition fee pursuant to 37 CFR § 1.17(g) is authorized to be paid from a deposit account.

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 30 June 2008 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/

Gregory Morse
Director,
Central Reexamination Unit 3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,146	08/03/2006	6373537	8733.059.60	7795

30827 7590 05/18/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRUCE L LAGERMAN
11921 FREEDOM DRIVE
SUITE 550
RESTON, VA 20190

Date:
MAILED
MAY 18 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008146
PATENT NO. : 6373537
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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1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

MAILED

MAY 18 2009

CENTRAL REEXAMINATION UNIT

BRUCE K. LAGERMAN
LAGERMAN & ASSOCIATES PLLC
11921 FREEDOM DRIVE, SUITE 550
RESTON, VA 20190

(For Requester)

In re Yun et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,146
Filed: August 3, 2006
For: U.S. Patent No. 6,373,537

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the May 1, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION."

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

The petition is **dismissed**.

BACKGROUND

- On August 3, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,146 ("the '146 proceeding").

- Prosecution progressed until, on February 3, 2009, patent owner filed a timely response, including declaration and exhibits, to a final Office action that was issued by the Office on November 3, 2008.

- On March 16, 2009, an advisory action was mailed by the Office, refusing entry of the earlier submitted declaration and exhibits, and setting a time period for response to run 6 months from the date of the final Office action.

- On May 1, 2009, patent owner filed a notice of appeal and a response entitled "REQUEST FOR RECONSIDERATION," requesting entry and consideration of the declaration, exhibits, and entirety of the response filed February 3, 2009.

- On May 1, 2009, patent owner also filed a petition entitled "PETITION UNDER 37 CFR 1.181," requesting entry and consideration of the declaration, exhibits, and entirety of the response filed February 3, 2009.

- On May 1, 2009, the patent owner also filed the instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the declaration, exhibits, and entirety of the response filed February 3, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.181 provides, in pertinent part:

(a) Petition may be taken to the Director:
(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

DECISION

A Petition Under 37 CFR 1.182 Will Not Be Granted Where Another Rule Applies

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 an action closing prosecution in an *inter partes* reexamination proceeding.

In this instance, the patent owner has concurrently pursued alternative relief via a 37 CFR 1.181 petition to request entry of the declaration, exhibits, and entirety of the response filed February 3,

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

2009. Since the concurrently filed May 1, 2009 petition under 37 CFR 1.181 to request entry of the amendment and response filed on October 30, 2008 has not yet been decided, the February 3, 2009 submission cannot be considered to have been denied entry after a final rejection, for the purpose of filing a §1.182 petition to request continued reexamination. Accordingly, the present § 1.182 petition to request continued reexamination filed to seek entry of the February 3, 2009 submission filed after a final rejection is premature, and is dismissed as such.

In addition, the relief requested in the petition under 37 CFR 1.182 would be moot, should relief be granted under 37 CFR 1.181. Since the entry of the February 3, 2009 submission is currently in the process of being addressed through 37 CFR 1.181, consideration of this situation under 37 CFR 1.182 would be premature. Patent owner retains the option of filing a renewed petition under 37 CFR 1.182, if at some future date relief has not been granted under 37 CFR 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.182.

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

Additional discussion:

The May 1, 2009, patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of the declaration, exhibits, and entirety of the response filed February 3, 2009. 37 CFR 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 CFR 1.182 is, according to the terms of that regulation, not an appropriate mechanism for relief. Here, the petition under 37 CFR 1.182 shares a common statement of facts upon which relief is requested with the concurrently filed petition under 37 CFR 1.181 (pages 2 and 3 of each petition). Both petitions allege that the evidence of secondary considerations has not been given the proper consideration, and that the evidence and declaration submitted on February 3rd was not entered or considered. The instant petition under 37 CFR 1.182 further alleges that sufficient reasons for the Examiner's rejection were not given in the advisory action mailed March 16, 2009. Each of the allegations made in the instant 37 CFR 1.182 petition addresses alleged impropriety as to the final Office action and the advisory action. While such allegations of impropriety of an Office action are properly addressed under 37 CFR 1.181, they are not the basis for a petition requesting continued examination under 37 CFR 1.182. If a petition requesting continued examination under 37 CFR 1.182 is subsequently filed, it should focus on how entry of the February 3, 2009 submission would further the prosecution of the reexamination proceeding, by reducing issues, to define the issues for appeal, or the issuance of a reexamination certificate, and why it was not apparent until the issuance of the final rejection that the specifics of the February 3, 2009 submission would do so.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- The Central Reexamination Unit will consider the May 1, 2009 petition under 37 CFR 1.181 in due course.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, Pinchus M. Laufer at (571) 272-7726.

Kenneth M. Schor

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,146	08/03/2006	6373537	8733.059.60	7795

30827 7590 09/11/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/11/2009

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BRUCE L LAGERMAN
11921 FREEDOM DRIVE
SUITE 550
RESTON, VA 20190

Date: MAILED
SEP 11 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008146
PATENT NO. : 6373537
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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SEP 11 2009
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BRUCE K. LAGERMAN
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1192 FREEDOM DRIVE, SUITE 550
RESTON VA 20190

: (For Third-Party Requester)

In re YUN *et alia*
Reexamination Proceeding
Control No. 90 / 008,146
Request Deposited: August 3, 2006
For: U.S. Patent No. 6,373,537

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

This is a decision on patent owner's petition for extension of time under 37 CFR 1.550(c) filed on September 4, 2009. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is granted to the extent indicated for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 6,373,537 was ordered in the Determination mailed September 15, 2006.

2. In response to the first office action, owner submitted evidence of secondary considerations evidenced by a declaration from Choi.

2. Prosecution was closed with the final rejection mailed November 3, 2008. The rejections set forth in the first office action were maintained and the Choi declaration found unpersuasive.

3. An after amendment was timely filed by owner on February 2, 2009 and denied entry in the advisory action of March 16, 2009. This proposed amendment included additional argument and evidence of secondary considerations evidenced by declarations from Choi, Varner and Phillips.

4. Owner petitions for entry of the February 2, 2009 submission on April 30, 2009.

5. Owner's period for response was extended to September 11, 2008 via grant of petition under 37 CFR 1.183 on July 28 2009. The extension was granted to allow for decision upon owner's April 30, 2009 decision and noted should said decision not be received prior to expiration, further extensions of time could be requested under 37 CFR 1.550(c).

6. On September 4, 2009 owner filed the instant petition requesting an additional 45 days to await decision on the April 30, 2009 petition and subsequently prepare a response.

DECISION

The Patent Owner requests an extension of time of 45 days in which to consider an expected decision on petition filed under 37 CFR 1.181 and prepare and file an Appeal Brief or take other appropriate action. The request for extension is the **fourth** request for an extension of time during the proceeding. The present petition for extension of time was timely filed on September 4, 2009, together with the requisite fee.

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 ....

> Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations...
>
> The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

The request notes what steps Owner has taken to date in preparation of a response to the Office action. Further, the request outlines why, in spite of the actions taken thus far, the requested additional time is believed necessary. Further, the reasoning outlined rises to the level of extraordinary sufficient to grant this subsequent request. Reference is made to the petition pages 1-6 for details of these issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" and "extraordinary circumstances " for an extension of time. It is clear Patent Owner requires some additional time to prepare an appropriate response to the final rejection. An extension of time of one month is considered sufficient.

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.

CONCLUSION

1. Petitioner's request is **granted** for one (1) month. The period during which Patent Owner may file a response to the final rejection remains running from the October 31, 2008 Office action and is extended an additional 30 days from its current September 11, 2009 expiration. Patent Owner's response is due October 11, 2009, absent further extension by grant of petition.

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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Commissioner for Patents
United States Patent & Trademark Office
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By FAX to: (571) 273-9900
Central Reexamination Unit

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

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

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30827 7590 09/15/2009

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008146
PATENT NO. : 6373537
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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BRUCE K. LAGERMAN
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: (For Third-Party Requester)

In re YUN *et alia*
Reexamination Proceeding
Control No. 90 / 008,146
Request Deposited: August 3, 2006
For: U.S. Patent No 6,373,537

: DECISION DISMISSING
: PETITION FOR
: ADMISSION OF EVIDENCE
: UNDER 37 CFR 1.116

This is a decision on patent owner's petition for admission of evidence under 37 CFR 1.116 filed on April 30, 2009. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 6,373,537 was ordered in the Determination mailed September 15, 2006.

2. In response to the first office action, owner submitted evidence of secondary considerations evidenced by a declaration from Choi.

3. Prosecution was closed with the final rejection mailed November 3, 2008. The action set a two month period for response. The rejections set forth in the first office action were maintained and the Choi declaration found unpersuasive.

4. An after amendment was timely filed by owner on February 3, 2009 and denied entry in the advisory action of March 16, 2009. This proposed amendment included additional argument and evidence of secondary considerations evidenced by declarations from Choi (unamended from first submission), Varner and Phillips.

5. Owner petitions for entry of the February 3, 2009 submission on May 1, 2009.

Applicable Statute or Regulation

37 CFR 1.116 states in pertinent part:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

*(a) An amendment after final action must comply with **§ 1.114** or this section.*

*(b) After a final rejection or other final action (**§ 1.113**) in an application or in an ex parte reexamination filed under **§ 1.510**, or an action closing prosecution (**§ 1.949**) in an inter partes reexamination filed under **§ 1.913**, but before or on the same date of filing an appeal (**§ 41.31** or **§ 41.61** of this title):*

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

[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

DECISION

Owner petitions for relief and requests entry and consideration of the declaration and exhibits related to secondary considerations filed after final rejection on February 3, 2009. Owner begins his presentation by noting an affidavit or other evidence submitted after a final rejection in an *ex parte* reexamination may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Owner opines his evidence of secondary considerations has not been given the full attention or weight it deserves. Owner submits the final office action showed confusion and necessitated clarification, but fails to elaborate any impropriety within the action. Additionally, owner argues the after final submission should be entered because it directly addressed and responded to arguments first made by the Examiner in the final office action. Owner further submits his good and sufficient reasons why the additional declarations presented after final were not earlier presented include the examiner did not fully appreciate the evidence and owner could not have reasonably predicted the Office would not fully appreciate the evidence. Finally, owner posits the newly

presented evidence should be entered after final as there would be minimum burden upon the examiner.

Respectfully, owners points are not well taken. Owner's first point, that his evidence of secondary considerations has not been given the full attention or weight it deserves, is not persuasive in that review of the official record indicates the Choi declaration has been given full attention and weight. The final office actions devotes at least three pages to explanations of the full consideration given by the examiner and why the evidence presented was not found persuasive. Clearly the evidence was given full attention and consideration by the examiner.

Next, owner alleges the final office action showed confusion and necessitated clarification. Review of the final office action reveals a clear, thorough and complete action by the examiner. It is not clear what confusion owner is referring to and why any clarification on owners part was necessitated. No particular language offered by the examiner in the final rejection has been highlighted as confusing nor any relation to how or why the additional declarations submitted after final would clarify the record.

Continuing, owner argues the after final submission should be entered because it directly addressed and responded to arguments first made by the Examiner in the final office action. It is axiomatic that an examiner must reply to all arguments advanced by an applicant in response to a rejection. See 37 CFR 1.104 and 1.112; see also MPEP 707 *et seq*, and in particular, MPEP 707.07(f). It would also appear to be axiomatic that an examiner cannot anticipate an argument that will be advanced by an applicant but has not so been advanced. That an examiner's considered response to an argument advanced by owner enlightens owner to additional arguments that could have been advanced but were not does not entitle owner to continued prosecution and right of entry of that new argument after prosecution is closed. Owner has a responsibility to make all arguments in a timely manner.

Additionally, owner argues that his good and sufficient reasons why the additional declarations presented after final were not earlier presented include (a) the examiner did not fully appreciate the evidence and (b) the owner could not have reasonably predicted the Office would not fully appreciate the evidence. While it is not clear what owner means by arguing the office did not "fully appreciate" his evidence, it would appear by "fully appreciate" owner intends "persuaded by". However, the fact that an examiner is not persuaded by an evidentiary showing does not mean the evidence was not fully considered or fully appreciated by the examiner. The standards for an adequate showing of secondary considerations are found in MPEP 716 and were readily available to owner while preparing his evidentiary showing. Further, owner was clearly and fairly noticed in the first office action of March 21, 2008 :

> " In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action; which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced. "

Accordingly, all evidence related to secondary considerations should have been submitted by owner in response to the first office action. Only the declaration of Choi was submitted prior to final rejection. No explanation has been proffered as to why the declarations of Varner and Phillips were not also presented at that time.

Finally, owner offers the newly presented evidence should be entered after final as there would be minimum burden upon the examiner. Respectfully, such is not the standard for entry of evidence after final nor is such the case herein. As every file is considered on its own merits, the fact that similar evidence has been considered against similar claims has no bearing upon the effort expended in consideration herein, nor does it explain why the evidence was not earlier presented.

As a final observation, the proposed additional evidence submitted after final rejection does not appear to be solely directed to correcting the deficiencies noted by the examiner in the final rejection. In fact, it resubmits the previously considered Choi declaration verbatim and fails to explain why the examiner's consideration was improper nor point out how the additional information provided by the additional declarations corrects those deficiencies. Nor does the after final submission explain why the additional evidence is necessary and was not earlier presented. In summary, the examiner's refusal to enter and consider the evidence presented after final rejection as lacking a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented appears to have been proper and no convincing basis for altering that decision has been advanced by petitioner.

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running from the October 31, 2008 Office action as extended in the July 28, 2009 decision on petition for extension of time. Patent Owner's response is due September 11, 2009, absent further extension by grant of petition.

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 Jessica Harrison at (571) 272-4449, Mark Reinhart at (571) 272-1611, or Eric Keasel, at (571) 272-4929.

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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,146	08/03/2006	6373537	8733.059.60	7795

30827 7590 10/27/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2009

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)

LAGERMAN,BRUCE

Lagerman and Associates, PC

11921 Freedom Drive, Suite 550

Reston, VA 20190

MAILED

OCT 27 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,146*.

PATENT NO. *6373537*.

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
Alexandria, VA 22313-1450
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MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

MAILED

OCT 27 2009

CENTRAL REEXAMINATION UNIT

BRUCE K. LAGERMAN
LAGERMAN & ASSOCIATES PLLC
11921 FREEDOM DRIVE, SUITE 550
RESTON, VA 20190

(For Requester)

In re Yun et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,146
Filed: August 3, 2006
For: U.S. Patent No. 6,373,537

DECISION
GRANTING PETITION
UNDER 1.182

This is a decision on the October 1, 2009 patent owner petition entitled "RENEWED PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION."

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

The petition is **granted**.

BACKGROUND

- On August 3, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,146 ("the '146 proceeding").

- Prosecution progressed until, on November 3, 2008, a final Office action was mailed. The final Office action addressed arguments based upon secondary considerations of nonobviousness grounded in factual representations submitted to the Office in a declaration by Wonjun Choi on June 30, 2008.

- On February 3, 2009, patent owner filed a response, including declarations and exhibits, to the final Office action issued on November 3, 2008.

- On March 16, 2009, an advisory Office action was mailed by the Office, refusing entry of the declarations and exhibits submitted on February 3, 2009, and setting a time period for response to run 6 months from the date of the final Office action.

- On May 1, 2009, patent owner filed a notice of appeal and a response entitled "REQUEST FOR RECONSIDERATION," requesting entry and consideration of the declaration, exhibits, and entirety of the response filed February 3, 2009.

- On May 1, 2009, patent owner also filed a petition entitled "PETITION UNDER 37 CFR 1.181," requesting entry and consideration of the declarations, exhibits, and entirety of the response filed February 3, 2009.

- On May 1, 2009, the patent owner also filed a petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the declarations, exhibits, and entirety of the response filed February 3, 2009.

- On May 8, 2009, the Office mailed an advisory Office action refusing entry and consideration of the proposed response filed May 1, 2009.

- On May 18, 2009, the Office dismissed as premature patent owner's petition under 37 CFR § 1.182 filed April 30, 2009.

- On June 26, 2009, the Office granted an extension of time as requested by patent owner on June 24, 2009, extending the time for filing an appeal brief until August 1, 2009.

- On July 28, 2009, the Office granted an extension of time as requested by patent owner on July 21, 2009, extending the time for filing an appeal brief to run 45 days from the date of the decision.

- On September 11, 2009, the Office granted an extension of time as requested by patent owner on September 4, 2009, extending the time for filing an appeal brief until October 11, 2009.

- On September 15, 2009, the Office dismissed patent owner's petition under 37 CFR § 1.181 filed April 30, 2009.

- On October 1, 2009, patent owner filed the instant petition entitled "RENEWED PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the declarations, exhibits, and entirety of the response filed February 3, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

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

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

37 CFR 1.525(a) provides, in pertinent part:

> If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for ex parte reexamination of the patent for **resolution of the question**. (emphasis added)

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the 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

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

denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* 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."

There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 CFR 1.182 can provide relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the requirement of special dispatch. 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 *ex parte* reexamination setting, where 35 U.S.C. 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the case without the amendment or evidence), since these are key factors in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution. And, the grant or dismissal of a § 1.182 petition depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request.

The first issue, then, is whether applicant's submission, if entered, would advance the issues towards resolution of the questions of patentability at issue in the proceeding. Patent owner states that the issues would be advanced because patent owner has "four co-pending reexaminations in a family of closely related patents," and that final resolution of all of the reexaminations would be best served by entry of the instant submission, which has "substantially similar" issues to those in the other reexaminations. However, since each proceeding must stand upon its own merits, entry of arguments and amendments is not justified by a desire to coordinate submissions between separate reexamination proceedings. Patent owner has not, through this argument, shown that any issues in the '8146 proceeding would be advanced towards resolution through entry of the submission.

However, patent owner also argues that the evidentiary submission attempts to address deficiencies in an earlier evidentiary submission, which deficiencies were first made of record by the Office in the final Office action. On June 30, 2008, patent owner filed a response to a non-final Office action. The response alleged secondary considerations of nonobviousness, and an attempt to support the allegation was proffered by way of factual assertions made in a declaration by Wonjun Choi, submitted therewith. The Office considered the secondary considerations; however, in the final Office action of November 3, 2008, the secondary considerations were found unpersuasive due, in part, to an insufficient evidentiary showing. *See* the final Office

action of November 3, 2008, pages 27-28. The February 3, 2009 response to the final Office action included three declarations, including a more detailed declaration by Wonjun Choi. These declarations are directed to factual assertions pertaining to the same secondary considerations presented earlier; however, the content of the assertions attempts to address the deficiencies in the earlier Choi declaration that were made of record in the final Office action of November 3, 2008. Entry of the February 3, 2009 declarations, therefore, is found to further define the issues for appeal, or the issuance of a reexamination certificate.

For the above reasons, the petition is deemed to have shown that entry of the submission would advance the issues towards appeal or issuance of a reexamination certificate.

The second issue is whether the submission comports with the requirement of special dispatch, in that the need for such response could not have been anticipated earlier. Patent owner indicates that the need for such response could not have been presented earlier, because the arguments clarify previously submitted evidence in light of the final Office action. *See* the instant petition at 4. As discussed above, the evidentiary submissions have been submitted in an attempt to address the deficiencies in the earlier Choi declaration that were made of record in the final Office action of November 3, 2008. For this reason, patent owner's response is persuasive as to the reasons why the need for such evidentiary submissions could not have been anticipated earlier.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is 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 granted.

CONCLUSION

- The petition is **granted to the extent set forth herein**.
- The prosecution of the present '8146 *ex parte* 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 November 3, 2008 final Office action is hereby withdrawn, and prosecution of the proceeding is reopened.
- The February 3, 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

10-22-09
Kenpet7/RCR

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.
90/008,150	08/03/2006	6020942	8733.069.60	2241

30827 7590 11/24/2008

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/24/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRUCE K. LAGERMAN
LAGERMAN AND ASSOCIATES, PLLC
11921 FREEDOM DRIVE, SUITE 550
RESTON, VA 20190

Date:
MAILED
NOV 24 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008150
PATENT NO. : 6020942
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Yong S Choi
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

MAILED

NOV 24 2008

CENTRAL REEXAMINATION UNIT

BRUCE K LAGERMAN
11921 Freedom Drive
Suite 550
Reston, VA 20190

(For Third Party Requester)

DECISION DISMISSING PETITION UNDER 37 CFR § 1.59 (b) TO EXPUNGE INFORMATION

In re Hee Young Yun *et alia*
Ex parte Reexamination Proceeding
Control No. 90/008,150
Deposited on: 3 August 2006
For: US Patent No. 6,020,942

This is a decision on the 30 June 2008, Patent Owner requested petition titled "Petition Under 37 CFR § 1.59(b) to Expunge Papers Filed in Second Information Disclosure Statement Filed on June 30, 2008 By, Or on Behalf of Hee Young Yun, *et al.*".

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 30 June 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 No6,020,942 issued on 1 February 2000.

2. On 3 August 2006 a third party requester requested *ex parte* reexamination of US Patent No. 6,020,942 which is identified under control no. 90/008,150.

3. The Order was granted for reexamination on 15 September 2006.

4. A first Office action on the merits (non-final) was mailed on 2 April 2008 in proceeding 90/008,150.

5. Documents were filed Under Seal on 30 June 2008.

5. A petition filed under 37 CFR 1.59 (b) to expunge information was timely filed 30 June 2008 with authorization to charge the appropriate fee under 37 CFR § 1.17(g).

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 petitioner requests that the documents submitted under seal on 30 June 2008 are subject to court ordered protective order from the record. 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 "references, pleadings, reports and/or various documents [are] associated a related litigation matter... Each of the submitted documents are subject to a protective order and the information has not been otherwise made public." In addition, the patent owner states that "[t]he information will be retained by the Applicants for a period of any patent with regard to which the information is submitted." Further the petition fee pursuant to 37 CFR § 1.17(g) is authorized to be paid from a deposit account.

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 30 June 2008 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/

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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JUN 14 2010

CENTRAL REEXAMINATION UNIT

REENA KUYPER, ESQ. BYARD NILSSON, ESQ. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES CA 90069	:	(For Patent Owner)
John L. Welsh WELSH & FLAXMAN LLC 2000 DUKE STREET, SUITE 100 ALEXANDRIA, VA 22314	:	(For Third Party Requester)
In re: Ronald A. Katz *Ex Parte* Reexamination Proceeding Control No. 90/008,155 Deposited on: 07 August 2006 For: US Patent No. 5,828,734	:	DECISION DISMISSING PETITION

This is a decision on patent owner petition, filed on 18 March 2010, denominated "Petition to the Director Under 37 CFR § 1.181" requesting the Director review the actions of Examiner Kielin in (1) dismissing the Petitioner's Appeal, (2) canceling claim 80 (the only claim on appeal), and (3) mailing a Notice of Intent to Issue *Ex Parte* Reexamination Certificate.

The proceeding and petition is before the Director of the Central Reexamination Unit for decision.

The request for review and the petition under 37 CFR § 1.181 are **dismissed**, because the Office lacks jurisdiction over U.S. Patent 5,828,734, since reexamination proceeding control no. 90/008,155 has now been concluded by the issuance and publication of a reexamination certificate.

SUMMARY OF RELEVANT FACTS

- On 27 October 1998 US Patent No. 5,828,734 was granted to Ronald A. Katz.
- On 07 August 2006 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,155.
- On 06 November 2006 the Order was granted for *ex parte* reexamination in control number 90/008,155.
- On 30 June 2008 a first Office action on the merits was mailed.
- On 20 March 2009 a Final Office action was mailed.
- On 27 July 2009 a Notice of Appeal was submitted by the patent owner.
- On 28 September 2009 the patent owner's Appeal Brief was submitted.
- On 13 November 2009 a Notice of Non Compliant Appeal Brief was mailed identifying defects in the appeal brief.
- On 15 January 2010 a supplemental patent owner's Appeal Brief was submitted.
- On 22 January 2010 a Notice of Intent to Issue Reexamination Certificate was mailed with an explanation as to how the defects were not corrected and the termination of the proceeding pursuant to 37 CFR § 41.37(d) .
- On 18 March 2010 the instant petition was submitted.
- On 25 May 2010 the Certificate Issued for *ex parte* reexamination proceeding control number 90/008,155; US 5,828,734 C1.

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.

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. An examiner does not have jurisdiction to act on a reexamination proceeding after the reexamination certificate has issued. 37 CFR 1.181 provides that, in appropriate circumstances, a petition may be filed/granted to invoke the supervisory authority of

the director. However, relief under this provision is limited to ensuring compliance with appropriate policies. As the examiner now has no authority to act on this proceeding, this petition is dismissed.

In this case, the Notice of Intent to Issue the Reexamination Certificate was issued on 25 May 2010. The patent owner filed a petition on 18 March 2010. Although the petition requests that the Director review the actions of the Examiner and the Notice of Intent to Issue the Reexamination Certificate, as evidenced by the publication process, insufficient time remained to review the petition prior to issuance of the Certificate. As a result of issuance of the Certificate, 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 Petition to the Director Under 37 CFR § 1.181 submitted 18 March 2010 is **dismissed** for lack of jurisdiction.

2. The Ex *Parte* Reexamination proceeding control no. 90/008,155 has concluded, and the *Ex Parte* Reexamination Certificate U.S. 5,828,734 C1 has issued on 25 May 2010.

Gregory Morse
Director,
Central Reexamination Unit 3900

ADDITIONAL DISCUSSION

In this proceeding, there was a focused dispute over the meaning of two (facially) means-plus-function claim elements in Claim 81. ('second response unit means for…' and 'means for processing qualified…') The identification of the structure in the specification that corresponds to a means-plus-function element is an important requirement even in a reexamination where 35 USC 112 rejections are not imposed. See, for example, the decision of 5/26/2010 in 90/008,373, where identification of structure corresponding to means plus function elements is apparently required.

The rule requirements for an ex parte appeal brief indicate that patent owner must identify the claimed subject matter in the specification of the patent under reexamination. From 37 CFR 41.37 (emphasis added):

> (v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, **every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.**

A review of the "Notice of Non-Compliant Appeal Brief" of 13 November 2009 indicates that the examiner found insufficient identification of the two identified means-plus-function elements. The specific elements which were not sufficiently identified were highlighted on page 3 of that action.

A review of the corrected appeal brief of 15 December 2009 shows that the "second response unit means" is identified as a generic telephone handset and the "means for processing" is identified as a generic control unit. In addition, patent owner has not stated that these are the only or best identifications of these elements in the specification - both are qualified by "e.g.". Given the specificity with which the examiner has identified claim elements (and functions performed by those elements) that are not identified in the summary, and the exemplary and very generic nature of the structure identified in the appeal brief, the decision of the examiner to require specific support for the means-plus-function elements and functions appears to be appropriate.

Options open to petitioner at this point include filing a petition under 37 CFR 1.137(b) to accept an unavoidably or unintentionally delayed response (if such is the case) together with a compliant response. Petitioner may wish to include as part of that compliant response either (a) a specific identification of the structures highlighted in bold in the paper of 13 November 1999 and functions performed by those structures; (b) a clear statement that there is no better showing in the specification of the two means-plus-function elements and their associated functions than the telephone handset and black-box "control unit"; or (c) a petition to waive the requirements to identify means plus function elements in rule 41.37. This is not a suggestion that a waiver of rule 41.37 is likely to be granted; but rather an indication that a grantable petition to do so would make the brief of 15 December 2009 compliant.

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.
90/007,922	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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,156	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.

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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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

In.1

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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John M. McCormack (For Patent Owner)
KOLISCH HARTWELL, PC
200 Pacific Building
520 S.W. Yamill Street, Suite 200
Portland, OR 97204

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FEB 07 2007

CENTRAL REEXAMINATION UNIT

Jeffrey B. Haendler (For *Inter Partes* Requester)
One World Trade Center, STE 1600
121 S.W. Salmon Street
Portland, OR 97204

In re Ramage et al *Ex parte* Reexamination Proceeding Control No. 90/008,161 Filed: August 14, 2006 For: U.S. Patent No. 6,664,595	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
In re Ramage et al *Inter partes* Reexamination Proceeding Control No. 95/000,182 Filed: October 19, 2006 For: U.S. Patent No. 6,664,595	

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 FACTS

1. United States Patent Number 6,664,595 (the '595 patent), issued November 11, 2003, is the subject of both *inter partes* Reexamination Control Number 95/000,182 and *ex parte* Reexamination Control Number 90/008,161.

2. A request for *ex parte* reexamination of the '595 patent, assigned Reexamination Control No. 90/008,161 (the '161 proceeding), was filed August 14, 2006, by patent owner.

3. A request for *inter partes* reexamination of the '595 patent, assigned Reexamination Control No. 95/000,182 (the '182 proceeding), was filed October 19, 2006, by third party requester Jeffrey Haendler.

4. An order granting *ex parte* reexamination was mailed for the '161 proceeding on October 20, 2006.

5. An order granting *inter partes* reexamination was mailed for the '182 proceeding on January 10, 2007.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '161 *ex parte* reexamination expired on December 20, 2006. [1] Furthermore, on December 19, 2006, the patent owner filed a paper waiving the filing of any such statement, since the *ex parte* reexamination was filed by the patent owner.

DECISION

I. MERGER OF PROCEEDINGS

As reexamination has been ordered for both proceedings, and there is no longer an opportunity for filing a patent owner's statement and/or requester's reply, consideration of merger 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

[1] There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action on the merits is issued prior to any input from parties.

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 95/000,182 and 90/008,161 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that 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 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 <u>of the *ex parte* reexamination</u> are governed by 37 CFR 1.510 through 1.560. In this instance, the *ex parte* reexamination was filed by the patent owner; thus, there is no *ex parte* reexamination third party requester.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action that applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner and the third party requester will contain the identifying data for <u>both</u> 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 <u>both</u> 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

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 any 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) 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 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'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 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. 95/000,182 and *ex parte* Reexamination Control No. 90/008,161 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 Karen Hastings, Legal Advisor, at 571-272-7717, 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

January 31, 2007
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PAMELA S. MERKADEAU
MANATT PHELPS AND PHILLIPS
1001 PAGE MILL ROAD
BUILDING 2
PALO ALTO, CA 94304

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CENTRAL REEXAMINATION UNIT

In re Application of	:	
MENDEZ et al.	:	
Control No. 90/008,162 (U.S. Patent 6,708,221)	:	DECISION ON PETITION
Filed: August 11, 2006	:	TO WITHDRAW
Attorney Docket No. 25587-033-045RE2	:	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 27, 2007.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). While the reasons may be provided by referencing a specific portion of 37 CFR 10.40, the reasons must deal with actions by the client. The reasons set forth in the request, "Attorneys are no longer representing Applicant" are not appropriate since it is not clear that the client initiated the transfer, or that the client knowingly or freely assents to the transfer to new counsel.

Additionally the request cannot be approved because a review of the file indicates that the power of attorney of record in this application was not appointed by customer number. Accordingly, the request under 37 C.F.R. § 1.136(b) to withdraw attorneys/agents associated with customer number 36614 cannot be approved. A request for withdrawal as attorney or agent *by customer number* cannot be accepted unless the power of attorney of record in the application is to the same customer number.

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

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

Patricia Volpe for

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: **SCOTT MCKEOWN**
OBLON, SPIVAK, MCCLELLAND, MAIER
& NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314-3412

cc: **NOVAK DRUCE & QUIGG, LLP** (Third Party Requester)
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON, DC 20005

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on March 27, 2007. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA VA 22314	:	For Patent Owner
Viola T. Kung, Ph. D. HOWREY LLP 2941 Fairview Park Drive, Suite 200 Falls Church, VA 22042-2924	:	For Third Party Requester
NOVAK DRUCE & QUIGG, LLP 1300 Eye Street NW 400 East Tower Washington, DC 20005	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Mendez *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,131 Filed: July 27, 2006 For: US Patent No. 6,708,221	:	
In re: Mendez *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,162 Filed: August 11, 2006 For: US Patent No. 6,708,221	:	

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. 6,708,221 issued on March 16, 2004.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,131 was requested by a third party requester on July 27, 2006

3. The Reexamination Order was granted in proceeding, control no. 90/008,131 on October 18, 2006.

4. There are currently no amendments proceeding control number 90/008,131.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,162 was requested by a third party requester filed on August 11, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,162 on October 18, 2006.

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

8. Proceedings control numbers 90/008,131 and 90/008162 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 90/008,131 and 90/008,162 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. 90/008,131 and 90/008,162 are **MERGED**.

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

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

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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CENTRAL REEXAMINATION UNIT

SCOTT MCKEOWN
OBLON, SPIVAK, MCCLELLAN
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

(For Patent Owner)

VIOLA T. KUNG, PH.D.
HOWREY LLP
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

(For Third Party Requester)

NOVAK, DRUCE DeLUCA & QUIGG, LLP
1300 EYE STREET, N.W.
SUITE 400 EAST TOWER
WASHINGTON, DC 20005

(For Third Party Requester)

RESEARCH IN MOTION LIMITED
102 DECKER COURT
SUITE 180
IRVING, TX 75039

(Courtesy Copy)

In re Mendez *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,131
Filed: July 27, 2006
For: U.S. Patent No. 6,708,221

In re Mendez *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,162
Filed: August 11, 2006
For: U.S. Patent No. 6,708,221

DECISION DISMISSING AND EXPUNGING PETITION

This is a decision on the September 10, 2008 third party requester paper entitled "PETITION UNDER 37 CFR § 1.182 AND/OR 1.183."

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 is being expunged by being be marked "closed" and "non-public" in the IFW, and will not constitute part of the record of the present reexamination proceeding. [1]

REVIEW OF FACTS

1. U.S. Patent No. 6,708,221 ("the '221 patent") issued to Mendez *et al.* on March 16, 2004.

2. On July 27, 2006, a request for *ex parte* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 90/008,131 ("the '8131 proceeding").

3. On August 11, 2006, a request for *ex parte* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 90/008,162 ("the '8162 proceeding").

4. On October 18, 2006, an order granting *ex parte* reexamination in the '8131 proceeding was mailed, and an order granting *ex parte* reexamination in the '8162 proceeding was mailed.

5. On August 3, 2007, a "DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS" was mailed, merging the '8131 proceeding and the '8162 proceeding ("the merged proceeding").

6. On September 21, 2007, a first Office action on the merits was mailed in the merged proceeding.

7. The present merged proceeding has progressed until, on September 10, 2008, the third party requester filed the present petition paper entitled "PETITION UNDER 37 CFR § 1.182 AND/OR 1.183," which is the subject of this decision.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

---

[1] *See* MPEP 2267.

35 U.S.C. § 304 provides:

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

37 CFR 1.183 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).

DECISION

The September 10, 2008 third party requester petition paper is filed under 37 CFR 1.182 and/or 1.183; however, the rules cannot be waived/suspended to provide the third party requester the right to file a paper at the present stage in the merged proceeding. Waiver/suspension of the rules to permit the third party requester submission via the petition is not 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 Federal Circuit stated (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].

Pursuant to 35 U.S.C. § 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends either: (1) upon expiration of the patent owner's time for filing a statement in response to the order for reexamination, or (2) if the patent owner files such a statement, upon expiration of the third party requester's time for filing a reply to the patent owner's statement (i.e., within two months from the date of service of the patent owner's statement).

On its face, the third party requester's September 10, 2008 petition paper was filed after the statutory statement and reply periods ended in the '8131 and '8162 proceedings. The statutory statement and reply period ended in the '8131 proceeding when the patent owner did not file a statement in response to the October 18, 2006 order granting reexamination within the two-month response period set forth in the order for filing such a statement. Similarly, the statutory statement and reply period ended in the '8162 proceeding when the patent owner did not file a statement in response to the October 18, 2006 order granting reexamination within the two-month response period set forth in the order for filing such a statement. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's September 10, 2008 petition paper, and the petition is dismissed.

It is noted that the correspondence address of the third party requester in the merged proceeding is unclear. A copy of this decision is being sent to the two addresses of record for the third party requester, and a courtesy copy of this decision is being sent to Research in Motion Ltd. of Irving, TX. In the future, however, the Office will assume that the third party requester intends to keep using both of the correspondence addresses of record for the third party requester in the '8131 and '8162 proceedings, unless the third party requester provides the Office with a single correspondence address of record for the third party requester for the merged proceeding.

CONCLUSION

1. The petition is dismissed.

2. The petition paper filed by the third party requester on September 10, 2008 is being expunged as not having an entry right. This will be carried out by closing the petition paper (document) in the IFW of the '8131 and '8162 proceedings and marking the paper "closed" and "non-public."

3. No copy of the petition papers will be maintained of record in the IFW for the '8131 and '8162 proceedings, or elsewhere in the Office.

4. A copy of this decision will be made of record in the reexamination files.

5. Telephone inquiries related to this decision should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

October 2, 2008
C:\kiva\kimpropa\3PR\8062 improper 1.183 pet for 3PR participation-dismiss.doc

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.
90/008,162	08/11/2006	6708221	306549USRX	9919

22850 7590 10/07/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/07/2008

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:

NOVAK DRUCE & QUIGG LLP
1300 EYE STREET N.W.
SUITE 1000 WEST TOWER
WASHINGTON, DC 20005

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008162
PATENT NO. : 6708221
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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OCT 07 2008

CENTRAL REEXAMINATION UNIT

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. (For Patent Owner)
1940 DUKE STREET
ALEXANDRIA, VA 22314

HOWREY LLP-CA (For Requester)
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

NOVAK DRUCE + QUIGG LLP (For Requester)
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON, DC 20005

In re Mendez *et alia* Reexamination Proceeding Control No. 90/008,131 For: U.S. Patent No. 6,708,221	DECISION DISMSSING PETITION UNDER 37 CFR 1.181
In re Mendez *et alia* Reexamination Proceeding Control No. 90/008,162 For: U.S. Patent No. 6,708,221	

This is a decision on the June 12, 2008 "PETITION UNDER 37 C.F.R. §1.181(a)(3)" requesting that the papers filed June 9, 2008 be returned/destroyed. No fee is required.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,708,221 (hereinafter, the '221 patent), issued to Mendez et al., on March 16, 2004.

2. On July 27, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '221 patent. The reexamination proceeding was assigned Control No. 90/008,131 (hereinafter, the '8131 proceeding).

3. On August 11, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '221 patent. The reexamination proceeding was assigned Control No. 90/008,162 (hereinafter, the '8162 proceeding).

4. The reexamination order was granted in the '8131 proceeding on October 18, 2006.

5. The reexamination order was granted in the '8162 proceeding on October 18, 2006.

6. The '8131 and '8162 proceedings were merged on August 3, 2007.

7. Later in prosecution, on April 25, 2008, the third party requester of the '8162 proceeding filed Litigation Papers that went beyond bare notice and contained further arguments or information. The papers of April 25, 2008 were closed from the file as noted in the paper mailed May 10, 2008.

8. On June 9, 2008, the third party requester of the '8162 proceeding filed a NOTICE OF CONCURRENT PROCEEDINGS.

9. On June 12, 2008, Patent Owner filed the present petition.

DECISION

Patent Owner argues that, in the third-party (of the '8162 proceeding) submission entitled "NOTICE OF CONCURRENT PROCEEDINGS" filed on June 9, 2008, the third party "has provided physical highlighting (bracketing of passages) of a [Patent Owner] reexamination response (identified as exhibit F...)".

While the paper of June 9, 2008 does contain bracketing in the margins of exhibit F (as well as other exhibits), it is unclear when the bracketing was made and for what purpose. These marking may have been made prior to their submission to the Court on May 30, 2008 and the bracketed passages were bracketed in the Court papers themselves. The petition is silent as to whether or not the submission of June 9, 2008 is merely a presentation of the Court papers in the form that they were presented to the Court.

Other papers submitted in this and related proceedings have similar bracketing of passages in Court papers. It appears that bracketing may be a convention that is used in these Court papers.

Therefore, with no clear indication that a third party added the bracketing to the Court papers of May 30, 2008 in the submission to the USPTO of June 9, 2008, the relief requested can not be granted.

Any request for reconsideration should be directed to the Central Reexamination Unit.

CONCLUSION

1. The petition to return/destroy the third party submission of June 9, 2008 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, or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

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AUG 22 2008

CENTRAL REEXAMINATION UNIT

MARK A LAUER 6601 KOLL CENTER PARKWAY SUITE 245 PLEASANTON CA 94566	:	(For Patent Owner)
ORRICK, HERRINGTON & SUTCLIFFE, LLP IP PROSECUTION DEPARTMENT 4 PARK PLAZA SUITE 1600 IRVINE, CA 92614-2558	:	(For Third Party Requester)
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP) 1000 LOUISIANA STREET FIFTY-THIRD FLOOR HOUSTON, TX 77002	:	(For Third Party Requester)
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS 37 C.F.R. § 1.565(c)
In re: Freeman *Ex Parte* Reexamination Proceeding Control No. 90/008,163 Deposited: 14 August 2006 For: US Patent No. 4,670,749	:	
In re: Freeman *Ex Parte* Reexamination Proceeding Control No. 90/010,118 Deposited: 7 March 2008 For: US Patent No. 4,670,749	:	

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. 4,670,749 issued on 2 June 1987.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,163 was requested by a third party requester on 14 August 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,163 on 10 October 2006.

4. There are currently no amendments proceeding control number 90/008,131.

5. *Ex Parte* Reexamination Proceeding, control no. 90/010,118 was requested by a third party requester filed on 7 March 2008.

6. The Reexamination Order was granted in proceeding, control no. 90/010,118 on 14 April 1008.

7. There are currently no amendments proceeding control number 90/010,118.

8. Proceedings control numbers 90/008,163 and 90/010,118 await action 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 90/008,163 and 90/010,118 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. 90/008,163 and 90/010,118 are hereby **MERGED**.

2. The reexamination files are being forwarded to the examiner for further 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
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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

3. 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, Art Unit 3992.

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

Gregory Morse,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Akin Gump Strauss Hauer & Feld L.L.P. One Commerce Square 2005 Market Street, Suite 2200 Philadelphia, PA 19103	:	For Patent Owner
Volpe and Koeing P.C. 30 South 17th Street United Plaza, Suite 1600 Philadelphia, PA 19103	:	For Requester
In re Houriet et al. *Ex Parte* Reexamination Proceeding Control No. 90/008,165 Filed: September 19, 2006 For: US Patent No. 5,575,717	:	DECISION DENYING PETITION UNDER 37 CFR 1.515(c)

This is a decision on the November 30, 2006, "Petition to the Director Under 37 CFR 1.515." Petitioner, the Third Party Requester, requests that the decision denying the request for reexamination of US Patent 5,575,717 be reversed.

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 August 15, 2006, a third party REQUEST FOR *EX PARTE* REEXAMINATION of U.S. Patent No.5,575,717 was filed, and eventually given a filing date of September 19, 2006 after all requirements were met. Reexamination was requested based on a variety of combination of references. Reference is made to the Request for details thereof.

2. On October 31, 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. Reference is made to the Order for details thereof.

3. On November 30, 2006, the present petition was filed.

Decision

A petition filed under 37 CFR 1.515(c), requesting that the examiner's decision denying the request for reexamination be reversed, is decided by the Central Reexamination Unit (CRU) Director. The Manual of Patent Examining Procedure 2248 further states that the CRU's Director's review will be *de novo.*

The alleged substantial new question of patentability presented by requester is based upon a variety of references, all in combination with either US Patent 5,604,860 to McLaughlin et al., or the Apple Macintosh User Manual, which are alleged to teach menu programming solutions.

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable.

In order to rely on a reference as a basis for rejection of an invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

With respect to McLaughlin et al., the petition asserts that this 'reference is directly within the field of endeavor' of the instant patent. This is incorrect, as requester's definition of 'field of endeavor' is simply too broad. The patent in question is directed to video games, whereas McLaughlin et al. is directed to document systems. Likewise the Macintosh Manual cannot be considered to be within the patent's field of endeavor as it is directed to personal computers. A reasonable examiner would consider neither McLaughlin et al. nor the Macintosh Manual to be within patentee's field of endeavor.

As to whether either McLaughlin et al. or the Macintosh Manual are reasonably pertinent to the particular problem with which the inventor was concerned, requester argues that "the problem allegedly solved is thus creating menus of selectable choices on a system" and that both McLaughlin et al. and the Macintosh Manual are reasonably pertinent to this problem, as both create such menus. This mischaracterizes the problem being solved. As described in the instant patent, prior art devices allowed game operators to change games available for play only by physically accessing a bank of cartridges. The problem is thus providing an easy way for an operator to change available games on a video game, and the use of a programmable menu is the *solution* to the problem.

In contrast, McLaughlin et al. is concerned with reducing the complexity of document system control panels, and the Macintosh Manual is concerned with providing a general purpose personal computer. Manifestly, neither McLaughlin et al. nor the Macintosh Manual would logically have commended themselves to an inventor's attention in considering the problem of easily changing available video games. A reasonable examiner would consider neither McLaughlin et al. nor the Macintosh Manual to be reasonably pertinent to the particular problem with which the instant patent is concerned.

Consequently, a reasonable examiner would consider neither McLaughlin et al. nor the Macintosh Manual to be analogous art.

Further, even if either reference were deemed analogous art, there would still be no motivation to combine either reference with any of the video game references of record. Requester states that "since McLaughlin et al. and the Macintosh Manual references disclose operator interfaces, one of ordinary skill in the art would readily combine the teachings of those references with the game references cited in the Request." However, this is a non-sequitur and a wholly conclusory statement. Under this proposed logic, it would be obvious to combine any operator interface with any video game; such is not the case. Requester goes on to argue that an implicit motivation exists because the references are directed to the same problem as the patent, but as noted above, all three documents are directed to entirely different problems. Requester's proposed combinations are based on impermissible hindsight. A reasonable examiner would not have found it obvious to combine either McLaughlin or the Macintosh Manual with the video game references of record.

Consequently, a reasonable examiner would not consider either McLaughlin et al. or the Macintosh Manual important in deciding whether or not the claims are patentable. As the Request and instant petition are predicated upon these references, no substantial new question of patentability has been presented by requester.

Conclusion

No substantial new question of patentability affecting at least one claim of U.S. patent 5,575,717 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.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

glm

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,170	08/18/2006	6501234	4421.75754	9831

41066 7590 04/16/2008

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Patrick G. Burns

Greer Burns & Crain Ltd.

300 South Wacker Drive Suite 2500

Chicago IL 60606

CLOSE PRINT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008170

PATENT NO. 6,501,234

ART UNI 3999

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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MURABITO, HAO & BARNES, LLP (For Patent Owner)
Two North Market Street
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San Jose, CA 95113

Patrick G. Burns (For *ex parte* Requester)
Greer, Burns & Crain Ltd.
300 South Wacker Drive
Suite 2500
Chicago, IL 60606

Finnegan, Henderson, et al., LLP (For *inter partes* Requester)
901 New York Avenue, NW
Washington, DC 20001-4413

In re Lin et al., *Ex parte* Reexamination Proceeding Control No. 90/008,170 Filed: August 18, 2006 For: U.S. Patent No. 6,501,234	:	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
In re Lin et al., *Inter partes* Reexamination Proceeding Control No. 95/000,283 Filed: August 7, 2007 For: U.S. Patent No. 6,501,234	:	

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 FACTS

1. On December 31, 2002, United States Patent Number 6,501,234 (the '234 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '234 patent, assigned Reexamination Control No. 90/008,170 (the '8170 proceeding), was filed by Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination of claims 1-56 of the '234 patent in the '8170 proceeding.

4. On August 7, 2007, a request for *inter partes* reexamination of the '234 patent, assigned Reexamination Control No. 95/000,283 (the '283 proceeding), was filed by Lionel Lavenue on behalf of Rohm Co., Ltd.

5. On October 26, 2007, the Office issued an order granting *inter partes* reexamination of claims 1-56 of the '234 patent in the '283 proceeding, without an accompanying action on the merits.

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 '283 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 95/000,283 and 90/008,170 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that 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*. As 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 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.

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

By hand to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Patent owner and requester(s) 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), and every paper filed must reflect that such paper was served on the other parties, 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 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) 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 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'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. 95/000,283 and *ex parte* Reexamination Control No. 90/008,170 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 Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759, or, in his absence, to the undersigned, at 571-272-7710.

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

April 16, 2008
C:\KIVA\KENPET3\817095'283_EP-IP-Merge_0182_cls-same.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,170	08/18/2006	6501234	4421.75754	9831

41066 7590 09/17/2008

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/17/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Patrick G. Burns
Greer Burns & Crain Ltd.
300 South Wacker Drive Suite 2500
Chicago IL 60606

Date:

MAILED

SEP 17 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008170
PATENT NO. : 6501234
ART UNIT : 3900

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

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

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CENTRAL REEXAMINATION UNIT

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In re Lin et al.,	:	
Ex parte Reexamination Proceeding	:	
Control No. 90/008,170	:	
Filed: August 18, 2006	:	
For: U.S. Patent No. 6,501,234	:	**DECISION**
	:	**DISMISSING**
In re Lin et al.,	:	**PETITION TO SEVER**
Inter partes Reexamination Proceeding	:	**PROCEEDINGS AND**
Control No. 95/000,283	:	**GRANTING PARTIAL**
Filed: August 7, 2007	:	**WAIVER OF 37 CFR 1.955**
For: U.S. Patent No. 6,501,234	:	

This is a decision on the August 16, 2008 patent owner petition titled "PETITION UNDER 37 C.F.R. § 1.183 SEEKING DE-MERGER OF REEXAMINATION CONTROL NOS. 90/008,170 AND 95/000,283 AND SUSPENSION OF REEXAMINATION CONTROL NO. 95/000,283"(the "Petition"). As the rules do not provide for a petition for severance (de-merger) of merged reexamination proceedings and suspension of a reexamination proceeding, the petition paper is being treated as a petition under 37 CFR 1.182.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to petitioner's credit card on August 18, 2008.

The petition and merged reexamination proceeding for 95/000,283 and 90/008,170 are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition for severance and suspension is dismissed as premature.

Patent owner's petition is, however, granted to the extent that the rules of practice (37 CFR 1.955) are waived to afford patent owner a **single opportunity** to hold an interview with the examiner in this proceeding if, and only if, patent owner proceeds as provided in Section V below.

BACKGROUND

1. On December 31, 2002, United States Patent Number 6,501,234 (the '234 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '234 patent, assigned Reexamination Control No. 90/008,170 (the '8170 proceeding), was filed by Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination in the '8170 proceeding.

4. On August 7, 2007, a request for *inter partes* reexamination of the '234 patent, assigned Reexamination Control No. 95/000,283 (the '283 proceeding), was filed by Lionel Lavenue on behalf of Rohm Co., Ltd.

5. Patent owner and third party requester in the '283 proceeding are adversarial parties in concurrent litigation regarding the '234 patent in the United States District Court for the Eastern District of Texas (concurrent litigation).[1]

6. On October 26, 2007, the Office issued an order granting *inter partes* reexamination in the '283 proceeding, without an accompanying action on the merits.

7. On April 16, 2008, the Office issued a decision *sua sponte* merging the '8170 *ex parte* proceeding and the '283 *inter partes* proceeding (the merged proceeding).

8. On April 23, 2008, the third party requester submitted a Notice of Concurrent Proceedings under 37 CFR 1.985(b). In paragraph 2 of the submission, the requester states that it "will no longer actively participate in the proceeding in any way" and waives its right to file any comment otherwise allowed under 35 U.S.C. § 314(b)(2) and/or 37 C.F.R. § 1.947." The notification included a court document from the concurrent litigation entitled "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008.

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[1] *O2 Micro Int'l, Ltd. v. Rohm Co. Ltd.*, Case No. 2:05-CV-0211 (E.D. Tex. 2005).

9. On June 24, 2008, the Office issued a non-final Office action on the merits in the merged proceeding.

10. On August 16, 2008, patent owner filed a petition under 37 CFR 1.183 requesting de-merger of the merged proceeding and suspension of the '283 proceeding.

PRELIMINARY MATTER: PATENT OWNER'S ADDRESS

37 CFR 1.33(c) states:

> (c) All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address.** Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

The patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the '283 proceeding and (3) the '8170 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. Additionally, the petition that is addressed by this decision is from a third counsel alleging that they are now counsel for patent owner in the '283 proceeding. **The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c)**, and it is that of Grossman, Tucker, Perreault & Pfleger, PLLC, 55 South Commercial Street, Manchester NH 03101. [2]

Clarification is required, so that all future correspondence can be directed to a single address for the patent owner. Accordingly, the patent owner is required to, within ONE (1) MONTH of this decision:

(a) Designate the correspondence address and attorneys of record in both proceedings, to provide one address and party for the merged proceeding, which is the same as that in the patent file, and

(b) If there is a newly designated attorney, supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings).

Patent owner is reminded to serve both reexamination requesters with copies of all papers filed in these proceedings, including said correspondence address communications.

As a courtesy, this decision is being mailed to all addresses. Pending clarification, the address of Grossman, Tucker, Perreault & Pfleger, PLLC, 55 South Commercial Street, Manchester NH 03101, will be used **in all future correspondence**.

---

[2] On September 18, 2007 a revocation of power of attorney and new power of attorney and change of address was submitted in the '283 proceeding, however no such transaction has ever occurred in the '234 patent.

RELEVANT STATUTES, REGULATIONS AND GUIDANCE

35 U.S.C. 314(c) states:

> SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(b) states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.907(b) states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

MPEP 2686.04 II B provides (Emphasis added):

> The Third Party Requester <u>Was a Party</u> to the Litigation.
>
> <u>Final Holding of validity</u>: The provisions of 37 CFR 1.907(b) apply. Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, that party and its privies may **not** request *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office, i.e., the proceeding will be concluded.
>
> ...
>
> In view of the above, when the examiner is aware that the third party requester was a party to previous Federal Court litigation as to the patent for which *inter partes* reexamination has been requested, the examiner must determine:

(1) Was the Federal Court's decision adverse to the third party requester as to at least one claim of the patent?

(2) Was the Federal Court's decision a final decision, after all appeals?

(3) Is the issue being raised in the reexamination request the same issue as was raised in the Federal Court during the civil action, or an issue that the third party requester could have raised in the Federal Court during the civil action?

- If the answer to each of questions (1)-(3) is "yes" for all claims for which reexamination was requested in the proceeding, then the *inter partes* reexamination prosecution must be terminated. In such a case, the Central Reexamination Unit (CRU) Director will prepare a decision discussing the above considerations (1)-(3) and vacate the reexamination proceeding at that time.

- If the answer to all of questions (1)-(3) is "yes" for one or more (but not all) of the claims for which reexamination was requested in the proceeding; those claims will not be treated. The examiner's action will point out the claims not treated and the reason why, i.e., a discussion of the above considerations (1)-(3). The guidelines set forth above in subsection II.(A) will be used for the claims remaining.

- If the answer to question (1) or to question (3) is "no" for all claims for which reexamination was requested, then the examination of the reexamination proceeding will proceed without any discussion on the record of considerations (1)-(3), using the guidelines set forth above in subsection II.(A).

- If, for any claim for which reexamination was requested, the answer to both of questions (1) and (3) is "yes", but the answer to question (2) is "no", then examination of the reexamination proceeding will proceed using the guidelines set forth above in subsection II.(A). The examiner's action will contain a discussion of considerations (1)-(3). If the examiner subsequently becomes aware that the Federal Court decision has become final, reexamination of the affected claims must be discontinued. If all claims being examined are affected, the reexamination will be vacated by the CRU Director as discussed above. See also subsection V. below.

Final Holding of invalidity: A final holding of claim invalidity or unenforceability (after all appeals) is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. See Ethicon v. Quigg, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). **Where all claims for which reexamination was requested are affected, the reexamination will be vacated by the CRU Director.** A non-final holding of claim invalidity or unenforceability, however, will not be controlling on the question of whether a substantial new question of patentability is present.

DECISION

I. Patent Owner's Position

Patent owner's petition filed August 16, 2008, requests that the merged reexamination proceeding should be severed ("de-merged"), that the '283 *inter partes* reexamination proceeding should be suspended while the '8170 *ex parte* proceeding continues, and that at the conclusion of the *ex parte* prosecution the *inter partes* proceeding be harmonized with the results of the '8170 *ex parte* reexamination proceeding by means of a housekeeping

amendment. The basis for patent owner's position is that - because the third party requester in the '283 *inter partes* reexamination proceeding has agreed to no longer exercise its right to file comments in the '283 proceeding, in light of a Consent Judgment/settlement agreement in concurrent litigation between the parties on the same patent, the presence of the procedural rules of *inter partes* reexamination will actually thwart special dispatch.

II. Analysis and Findings

Initially, it is to be noted that, regardless of any merit to patent owner's position, the statutory issue of the attachment of estoppel must first be addressed before any determination can be made on the merits of patent owner's petition (whether the petition is taken under 37 CFR 1.182 or 37 CFR 1.183). Patent owner's petition is silent regarding the estoppel provisions of 35 U.S.C. § 317(b) which attach to an *inter partes* reexamination proceeding when a final decision has been entered. Yet, if the estoppel provisions of 35 U.S.C. § 317(b) have attached to all claims of the '283 *inter partes* reexamination proceeding, the '283 *inter partes* reexamination would be terminated. If so, the relief requested by patent owner would then follow in due course, and there would be no need for resort to 37 CFR 1.182 and 37 CFR 1.183.

A review of the record reveals that neither party has disclosed and/or submitted court records to establish which claims of the '234 patent were being asserted in the concurrent litigation. The initial request only lists the litigation proceedings and includes a court memorandum opinion and order that appears to be the result of a Markman claim construction hearing from a companion case in the District Court. [3] The memorandum does not state which claims from the '234 patent were being asserted or being challenged with the defense of invalidity. The third party requester's submission of court papers in the "Notice of Concurrent Proceedings under 37 CFR 1.985(b)," filed on April 23, 2008, is silent regarding both as to which claims from the '234 patent were being asserted or being challenged with the defense of invalidity, as well as to the finality of the court's decision.

The '234 patent issued with 56 claims, of which claims 1, 27, and 31, are independent. The request for reexamination filed on behalf of Rohm Co. Ltd., (as the real party in interest) established a substantial new question of patentability with respect to all the claims of the '234 patent.

Based on the above, it cannot be determined if the claims in suit are or are not ***identical*** to the claims under reexamination in the '283 proceeding, because such has not been made of record in the '283 *inter partes* reexamination proceeding, but all the patent claims, i.e., claims 1-56, are subject to reexamination in the '283 proceeding. Furthermore, it cannot be determined from the record if the concurrent litigation resulted in a final decision.

35 U.S.C. § 317(b) attaches the estoppel on a claim-by-claim basis. Thus, if the present *inter partes* reexamination of claims 1-56 contained evidence of a final decision, the *inter* partes reexamination proceeding could not continue as to any claims subject to the "final decision."

Therefore, if evidence on the record shows that a final decision was rendered on all the claims subject to *inter partes* reexamination that the third party requester "has not sustained its burden of proving the invalidity of any patent claim in suit" then the statute would

[3] Memorandum Opinion and Order, *O2 Micro Int'l, Ltd. v. Samsung Elecs. Co. Ltd.*, Case No. 2:04-CV-323, (E.D. Tex. 2004)

require the Office to terminate the '283 *inter partes* proceeding. As a result of such a termination, the '8170 *ex parte* proceeding would be severed (from the terminated *inter partes* proceeding) to continue prosecution, thus obviating the need for the three step relief requested by petitioner. In such a circumstance the Office would not have to grant petitioner relief not specifically provided for in the rules, but instead would grant petitioner, in effect, relief as provided for under the rules, *i.e.* termination which will result in severance. See 35 U.S.C. 317(b) and 37 CFR 1.907(b).

However, it has not been established that the consent judgment entered in the civil proceeding constitutes "a final decision ... against a party in a civil action ... that the party has not sustained its burden of proving the invalidity" of the claims in suit. Accordingly, the petition to sever and suspend the '283 proceeding is dismissed as premature.

III. Guidance for Petition to Terminate

In order to resolve the need for relief in this instance, patent owner is called upon to present the following, with supporting documentation from the concurrent litigation, to complete the petition, and resolve the issue under 35 U.S.C. 317(b) and 37 CFR 907(b) as to termination of the '283 *inter partes* reexamination proceeding:

1) An explanation, with supporting court documentation, as to whether or not the action taken in the concurrent litigation, i.e. the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008, is a "Final Decision" within the statutory meaning of 35 U.S.C. 317(b).

2) If the action taken in the concurrent litigation is a "Final Decision," then identify, with supporting documentation from the record of the litigation, which claims from the '234 patent were subject to adjudication in the concurrent litigation.

3) For all claims identified as being subject to adjudication by the court in the concurrent litigation disclose, with supporting court documentation, how they were challenged and treated in resolution or affirmance of the challenge in regard to their patentability.

Patent owner's showing must establish, based on specifically pointed out part(s) of the record of the litigation, whether the estoppel provisions of 35 U.S.C. 317(b) should apply to all the claims of the patent and/or issues for which patent owner requests the Office to no longer maintain. Specifically, the showing must be adequate to establish whether the third party requester had the burden of proving invalidity of the various claims and that it "has not sustained its burden of proving the invalidity of any patent claim in suit."

IV. Interim Prosecution of the merged proceeding

Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding, except that, in light of requester's express waiver of its right to

file comments, the proceeding will be forwarded to the examiner for action immediately upon entry of patent owner responses, or the expiration of time for same.[4]

If an Action Closing Prosecution (ACP) is generated for the merged proceeding and the *inter partes* reexamination proceeding is subsequently terminated and/or severed, that will result in the treating of such ACP as a final Office action in the remaining *ex parte* proceeding, governed by the rules of *ex parte* reexamination.

V. Interview

37 CFR 1.955 states:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent owner has also requested an interview in the merged proceeding. Patent owner's rationale requesting a waiver of the rule precluding interviews in an *inter partes* reexamination is that, in light of assertions on the record by third party requester, from the '283 *inter partes* reexamination proceeding, the third party would not be prejudiced and conduct of the interview will facilitate the statutory mandate of "special dispatch."

There is substantial evidence on the record that the third party requester from the '283 *inter partes* reexamination proceeding will not participate, nor be prejudiced by the conduct of an interview, as evidenced by the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008. Accordingly, **a single interview** will be permitted. This waiver of the rules is solely to conduct a single interview. There is no further waiver of the rules at this time. Any requests for further interviews can be considered in the future, after the matters discussed above in this decision are resolved.

Patent owner is give fifteen (15) days with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

CONCLUSION

1. The patent owner petition to sever the '283 and '8170 proceedings and suspend the '283 proceeding is dismissed.

2. Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding.

3. The patent owner may file a petition to terminate or limit the '283 proceeding in accordance with the guidance provided above in Section III.

---

[4] If third party requester objects to this procedure, and wishes to preserve its right to comment, then requester is called upon to immediately inform the Office of that decision and explain the circumstances for withdrawing an assertion made in the record of this proceeding. Note further, that the language of the third party's submission does not make it entirely clear whether they intend to prospectively waive any participation in the appeal process.

4. Patent owner's petition is granted in part such that 37 CFR 1.955 is waived to the extent that Patent owner is being afforded a **single opportunity** to hold an interview with the examiner in this proceeding if, and only if, patent owner proceeds as provided above in Section V. Patent owner is given **fifteen (15) days** from the mail date of this decision with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

5. Jurisdiction of the merged proceeding is returned to the Central Reexamination unit (CRU) for examination consistent with this decision.

6. Telephone inquires related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in their absence, to the undersigned at (571) 272-7710.

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

09-15-08
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C:\kiva\kenpet7\IP\95_283_EP '8170 no sever and suspend.doc

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(For Patent Owner)

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(For 3rd Party Requester)

Reexam Control No.: 90/008,173
Filed : August 16, 2006
For U.S. Patent No. : 6,134,461

Reexam Control No.: 90/008,928
Filed : November 16, 2007
For U.S. Patent No. : 6,134,461

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. 90/008,173 was ordered in a decision mailed October 25, 2006 indicating that claims 1-4 would be reexamined. Prosecution has progressed to the point where an amendment was filed August 22, 2007, amending claim 1 and adding claims 30-188. A number of Information Disclosure Statements have been filed but no Office action has been issued that is responsive to the August 22, 2007 amendment.

Reexamination in application control No. 90/008,928 was ordered in a decision mailed January 16, 2008 indicating that claims 1-4 would be reexamined. Patent Owner filed a "Waiver of Patent Owner's Statement under 37 CFR §1.530" on February 25, 2008. A number of Information Disclosure Statements have been filed since the filing of the waiver but no Office action has been prepared.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines.

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

As noted above, claims have been amended and added in n the '8,173 reexamination proceedings by virtue of the amendment filed August 22, 2007. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in both files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files**. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-4 and new claims 30-188 are the claims that are currently subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Dual Correspondence

Currently, patent owner appears to be represented by two different representatives. In reexamination proceeding control No. 90/008,173, patent owner is represented by the Baker Botts LLP law firm per the "Submission of Revocation of Power of Attorney with New Power of Attorney" paper filed June 29, 2007. In reexamination control No. 90/008,928, patent owner is represented by the law firm of Merchant & Gould PC. Under 37 CFR 1.33(a), the Office will not engage in double correspondence with more than one registered attorney or agent except as deemed necessary by the Director. Accordingly, the patent owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision.

Conclusion

Reexamination Control Nos. 90/008,173 and 90/008,928 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in both files and to name but a single representative**. Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,175	08/18/2006	6707264	4421.75753	9460

32047 7590 03/21/2008

GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC
55 SOUTH COMMERICAL STREET
MANCHESTER, NH 03101

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,274	07/11/2007	6707264	10598.0004-00	7040

41066 7590 03/21/2008

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER

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Murabito, Hao & Barnes, LLP
Two North Market Street
Third Floor
San Jose, CA 95113

(For Patent Owner)

MAILED

MAR 21 2008

CENTRAL REEXAMINATION UNIT

Patrick G. Burns
Greer Burns & Crain, Ltd.
300 South Wacker Drive, Suite 2500
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(For *Ex Parte* Requester)

Lionel M. Lavenue
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(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding Control No. 90/008,175 Filed: August 18, 2006 For: U.S. Patent No. 6,707,264	:	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
Inter Partes Reexamination Proceeding Control No. 95/000,274 Filed: July 11, 2007 For: U.S. Patent No. 6,707,264	:	

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 FACTS

1. U.S. Patent No. 6,707,264 (the '264 patent) issued to Yung-Lin Lin *et al.* on March 16, 2004, and was assigned to O2Micro International Limited.

2. A request for *ex parte* reexamination of claims 1-22 of the '264 patent was filed on August 18, 2006, by third party requester Patrick G. Burns, and the request was assigned control number 90/008,175 (the '8175 *ex parte* reexamination proceeding).

3. On October 26, 2006, *ex parte* reexamination was ordered for claims 1-22 of the '264 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability as to those claims.

4. A request for *inter partes* reexamination of claims 1-22 of the '264 patent was filed on July 11, 2007, by third party requester Rohm Co., Ltd., who is also the real party in interest. The request was assigned control number 95/000,274 (the '0274 *inter partes* reexamination proceeding).

5. On August 8, 2007, *inter partes* reexamination was ordered for claims 1-22 of the '264 patent, based on the examiner's determination that the request for *inter partes* reexamination raised a substantial new question of patentability as to those claims.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '8175 *ex parte* reexamination expired after December 26, 2006.[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 '0274 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (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.

[1] There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action is issued prior to any input from parties.

In accordance with 37 CFR 1.989(a), the 90/008,175 and 95/000,274 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that 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 in this instance.

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.

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 requesters, will contain the identifying data for both files and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) <u>must</u> 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 requesters 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

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Patent owner and requesters 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), and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided 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), 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* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,274 and *ex parte* Reexamination Control No. 90/008,175 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 Nicole D. Dretar, Legal Advisor, at 571-272-7717.

Kenneth M. Schor

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

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OCT 06 2008

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In re Lin et al.,	:	
Ex parte Reexamination Proceeding	:	
Control No. 90/008,175	:	
Filed: August 18, 2006	:	
For: U.S. Patent No. 6,707,264	:	**DECISION**
	:	**DISMISSING**
In re Lin et al.,	:	**PETITION TO SEVER**
Inter partes Reexamination Proceeding	:	**PROCEEDINGS AND**
Control No. 95/000,274	:	**GRANTING PARTIAL**
Filed: July 11, 2007	:	**WAIVER OF 37 CFR 1.955**
For: U.S. Patent No. 6,707,264	:	

This is a decision on the August 16, 2008 patent owner petition titled "PETITION UNDER 37 C.F.R. § 1.183 SEEKING DE-MERGER OF REEXAMINATION CONTROL NOS. 90/008,175 AND 95/000,274 AND SUSPENSION OF REEXAMINATION CONTROL NO. 95/000,274" (the "Petition"). As the rules do not provide for a petition for severance (de-merger) of merged reexamination proceedings and suspension of a reexamination proceeding, the petition paper is being treated as a petition under 37 CFR 1.182.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to petitioner's credit card on August 18, 2008.

The petition and merged reexamination proceeding for 95/000,274 and 90/008,175 are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition for severance and suspension is dismissed as premature.

Patent owner's petition is, however, granted to the extent that the rules of practice (37 CFR 1.955) are waived to afford patent owner a **single opportunity** to hold an interview with the examiner in this proceeding if, and only if, patent owner proceeds as provided in Section V below.

BACKGROUND

1. On March 16, 2004, United States Patent Number 6,707,264 (the '264 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '264 patent, assigned Reexamination Control No. 90/008,175 (the '8175 proceeding), was filed by Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination in the '8175 proceeding.

4. On July 11, 2007, a request for *inter partes* reexamination of the '264 patent, assigned Reexamination Control No. 95/000,274 (the '274 proceeding), was filed by Lionel Lavenue on behalf of Rohm Co., Ltd.

5. Patent owner and third party requester in the '274 proceeding are adversarial parties in concurrent litigation regarding the '264 patent in the United States District Court for the Eastern District of Texas (concurrent litigation).[1]

6. On August 8, 2007, the Office issued an order granting *inter partes* reexamination in the '274 proceeding, without an accompanying action on the merits.

7. On March 21, 2008, the Office issued a decision *sua sponte* merging the '8175 *ex parte* proceeding and the '274 *inter partes* proceeding (the merged proceeding).

8. On April 23, 2008, the third party requester submitted a Notice of Concurrent Proceedings under 37 CFR 1.985(b). In paragraph 2 of the submission, the requester states that it "will no longer actively participate in the proceeding in any way" and waives its right to file any comment otherwise allowed under 35 U.S.C. § 314(b)(2) and/or 37 C.F.R. § 1.947." The notification included a court document from the concurrent litigation entitled "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008.

[1] *O2 Micro Int'l, Ltd. v. Rohm Co. Ltd.*, Case No. 2:05-CV-0211 (E.D. Tex. 2005).

9. On June 5, 2008, the Office issued a non-final Office action on the merits in the merged proceeding.

10. On August 16, 2008, patent owner filed a petition under 37 CFR 1.183 requesting de-merger of the merged proceeding and suspension of the '274 proceeding.

PRELIMINARY MATTER: PATENT OWNER'S ADDRESS

37 CFR 1.33(c) states:

> (c) All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address.** Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

The patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the '274 proceeding and (3) the '8175 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. Additionally, the petition that is addressed by this decision is from a third counsel alleging that they are now counsel for patent owner in the merged proceeding. **The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c)** and it is that of Grossman, Tucker, Perreault & Pfleger, PLLC, and 55 South Commercial Street, Manchester NH 03101. [2]

Clarification is required, so that all future correspondence can be directed to a single address for the patent owner. Accordingly, the patent owner is required to, within ONE (1) MONTH of this decision:

(a) Designate the correspondence address and attorneys of record in both proceedings, to provide one address and party for the merged proceeding, which is the same as that in the patent file, and

(b) If there is a newly designated attorney, supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings).

Patent owner is reminded to serve both reexamination requesters with copies of all papers filed in these proceedings, including said correspondence address communications.

As a courtesy, this decision is being mailed to all addresses. Pending clarification, the address of Grossman, Tucker, Perreault & Pfleger, PLLC, 55 South Commercial Street, Manchester NH 03101, will be used **in all future correspondence**.

---

[2] On September 18, 2007 a revocation of power of attorney and new power of attorney and change of address was submitted in the '274 proceeding, however no such transaction has ever occurred in the '264 patent.

RELEVANT STATUTES, REGULATIONS AND GUIDANCE

35 U.S.C. 314(c) states:

SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(b) states:

Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.907(b) states:

Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

MPEP 2686.04 II B provides (Emphasis added):

The Third Party Requester Was a Party to the Litigation.

Final Holding of validity: The provisions of 37 CFR 1.907(b) apply. Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, that party and its privies may **not** request *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office, i.e., the proceeding will be concluded.

...

In view of the above, when the examiner is aware that the third party requester was a party to previous Federal Court litigation as to the patent for which *inter partes* reexamination has been requested, the examiner must determine:

(1) Was the Federal Court's decision adverse to the third party requester as to at least one claim of the patent?

(2) Was the Federal Court's decision a final decision, after all appeals?

(3) Is the issue being raised in the reexamination request the same issue as was raised in the Federal Court during the civil action, or an issue that the third party requester could have raised in the Federal Court during the civil action?

- If the answer to each of questions (1)-(3) is "yes" for all claims for which reexamination was requested in the proceeding, then the *inter partes* reexamination prosecution must be terminated. In such a case, the Central Reexamination Unit (CRU) Director will prepare a decision discussing the above considerations (1)-(3) and vacate the reexamination proceeding at that time.

- If the answer to all of questions (1)-(3) is "yes" for one or more (but not all) of the claims for which reexamination was requested in the proceeding; those claims will not be treated. The examiner's action will point out the claims not treated and the reason why, i.e., a discussion of the above considerations (1)-(3). The guidelines set forth above in subsection II. (A) will be used for the claims remaining.

- If the answer to question (1) or to question (3) is "no" for all claims for which reexamination was requested, then the examination of the reexamination proceeding will proceed without any discussion on the record of considerations (1)-(3), using the guidelines set forth above in subsection II.(A).

- If, for any claim for which reexamination was requested, the answer to both of questions (1) and (3) is "yes", but the answer to question (2) is "no", then examination of the reexamination proceeding will proceed using the guidelines set forth above in subsection II.(A). The examiner's action will contain a discussion of considerations (1)-(3). If the examiner subsequently becomes aware that the Federal Court decision has become final, reexamination of the affected claims must be discontinued. If all claims being examined are affected, the reexamination will be vacated by the CRU Director as discussed above. See also subsection V. below.

Final Holding of invalidity: A final holding of claim invalidity or unenforceability (after all appeals) is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. See *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). **Where all claims for which reexamination was requested are affected, the reexamination will be vacated by the CRU Director.** A non-final holding of claim invalidity or unenforceability, however, will not be controlling on the question of whether a substantial new question of patentability is present.

DECISION

I. Patent Owner's Position

Patent owner's petition filed August 16, 2008, requests that the merged reexamination proceeding should be severed ("de-merged"), that the '274 *inter partes* reexamination proceeding should be suspended while the '8175 *ex parte* proceeding continues, and that at the conclusion of the *ex parte* prosecution the *inter partes* proceeding be harmonized with the results of the '8175 *ex parte* reexamination proceeding by means of a housekeeping

amendment. The basis for patent owner's position is that - because the third party requester in the '274 *inter partes* reexamination proceeding has agreed to no longer exercise its right to file comments in the '274 proceeding, in light of a Consent Judgment/settlement agreement in concurrent litigation between the parties on the same patent, the presence of the procedural rules of *inter partes* reexamination will actually thwart special dispatch.

II. Analysis and Findings

Initially, it is to be noted that, regardless of any merit to patent owner's position, the statutory issue of the attachment of estoppel must first be addressed before any determination can be made on the merits of patent owner's petition (whether the petition is taken under 37 CFR 1.182 or 37 CFR 1.183). Patent owner's petition is silent regarding the estoppel provisions of 35 U.S.C. § 317(b) which attach to an *inter partes* reexamination proceeding when a final decision has been entered. Yet, if the estoppel provisions of 35 U.S.C. § 317(b) have attached to all claims of the '274 *inter partes* reexamination proceeding, the '274 *inter partes* reexamination would be terminated. If so, the relief requested by patent owner would then follow in due course, and there would be no need for resort to 37 CFR 1.182 and 37 CFR 1.183.

A review of the record reveals that neither party has disclosed and/or submitted court records to establish which claims of the '264 patent were being asserted in the concurrent litigation. The initial request only lists the litigation proceedings and includes a court memorandum opinion and order that appears to be the result of a Markman claim construction hearing from a companion case in the District Court. [3] The memorandum does not state which claims from the '264 patent were being asserted or being challenged with the defense of invalidity. The third party requester's submission of court papers in the "Notice of Concurrent Proceedings under 37 CFR 1.985(b)," filed on April 23, 2008, is silent regarding both as to which claims from the '264 patent were being asserted or being challenged with the defense of invalidity, as well as to the finality of the court's decision.

The '264 patent issued with 22 claims, of which claims 1, 9, and 16, are independent. The request for reexamination filed on behalf of Rohm Co. Ltd., (as the real party in interest) established a substantial new question of patentability with respect to all the claims of the '264 patent.

Based on the above, it cannot be determined if the claims in suit are or are not ***identical*** to the claims under reexamination in the '274 proceeding, because such has not been made of record in the '274 *inter partes* reexamination proceeding, but all the patent claims, i.e., claims 1-22, are subject to reexamination in the '274 proceeding. Furthermore, it cannot be determined from the record if the concurrent litigation resulted in a final decision.

35 U.S.C. § 317(b) attaches the estoppel on a claim-by-claim basis. Thus, if the present *inter partes* reexamination of claims 1-22 contained evidence of a final decision, the *inter* partes reexamination proceeding could not continue as to any claims subject to the "final decision."

Therefore, if evidence on the record shows that a final decision was rendered on all the claims subject to *inter partes* reexamination that the third party requester "has not sustained its burden of proving the invalidity of any patent claim in suit" then the statute would

[3] Memorandum Opinion and Order, *O2 Micro Int'l, Ltd. v. Samsung Elecs. Co. Ltd.*, Case No. 2:04-CV-323, (E.D. Tex. 2004)

require the Office to terminate the '274 *inter partes* proceeding. As a result of such a termination, the '8175 *ex parte* proceeding would be severed (from the terminated *inter partes* proceeding) to continue prosecution, thus obviating the need for the three step relief requested by petitioner. In such a circumstance the Office would not have to consider granting petitioner relief not specifically provided for in the rules, but instead would grant petitioner, in effect, relief as provided for under the rules, *i.e.* termination which will result in severance. See 35 U.S.C. 317(b) and 37 CFR 1.907(b).

However, it has not been established that the consent judgment entered in the civil proceeding constitutes "a final decision ... against a party in a civil action ... that the party has not sustained its burden of proving the invalidity" of the claims in suit. Accordingly, the petition to sever and suspend the '274 proceeding is dismissed as premature.

III. Guidance for Petition to Terminate

In order to resolve the need for relief in this instance, patent owner is called upon to present the following, with supporting documentation from the concurrent litigation, to complete the petition, and resolve the issue under 35 U.S.C. 317(b) and 37 CFR 907(b) as to termination of the '274 *inter partes* reexamination proceeding:

1) An explanation, with supporting court documentation, as to whether or not the action taken in the concurrent litigation, i.e. the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008, is a "Final Decision" within the statutory meaning of 35 U.S.C. 317(b).

2) If the action taken in the concurrent litigation is a "Final Decision," then identify, with supporting documentation from the record of the litigation, which claims from the '264 patent were subject to adjudication in the concurrent litigation.

3) For all claims identified as being subject to adjudication by the court in the concurrent litigation, disclose, with supporting court documentation, how they were challenged and treated in resolution or affirmance of the challenge in regard to their patentability.

Patent owner's showing must establish, based on specifically pointed out part(s) of the record of the litigation, whether the estoppel provisions of 35 U.S.C. 317(b) should apply to all the claims of the patent and/or issues for which patent owner requests the Office to no longer maintain. Specifically, the showing must be adequate to establish whether the third party requester had the burden of proving invalidity of the various claims and that it "has not sustained its burden of proving the invalidity of any patent claim in suit."

IV. Interim Prosecution of the merged proceeding

Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding, except that, in light of requester's express waiver of its right to

file comments, the proceeding will be forwarded to the examiner for action immediately upon entry of patent owner responses, or the expiration of time for same.[4]

If an Action Closing Prosecution (ACP) is generated for the merged proceeding and the *inter partes* reexamination proceeding is subsequently terminated and/or severed, that will result in the treating of such ACP as a final Office action in the remaining *ex parte* proceeding, governed by the rules of *ex parte* reexamination.

V. Interview

37 CFR 1.955 states:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent owner has also requested an interview in the merged proceeding. Patent owner's rationale requesting a waiver of the rule precluding interviews in an *inter partes* reexamination is that, in light of assertions on the record by third party requester, from the '274 *inter partes* reexamination proceeding, the third party would not be prejudiced and conduct of the interview will facilitate the statutory mandate of "special dispatch."

There is substantial evidence on the record that the third party requester from the '274 *inter partes* reexamination proceeding will not participate, nor be prejudiced by the conduct of an interview, as evidenced by the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008. Accordingly, **a single interview** will be permitted. This waiver of the rules is solely to conduct a single interview. There is no further waiver of the rules at this time. Any requests for further interviews can be considered in the future, after the matters discussed above in this decision are resolved.

Patent owner is give fifteen (15) days with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

CONCLUSION

1. The patent owner petition to sever the '274 and '8175 proceedings and suspend the '274 proceeding is dismissed.

2. Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding.

3. The patent owner may file a petition to terminate or limit the '274 proceeding in accordance with the guidance provided above in Section III.

4. Patent owner's petition is granted in part such that 37 CFR 1.955 is waived to the extent that Patent owner is being afforded a **single opportunity** to hold an interview with the

[4] If third party requester objects to this procedure, and wishes to preserve its right to comment, then requester is called upon to immediately inform the Office of that decision and explain the circumstances for withdrawing an assertion made in the record of this proceeding. Note further, that the language of the third party's submission does not make it entirely clear whether they intend to prospectively waive any participation in the appeal process.

examiner in this proceeding if, and only if, patent owner proceeds as provided above in Section V. Patent owner is given **fifteen (15) days** from the mail date of this decision with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

5. Jurisdiction of the merged proceeding is returned to the Central Reexamination unit (CRU) for examination consistent with this decision.

6. Telephone inquires related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in their absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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In re Lin et al.,	:	
Ex parte Reexamination Proceeding	:	
Control No. 90/008,175	:	
Filed: August 18, 2006	:	
For: U.S. Patent No. 6,707,264	:	**DECISION**
	:	**DISMISSING**
In re Lin et al.,	:	**PETITION TO SEVER**
Inter partes Reexamination Proceeding	:	**PROCEEDINGS AND**
Control No. 95/000,274	:	**GRANTING PARTIAL**
Filed: July 11, 2007	:	**WAIVER OF 37 CFR 1.955**
For: U.S. Patent No. 6,707,264	:	

This is a decision on the August 16, 2008 patent owner petition titled "PETITION UNDER 37 C.F.R. § 1.183 SEEKING DE-MERGER OF REEXAMINATION CONTROL NOS. 90/008,175 AND 95/000,274 AND SUSPENSION OF REEXAMINATION CONTROL NO. 95/000,274"(the "Petition"). As the rules do not provide for a petition for severance (de-merger) of merged reexamination proceedings and suspension of a reexamination proceeding, the petition paper is being treated as a petition under 37 CFR 1.182.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to petitioner's credit card on August 18, 2008.

The petition and merged reexamination proceeding for 95/000,274 and 90/008,175 are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition for severance and suspension is dismissed as premature.

Patent owner's petition is, however, granted to the extent that the rules of practice (37 CFR 1.955) are waived to afford patent owner a **single opportunity** to hold an interview with the examiner in this proceeding if, and only if, patent owner proceeds as provided in Section V below.

BACKGROUND

1. On March 16, 2004, United States Patent Number 6,707,264 (the '264 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '264 patent, assigned Reexamination Control No. 90/008,175 (the '8175 proceeding), was filed by Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination in the '8175 proceeding.

4. On July 11, 2007, a request for *inter partes* reexamination of the '264 patent, assigned Reexamination Control No. 95/000,274 (the '274 proceeding), was filed by Lionel Lavenue on behalf of Rohm Co., Ltd.

5. Patent owner and third party requester in the '274 proceeding are adversarial parties in concurrent litigation regarding the '264 patent in the United States District Court for the Eastern District of Texas (concurrent litigation).[1]

6. On August 8, 2007, the Office issued an order granting *inter partes* reexamination in the '274 proceeding, without an accompanying action on the merits.

7. On March 21, 2008, the Office issued a decision *sua sponte* merging the '8175 *ex parte* proceeding and the '274 *inter partes* proceeding (the merged proceeding).

8. On April 23, 2008, the third party requester submitted a Notice of Concurrent Proceedings under 37 CFR 1.985(b). In paragraph 2 of the submission, the requester states that it "will no longer actively participate in the proceeding in any way" and waives its right to file any comment otherwise allowed under 35 U.S.C. § 314(b)(2) and/or 37 C.F.R. § 1.947." The notification included a court document from the concurrent litigation entitled "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008.

[1] *O2 Micro Int'l, Ltd. v. Rohm Co. Ltd.*, Case No. 2:05-CV-0211 (E.D. Tex. 2005).

9. On June 5, 2008, the Office issued a non-final Office action on the merits in the merged proceeding.

10. On August 16, 2008, patent owner filed a petition under 37 CFR 1.183 requesting de-merger of the merged proceeding and suspension of the '274 proceeding.

PRELIMINARY MATTER: PATENT OWNER'S ADDRESS

37 CFR 1.33(c) states:

> (c) All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address.** Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

The patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the '274 proceeding and (3) the '8175 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. Additionally, the petition that is addressed by this decision is from a third counsel alleging that they are now counsel for patent owner in the merged proceeding. **The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c)**, and it is that of Grossman, Tucker, Perreault & Pfleger, PLLC, 55 South Commercial Street, Manchester NH 03101. [2]

Clarification is required, so that all future correspondence can be directed to a single address for the patent owner. Accordingly, the patent owner is required to, within ONE (1) MONTH of this decision:

(a) Designate the correspondence address and attorneys of record in both proceedings, to provide one address and party for the merged proceeding, which is the same as that in the patent file, and

(b) If there is a newly designated attorney, supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings).

Patent owner is reminded to serve both reexamination requesters with copies of all papers filed in these proceedings, including said correspondence address communications.

As a courtesy, this decision is being mailed to all addresses. Pending clarification, the address of Grossman, Tucker, Perreault & Pfleger, PLLC, 55 South Commercial Street, Manchester NH 03101, will be used **in all future correspondence.**

---

[2] On September 18, 2007 a revocation of power of attorney and new power of attorney and change of address was submitted in the '274 proceeding, however no such transaction has ever occurred in the '264 patent.

RELEVANT STATUTES, REGULATIONS AND GUIDANCE

35 U.S.C. 314(c) states:

> SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(b) states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.907(b) states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

MPEP 2686.04 II B provides (Emphasis added):

> The Third Party Requester <u>Was a Party</u> to the Litigation.
>
> <u>Final Holding of validity</u>: The provisions of 37 CFR 1.907(b) apply. Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, that party and its privies may **not** request *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office, i.e., the proceeding will be concluded.
>
> ...
>
> In view of the above, when the examiner is aware that the third party requester was a party to previous Federal Court litigation as to the patent for which *inter partes* reexamination has been requested, the examiner must determine:

(1) Was the Federal Court's decision adverse to the third party requester as to at least one claim of the patent?

(2) Was the Federal Court's decision a final decision, after all appeals?

(3) Is the issue being raised in the reexamination request the same issue as was raised in the Federal Court during the civil action, or an issue that the third party requester could have raised in the Federal Court during the civil action?

- If the answer to each of questions (1)-(3) is "yes" for all claims for which reexamination was requested in the proceeding, then the *inter partes* reexamination prosecution must be terminated. In such a case, the Central Reexamination Unit (CRU) Director will prepare a decision discussing the above considerations (1)-(3) and vacate the reexamination proceeding at that time.

- If the answer to all of questions (1)-(3) is "yes" for one or more (but not all) of the claims for which reexamination was requested in the proceeding; those claims will not be treated. The examiner's action will point out the claims not treated and the reason why, i.e., a discussion of the above considerations (1)-(3). The guidelines set forth above in subsection II.(A) will be used for the claims remaining.

- If the answer to question (1) or to question (3) is "no" for all claims for which reexamination was requested, then the examination of the reexamination proceeding will proceed without any discussion on the record of considerations (1)-(3), using the guidelines set forth above in subsection II.(A).

- If, for any claim for which reexamination was requested, the answer to both of questions (1) and (3) is "yes", but the answer to question (2) is "no", then examination of the reexamination proceeding will proceed using the guidelines set forth above in subsection II.(A). The examiner's action will contain a discussion of considerations (1)-(3). If the examiner subsequently becomes aware that the Federal Court decision has become final, reexamination of the affected claims must be discontinued. If all claims being examined are affected, the reexamination will be vacated by the CRU Director as discussed above. See also subsection V. below.

Final Holding of invalidity: A final holding of claim invalidity or unenforceability (after all appeals) is controlling on the Office. In such cases, a substantial new question of patentability would not be present as to the claims held invalid or unenforceable. See *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). **Where all claims for which reexamination was requested are affected, the reexamination will be vacated by the CRU Director.** A non-final holding of claim invalidity or unenforceability, however, will not be controlling on the question of whether a substantial new question of patentability is present.

DECISION

I. Patent Owner's Position

Patent owner's petition filed August 16, 2008, requests that the merged reexamination proceeding should be severed ("de-merged"), that the '274 *inter partes* reexamination proceeding should be suspended while the '8175 *ex parte* proceeding continues, and that at the conclusion of the *ex parte* prosecution the *inter partes* proceeding be harmonized with the results of the '8175 *ex parte* reexamination proceeding by means of a housekeeping

amendment. The basis for patent owner's position is that - because the third party requester in the '274 *inter partes* reexamination proceeding has agreed to no longer exercise its right to file comments in the '274 proceeding, in light of a Consent Judgment/settlement agreement in concurrent litigation between the parties on the same patent, the presence of the procedural rules of *inter partes* reexamination will actually thwart special dispatch.

II. Analysis and Findings

Initially, it is to be noted that, regardless of any merit to patent owner's position, the statutory issue of the attachment of estoppel must first be addressed before any determination can be made on the merits of patent owner's petition (whether the petition is taken under 37 CFR 1.182 or 37 CFR 1.183). Patent owner's petition is silent regarding the estoppel provisions of 35 U.S.C. § 317(b) which attach to an *inter partes* reexamination proceeding when a final decision has been entered. Yet, if the estoppel provisions of 35 U.S.C. § 317(b) have attached to all claims of the '274 *inter partes* reexamination proceeding, the '274 *inter partes* reexamination would be terminated. If so, the relief requested by patent owner would then follow in due course, and there would be no need for resort to 37 CFR 1.182 and 37 CFR 1.183.

A review of the record reveals that neither party has disclosed and/or submitted court records to establish which claims of the '264 patent were being asserted in the concurrent litigation. The initial request only lists the litigation proceedings and includes a court memorandum opinion and order that appears to be the result of a Markman claim construction hearing from a companion case in the District Court. [3] The memorandum does not state which claims from the '264 patent were being asserted or being challenged with the defense of invalidity. The third party requester's submission of court papers in the "Notice of Concurrent Proceedings under 37 CFR 1.985(b)," filed on April 23, 2008, is silent regarding both as to which claims from the '264 patent were being asserted or being challenged with the defense of invalidity, as well as to the finality of the court's decision.

The '264 patent issued with 22 claims, of which claims 1, 9, and 16, are independent. The request for reexamination filed on behalf of Rohm Co. Ltd., (as the real party in interest) established a substantial new question of patentability with respect to all the claims of the '264 patent.

Based on the above, it cannot be determined if the claims in suit are or are not ***identical*** to the claims under reexamination in the '274 proceeding, because such has not been made of record in the '274 *inter partes* reexamination proceeding, but all the patent claims, i.e., claims 1-22, are subject to reexamination in the '274 proceeding. Furthermore, it cannot be determined from the record if the concurrent litigation resulted in a final decision.

35 U.S.C. § 317(b) attaches the estoppel on a claim-by-claim basis. Thus, if the present *inter partes* reexamination of claims 1-22 contained evidence of a final decision, the *inter* partes reexamination proceeding could not continue as to any claims subject to the "final decision."

Therefore, if evidence on the record shows that a final decision was rendered on all the claims subject to *inter partes* reexamination that the third party requester "has not sustained its burden of proving the invalidity of any patent claim in suit" then the statute would

[3] Memorandum Opinion and Order, *O2 Micro Int'l, Ltd. v. Samsung Elecs. Co. Ltd.*, Case No. 2:04-CV-323, (E.D. Tex. 2004)

require the Office to terminate the '274 *inter partes* proceeding. As a result of such a termination, the '8175 *ex parte* proceeding would be severed (from the terminated *inter partes* proceeding) to continue prosecution, thus obviating the need for the three step relief requested by petitioner. In such a circumstance the Office would not have to consider granting petitioner relief not specifically provided for in the rules, but instead would grant petitioner, in effect, relief as provided for under the rules, *i.e.* termination which will result in severance. See 35 U.S.C. 317(b) and 37 CFR 1.907(b).

However, it has not been established that the consent judgment entered in the civil proceeding constitutes "a final decision ... against a party in a civil action ... that the party has not sustained its burden of proving the invalidity" of the claims in suit. Accordingly, the petition to sever and suspend the '274 proceeding is dismissed as premature.

III. Guidance for Petition to Terminate

In order to resolve the need for relief in this instance, patent owner is called upon to present the following, with supporting documentation from the concurrent litigation, to complete the petition, and resolve the issue under 35 U.S.C. 317(b) and 37 CFR 907(b) as to termination of the '274 *inter partes* reexamination proceeding:

1) An explanation, with supporting court documentation, as to whether or not the action taken in the concurrent litigation, i.e. the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008, is a "Final Decision" within the statutory meaning of 35 U.S.C. 317(b).

2) If the action taken in the concurrent litigation is a "Final Decision," then identify, with supporting documentation from the record of the litigation, which claims from the '264 patent were subject to adjudication in the concurrent litigation.

3) For all claims identified as being subject to adjudication by the court in the concurrent litigation, disclose, with supporting court documentation, how they were challenged and treated in resolution or affirmance of the challenge in regard to their patentability.

Patent owner's showing must establish, based on specifically pointed out part(s) of the record of the litigation, whether the estoppel provisions of 35 U.S.C. 317(b) should apply to all the claims of the patent and/or issues for which patent owner requests the Office to no longer maintain. Specifically, the showing must be adequate to establish whether the third party requester had the burden of proving invalidity of the various claims and that it "has not sustained its burden of proving the invalidity of any patent claim in suit."

IV. Interim Prosecution of the merged proceeding

Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding, except that, in light of requester's express waiver of its right to

file comments, the proceeding will be forwarded to the examiner for action immediately upon entry of patent owner responses, or the expiration of time for same.[4]

If an Action Closing Prosecution (ACP) is generated for the merged proceeding and the *inter partes* reexamination proceeding is subsequently terminated and/or severed, that will result in the treating of such ACP as a final Office action in the remaining *ex parte* proceeding, governed by the rules of *ex parte* reexamination.

V. Interview

37 CFR 1.955 states:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent owner has also requested an interview in the merged proceeding. Patent owner's rationale requesting a waiver of the rule precluding interviews in an *inter partes* reexamination is that, in light of assertions on the record by third party requester, from the '274 *inter partes* reexamination proceeding, the third party would not be prejudiced and conduct of the interview will facilitate the statutory mandate of "special dispatch."

There is substantial evidence on the record that the third party requester from the '274 *inter partes* reexamination proceeding will not participate, nor be prejudiced by the conduct of an interview, as evidenced by the "ORDER GRANTING STIPULATION OF DISMISSAL WITH PREJUDICE" dated April 17, 2008. Accordingly, **a single interview** will be permitted. This waiver of the rules is solely to conduct a single interview. There is no further waiver of the rules at this time. Any requests for further interviews can be considered in the future, after the matters discussed above in this decision are resolved.

Patent owner is give fifteen (15) days with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

CONCLUSION

1. The patent owner petition to sever the '274 and '8175 proceedings and suspend the '274 proceeding is dismissed.

2. Prosecution of the merged proceeding will continue consistent with the rules relevant to the prosecution of a merged reexamination proceeding that includes an *inter partes* reexamination proceeding.

3. The patent owner may file a petition to terminate or limit the '274 proceeding in accordance with the guidance provided above in Section III.

4. Patent owner's petition is granted in part such that 37 CFR 1.955 is waived to the extent that Patent owner is being afforded a **single opportunity** to hold an interview with the

[4] If third party requester objects to this procedure, and wishes to preserve its right to comment, then requester is called upon to immediately inform the Office of that decision and explain the circumstances for withdrawing an assertion made in the record of this proceeding. Note further, that the language of the third party's submission does not make it entirely clear whether they intend to prospectively waive any participation in the appeal process.

examiner in this proceeding if, and only if, patent owner proceeds as provided above in Section V. Patent owner is given **fifteen (15) days** from the mail date of this decision with which to arrange for the conduct of an interview in accordance with the relevant *ex parte* reexamination rules and procedures that govern the conduct of interviews.

5. Jurisdiction of the merged proceeding is returned to the Central Reexamination unit (CRU) for examination consistent with this decision.

6. Telephone inquires related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in their absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor
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UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 20 2008

CENTRAL REEXAMINATION UNIT

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Ex parte Reexamination Proceeding Control No. 90/008,175 Filed: August 18, 2006 For: U.S. Patent No. 6,707,264	**DECISION GRANTING PETITION**
Inter Partes Reexamination Proceeding Control No. 95/000,274 Filed: July 11, 2007 For: U.S. Patent No. 6,707,264	

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 August 5, 2008.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 will be charged to patent owner's Deposit Account No. 50-4160, as authorized on page two of the transmittal letter, which accompanied the petition on August 5, 2008.

REVIEW OF THE RELEVANT FACTS

1. On March 16, 2004, United States Patent Number 6,707,264 (the '264 patent) issued.

2. On August 18, 2006, a request for *ex parte* reexamination of the '264 patent, assigned Reexamination Control No. 90/008,175 (the '8175 proceeding), was filed by third party requester Patrick G. Burns.

3. On October 26, 2006, the Office issued an order granting *ex parte* reexamination in the '8175 proceeding.

4. On July 11, 2007, a request for *inter partes* reexamination of the '264 patent, assigned Reexamination Control No. 95/000,274 (the '274 proceeding), was filed by third party requester Lionel Lavenue on behalf of real party in interest Rohm Co., Ltd.

5. On August 8, 2007, the Office issued an order granting *inter partes* reexamination in the '274 proceeding, without an accompanying action on the merits.

6. On March 21, 2008, the Office issued a decision *sua sponte* merging the '8175 *ex parte* proceeding and the '274 *inter partes* proceeding (the merged proceeding).

7. On June 5, 2008, the Office issued a non-final Office action on the merits in the merged proceeding.

8. On August 5, 2008, patent owner filed, in the '8175 proceeding, 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)."

9. Concurrently on August 5, 2008, patent owner filed, in the '8175 proceeding, a response to the June 5, 2008 Office action, which exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 12 pages.

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.

In the instant petition, patent owner requests waiver of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, with respect to patent owner's response to the June 5, 2008 Office action filed concurrently with the instant petition on August 5, 2008. As pointed out above, patent owner's August 5, 2008 response exceeds the 50-page limit by 12 pages. In support of waiver of the rule, patent owner points out that the June 5, 2008 Office action is an Office action in a merged proceeding, and is itself 112 pages in length, and the action cites numerous references, each of which raises an issue corresponding to some or all of the 22 claims of the '264 patent. In order to effectively address the issues raised in the Office action, patent owner deems it necessary to exceed the page limit set forth in 37 CFR 1.943(b).

Upon consideration of the instant petition, it is noted that the June 5, 2008 Office action applies or discusses 29 references, and analyzes 100 proposed grounds of rejection raised by the third party requesters, in addition to raising several new grounds of rejection. Based upon the extensive incorporation by reference of the requesters' proposed rejections, the new rejections made by the examiner in the June 5, 2008 Office action, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit for the patent owner's response to the extent that the patent owner's August 5, 2008 response exceeds the 50-page limit by 12 pages.

It is noted, however, that the August 5, 2008 patent owner petition paper and concurrently filed response do not comply with the requirements set forth in the March 21, 2008 "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS" (the merger decision). In particular, section III(B) of the merger decision indicates (emphasis added):

> 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 requesters, will contain the identifying data for both files and will be entered in each reexamination file. **All papers filed by the patent owner and the third party requester(s) <u>must</u> consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.**
>
> ****
>
> Patent owner and requesters are reminded that **<u>every</u> paper filed in the merged proceeding subsequent to this Decision must be served on the other parties** (including papers filed *via* facsimile transmission), **and every paper filed must reflect that such paper**

> **was served on the other parties, pursuant to 37 CFR 1.903.** All papers are to be addressed to the Central Reexamination Unit as provided above.

In this instance, the August 5, 2008 patent owner petition paper and response were not filed in accordance with the March 21, 2008 merger decision because the patent owner petition paper and response (1) were not filed in duplicate (the petition paper and response were only filed in the '8175 proceeding), (2) do not contain identifying data for both files (the petition paper and response only contain identifying data for the '8175 proceeding), and (3) do not reflect that the petition paper and response were served on all of the other parties (the certificate of service accompanying the petition paper and response reflects only that the *ex parte* third party requester was served, but not the *inter partes* third party requester).

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 provisionally waived as to the 12 pages of the patent owner's August 5, 2008 response that exceed the 50-page limit, **contingent** upon the patent owner timely re-filing the August 5, 2008 petition paper and response in accordance with the March 21, 2008 merger decision as set forth below.

The patent owner is hereby given a **non-extendible period of 15 days from the mailing date of this decision** to re-file the August 5, 2008 petition paper and response in accordance with the March 21, 2008 merger decision.

If patent owner does so, then the *inter partes* third party requester may once file written comments on the patent owner's response within a **non-extendible period of 30 days from the date of service of patent owner's re-filed response**.

In the event the patent owner fails to re-file the August 5, 2008 petition paper and response in accordance with the March 21, 2008 merger decision within the time period set forth above, the 50-page limit of 37 CFR 1.943(b) will not be waived, and the patent owner's August 5, 2008 response will be deemed improper (i.e., because the length of the patent owner submission exceeds that permitted by 37 CFR 1.943) and will not be considered, i.e., there would be no response to the Office action, and the Office would take action accordingly. [1]

CONCLUSION

1. 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 provisionally waived as to the 12 pages of the patent owner's August 5, 2008 response that exceed the 50-page limit, **contingent** upon the patent owner timely re-filing the August 5, 2008 petition paper and response in accordance with the March 21, 2008 merger decision.

---

[1] *See Manual of Patent Examining Procedure* § 2667(I)(2) (8th ed. 2001) (Rev. 7, July 2008).

2. A **non-extendible period of 15 days from the mailing date of this decision** is hereby set for patent owner to re-file the August 5, 2008 petition paper and response to the outstanding Office action in accordance with the March 21, 2008 merger decision.

3. If patent owner does re-file, then the *inter partes* third party requester may once file written comments within a non-extendible period of 30 days from the date of service of the re-filed patent owner's response.

4. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Nicole D. Dretar, Legal Advisor, at 571-272-7717.

Kenneth M. Schor

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

10/20/08
C:\Kiva\Kenpet7\IP\length\95_274 & 90_8175 Provisional Grant Pg Length Waiver-must comply w merger.doc

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Murabito, Hao & Barnes, LLP (For Patent Owner)
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Patrick G. Burns (For *Ex Parte* Requester)
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Lionel M. Lavenue (For *Inter Partes* Requester)
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Two Freedom Square
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Reston, VA 20190-5675

Ex parte Reexamination Proceeding	:	
Control No. 90/008,175	:	
Filed: August 18, 2006	:	
For: U.S. Patent No. 6,707,264	:	**DECISION**
	:	**GRANTING**
	:	**PETITION**
Inter Partes Reexamination Proceeding	:	
Control No. 95/000,274	:	
Filed: July 11, 2007	:	
For: U.S. Patent No. 6,707,264	:	

This is a decision on the October 29, 2008 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)" (the re-filed petition), which has been filed concurrently with a response to the June 5, 2008 Office Action (the re-filed response).

The re-filed petition is before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 will be charged to patent owner's Deposit Account No. 50-4160, as authorized on page two of the re-filed petition.

DECISION

On August 5, 2008, patent owner filed a petition paper in the 90/008,175 reexamination proceeding entitled "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)," concurrently with a response to the June 5, 2008 Office Action. Patent owner's August 5, 2008 response exceeds the 50-page limit of 37 CFR 1.943(b) by 12 pages.

On October 20, 2008, the Office issued a decision provisionally granting patent owner's August 5, 2008 petition under 37 CFR 1.183. Specifically, the October 20, 2008 decision provisionally waived the page limit of 37 CFR 1.943(b) as to the 12 pages of patent owner's August 5, 2008 response that exceed the 50-page limit, contingent upon patent owner timely re-filing the August 5, 2008 petition paper and response in accordance with the Office's March 21, 2008 "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS" (the merger decision).

Because it appears patent owner has timely re-filed the August 5, 2008 petition paper and response in accordance with the merger decision, the re-filed petition is **granted** to the extent that the 50-page limit of 37 CFR 1.943(b) is waived as to the 12 pages of patent owner's August 5, 2008 response that exceed the 50-page limit.

It is noted that the pagination of patent owner's re-filed response (71 pages) differs from that of patent owner's August 5, 2008 response (62 pages). However, it appears the content of the re-filed response is identical to that of the August 5, 2008 response, except that the re-filed response includes identifying data for both the 90/008,175 and 95/000,274 reexamination proceedings and the certificate of service appended thereto reflects that both the *ex parte* and *inter partes* third party requesters were served.

The October 20, 2008 decision provided *inter partes* third party requester with an opportunity to once file written comments on patent owner's re-filed response within a non-extendible period of 30 days from the date of service of patent owner's re-filed response. That 30-day time period (from the service of the October 29, 2008 patent owner re-filed response) for *inter partes* third party requester to have submitted written comments has expired.

CONCLUSION

1. Patent owner's re-filed 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 12 pages of patent owner's August 5, 2008 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 D. Dretar, Legal Advisor, at 571-272-7717.

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

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Lerner, David, Littenberg, Krumholz & Mentlik
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Westfield, NJ 07090

(For Patent Owner)

FEB - 8 2007

Jeffrey E. Young
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Bank of America Plz., 101 South Tryon St.
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Charlotte, NC 28280-4000

(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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,183	08/02/2006	6538024	1036.031RX2	6759

21186 7590 09/15/2006

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2006

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

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SCHEWEGMAN, LUNDBERG,
WOESSNER & KLUTH, P.A.
Attn: Albin J. Nelson, Esq.
P.O. Box 2938
Minneapolis, MN 55402

(For Patent Owner)

MAILED

SEP 15 2006

CENTRAL REEXAMINATION UNIT

In re Timothy M. Macdonald *et al.*	)	
Reexamination Proceeding	)	
Control No. 90/008,183	)	
Filing Date: August 02, 2006	)	DECISION
For: U.S. Patent No. 6,538,024	)	GRANTING
Title: FELBAMATE DERIVED	)	PETITION
COMPOUNDS	)	

This is a decision in response to the REQUEST REGARDING FEE FOR PETITION FOR REEXAMINATION (Request) filed on August 02, 2006. The Request is taken as a petition under 37 CFR 1.181 requesting that the Office accept the papers filed on August 02, 2006, as having been timely filed.

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

The petition is **granted.**

BACKGROUND

1. On May 31, 2006, the patent owner (hereinafter, "requester") deposited papers requesting *ex parte* reexamination of U.S. Patent No. 6,538,024.

2. On June 13, 2006 a Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements (the Notice) was mailed to requester. The Notice set a 30 day period from the day the Notice was mailed to submit a compliant response.

3. On August 02, 2006, the requester submitted the instant request in response to The Notice of May 31, 2006, accompanied by a corrected request for reexamination.

DECISION

The requester asserts that the Notice was not received at the requestor's address of record until July 18, 2006. To support these assertions, the petitioner has submitted a copy of The Notice that has a received date stamp of July 18, 2006, in the office of counsel for the requester.

A review of the written record indicates no irregularity in the mailing of the Office communication, and in the absence of any irregularity there is a strong presumption that the Office communication was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office communication was not in fact timely received. The showing required to establish the failure to timely receive Office action may include a statement from the practitioner stating that the Office action was not timely received by the practitioner and any substantiating documents.

The requester has provided a statement that the Notice was not timely received and a copy of the Notice with a date stamp of July 18th 2006 from the addressee of record. Thus the evidence submitted indicates that the requester did in fact receive the Notice on July 18th, effectively after the July 13th due date for response. Accordingly, the presumption that there were no irregularities in the mailing of the Office communication has been overcome, and the Office will accept requester's August 02, 2006 submission as a timely response to the Notice of June 13, 2006.

It has been determined that the request, as corrected, complies with the requirements of 37 CFR 1.510(b)(2), with the submission of the rectified 1449. Accordingly a filing date of August 02, 2006 has been granted for the above identified request.

CONCLUSION

1. The petition is **granted**

2. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit technical support staff for processing with a filing date of August 02, 2006.

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

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

9-13-06
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,189	08/24/2006	6470595	JHN-10-1538	5000

23117 7590 06/17/2010

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID R. FAIRBAIRN
KINNEY&LANGE,P.A.,THEKINNEY&LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS,MN 55415-1002

Date:

MAILED

JUN 17 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008189
PATENT NO. : 6470595
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
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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90008189	8/24/06	6470595	JHN-10-1538

EXAMINER

BIRCH STEWART KOLASCH & BIRCH
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

ART UNIT	PAPER
3999	20100617

MAILED

DATE MAILED:

JUN 17 2010

CENTRAL REEXAMINATION UNIT

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

Commissioner for Patents

This is a courtesy copy of the granting of the petition

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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Birch Stewart Kolasch & Birch (For patent owner)
P.O. Box 747
Falls Church, VA 22040-0747

MAILED

JUN 17 2010

CENTRAL REEXAMINATION UNIT

David R. Fairbairn (Requester)
Kinney & Lange, P.A.
The Kinney & Lange Building
312 South Third Street
Minneapolis, MN 55415-1002

Nixon & Vanderhye, PC (Courtesy copy)
901 North Glebe Road
11th Floor
Arlington, VA 22203

In re Peter Gaiser et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,189 : **GRANTING**
Filed: August 24, 2006 : **PETITION UNDER**
For: U.S. Patent No. 6,470,595 : **37 CFR 1.137(b)**

This is a decision on the May 19, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response and revive the present terminated[1] reexamination ("the May 19, 2010 patent owner petition to revive").

The May 19, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 19, 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:

[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 to the requirement set forth at paragraph 48 of the February 17, 2010 final Office action.

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 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.

Regarding item (1), the instant reexamination proceeding was terminated due to patent owner's failure to timely submit a response to the requirement set forth at paragraph 48 of the February 17, 2010 final Office action to resubmit the April 3, 2009 Response in rule-compliant form. Paragraph 48 gave the patent owner a time period of two months from the mailing date of the February 17, 2010 final Office action to respond to the requirement. A response to the requirement was not filed until May 19, 2010; thus, the response was untimely. However, for the purpose of evaluating whether the

May 19, 2010 patent owner petition to revive is a grantable petition, the submission of the May 19, 2010 Corrected Response satisfies item (1).[2]

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the May 19, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the May 19, 2010 patent owner petition to revive is **granted**.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,470,595 patent file is that of Birch Stewart Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747.

As a courtesy, this decision is being mailed to the address of Nixon & Vanderhye, PC, 901 North Glebe Road, 11th Floor, Arlington, VA 22203, in view of the November 9, 2006 Power of Attorney in the file of the '8189 reexamination proceeding.

The address of Birch Stewart Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '595 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The May 19, 2010 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 (CRU), Art Unit 3993, for treatment in due course of the May 19, 2010 Corrected Response.

3. The address of Birch Stewart Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '595 patent file is made in accordance with 37 CFR 1.33(c).

---

[2] This decision does not speak to whether the May 19, 2010 Corrected Response actually corrects the informalities that led to the inclusion of paragraph 48 in the February 17, 2010 final Office action; such is the examiner's province.

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Sara Clarke, of CRU Art Unit 3993, at (571) 272-4873.

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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DENTON L. ANDERSON
SHELDON & MAK
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PASADENA, CA 91101

(For Patent Owner)

MAY - 7 2007

DOCKET CLERK
P.O. DRAWER 800889
DALLAS, TX 75380

(For Requester)

In re Baikoff
Reexamination Proceeding
Control No. 90/008,191
Filed: August 25, 2006
For: U.S. Patent No. 6,673,111

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on October 10, 2006, styled as "Petition Under 37 CFR § 1.181," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated September 15, 2006. Specifically, petitioner requests that the CRU Director find that the examiner's interpretation of the claim limitation "spatula-shaped" is not a reasonable interpretation consistent with USPTO policy and procedures.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,673,111 (hereinafter, the '111 patent) issued on January 6, 2004 of an application filed April 12, 2001.

2. On August 25, 2006, the third party requester deposited a request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned Control No. 90/008,191 (hereinafter, the '191 proceeding).

3. Reexamination was requested for claims 1-4 and 6-10 of the '111 patent.

4. A Notice of Reexamination Request Filing Date was issued on August 30, 2006.

5. An order denying the request for reexamination for claims 1-4 and 6-10 was issued on September 15, 2006.

6. On October 10, 2006, the third party requester filed the above-mentioned petition under 37 CFR § 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 interpretation of the claim limitation "spatula shaped" is arbitrary and capricious and an unreasonable interpretation inconsistent with Office policy and procedures. Although petitioner does not specifically allege that a substantial new question of patentability exists, it is assumed that this is being alleged via the arguments pertaining to claim interpretation.

In support of their showing that the examiner's interpretation of "spatula shaped" is unreasonable, the petitioner advances the following four arguments:

1. The interpretation adopted by the examiner for the claim limitation "spatula shaped" is not supported by the specification, the drawings, or the file history.
2. The interpretation adopted by the examiner for the claim limitation "spatula shaped" is unnecessarily narrower than is required by the specification, drawings and prosecution history.
3. The claims only require that the recited "ends" be wider than the central "bridge" portion, a feature satisfied by the cited reference.
4. The ends in Schachar have a flat inner surface.

Petitioner arguments strictly pertain to the application of the Schachar reference, which is U.S. Patent No. 6,280,468.

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 1-4 and 6-10 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 1-4 and 6-10 of the '111 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 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.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 states that:

> No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.
>
> The decision denying the request will then indicate, for each patent and printed publication cited in the request, why the citation is:

(A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;

(B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);

(C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or

(D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § **2242** subsection II. A.

The examiner should also, in the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

A review of the position taken by third party requester (petitioner) in the *ex parte* reexamination request clearly shows that the substantial new questions of patentability rest on the patent owner's statements made in the background of the '111 patent and U.S. Patent 6,280,468 to Schachar.

The examiner, in the order denying reexamination dated September 15, 2006, stated that no substantial new question of patentability was established by the request. The examiner's rationale for this conclusion is that (1) the specification of the '111 patent was before the examiner in the previous examination of the application that was granted as the '111 patent; and (2) the disclosure of U.S. Patent 6,280,468 to Schachar is substantially similar to the disclosure of U.S. Patent 6,007,578 to Schachar, which was before the examiner in the previous examination of the application that was granted as the '111 patent. In accordance with MPEP 2247, the examiner denied the order for reexamination because the references, which were the basis of the request, were cumulative to the teachings of the art cited in the earlier concluded examination.

The examiner then went on to explain the limitations from claim 1 that was not taught by the specification of the '111 patent and U.S. Patent 6,280,468 to Schachar, in order to respond to the substance of each argument raised by the requested as suggested by MPEP 2247. During this explanation, the examiner set forth his interpretation of the claim limitation "spatula shaped" in response to the petitioner's statement in the request that such a term is unclear. It is this claim interpretation that is being disputed by the above-mentioned petition.

In regards to petitioner's first two arguments pertaining to the interpretation of the claim limitation "spatula shaped," petitioner correctly points out that the specification of the '111 patent nor the prosecution history set forth a clear definition. When a patent applicant fails to set forth a clear and explicitly definition for a term, such term is given its plain meaning, which is its ordinary and customary meaning.

> "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, *>415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (*en banc*). *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). The ordinary and customary meaning of a term may be evidenced by a variety of sources, >including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art."< *Phillips v. AWH Corp.*, *>415 F.3d at 1314<, 75 USPQ2d **>at 1327.< If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms. *Brookhill-Wilk 1*, 334 F. 3d at 1300, 67 USPQ2d at 1137; see also *Renishaw PLC v. Marposs Societa" per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998). " See MPEP 2111.01.

The examiner defined the term "spatula shaped" by relying upon the meaning imparted by the specification and the drawings to one of ordinary skill in the related art at the time the invention was made. Accordingly, the examiner's interpretation is consistent with the Office's policy and procedures, and is not arbitrary and capricious nor unduly narrow (petitioner's first two arguments). The examiner's interpretation is further supported by the dictionary definition for "spatula shaped."[1] Therefore, petitioner's first two arguments do not establish a substantial new question of patentability.

In regards to petitioner's third argument that the claims only require that the recited "ends" be wider than the central "bridge" portion, a feature satisfied by the cited reference, this argument is not persuasive. Claim 1 clearly states that the free ends of the rod "... have a **spatula shape** wider than a diameter of said bridge, so as to constitute wide support bases" (emphasis added). Petitioner's statement has the effect

---

[1] Two on-line dictionaries consistently define "spatula shaped" as "of a leaf shape; having a broad rounded apex and a narrow base." See definition by Webster's Online Dictionary and The Free Dictionary by Farlex (printout attached to the decision).

of eliminating the limitation "spatula shaped" in its entirety. As explained the examiner and as explained above, the limitation "spatula shaped" does impart structural limitations to the claim. In addition, for support, petitioner only uses the teachings in Schacher that were disclosed in the earlier patent to Schacher, which was considered in the previous examination of the application that was granted as the '111 patent. Accordingly, this argument does not establish a substantial new question of patentability.

In regards to petitioner's fourth argument that the ends in Schachar have a flat inner surface, petitioner relies on the teachings in Schachar that were clearly set forth in the earlier patent to Schachar that was considered in the previous examination of the application that was granted as the '111 patent. Therefore, these teachings do not create a substantial new question of patentability. Furthermore, petitioner's argument that the new embodiment, which is taught by U.S. Patent 6,280,468 to Schachar to be made out of rigid material, can be made out of non-rigid material is not persuasive. This argument goes against the clear teachings of Schachar without any evidence or reasoning to modify this teaching. Accordingly, this argument does not establish a substantial new question of patentability.

CONCLUSION

1. Given the facts involved in this proceeding, the request for *ex parte* reexamination of claims 1-4 and 6-10 of the '111 patent was properly denied by the examiner.

2. Accordingly, the PETITION is DENIED.

3. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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Commissioner for Patents
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In re Semple et al.
Reexamination Proceeding
Control No.: 90/008,192
Filed: September 20, 2006
For: U.S. Patent No. 6,385,622 B1

: DECISION DISMISSING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the June 13, 2006 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 AND 1.183." The petition requests waiver of the formal submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of a proper filing of an identical IDS in a related case.

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

The petition is dismissed as moot.

REVIEW OF FACTS

1. U.S. Patent No. 6,385,622 (the '662 patent) issued on May 7, 2002.

2. The '622 patent claims benefit to US Patent No. 6,408,307 (the '307 patent).[1]

3. U.S. Patent No. 6,415, 291 is a sibling of the '622 patent, which also claims benefit to the '307 patent.

4. A request for reexamination of the '622 patent was filed on September 20, 2006.

[1] US 6,385,622 issued before the '307 patent even though its filing date is later than the '307 patent's filing date.

The request was assigned control No. 90/008,192 (the '8192 reexamination proceeding).

5. A request for reexamination of the '307 patent was filed on December 22, 2006. The request was assigned control No. 90/008,398 (the '8398 reexamination proceeding).

6. A request for reexamination of the '291 patent was filed on November 13, 2006, and accorded a filing date of January 23, 2007. The request was assigned control No. 90/008,329 (the '8329 reexamination proceeding).

7. Reexamination was ordered for the '8192 proceeding on October 28, 2006.

8. Reexamination was ordered for the '8398 proceeding on February 21, 2007.

9. Reexamination was ordered for the '8329 proceeding on April 3, 2007.

10. On June 13, 2007, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 concurrently in the '8192, '8329 and the '8398 proceedings. Copies of references, as required by the cited rules, were filed only in the '8192 proceeding.[2]

11. Concurrent with the June 13, 2007 IDS submissions in the '8192, '8329 and the '8398 proceedings, patent owner filed a petition under 37 CFR 1.182 and 1.183 requesting waiver of the formal reference–copy submission requirements for an IDS under 37 CFR 1.555 and 1.98 by dint of a proper filing of an identical IDS in a related case.

DECISION

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). In the present proceeding, the patent owner has fulfilled the reference–copy submission requirements of 37 CFR 1.98(a) in the '8192 proceeding for which a waiver is sought. Accordingly, the petition is dismissed as moot. No fee is due, and none will be charged.

This decision does not constitute an acknowledgement that patent owner's June 13, 2007 submission complies with all the requirements of the relevant rules. The examiner of record will make such a determination once jurisdiction is returned.

[2] a total of approximately twenty (20) bankers boxes of references.

ADDITIONAL DISCUSSION

EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future, as references could be scanned in and electronically submitted directly into each case.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the reference–copy submission requirements of 37 CFR 1.555, 1.97 and 1.98 is dismissed as moot.

2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers at the point when there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

3. Telephone inquiries with regard to this decision should be directed to 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

7-31-07
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MAR 25 2009

CENTRAL REEXAMINATION UNIT

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Washington, D.C. 2005

(Courtesy Copy)

In re Bouve et al.	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No. 90/008,192	:	**DISMISSING**
Filed: September 20, 2006	:	**PETITION**
For: U.S. Patent No. 6,385,622	:	

This is a decision on the patent owner petition, filed January 30, 2009, denominated "Petition Under 37 CFR § 1.183" requesting waiver of the signature of an unwilling inventor on a declaration under 37 CFR 1.131 and acceptance of the declaration under 37 CFR 1.131 without execution by all of the named inventors.

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 petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is **dismissed**. However, for reasons detailed below, the declaration under 37 CFR 1.131 will be accepted for entry as submitted.

REVIEW OF FACTS

1. On May 7, 2002, U.S. Patent No. 6,385,622 (the '622 patent) issued from application serial no. 09/816,626 (the '626 application) to Bouve et al. with 63 claims.

2. The patent does not list an assignee on its face. However, the assignee is listed as Civix-DDI, LLC, based on the recorded assignment documents for the parent application of the '626 application.

3. On August 25, 2006, a third party requester, Yahoo!, deposited an incomplete request for *ex parte* reexamination of claims 1, 2, 6-9, 11-21, 23-34, 38, 41-47, and 52-63 of the '622 patent, which was assigned control no. 90/008,192 (the '8192 proceeding). A corrected request was filed September 20, 2006, and afforded a filing date.

4. A concurrent litigation in the U.S. District Court, N. District of Illinois, styled *Civix-DDI, LLC v. National Association of Realtors et al.*, No. 05 C 06869, is now stayed pending reexamination of the '622 patent and other related patents. Third party requestor, Yahoo!, is a defendant in the suit.

5. On October 28, 2006, an order granting the reexamination request was mailed.

6. A non-final Office action was mailed March 28, 2008, in which claims 1, 2, 6-9, 11-21, 25-34, 38, 41-47, and 52-63 were rejected.

7. An interview was held on May 2, 2008, and a subsequent response was filed May 28, 2008, along with a declaration under 37 CFR 1.132.

8. On November 19, 2008, a final rejection was mailed.

9. On November 26, 2008, a power of attorney revoking the previous power of attorney and appointing new counsel was filed, and on December 2, 2008, a statement under 37 CFR 3.73(b) establishing that the present assignee has the authority to act in this proceeding was filed. The power of attorney was filed by one of the co-inventors as "manager" of the assignee, and the statement under 37 CFR 3.73(b) was filed by the new counsel as authorized to act on behalf of the assignee.

10. An interview with the examiner was held on December 9, 2008, and a subsequent response was filed on January 21, 2009. The January 21, 2009, response was filed with two declarations, one styled an "Internet" Declaration and the other styled as a Declaration Under 37 CFR 1.131 ("the rule 131 declaration"). A petition under 37 CFR 1.183 was submitted with the rule 131 declaration requesting that the provisions of 37 CFR 1.131 requiring execution of the declaration by all named inventors be waived and the declaration be accepted as filed. A corrected petition under 37 CFR 1.183, which was submitted to replace the January 21, 2009 petition and is the subject of this decision, was filed January 30, 2009.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.131(a) provides, in pertinent part (emphasis added):

> When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, **the owner of the patent under reexamination**, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. [Emphasis added.]

37 CFR 1.183 provides, in pertinent part:

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

MPEP 715.04 I. provides, in pertinent part (emphasis added):

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s)**. Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. [Emphasis added.]

37 CFR § 1.47 Filing when an inventor refuses to sign or cannot be reached:

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § **1.17(g)**, and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § **1.63**.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § **1.17(g)**, and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § **1.63**.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

37 CFR § 3.73 Establishing right of assignee to take action:

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.
(b) (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § **3.11** in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § **3.11**; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

ANALYSIS AND FINDINGS

Patent owner requests that the signature of one of the inventors, Steve W. Oxman, be waived for a declaration under 37 CFR 1.131, which has been submitted with signatures of the other two inventors, William T. Semple and W. Lincoln Bouve. Addressing the substance of the petition, it is pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. See, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, an alternative avenue that complies with the rules is available to obtain the requested relief.

37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination. . .* may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). As pointed out in MPEP 715.04 I.(D), an assignee, or other party in interest is permitted to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is asserted in the case here. In accordance with the language of 37 CFR 1.131, the assignee may make the declaration for a patent under reexamination, even if the inventors are available to sign a declaration. In this case, the inventors, rather than the patent owner, have attempted to submit a declaration under 37 CFR 1.131. Thus, as this avenue for relief is available to patent owner, waiver of the rule is not required.

It is noted that the declaration has in fact been signed by an authorized agent of the assignee, who is also one of the inventors, William T. Semple. Mr. Semple signed the power of attorney as "manager" for the assignee, and a proper statement under 37 CFR 3.73(b) has been filed establishing the authority of the assignee to act in this proceeding. Thus, the rule 131 declaration has been signed by the assignee, albeit without expressly noting Mr. Semple's capacity as an authorized agent. Although Mr. Semple has not expressly signed in this capacity, the record is clear in terms of his authority to make the declaration for the assignee. To avoid unnecessary delay, the rule 131 declaration as signed will be accepted and will be entered in the proceeding.

In summary, the petitioner has not shown the present situation to be one warranting extraordinary relief and for that reason the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed. However, as the rule 131 declaration has been signed by a person authorized to act on behalf of the assignee, it will be entered in the proceeding.

PATENT OWNER'S ADDRESS

The patent owner is reminded to update the correspondence address in the patent file based on the change in power of attorney in this proceeding. The Office will not engage in double correspondence with more than one attorney or agent. See 37 CFR 1.33(c). It is recommended that Form PTO/SB/123 be used for this purpose.

CONCLUSION

1. For the reasons set forth above, the petition under 37 CFR 1.183 to waive 37 CFR 1.131 as to its requirement for signature of an oath or declaration is **dismissed**.

2. The declaration under 37 CFR 1.131 will be entered in the proceeding. This decision does not address the merits of the patent owner's response or the substance of the declaration, which are determinations within the jurisdiction of the examiner of record.

3. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for entry of the declaration and any further examination as appropriate.

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

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

March 24, 2009

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Reexam Control No.: 90/007,026
Filed : May 4, 2004
For U.S. Patent No. : 6,712,847

Reexam Control No.: 90/008,195
Filed : August 25, 2006
For U.S. Patent No. : 6,712,847

Reexam control No. : 90/008,415
Filed : January 12, 2007
For U.S. Patent No. : 6,712,847

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. 90/007,026 was ordered in a decision mailed July 2, 2004. Prosecution has proceeded to the mailing of a decision granting a petition for entry of late papers on July 30, 2007. The paper that was entered was filed February 20, 2007 and it is an amendment to the claims wherein original claims 1, 2, and 4 are amended and new claims 7-9 presented.

Reexamination in application control No. 90/008,195 was ordered in a decision mailed October 20, 2006. No Patent Owner's statement under the provisions of 37 CFR § 1.530 (c) and (d) has been filed and no Office action has been issued in this proceeding. There have been no amendments to the claims, specification and drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,415 was ordered in a decision mailed February 28, 2007. No Patent Owner's statement under the provisions of 37 CFR § 1.530 (c) and (d) has been filed and no Office action has been issued in this proceeding. There have been no amendments to the claims, specification and drawings in this reexamination proceeding.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR § 1.565(c)). In view of the above, merger is appropriate and is hereby ordered.

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

As noted above, the claims have been amended in the '026 reexamination proceeding by virtue of the amendment filed February 20, 2007. No amendments have been filed in the '195 and '415 proceedings. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the three files**. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

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

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

Conclusion

Reexamination Control Nos. 90/007,026, 90/008,195 and 90/008,415 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files.** Upon receipt of the response, an Office action will issue in due course.

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

Andrés Kashnikow

for

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,196	08/28/2006	6009488	17774-010LL1	7379

26568 7590 10/12/2007

COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD
SUITE 2850
200 WEST ADAMS STREET
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/12/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,106	06/30/2006	6009488	0298-0001.03	9951

26568 7590 10/12/2007

COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD
SUITE 2850
200 WEST ADAMS STREET
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/12/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Eugene M. Cummings
Cook, Alex, McFarron, Manzo, Cummings & Mehler, Ltd.
200 West Adams Street, Suite 2850
Chicago, IL 60606

(For Patent Owner Requester)

MAILED

OCT 12 2007

CENTRAL REEXAMINATION UNIT

Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Third Party Requester)

In re Kavipurapu Reexamination Proceeding Control No. 90/008,106 Request Deposited: June 30, 2006 For: U.S. Patent No. 6,009,488	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Kavipurapu Reexamination Proceeding Control No. 90/008,196 Request Deposited: August 28, 2006 For: U.S. Patent No. 6,009,488	

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. 6,009,488 (hereinafter, the '488 patent), issued to Kavipurapu, on December 28, 1999.

2. On June 30, 2006, Patent Owner deposited a Request for *Ex Parte* Reexamination of claims 1-13 of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,106 (hereinafter, the '8106 proceeding).

3. The Reexamination Order was granted in the '8106 proceeding on August 22, 2006.

4. There are currently no amendments in the '8106 proceeding.

5. On August 28, 2006, a third party deposited a Request for *Ex Parte* Reexamination of claims 1, 2, 3, and 6 of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,196 (hereinafter, the '8196 proceeding).

6. The Reexamination Order was granted in the '8196 proceeding on October 20, 2006.

7. There are currently no amendments in the '8196 proceeding.

8. The '8106 and the '8196 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 '8106 and the '8196 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. 90/008,106 and 90/008,196 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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

JUN 19 2008

CENTRAL REEXAMINATION UNIT

Eugene M. Cummings, P.C.
One North Wacker Drive
Suite 4130
Chicage, IL 60606

(For Patent Owner)

Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Third Party Requester)

Perkins Coie LLP
Patent-Sea
P.O. Box 1247
Seattle, WA 98111-1247

(For Third Party Requester)

In re Kavipurapu
Reexamination Proceeding
Control No. 90/008,106
Request Deposited: June 30, 2006
For: U.S. Patent No. 6,009,488

In re Kavipurapu
Reexamination Proceeding
Control No. 90/008,196
Request Deposited: August 28, 2006
For: U.S. Patent No. 6,009,488

In re Kavipurapu
Reexamination Proceeding
Control No. 90/009,098
Request Deposited: March 26, 2008
For: U.S. Patent No. 6,009,488

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).

Copied from 90008106 on 06/25/2008

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,009,488 (hereinafter, the '488 patent), issued to Kavipurapu, on December 28, 1999.

2. On June 30, 2006, patent owner deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,106 (hereinafter, the '8106 proceeding).

3. The Reexamination Order was granted in the '8106 proceeding on August 22, 2006.

4. On August 28, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,196 (hereinafter, the '8196 proceeding).

5. The Reexamination Order was granted in the '8196 proceeding on October 20, 2006.

6. The '8106 and the '8196 proceedings were merged on October 12, 2007.

7. A non-final office action was mailed on October 29, 2007.

8. A response was filed on December 27, 2007, and a supplemental response was filed on January 21, 2008, including an amendment to the claims.

9. On March 26, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/009,098 (hereinafter, the '9098 proceeding).

10. The Reexamination Order was granted in the '9098 proceeding on May 15, 2008.

11. Patent Owner waived the right to file a statement under 37 CFR 1.530 on June 2, 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.

Copied from 90008106 on 06/25/2008

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 '8106, '8196, and '9098 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.

As noted above, the claims have been amended in the '8106 and '8196 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

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.

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CONCLUSION

1. Reexamination Control Nos. 90/008,106, 90/008,196, and 90/009,098 are **merged**.

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

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

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Eric Keasel For

Lissi Mojica Marquis
Director, Central Reexamination Unit

Copied from 90008106 on 06/25/2008

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

BRINKS HOFER GILSON & LIONE (For Patent Owner)
P.O. BOX 10395
CHICAGO IL 60610

Enclosure: Copy of Third Party Requester's November 17, 2006 petition.

John A. Kramer (For Third Party Requester)
McCORMICK, PAULDING & HUMBER LLP
185 ASYLUM STREET
HARTFORD, CT 06103

MAILED

NOV 24 2006

CENTRAL REEXAMINATION UNIT

Enclosure: Third Party Requester's November 17, 2006 petition.

In re PEOT et al	:
Ex Parte Reexamination Proceeding	:
Control No.: 90/008,197	: **DECISION DISMISSING**
Filed: October 20, 2006	: **AND RETURNING**
For: U.S. Patent No. 6,755,107	: **PETITION**
	:

This is a decision on the November 17, 2006 third party requester petition entitled "PETITION TO DISMISS OR WITHDRAW REEXAMINATION REQUEST."

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

The petition does not assert a regulatory basis for the requested relief; and, the basis for the relief requested is 37 CFR 1.182. [1] The petition fee that is required under 37 CFR 1.182 and 37 CFR 1.17(f) is $400.00. Pursuant to the instructions on the second page of the petition (to charge applicable fees), petitioner's Deposit Account No. 13-0235 is being charged to cover the petition fee.

The petition is dismissed and is being returned to the requester for the reasons pointed out below.

[1] 37 CFR 1.182 states:
"All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, 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 RETURNING IMPROPER SUBMISSION

The present petition for dismissal or withdrawal of the reexamination request filed October 20, 2006, is being returned with this decision, since the request is an improper submission:

1. Pursuant to the second sentence of 37 CFR 1.540:

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

Under 37 CFR 1.540, the present petition does not have an entry right, since it is not a statement under 37 CFR 1.530, nor is it a reply under 37 CFR 1.535, and it has been filed prior to the start of *ex parte* examination on the merits. It is also to be noted that, except for the right to file a reply under 37 CFR 1.535 where appropriate, a third party requester has no right to comment or participate in a reexamination proceeding.

2. As to third parties in general, 37 CFR 1.550 provides:

> (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 petition is not entitled to entry under 37 CFR 1.550, as a submission by a third party in general, since it is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, it is not a reply to a patent owner's statement pursuant to 37 CFR 1.535, and it does not qualify as a prior art citation under 37 CFR 1.501.

3. Accordingly, the present petition does not have an entry right under the rules, it will not be made of record in the reexamination file, and it is being returned with this decision. See MPEP 2267. This decision returning the improper petition submission is, however, being made of record in the reexamination file.

ADDITIONAL DISCUSSION

The third party requester has not requested the waiver of any regulation precluding entry of the present petition; however, no such waiver would be appropriate even if requested. Neither the statute, nor the rules, provide for the withdrawal of a request for reexamination that is presently sought. In fact, no withdrawal of a request for reexamination is possible. As stated in MPEP 2210:

> After the request for reexamination, including the entire fee for requesting reexamination is received in the Office, no abandonment, withdrawal or striking of the request is possible, regardless of who requests the same.

See also *Joy Manufacturing Co. v National Mine Service Co,* 810 F.2d 1127 (Fed. Cir. 1987), where the court stated:

> In this connection, we also note that the principal relief which Joy seeks -- namely, stopping the re-examination of its patent -- is not available in these proceedings. Accord Manual of Patent Examining Procedure § 2210 (5th ed. 1983);

The statement in MPEP 2210 is grounded upon the following analysis:

35 U.S.C. § 302 states, in pertinent part:

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. § 303(a) states, in pertinent part:

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director **will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request**, with or without consideration of other patents or printed publications. ... **On his own initiative, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title**.
> (Emphasis supplied.)

35 U.S.C. § 304 states, in pertinent part:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination **will include an order for reexamination of the patent for resolution of the question**.
> (Emphasis supplied.)

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

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination **will** be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. ... In any reexamination proceeding under this chapter, **the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto**, ... (Emphasis supplied.)

35 U.S.C. §§ 302–305 provide, *inter alia*, that when a request for reexamination is filed, the Director <u>will</u> determine whether a substantial new question of patentability exists. [2] Thereafter, if the Director has determined that a substantial new question of patentability exists, that determination <u>will</u> include an order for reexamination of <u>the patent</u>. [3] Thereafter, reexamination <u>will</u> be conducted, and patent owner <u>will</u> be permitted to amend <u>his patent</u> and a new claim or claims <u>thereto</u>. [4]

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[2] 35 U.S.C. § 303
[3] 35 U.S.C. § 304
[4] 35 U.S.C. § 305

A request to withdraw an *ex parte* reexamination request is not permitted in view of that enacted legislation and the implementing rules which require that (1) once an *ex parte* reexamination request is filed, it will be decided, and (2) once the request is determined to raise a substantial new question of patentability of a claim of the patent, the request *will* result in an order for reexamination to resolve the substantial new question, which in turn *will* be followed by reexamination in accordance with 35 U.S.C. §§ 303-305.

The statutory language is based on the public interest in resolving any reexamination proceeding that is filed. Withdrawal of a third party requested reexamination proceeding would leave both the public and the patent owner with an unresolved request for reexamination. Both the public and the patent owner have a right to such a resolution. Further, in the event a substantial new question of patentability is raised by the request, the patent owner has a statutory right to have that question resolved, including amending the patent as patent owner deems necessary. All of this would be abrogated by "withdrawing" or otherwise "abandoning" or "terminating" a reexamination.

It is finally to be noted that, even **if** a reexamination request could be withdrawn, the Director is authorized under 35 U.S.C. § 303(a) to order reexamination on his own initiative, based on any substantial new question of patentability which might be raised by such a request. [5] As a matter of administrative convenience, the Office need not, and does not, expend the additional resources needed to terminate one reexamination proceeding only to institute (on its own initiative) another one based on the same substantial new question of patentability that exists in a reexamination sought to be withdrawn.

SERVICE

Under 37 CFR 1.550(f):

> After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

A review of the petition paper filed on November 17, 2006, shows that it does not reflect service on the patent owner as required by 37 CFR 1.550(f). A certificate of service for the third party requester petition paper filed November 17, 2006, has not been found present as part of the paper. Accordingly, a copy of the November 17, 2006, petition paper is being supplied to patent owner with this decision.

In the future, any submission by the third party requestor for the present reexamination proceeding must be served on the patent owner, and such service evidenced by the inclusion of a certificate of service on the patent owner.

CONCLUSION

1. The third party requester petition filed November 17, 2006, is <u>dismissed</u> as not having an entry right.

---

[5] And such would serve the public interest on which the Director-initiated-reexamination enactment is grounded.

2. The November 17, 2006 petition is being returned to the requester with the present decision.

3. A copy of the November 17, 2006 petition is being provided to the patent owner with the present decision.

4. No copy of the petition will be maintained in the electronic Image File Wrapper, or elsewhere in the Office.

5. A copy of this decision will be made of record in the electronic Image File Wrapper for the present reexamination proceeding.

6. The present *ex parte* reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit, for appropriate action in due course.

7. Telephone inquiries related to the present decision should be directed to the undersigned at 571-272-7710.

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

C:\kiva\kenWD\ 8197 Withdraw Request.doc
November 21, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,198	10/13/2006	6778717		2014

23409 7590 06/03/2008

MICHAEL BEST & FRIEDRICH LLP
100 E WISCONSIN AVENUE
Suite 3300
MILWAUKEE, WI 53202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/03/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Michael Best & Friedrich LLP
100 E Wisconsin Ave.
Suite 3300
Milwaukee, WI 53202

(For Patent Owner)

MAILED

JUN 03 2008

CENTRAL REEXAMINATION UNIT

In re: Tapanes *et alia*
Reexamination Proceeding
Control No. 90/008,198
Corrected Request Deposited: October 13, 2006
For: U.S. Patent No. 6,778,717

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

This is a decision on the May 30, 2008, "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 CFR 1.550(c)" requesting that the time to submit a Patent Owner response be extended an additional two months.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,778,717 (hereinafter, the '717 patent), issued to Tapanes *et alia*, August 17, 2004.

2. On September 1, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '717 patent. The reexamination proceeding was assigned Control No. 90/008,198 (hereinafter, the '8198 proceeding). Said request was held to be non-compliant. A corrected request was filed on October 13, 2006.

3. The reexamination order was granted in the '8198 proceeding on December 7, 2006.

4. A non-final rejection was mailed on April 11, 2008 setting a two-month period for response.

5. A petition for extension of time was filed on May 30, 2008 requesting an additional two months.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the non-final office action mailed April 11, 2008. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on May 30, 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.

The request alleges "[t]he Examiner's rejections...gloss over fundamental deficiencies in the cited references...there is critical need to thoroughly address the Examiner's misplaced concerns, which span over twenty pages."

Reference is made to the petition for details of these and other issues.

On balance it is considered that the petition does not explain the "sufficient cause" for an extension of time. If the deficiencies in the references are as fundamental as alleged, there does not appear to be any need for additional time to respond. Furthermore, the office action is only

16 pages in length (not "over twenty" as alleged in the request for extension of time). The office action is relatively short and there does not appear to be sufficient cause for the relief requested.

CONCLUSION

1. Petitioner's request is dismissed. The period during which Patent Owner may file a response remains two months from the mailing of the non-final rejection of April 11, 2008.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,199	10/13/2006	6621947		2013

23409 7590 06/03/2008

MICHAEL BEST & FRIEDRICH LLP
100 E WISCONSIN AVENUE
Suite 3300
MILWAUKEE, WI 53202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/03/2008

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

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MAILED
JUN 03 2008
CENTRAL REEXAMINATION UNIT

Michael Best & Friedrich LLP
100 E Wisconsin Ave.
Suite 3300
Milwaukee, WI 53202

(For Patent Owner)

In re: Tapanes *et alia*
Reexamination Proceeding
Control No. 90/008,199
Corrected Request Deposited: October 13, 2006
For: U.S. Patent No. 6,621,947

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

This is a decision on the May 30, 2008, "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 CFR 1.550(c)" requesting that the time to submit a Patent Owner response be extended an additional two months.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,621,947 (hereinafter, the '947 patent), issued to Tapanes *et alia*, September 16, 2003.

2. On September 1, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '947 patent. The reexamination proceeding was assigned Control No. 90/008,199 (hereinafter, the '8199 proceeding). Said request was held to be non-compliant. A corrected request was filed on October 13, 2006.

3. The reexamination order was granted in the '8199 proceeding on December 7, 2006.

4. A non-final rejection was mailed on April 11, 2008 setting a two-month period for response.

5. A petition for extension of time was filed on May 30, 2008 requesting an additional two months.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the non-final office action mailed April 11, 2008. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on May 30, 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.

The request alleges "[t]he Examiner's rejections...gloss over fundamental deficiencies in the cited references...there is critical need to thoroughly address the Examiner's misplaced concerns, which span over twenty pages."

Reference is made to the petition for details of these and other issues.

On balance it is considered that the petition does not explain the "sufficient cause" for an extension of time. If the deficiencies in the references are as fundamental as alleged, there does not appear to be any need for additional time to respond. Furthermore, the office action is

relatively short at 24 pages, which include many portions, that Patent Owner presumably will not rebut (e.g. the confirmation of certain claims).

CONCLUSION

1. Petitioner's request is dismissed. The period during which Patent Owner may file a response remains two months from the mailing of the non-final rejection of April 11, 2008.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,202	08/30/2006	7008396	PRES06-00396	5546

7590 04/15/2008

Thomas M. Saunders
BROWN RUDNICK BERLACK ISRAELS
One Financial Center
18th Floor
Boston, MA 02111

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

William A. Munck

Munck Butrus P.C.

P.O. Drawer 800889

Dallas, TX 75380

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008202

PATENT NO. 7,008,396

ART UNI 3999

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 :

Thomas M. Saunders
Seyfarth Shaw LLP
Two Seaport Lane
Suite 300
Boston, MA 02210-2028

(for Patent Owner)

William A Munck
Munck Butrus, P.C.
P.O. Drawer 800889
Dallas, TX 75380

(for Third Party Requester)

In re Straub
Reexamination Proceeding
Control No.: 90/008,202
Filed: August 30, 2006
For: U.S. Patent 7,008,396

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Straud
Reexamination Proceeding
Control No.: 90/008,315
Filed: November 03, 2006
For: U.S. Patent 7,008,396

The above noted reexamination files are before the Director of Technology Center 3900 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 7,008,396, issued March 7, 2006, is the subject of Reexamination Control Nos. 90/008,202 and 90/008,315.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,202 ('8202), was filed August 30, 2006 by William A. Munck of Munck Butrus, P.C. in Dallas, TX on behalf of Refocus Group, Inc. also in Dallas, TX. The request urged that a substantial new question of patentability was raised by the teachings of U.S. Patent No. 6,280,468 to Schachar which was not cited in the prosecution of U.S. Patent No. 7,008,396.

3. Reexamination was ordered for '8202 on November 6, 2006.

4. A second request for reexamination, assigned Reexamination Control No. 90/008,315 ('8315), was filed November 3, 2006 by William A. Munck of Munck Butrus, P.C. in Dallas TX on behalf of Refocus Group, Inc. also in Dallas, TX. The request urder that a substantial new question of patentability was raised by the teachings of U.S.

Patent Publication No. 2005/0283233 to Schachar which was not cited in the prosecution of U.S. Patent No. 7,008,396.

5. Reexamination was ordered for '8315 on January 30, 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 90/008,202 and 90/008,315 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 No. 90/008,315 as:

Reexamination Control Ns. 90/008,202 and 90/008,315

Thomas M. Saunders
Seyfarth Shaw LLP
Two Seaport Lane
Suite 300
Boston, MA 02210-2028

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/008,202 and 90/008,315 as:

William A. Munck
Munck Brutus, P.C.
P.O. Drawer 800889
Dallas, TX 75380

CONCLUSION

Reexamination Control Nos. 90/008,202 and 90/008,315 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

Lissi M. Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,204	10/26/2006	4924078	10287.8051-0000	7895

7590 03/21/2008

STAAS & HALSEY
1825 K STREET, N.W.
SUITE 816
WASHINGTON, DC 20006

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
FINNEGAN, HENDERSON, FARROW, GARRETT & DUNNER
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Date: MAILED

MAR 21 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008204
PATENT NO. : 4924078
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.
90/008,204	10/26/2006	4924078	10287.8051-0000	7895

7590 03/21/2008

STAAS & HALSEY
1825 K STREET, N.W.
SUITE 816
WASHINGTON, DC 20006

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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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

FINNEGAN, HENDERSON, FARROW, GARRETT & DUNNER
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008204
PATENT NO. : 4924078
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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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(for Patent Owner)

MAILED

MAR 21 2008

CENTRAL REEXAMINATION UNIT

Charles E. Van Horn, Esq.
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(for third
Party 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. 90/008,204
Deposited: 26 Ocyober 2006
For: US Patent No. 4,924,078

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

mas

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Daniel E. Venglarik
Munck Butrus PC
13155 Noel Road
900 Three Galleria Tower
Dallas, TX 75240

(For Patent Owner)

MAILED

MAR 08 2007

CENTRAL REEXAMINATION UNIT

Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109

(For Requester)

In re: Goodenough et al.
Reexamination Proceeding
Control No. 90/008,207
For: U.S. Patent No. 5,910,382

: DECISION ON
: PETITION UNDER
: 37 CFR § 1.181
:

For the reasons set forth below, the petition is denied, and the filing date given to the request for *ex parte* reexamination dated September 11, 2006 will not be vacated. The matter is before the Director of the Central Reexamination Unit for consideration of whether or not to vacate the filing date and to terminate the preprocessing of the *ex parte* reexamination proceeding for failure to comply with the provisions of 37 CFR 1.510.

REVIEW OF FACTS

1. U.S. Patent No. 5,910,382 (hereinafter, the '382 patent), issued to Goodenough et al., on June 8, 1999, from an application filed on April 21, 1997.

2. A third party requested *ex parte* reexamination of the '382 patent pursuant to 37 CFR 1.510, on September 11, 2006. The reexamination proceeding was assigned Control No. 90/008,207 (hereinafter, the '8207 proceeding).

3. On October 26, 2006, an order granting reexamination of claims 1-9 of the '382 patent was issued.

4. On December 29, 2006, patent owner filed a "Petition under 37 CFR § 1.181" to petition the Director to invoke his supervisory authority to reverse the decision according a filing date to the reexamination request of September 11, 2006, and to set aside the order granting reexamination issued on October 26, 2006.

DECISION

Petitioner argues that the filing date granted to the reexamination request of September 11, 2006 should be vacated based upon the fact that a similarly formatted request filed in another reexamination proceeding 90/008.205 received a "Notice of Failure to Comply With *Ex Parte* Reexamination Request Filing Requirements (37 CFR 1.510(c))." Petitioner advances that the request filed on September 11, 2006 in this reexamination proceeding is similarly defective in that it lacks statements of proposed rejections and statements explaining the substantial new question of patentability.

In response to petitioner arguments, every reexamination proceeding is reviewed for compliance with 35 CFR 1.510 on its own merits. In other words, the noncompliance of the original request submitted in reexamination proceeding 90/008,205 is not relevant as to whether the request submitted in this '8207 proceeding is compliant with 37 CFR 1.510.

Under 35 U.S.C. 304, the Office must determine whether "a substantial new question of patentability" affecting any claim of the patent has been raised. 37 CFR 1.510(b)(1) requires that a request for ex parte reexamination include "a statement pointing out each substantial new question of patentability based on prior patents and printed publications." If such a new question is found, an order for ex parte reexamination of the patent is issued. It is therefore important that the request clearly set forth in detail what the requester considers the "substantial new question of patentability" to be in view of prior patents and printed publications. See MPEP 2216

The third sentence of 35 U.S.C. 302 indicates that the "request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination

is requested." 37 CFR 1.510(b)(2) requires that the request include "[a]n identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested." See MPEP 2217.

The request filed on September 11, 2006 in the '8207 proceeding clearly sets forth in detail what the requester considers to be the substantial new questions of patentability and provides a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested on pages 3-36 of the request and in appendix E. The request clearly explains how each reference applies to the claimed elements of the invention, and provides an appropriately detailed claim chart in appendix E attached to the request, which compares limitation by limitation, each claim for which reexamination is requested with the relevant teachings of each cited reference. Although there might not be an explicit statement of a proposed rejection for the application of each reference to each claim, it is clear from the detailed explanation what the proposed rejections are for each claim.

Accordingly, the filing date given to the request for *ex parte* reexamination dated September 11, 2006 will not be vacated because the request filed on September 11, 2006 is deemed to have complied with 37 CFR 1.510.

CONCLUSION

1. The filing date granted to *Ex parte* reexamination proceeding Control No. 90/008,207 is maintained.

2. The petition under 37 CFR 1.181 is denied.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Special Program Examiner, at (571) 272-1535, or in her absence, to Jeanne Clark, at (571) 272-7714.

Lissi Mojica Marquis
Director
Central Reexamination Unit

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Merchant & Gould PC P.O. Box 2903 Minneapolis, MN 55402-0903	:	For Patent Owner
Bradley J. Thorson Patterson Thuente Skarr & Christensen PA 4800 IDS Center 80 south 8th Street Minneapolis, MN 55402	:	For Requester
In re Woolford et al. *Ex Parte* Reexamination Proceeding Control No. 90/008,210 Filed: September 6, 2006 For: US Patent No. 6,142,713	:	DECISION DENYING PETITION UNDER 37 CFR 1.515(c)

MAILED

DEC 19 2006

CENTRAL REEXAMINATION UNIT

This is a decision on the November 13, 2006, "Petition Under 37 CFR 1.515(c)." Petitioner, the Third Party Requester, requests that the decision denying the request for reexamination of US Patent 5,827,015 be reversed.

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 September 6, 2006, a third party REQUEST FOR *EX PARTE* REEXAMINATION of U.S. Patent No. 5,827,015 was filed, the fourth such request for reexamination of the instant patent. The request cited Swiss patent CH 663,437 to Schiffer as raising substantial new questions of patentability in regards to claims 1-51 of the instant patent, alone or in combination with a variety of secondary references. The request also asserted that affidavits submitted by Patent Owner under 35 USC 132 in a previous reexamination proceeding (90/007,385) of the instant patent were insufficient as a matter of law.

2. On October 20, 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 references had already been considered in the previous reexamination proceeding (90/007,385), (or in the case of some of the secondary references were merely cumulative to art previously considered) and thus the same question of patentability had already been decided by the Office. The examiner also remarked that consideration of the submitted affidavits was appropriate.

3. On November 13, 2006, the present petition was filed.

Decision

A petition filed under 37 CFR 1.515(c), requesting that the examiner's decision denying the request for reexamination be reversed, is decided by the Central Reexamination Unit (CRU) Director. The Manual of Patent Examining Procedure 2248 further states that the CRU's Director's review will be *de novo.*

Requester raises four points in the petition, those being briefly:

1. The commercial success evidence submitted in the previous reexamination (90/007,385) was fatally defective.
2. Commercial success now relied upon is contradicted by the existing evidence.
3. Patent Owner has presented no 'legally competent secondary consideration evidence.
4. The denial was based on an overly narrow view of Schiffer.

As for the first and third points, neither are a valid reason to grant a request for reexamination. Reexamination is conducted on the basis of prior art which raises a substantial new question of patentability. A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996). MPEP 2242(II). Also, in *ex parte* reexamination, "the active participation of the *ex parte* reexamination requester ends with the reply pursuant to §1.535" (37 CFR 1.550(g)). In the instant case, requester's points one and three above relate solely to an issue which was raised and decided in the previous reexamination proceeding (90/007,385). As such they cannot be considered as raising a substantial *new* question of patentability. Granting a reexamination on this basis would be tantamount to allowing requester's active participation in the previous reexamination proceeding simply by deeming it a new proceeding. Under such a system, any decision of the Office with which a requester disagreed could form the basis for a subsequent reexamination proceeding. The Office declines to institute such a system.

As to the third point, requester appears to misunderstand the examiner's position. The order denying reexamination did not state that commercial success hinged upon the planar upper and lower surfaces and sidewall surfaces being solid and continuous. It simply stated that since Schiffer did not disclose these features then consideration of secondary considerations and evidence of non-obviousness was appropriate. Naturally, in any obviousness analysis, evidence of non-obviousness must be considered. Again, the issue of commercial success was dealt with in the previous reexamination proceeding, and requester's criticism of the Office's acceptance of the provided evidence cannot be considered a substantial *new* question of patentability.

As for the fourth point, requester appears to be attempting to view Schiffer in a "new light" in an attempt to raise a substantial new question of patentability. However, it is evident from the petition that requester's position is based on an attempt to interpret the reference's specification in light of its claims, which is improper. Claims are legal statements which define a patentee's rights; they are not disclosures of inventions. A reasonable examiner would not consider the omission of a feature from a reference patent's claim to be materially important to the interpretation of that reference's disclosure. No substantial new question of patentability is seen in requester's forced interpretation of Schiffer, particularly given that the reference was applied against the claims in the previous reexamination proceeding (90/007,385) under 35 USC 103 (a rejection which was subsequently dropped).

Conclusion

No substantial new question of patentability affecting at least one claim of U.S. patent 5,827,015 has been presented by requester for the reasons set forth above.

The petition is **DENIED**.

This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

glm

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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.

Deborah Jones

Lissi M. Marquis, Director
Central Reexamination Unit

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Merchant & Gould PC P.O. Box 2903 Minneapolis, MN 55402-0903	:	For Patent Owner
Bradley J. Thorson Patterson Thuente Skarr & Christensen PA 4800 IDS Center 80 south 8th Street Minneapolis, MN 55402	:	For Requester
In re Woolford et al. *Ex Parte* Reexamination Proceeding Control No. 90/008,218 Filed: September 6, 2006 For: US Patent No. 5,827,015	:	DECISION DENYING PETITION UNDER 37 CFR 1.515(c)

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CENTRAL REEXAMINATION UNIT

This is a decision on the November 13, 2006, "Petition Under 37 CFR 1.515(c)." Petitioner, the Third Party Requester, requests that the decision denying the request for reexamination of US Patent 5,827,015 be reversed.

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 September 6, 2006, a third party REQUEST FOR *EX PARTE* REEXAMINATION of U.S. Patent No. 5,827,015 was filed, the fourth such request for reexamination of the instant patent. The request cited Swiss patent CH 663,437 to Schiffer as raising substantial new questions of patentability in regards to claims 1-51 of the instant patent, alone or in combination with a variety of secondary references. The request also asserted that affidavits submitted by Patent Owner under 35 USC 132 in a previous reexamination proceeding (90/007,385) of the instant patent were insufficient as a matter of law.

2. On October 20, 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 references had already been considered in the previous reexamination proceeding (90/007,385), (or in the case of some of the secondary references were merely cumulative to art previously considered) and thus the same question of patentability had already been decided by the Office. The examiner also remarked that consideration of the submitted affidavits was appropriate.

3. On November 13, 2006, the present petition was filed.

Decision

A petition filed under 37 CFR 1.515(c), requesting that the examiner's decision denying the request for reexamination be reversed, is decided by the Central Reexamination Unit (CRU) Director. The Manual of Patent Examining Procedure 2248 further states that the CRU's Director's review will be *de novo.*

Requester raises four points in the petition, those being briefly:

1. The commercial success evidence submitted in the previous reexamination (90/007,385) was fatally defective.
2. Commercial success now relied upon is contradicted by the existing evidence.
3. Patent Owner has presented no 'legally competent secondary consideration evidence.
4. The denial was based on an overly narrow view of Schiffer.

As for the first and third points, neither are a valid reason to grant a request for reexamination. Reexamination is conducted on the basis of prior art which raises a substantial new question of patentability. A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996). MPEP 2242(II). Also, in *ex parte* reexamination, "the active participation of the *ex parte* reexamination requester ends with the reply pursuant to §1.535" (37 CFR 1.550(g)). In the instant case, requester's points one and three above relate solely to an issue which was raised and decided in the previous reexamination proceeding (90/007,385). As such they cannot be considered as raising a substantial *new* question of patentability. Granting a reexamination on this basis would be tantamount to allowing requester's active participation in the previous reexamination proceeding simply by deeming it a new proceeding. Under such a system, any decision of the Office with which a requester disagreed could form the basis for a subsequent reexamination proceeding. The Office declines to institute such a system.

As to the third point, requester appears to misunderstand the examiner's position. The order denying reexamination did not state that commercial success hinged upon the planar upper and lower surfaces and sidewall surfaces being solid and continuous. It simply stated that since Schiffer did not disclose these features then consideration of secondary considerations and evidence of non-obviousness was appropriate. Naturally, in any obviousness analysis, evidence of non-obviousness must be considered. Again, the issue of commercial success was dealt with in the previous reexamination proceeding, and requester's criticism of the Office's acceptance of the provided evidence cannot be considered a substantial *new* question of patentability.

As for the fourth point, requester appears to be attempting to view Schiffer in a "new light" in an attempt to raise a substantial new question of patentability. However, it is evident from the petition that requester's position is based on an attempt to interpret the reference's specification in light of its claims, which is improper. Claims are legal statements which define a patentee's rights; they are not disclosures of inventions. A reasonable examiner would not consider the omission of a feature from a reference patent's claim to be materially important to the interpretation of that reference's disclosure. No substantial new question of patentability is seen in requester's forced interpretation of Schiffer, particularly given that the reference was applied against the claims in the previous reexamination proceeding (90/007,385) under 35 USC 103 (a rejection which was subsequently dropped).

Conclusion

No substantial new question of patentability affecting at least one claim of U.S. patent 5,827,015 has been presented by requester for the reasons set forth above.

The petition is **DENIED**.

This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

glm

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Henneman & Associates, PLC
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(For Patent Owner)

JUN 14 2007

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(For 3rd Party Requester)

Michael Hawes
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910 Louisiana
Houston, TX 77002

(For 3rd Party Requester)

Reexam Control No. : 90/008,225
Filed : November 15, 2006
For U.S. Patent No. : 5,784,584

Reexam Control No.: 90/008,299
Filed : October 19, 2006
For U.S. Patent No. : 5,784,584

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. 90/008,225 was ordered in a decision mailed February 12, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/008,299 was ordered in a decision mailed December 22, 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. 90/008,225 and reexamination control No. 90/008,299 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 each of the third party requesters and each 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. 90/008,225 and 90/008,299 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.

Andres Kashnikow

for Lissi Mojica Marquis, Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
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MATTHEW A. SMITH
FOLEY & LARDNER LLP
3000 K STREET NW, SUITE 500
WASHINGTON, DC 20007 (For 3rd Party Requester)

MICHAEL HAWES
BAKER BOTTS L.L.P.
910 LOUISIANA
HOUSTON, TX 77002 (For 3rd Party Requester)

In re Moore et al.
Reexamination Proceeding
Control No.: 90/008,225
Filed: November 15, 2006
For: U.S. Patent No.: 5,784,584

In re Moore et al.
Reexamination Proceeding
Control No.: 90/008,299
Filed: October 19, 2006
For: U.S. Patent No.: 5,784,584

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the June 17, 2009 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this merged reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

BACKGROUND

1. Patent number 5,784,584 (the '584 patent) issued on July 21, 1998.

2. On December 22, 2006, the Office issued an order granting an October 19, 2006 request for reexamination of claim 29 by a third party requester, which was accorded control number 90/008,299.
3. On February 12, 2007, the Office issued an order granting a November 15, 2006 request for reexamination of claim 29 by a third party requester, which was accorded control number 90/008,225.
4. Reexamination Control Numbers 90/008,225 and 90/008,299, addressed to the '584 patent, were merged on June 14, 2007 (the merged '8225/'8299 proceeding).
5. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the merged '8225/'8299 proceeding on April 21, 2009.
6. On April 24, 2009, the '8225/'8299 proceeding was forwarded to the Office of Publications.
7. The instant petition was filed on June 17, 2009, accompanied by an IDS that the patent owner requests the Office to consider.
8. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle), which is currently scheduled for July 21, 2009.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

. . . All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2256 provides, (in part):

. . . Once the reexamination has entered the Reexamination Certificate printing cycle (452 status), 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 printing cycle 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 printing cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its printing 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 printing 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 (see item (A) above) 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 printing cycle for entry and consideration of the information submitted by patent owner. A grantable petition must

provide the requisite showing discussed in this paragraph.
(latter emphasis added)

DECISION

There is no issue fee in reexamination, and, in this instance, the reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present merged proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 has provided such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256, which requires that 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.

In the present instance, the submission fails to satisfy the above-quoted criteria. The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. To the contrary, patent owner merely provides Office actions from applications having a common parent application with the '584 patent. Patent owner submits these documents not out of a belief that the documents would make at least one claim unpatentable, but instead "out of an abundance of caution." Petition at 3. There are no statements by the patent owner that unequivocally state why the art submitted makes at least one claim unpatentable.

Furthermore, patent owner has failed to present a sufficient factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. Patent owner states that the information could not have been presented earlier because of a belief that previous IDS submissions were "believed to be adequate to conform with the duty to disclose." Patent owner's instant submission was stated to be made due to "the recently expanded scope of information required by the recent decisions of the Court of Appeals for the Federal Circuit, and out of an abundance of caution." Neither of these reasons shows why the submission could not have been submitted earlier. Rather, these reasons provide patent owner's rationale for deciding (choosing) not to submit the information earlier. Patent owner has not, for instance, asserted that each of the items in the current submission were unknown or unavailable to the patent owner at an earlier date. Therefore, the petition fails to present a sufficient explanation of why the information submitted could not have been submitted earlier. For these reasons, the petition fails to conform to the requirements set forth in MPEP 2256.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Since it has been required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory provision for special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2256, as reproduced above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on April 21, 2009, and the proceeding has now entered the final stages of the publication process, with the reexamination certificate scheduled to be printed on July 21, 2009. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding and the failure to identify a question of patentability of the claim under reexamination, the present merged reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers.

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

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on June 17, 2009.

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

3. Telephone inquiries related to 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 14, 2009

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.
90/008,227	09/21/2006	6598148	0081-011D3C1X1	6167

40972 7590 10/02/2009

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FOLEY AND LARDNER LLP
3000 K STREET NW
SUITE 500
WASHINGTON, DC 20007

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OCT 02 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,227*.

PATENT NO. *6598148*.

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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SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

WHITE & CASE LLP (For Third Party Requester)
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

In re Moore *et alia* Reexamination Proceeding Control No. 90/008,227 For: U.S. Patent No. 6,598,148	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Moore *et alia* Reexamination Proceeding Control No. 90/010,562 For: U.S. Patent No. 6,598,148	: : : :

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CENTRAL REEXAMINATION UNIT

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. 6,598,148 (hereinafter, the '148 patent), issued to Moore *et alia*, on July 22, 2003.

2. On September 21, 2006, a request for *ex parte* reexamination of the '148 patent was filed. The reexamination proceeding was assigned Control Nos. 90/008,227 (hereinafter, the '8227 proceeding).

3. On November 22, 2006, the reexamination order granting the request in the '8227 proceeding was mailed. There are amendments to the claims in '8227 proceeding.

4. On May 29, 2009, a third party deposited a request for *ex parte* reexamination of the '148 patent. The reexamination proceeding was assigned Control No. 90/010,562 (hereinafter, the '10562 proceeding).

5. On August 20, 2009, the reexamination order granting the request in the '10562 proceeding was mailed. There are no amendments in the '10562 proceeding. Patent owner waived the right to a patent owner statement in a paper filed September 17, 2009.

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 '8227 and '10562 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, claims have been amended in the '8227 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 all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, 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. 90/008,227 and 90/010,562 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.

Eric Keasel
SPE, AU 3992

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.
90/008,229	09/20/2006	5974120	RE-120	6348

35554 7590 04/17/2008

REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES, CA 90069

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/17/2008

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

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WELSH & FLAXMAN LLC

2000 DUKE STREET, SUITE 100

ALEXANDRIA, VA 22314

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,229*.

PATENT NO. *5974120*.

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)).

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

REENA KUYPER, ESQ. BYARD NILSSON, ESQ. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES CA 90069	:	(For Patent Owner)
WELSH & FLAXMAN LLC 2000 Duke Street Suite 100 Alexandria VA 22314	:	(For Third Party Requester)
NOVAK DRUCE & QUIGG, LLP (NDQ Reexamination Group) 1000 Louisiana Street Fifty-Third Floor Houston, TX 77002	:	(For Third Party Requester)
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Katz *Ex Parte* Reexamination Proceeding Control No. 90/008,229 Deposited : 20 September 2006 For: US Patent No. 5,974,120	:	
In re: Katz *Ex Parte* Reexamination Proceeding Control No. 90/010,044 Deposited : 5 November 2007 For: US Patent No. 5,974,120	:	

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).

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.

Since the two proceedings have not been terminated, 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 90/008,229 and 90/010,044 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. 90/008,229 and 90/010,044 are hereby **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, 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

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,229	09/20/2006	5974120	RE-120	6348

35554 7590 04/17/2008

REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES, CA 90069

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/17/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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WELSH & FLAXMAN LLC

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ALEXANDRIA, VA 22314

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,229*.

PATENT NO. *5974120*.

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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Reena Kuyper, Esq.
Byard Nilsson, Esq.
9255 Sunset Boulevard
Suite 810
Los Angeles, CA 90069

(For Patent Owner)

Welsh & Flaxman
2000 Duke Street, Suite 100
Alexandria, VA 22314

(For Third Party Requester)

Novak, Druce, & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester)

In re Katz *et alia*
Reexamination Proceeding
Control No. 90/008,229
Request Deposited: September 20, 2006
For: U.S. Patent No. 5,974,120

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

In re Katz *et alia*
Reexamination Proceeding
Control No. 90/010,044
Request Deposited: November 5, 2007
For: U.S. Patent No. 5,974,120

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. 5,974,120 (hereinafter, the '120 patent), issued to Katz *et alia*, on October 26, 1999.

2. On September 20, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '120 patent. The reexamination proceeding was assigned Control No. 90/008,229 (hereinafter, the '8229 proceeding).

3. The Reexamination Order was granted in the '8229 proceeding on December 14, 2006.

4. There are currently no amendments in the '8229 proceeding.

5. On November 5, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '120 patent. The reexamination proceeding was assigned Control No. 90/010,044 (hereinafter, the '10044 proceeding).

6. The Reexamination Order was granted in the '10044 proceeding on February 1, 2008.

7. There are currently no amendments in the '10044 proceeding.

8. The '8229 and '10044 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 '8229 and the '10044 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 duplicate, 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. 90/008,229 and 90/010,044 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

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.
90/008,229	09/20/2006	5974120	6646-250,-250A,-250B	6348

35554 7590 05/14/2009

REENA KUYPER, ESQ.
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9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES, CA 90069

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/14/2009

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MAY 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,229*.

PATENT NO. *5974120*.

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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REENA KUYPER, ESQ. BYARD NILSSON, ESQ. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES CA 90069	:	(For Patent Owner)
John L. Welsh WELSH & FLAXMAN LLC 2000 DUKE STREET, SUITE 100 ALEXANDRIA, VA 22314	:	(For Third Party Requester)
Tracy W. Druce NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP) 1000 LOUISIANA STREET FIFTY-THIRD FLOOR HOUSTON, TX 77002	:	(For Third Party Requester)
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS [37 CFR § 1.565(c)]
In re: Katz *Ex Parte* Reexamination Proceeding Control No. 90/008,229 Deposited : 20 September 2006 For: US Patent No. 5,974,120	:	
In re: Katz *Ex Parte* Reexamination Proceeding Control No. 90/010,044 Deposited : 5 November 2007 For: US Patent No. 5,974,120	:	
In re: Katz *Ex Parte* Reexamination Proceeding Control No. 90/010,130 Deposited : 28 March 2008 For: US Patent No. 5,974,120	:	

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MAY 14 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. On 26 October 1999 US Patent No. 5,974,120 was granted to Ronald A. Katz.

2. On 20 September 2006 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,229.

3. On 14 December 2006 the Order was granted for *ex parte* reexamination in control number 90/008,229.

4. On 05 November 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,044.

5. On 01 February 2008 the Order was granted for *ex parte* reexamination in control number 90/010,044.

6. On 28 March 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,130.

7. On 28 May 2009 the Order was granted for *ex parte* reexamination in control number 90/010,130.

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 for consolidation of the proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,229 and 90/010,044 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. 90/008,229; 90/010,044; and 90/010,130 are hereby **MERGED**.

2. The reexamination files are being forwarded to the examiner for further 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

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

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.
90/008,233	09/22/2006	5689499	335795US91RX	9196

22850 7590 02/19/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/19/2009

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

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CHRISTOPHER L. MCKEE
BANNER & WITCOFF LTD.
1100 13TH STREET, N.W., SUITE 1200
WASHINGTON, DC 20005-4051

Date:

MAILED

FEB 19 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008233
PATENT NO. : 5689499
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

Scott A. McKeown : (For Patent Owner)
OBLON, SPIVAK, MCCLELLAND :
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

MAILED

FEB 19 2009

CENTRAL REEXAMINATION UNIT

Christopher L. McKee
BANNER & WITCOFF, LTD. : (For Third Party
1100 13TH STREET, N.W. : Requester)
SUITE 1200 :
WASHINGTON, DC 20005-4051 :
: DECISION GRANTING
: PETITION TO EXCERCISE
: SUPERVISORY AUTHORITY
: 37 CFR § 1.181 (a)(3)

In re Hullett *et alia* :
Inter partes Reexamination Proceeding :
Control No. 90/008,233 :
Deposited on: 22 September 2006 :
For: U.S. Patent No. 5,689,499 :

This is a decision on the 30 January 2009 patent owner "Petition Under 37 CFR § 1.181 (a) (1)." The instant petition is treated pursuant to 37 CFR § 1.181 (a) (3).

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

The petition is granted for the reasons set forth below.

DISCUSSION REGARDING EXERCISING SUPERVISORY AUTHORITY

§ 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and

Interferences or to the court;
(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3) To invoke the supervisory authority of the Director in appropriate circumstances.

MPEP § 2258 Scope of Ex Parte Reexamination

37 CFR 1.552. Scope of reexamination in ex parte reexamination proceedings.
(a) Claims in an ex parte reexamination proceeding will be examined on the basis of patents or
printed publications and, with respect to subject matter added or deleted in the reexamination
proceeding, on the basis of the requirements of 35 U.S.C. 112.
(b) Claims in an ex parte reexamination proceeding will not be permitted to enlarge the scope of
the claims of the patent.
(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be
resolved in a reexamination proceeding. If such issues are raised by the patent owner or third party
requester 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 consider the advisability of
filing a reissue application to have such issues considered and resolved.

MPEP § 2658 further states:
E. Affidavits or Declarations or Other Written Evidence
Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.
...
G. Claim Interpretation and Treatment
Original patent claims will be examined only on the basis of prior art patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103. See MPEP § 2217. During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (In re Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). In a reexamination proceeding involving claims of an expired patent, claim construction pursuant to the principle set forth by the court in Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim are not subject to amendment. The statutory presumption of

validity, 35 U.S.C. 282, has no application in reexamination (In re Etter, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985)).

MPEP § 2272 After Final Practice

It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution. Consideration of amendments submitted after final rejection and prior to, or with, the appeal will be governed by the strict standards of 37 CFR § 1.116. Further, consideration of amendments submitted after appeal will be governed by the strict standards of 37 CFR § 41.33. Both the examiner and the patent owner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR § 1.53(b), or § 1.53(d), and with no opportunity to file a request for continued examination under 37 CFR § 1.114. Accordingly, both the examiner and the patent owner should identify and develop all issues prior to the final Office action, including the presentation of evidence under 37 CFR § 1.131 and § 1.132.

DECISION REGARDING EXCERCISING SUPERVIRORY AUTHORITY .

The patent owner seeks to have the director exercise his supervisory authority to overturn the denial of entry of declarations by the examiner in the after final submission dated 4 November 2008. The patent owner cites the interview summary record written by the examiner which was mailed on 29 October 2008 for the interview of the same date. The examiner states (in-part) "[The] applicant's representative ...further agreed to submit a mapping of the means as disclosed in the specification." The patent owner states that they submitted the two declarations in question as a response to the examiner's request.

The director of the Central Reexamination Unit returns the proceeding to the examiner to consider the declarations as the decision of this petition decision.

The *Ex Parte* proceeding 90/008,233 is hereby returned to the examiner in charge of the case for consideration of the two declarations submitted 4 November 2008 pursuant to 37 CFR § 1.132 and § 1.116(e).

The patent owner's petition requesting the director of the Central Reexamination Unit to exercise authority is hereby granted.

CONCLUSION

1. The patent owner's petition requesting the director of the Central Reexamination Unit to exercise authority is hereby **granted.**

2. The *Ex Parte* proceeding 90/008,233 is returned to the examiner in charge of the case for consideration of the two declarations submitted 4 November 2008.

3. The Examiner will issue a decision on the declarations subsequently.

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, Supervisory Patent Examiner, in the absence of Mark Reinhart calls may be directed to 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

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.
90/008,233	09/22/2006	5689499	335795US91RX	9196

22850 7590 03/25/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2009

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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
CHRISTOPHER L. MCKEE
BANNER & WITCOFF LTD.
1100 13TH STREET, N.W., SUITE 1200
WASHINGTON, DC 20005-4051

Date:
MAILED
MAR 25 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008233
PATENT NO. : 5689499
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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MAR 25 2009

CENTRAL REEXAMINATION UNIT

Scott A. McKeown OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA VA 22314	:	(For Patent Owner)
Christopher L. McKee BANNER & WITCOFF, LTD. 1100 13TH STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051	:	(For Third Party Requester)
	:	**DECISION ON PETITION TO EXERCISE AUTHORITY, OR ALTERNATIVELY, EXTEND RESPONSE TIME PURSUANT TO 37 CFR §§ 1.181(a)(1) & 1.550(c)**
In re Hullett *et alia* *Ex Partes* Reexamination Proceeding Control No. 90/008,233 Deposited on: 22 September 2006 For: U.S. Patent No. 5,689,499	:	

The patent owner petition titled, "Petition Under 37 CFR § 1.181(a)(1) & 37 CFR § 1.550(c)" is before the Director of the Central Reexamination Unit for consideration. The petition was timely filed on 17 March 2009. The petition seeks the director the exercise authority to instruct the examiner to supplement the statements made in the advisory action mailed on 5 March 2009, or alternatively, requests the period for response be extended by two (2) months time.

The petition is **DISMISSED**.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,689,499 issued to Hullet *et alia* on 18 November 1997.

2. On 22 September 2006, a third party deposited a Request for *Ex Parte* Reexamination of U.S. Patent No. 5,689,499. The reexamination proceeding was assigned control no. 90/008,233

3. The Order granting *ex parte* reexamination was mailed on 21 November 2006.

4. On 4 September 2008 a Final Office action was mailed.

5. On 29 October 2008 an interview was conducted with the patent owner.

6. On 4 November 2008 an after final response request for reconsideration under 37 CFR § 1.116 was submitted.

7. On 14 January 2009 the examiner in charge of the proceeding mailed an Advisory Action responsive to the after final response dated 4 November 2008.

8. On 30 January 2009 the patent owner petitioned the Office for the director to exercise authority under 37 CFR 1.181(a)(1).

9. On 4 February 2009 the patent owner filed a Notice of Appeal.

10. On 19 February 2009 a petition decision granting the petition to exercise authority was mailed.

11. On 5 March 2009 a second advisory action was mailed.

12. On 17 March 2009 the instant petition was submitted for consideration.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.4(c) Nature of Correspondence states:

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

DECISION

The petition raises multiple issues which are distinct inquiries which may be addressed by different branches of the Office. In view of the fact that the petition improperly combines multiple, distinct subjects of inquiry in a single paper, the petition is dismissed under 37 CFR § 1.4(c).

CONCLUSION

1. Petitioner's requests are hereby dismissed.

2 The time for response to the Notice of Appeal continues to run from the date of submission 4 February 2009.

3. Any response to this decision should be directed to:

By Mail: Mail Stop *Inter Partes* 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

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

By Fax to: (571) 273-9900
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401 Dulany Street
Alexandria, VA 22314

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4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the absence of Mark Reinhart calls may be directed to 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.

/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
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,233	09/22/2006	5689499	335795US91RX	9196

22850 7590 04/02/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/02/2009

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
CHRISTOPHER L. MCKEE
BANNER & WITCOFF LTD.
1100 13TH STREET, N.W., SUITE 1200
WASHINGTON, DC 20005-4051

Date:
MAILED
APR 02 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008233
PATENT NO. : 5689499
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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APR 02 2009

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

Christopher L. McKee
BANNER & WITCOFF, LTD.
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

(For Third Party Requester)

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

In re Hullett *et alia*
Inter partes Reexamination Proceeding
Control No. 90/008,233
Deposited on: 22 September 2006
For: U.S. Patent No. 5,689,499

This is a decision on the 25 March 2009, petition for "Petition Under37 CFR § 1.550(c)," requesting that the time for responding to the date of a concurrently filed petition be extended by two (2) months.

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

The petition is Dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,689,499 issued to Hullet *et alia* on 18 November 1997.

2. On 22 September 2006, a third party deposited a Request for *Ex Parte* Reexamination of U.S. Patent No. 5,689,499. The reexamination proceeding was assigned control no. 90/008,233

3. The Order granting *ex parte* reexamination was mailed on 21 November 2006.

4. On 4 September 2008 a Final Office action was mailed.

5. On 29 October 2008 an interview was conducted with the patent owner.

6. On 4 November 2008 an after final response request for reconsideration under 37 CFR § 1.116 was submitted.

7. On 14 January 2009 the examiner in charge of the proceeding mailed an Advisory Action responsive to the after final response dated 4 November 2008.

8. On 30 January 2009 the patent owner petitioned the Office for the director to exercise authority under 37 CFR 1.181(a)(1).

9. On 4 February 2009 the patent owner filed a Notice of Appeal.

10. On 19 February 2009 a petition decision granting the petition to exercise authority was mailed.

11. On 5 March 2009 a second advisory action was mailed.

12. On 25 March 2009 the instant petition was submitted for consideration.

DECISION

The Patent Owner requests an extension of time in which to file the Appeal Brief. The Notice of Appeal was submitted on 4 February 2009. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond be extended by two (2) additional months from the date of decision of a concurrently filed petition. The petitioner has provided the petition fee set forth in 37 CFR § 1.17(g).

The petition is dismissed.

37 CFR 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an

argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

MPEP § 2265 Extensions of Time (in-part)

An extension of time in an *ex parte* reexamination proceeding is requested pursuant to 37 CFR § 1.550(c). Accordingly, a request for an extension (A) must be filed on or before the day on which action by the patent owner is due and (B) must set forth sufficient reason for the extension, and (C) must be accompanied by the petition fee set forth in 37 CFR § 1.17(g). Requests for an extension of time in an *ex parte* reexamination proceeding will be considered only after the decision to grant or deny reexamination is mailed. Any request filed before that decision will be denied.

...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR § 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR § 1.515(c) will be granted only in extraordinary situations.

ANALYSIS AND FINDINGS

The Patent Owner requests an extension of time in which to file the Appeal Brief. The Notice of Appeal was submitted on 4 February 2009. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond be extended by two (2) additional months from the date of decision of a concurrently filed petition.

The petitioner states that the sufficient cause for extending the time for the Appeal Brief is because the record, "lacks a detailed explanation of the reasons why the declarations are deemed insufficient." A review of the record of the proceeding indicates that the advisory action mailed 5 March 2009 broadly addresses the declarations.

The petitioner further alleges that the appeal proceedings are premature and proposes

reopening prosecution. The petitioner is reminded of a previous decision mailed 25 March 2009 pursuant to 37 § CFR 1.4. The issues before the director with this petition are whether or not there is sufficient cause to grant an extension of time pursuant to 37 CFR 1.550(c).

The petitioner has provided no specific reasons as to the requirements of MPEP § 2265,

> "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."

The petition request for two (2) months additional time to respond to the Notice of Appeal is hereby **dismissed**.

CONCLUSION

1. The patent owner's petition for extension of two (2) months time in which to file a response to the Notice of Appeal is **dismissed**.

2. The patent owner's response to the Notice of Appeal continues to run from the date of submission 4 February 2009.

3. Future correspondence may be submitted as follows:

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

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

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

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, alternatively where Mark Reinhart is unavailable, Eric Keasel, at 571-272-4929, or Jessica Harrison at (571) 272-4449, all Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also 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
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.
90/008,233	09/22/2006	5689499	335795US91RX	9196

22850 7590 04/02/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/02/2009

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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
CHRISTOPHER L. MCKEE
BANNER & WITCOFF LTD.
1100 13TH STREET, N.W., SUITE 1200
WASHINGTON, DC 20005-4051

Date:

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APR 02 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008233
PATENT NO. : 5689499
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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CENTRAL REEXAMINATION UNIT

Scott A. McKeown OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA VA 22314	: :	(For Patent Owner)
Christopher L. McKee BANNER & WITCOFF, LTD. 1100 13TH STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051	: : : :	(For Third Party Requester)
	: : : :	DECISION DENYING PETITION TO EXCERCISE SUPERVISORY AUTHORITY 37 CFR § 1.181 (a)(1)

In re Hullett *et alia* :
Inter partes Reexamination Proceeding :
Control No. 90/008,233 :
Deposited on: 22 September 2006 :
For: U.S. Patent No. 5,689,499 :

This is a decision on the 25 March 2009 patent owner "Petition Under 37 CFR § 1.181 (a) (1)."

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

The petition is denied for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,689,499 issued to Hullet *et alia* on 18 November 1997.

2. On 22 September 2006, a third party deposited a Request for *Ex Parte* Reexamination of U.S. Patent No. 5,689,499. The reexamination proceeding was assigned control no. 90/008,233

3. The Order granting *ex parte* reexamination was mailed on 21 November 2006.

4. On 4 September 2008 a Final Office action was mailed.

5. On 29 October 2008 an interview was conducted with the patent owner.

6. On 4 November 2008 an after final response request for reconsideration under 37 CFR § 1.116 was submitted.

7. On 14 January 2009 the examiner in charge of the proceeding mailed an Advisory Action responsive to the after final response dated 4 November 2008.

8. On 30 January 2009 the patent owner petitioned the Office for the director to exercise authority under 37 CFR 1.181(a)(1).

9. On 4 February 2009 the patent owner filed a Notice of Appeal.

10. On 19 February 2009 a petition decision granting the petition to exercise authority was mailed.

11. On 5 March 2009 a second advisory action was mailed.

12. On 25 March 2009 the instant petition was submitted for consideration.

DISCUSSION REGARDING EXERCISING SUPERVISORY AUTHORITY

The petitioner submitted a petition under 37 CFR § 1.181(a)(1) on 25 March 2009. The petition was submitted with the appropriate fees pursuant to 37 CFR § 1.17(g) and was timely filed. The patent owner seeks to have the director exercise his supervisory authority to "instruct the examiner to supplement the general statements made in the Advisory Action" mailed on 5 March 2009. The Patent Holder requests that a specific explanation of each of the alleged insufficiencies, relative to the declarations filed be delineated.

CITATION OF RELEVANT AUTHORITY

§ 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances.

MPEP § 2258 Scope of Ex Parte Reexamination

37 CFR 1.552. Scope of reexamination in ex parte reexamination proceedings.

(a) Claims in an ex parte reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. § 112.

(b) Claims in an ex parte reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such issues are raised by the patent owner or third party requester 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 consider the advisability of filing a reissue application to have such issues considered and resolved.

MPEP § 2658 further states:

E. Affidavits or Declarations or Other Written Evidence

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.

...

G. Claim Interpretation and Treatment

Original patent claims will be examined only on the basis of prior art patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103. See MPEP § 2217. During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (In re Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). In a reexamination proceeding involving claims of an expired patent, claim construction pursuant to the principle set forth by the court in Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim are not subject to amendment. The statutory presumption of validity, 35 U.S.C. 282, has no application in reexamination (In re Etter, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985)).

MPEP § 2272 After Final Practice

> It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution. Consideration of amendments submitted after final rejection and prior to, or with, the appeal will be governed by the strict standards of 37 CFR § 1.116. Further, consideration of amendments submitted after appeal will be governed by the strict standards of 37 CFR § 41.33. Both the examiner and the patent owner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR § 1.53(b), or § 1.53(d), and with no opportunity to file a request for continued examination under 37 CFR § 1.114. Accordingly, both the examiner and the patent owner should identify and develop all issues prior to the final Office action, including the presentation of evidence under 37 CFR § 1.131 and § 1.132.

37 CFR § 41.33 (d) (1) & (2) Amendments and affidavits or other evidence after appeal.

> d)
> (1) An affidavit or other evidence filed after the date of filing an appeal pursuant o § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.
> (2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

DECISION REGARDING EXCERCISING SUPERVIRORY AUTHORITY

The patent owner seeks to have the director exercise his supervisory authority to "instruct the examiner to supplement the general statements made in the Advisory Action" mailed on 5 March 2009. The Patent Holder requests that a specific explanation of each of the alleged insufficiencies, relative to the declarations filed be delineated.

Pursuant to 37 CFR § 41.33 (d)(1) articulates that the admission of an affidavit into the record of the proceeding was entirely at the discretion of the examiner. While entry is discretionary given that the declarations did not place any claims in condition for allowance but as a courtesy to the Patent Holder for the purpose of consideration. The examiner addressed the issues in the advisory action mailed 5 March 2009 as specific to differing interpretation of claim construction and very specifically how the prior art meets those limitations. This is a differing point of view from that of the Patent Holder and at this point in prosecution, one which should be decided by the Board of Patent Appeals and Interferences. As to the specifics of the declarations, the examiner noted that the declarations were not persuasive for the same reasons specific to the prior art rejections addressed in the Advisory Action.

The Advisory Action mailed on 5 March 2009 is considered sufficient per the requirements of the Manual of Patent Examining Procedure and Code of Federal Regulation .

The petition to invoke supervisory authority under 37 CFR § 1.181(a)(1) is hereby denied.

CONCLUSION

1. The patent owner's petition requesting the director of the Central Reexamination Unit to exercise authority pursuant to 37 CFR § 1.181(a)(1) is hereby **denied.**

2. The patent owner may submit an Appeal Brief following the filing of the Notice of Appeal dated 4 February 2009.

3. All correspondence involving this proceeding may be addressed to the following:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, Supervisory Patent Examiner, in the absence of Mark Reinhart calls may be directed to 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

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.
90/008,234	10/31/2006	5899855	06-0643 / 7553.00059	8370

60683 7590 07/07/2008

HEALTH HERO NETWORK, INC.
2400 GENG ROAD, SUITE 200
PALO ALTO, CA 94303

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2008

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

Health Hero Network, Inc.
2000 Seaport Blvd.
Suite 400
Redwood City, CA 94063

(For Patent Owner)

MAILED

JUL 07 2008

CENTRAL REEXAMINATION UNIT

Richard C. Kim
Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130

(For 3rd Party Requester)

Reexam Control No.: 90/008,234
Filed : October 31, 2006
For U.S. Patent No. : 5,899,855

Reexam Control No.: 90/008,909
Filed : December 11, 2007
For U.S. Patent No. : 5,899,855

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. 90/008,234 was ordered in a decision mailed December 13, 2006 indicating that claims 47-50 would be reexamined. Prosecution has progressed to the point where an amendment was filed May 15, 2008 amending claim 47. No further action has taken place since the filing of the amendment.

Reexamination in application control No. 90/008,909 was ordered in a decision mailed January 24, 2008 indicating that claims 47-50 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. Thus, there have been no changes made to the specification, claims, or drawings.

As evidenced by the above facts, reexamination control No. 90/008,234 and reexamination control No. 90/008,909 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

As noted above, claim 47 has been amended in the '234 reexamination proceeding by virtue of the amendment filed May 15, 2008. No amendment has been filed in the '909 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files**. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 47-50, the only claims 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 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. 90/008,234 and 90/008,909 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files**. Upon receipt of the response, an Office action will issue in due course.

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

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.
90/008,474	01/30/2007	5809336		2845

40972 7590 04/11/2008

HENNEMAN & ASSOCIATES, PLC
714 W. MICHIGAN AVENUE
THREE RIVERS, MI 49093

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/11/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,237	11/17/2006	5809336	069974-0160	8857

40972 7590 04/11/2008

HENNEMAN & ASSOCIATES, PLC
714 W. MICHIGAN AVENUE
THREE RIVERS, MI 49093

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/11/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Matthew A. Smith
FOLEY & LARDNER LLP
3000 K Street NW, Suite 500
Washington, DC 20007

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008237
PATENT NO. : 5809336
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:

MICHAEL HAWES
BAKER BOTTS L.L.P.
910 LOUISANA
HOUSTON, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008306
PATENT NO. : 5809336
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:

DANIEL B. RAVICHER
PUBLIC PATENT FOUNDATION, INC.
1375 BROADWAY, SUITE 600
NEW YORK, NY 10018

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008474
PATENT NO. : 5809336
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

Henneman & Associates, PLC (For Patent Owner)
714 W. Michigan Avenue
Three Rivers, MI 49093

Matthew A. Smith (For Third Party Requester)
Foley & Lardner LLP
3000 K Street NW, Suite 500
Washington, DC 20007

Michael Hawes (For Third Party Requester)
Baker Botts LLP
910 Louisiana
Houston, TX 77002

Daniel B. Ravicher (For Third Party Requester)
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

In re Moore *et alia* :
Reexamination Proceeding : DECISION *SUA SPONTE*
Control No. 90/008,237 : MERGING
Corrected Request Deposited: November 17, 2006 : REEXAMINATION
For: U.S. Patent No. 5,809,336 : PROCEEDINGS

In re Moore *et alia* :
Reexamination Proceeding :
Control No. 90/008,306 :
Request Deposited: October 19, 2006 :
For: U.S. Patent No. 5,809,336 :

In re Moore *et alia* :
Reexamination Proceeding :
Control No. 90/008,474 :
Request Deposited: January 30, 2007 :
For: U.S. Patent No. 5,809,336 :

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;809,336 (hereinafter, the '336 patent), issued to Moore *et alia*, on September 15, 1998.

2. On November 17, 2006, a third party deposited a corrected Request for *Ex Parte* Reexamination of claims 1-10 of the '336 patent. The reexamination proceeding was assigned Control No. 90/008,237 (hereinafter, the '8237 proceeding).

3. The Reexamination Order was granted in the '8237 proceeding on January 19, 2007.

4. There are currently no amendments in the '8237 proceeding.

5. On October 19, 2006, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-10 of the '336 patent. The reexamination proceeding was assigned Control No. 90/008,306 (hereinafter, the '8306 proceeding).

6. The Reexamination Order was granted in the '8306 proceeding on January 16, 2007.

7. There are currently no amendments in the '8306 proceeding.

8. On January 30, 2007, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-10 of the '336 patent. The reexamination proceeding was assigned Control No. 90/008,474 (hereinafter, the '8474 proceeding).

9. The Reexamination Order was granted in the '8474 proceeding on April 5, 2007.

10. There are currently no amendments in the '8474 proceeding.

11. The '8237, '8306, and '8474 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 '8237, '8306, and '8474 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. 90/008,237, 90/008,306, and 90/008,474 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

MAY 24 2007

CENTRAL REEXAMINATION UNIT

MICHAEL S. DOWLER HOWREY LLP 1111 LOUISIANA, 25TH FLOOR HOUSTON, TX 77002	:	(for patent owner)
David L. Fehrman MORRISON & FOERSTER LLP 555 West Fifth Street Suite 3500 Los Angeles, CA 90013	:	(for requestor)
In re VOGEL *Ex Parte* Reexamination Proceeding Control No. 90/007,733 Filed: September 26, 2005 Title: **Automatic Censorship of Video Programs**	:	*SUA SPONTE* DECISION MERGING REEXAMINATION PROCEEDINGS
In re VOGEL *Ex Parte* Reexamination Proceeding Control No. 90/008,243 Filed: September 29, 2006 Title: **Automatic Censorship of Video Programs**	:	

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

BACKGROUND

1. Patent No. 4,930,160 issued on May 29, 1990.

2. A first request for Reexamination control number 90/007,733 was made by a third party requester was made September 26, 2005 by a third party requester for reexamination of claims 1-26.

3. Reexamination was ordered in the '7733 reexamination proceeding on November 23, 2005.

4. A request for reexamination, Reexamination Control No. 90/008,243, was filed by the third party requester on September 29, 2006. This request was directed to claims 1, 3, 4, 6-8, 11, 14, 16, 17, 19-21, 24, and 27-44,

5. Reexamination was ordered in the '8,243 reexamination proceeding on March 19, 2007.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '7,733 and 8,243 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding

would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/7,733 and 90/008,243 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

Patent owner is required to maintain the same claims and specification in all files.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

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.
90/008,243	01/08/2007	4930160	487132800131	6416

37086 7590 04/25/2008

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/25/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David L. Fehrman
Morrison and Foerster, LLP
555 W. Fifth St. Suite 3500
Los Angeles, CA 90013

MAILED
APR 25 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,243, 90/007,733

PATENT NO. 4930160.

ART UNIT 3992.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Novak Druce & Quigg, LLP (For Patent Owner)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

Morrison & Foerster LLP (For Third-Party Requester)
555 West Fifth Street
Suite 3500
Los Angeles, CA 90013-1024

In re: Vogel	: DECISION
Reexamination Proceeding	: GRANTING-IN-PART
Control No. 90/007,733	: PETITION FOR
Request Deposited: September 14, 2006	: EXTENSTION OF TIME
For: U.S. Patent No. 4,930,160	: [37 CFR 1.550(c)]
In re: Vogel	:
Reexamination Proceeding	:
Control No. 90/008,243	:
Corrected Request Deposited: January 8, 2007	:
For: U.S. Patent No. 4,930,160	:

This is a decision on the April 21, 2008, "PATENT OWNER'S REQUEST FOR EXTENSION OF TIME TO FILE RESPONSE TO OFFICE ACTION PURSUANT TO 37 CFR 1.550(C)" requesting that the time to submit a Patent Owner response be extended an additional 35 days.

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

The petition is granted-in-part and a thirty-day extension of time is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 4,930,160 (hereinafter, the '160 patent), issued to Vogel, on May 29, 1990 from application number 07/237,176, filed August 29, 1988.

2. On September 26, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '160 patent. The reexamination proceeding was assigned Control No. 90/007,733 (hereinafter, the '7733 proceeding).

3. The reexamination order was granted in the '7733 proceeding on November 23, 2005.

4. A non-final rejection was mailed on April 28, 2006 setting a two-month period for response.

5. A petition for extension of time was filed on May 31, 2006 requesting an additional 30 days for response. Said petition was granted on June 19, 2006.

6. A response was timely filed on July 28, 2006.

7. On September 29, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '160 patent. The reexamination proceeding was assigned Control No. 90/008,243 (hereinafter, the '8243 proceeding). Said request was given a filing date of September 29, 2006, which was vacated in the decision of December 8, 2006. On January 8, 2007, the third party deposited a corrected Request for *Ex Parte* Reexamination of the '160 patent.

8. The reexamination order was granted in the '8243 proceeding on March 19, 2007.

9. The '7733 and '8243 proceedings were merged on May 24, 2007.

10. A housekeeping amendment was filed on July 3, 2007.

11. A non-final office action was mailed on August 8, 2007. A subsequent non-final office action was mailed on October 1, 2007 setting a two-month period for response.

12. Patent Owner timely filed a response on December 3, 2007 (December 1st being a Saturday).

13. A final rejection was mailed on March 25, 2008 setting a one-month period for response as an order granting the joint motion to stay litigation pending reexamination proceedings was issued on January 17, 2008.

14. A request for extension of time was timely filed on April 21, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the final office action mailed March 25, 2008. The request for extension is the second request for an extension of time. The present petition for extension of time was timely filed on April 21, 2008, together with the petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor ....

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

The request notes that "Patent Owner wishes to present declaration testimony rebutting the Office's interpretation of the priority document and the standard upon which the judgment has been made. Also for the first time, the Office has determined the declarations by Thomas Coverstone insufficient to establish the requisite nexus between the evidence of commercial success based on licensing activities of the '160 patent and the subject matter of the currently pending claims in the reexamination proceeding. Again, for rebuttal, declaration testimony is desired.

Patent Owner has initiated contact with prospective declarants, including certain foreign residents. Among other factors, the difference in time zones complicates cooperation for the preparation of the necessary declarations. Furthermore, we have just received a return contact from one of the prospective declarants and have begun the process for obtaining one of the

desired declarations. In that a substantial portion of the Response to the Final Office Action is dependent on the declarations and their content, that work must be completed for the most part after the declarations are solidified."

Reference is made to the petition for details of these and other issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear Patent Owner requires some additional time to prepare a complete response. An extension of time of 30 days is considered sufficient.

It is noted that Patent Owner states that they "must respond to the Advisory Action, also due on or before April 25, 2008 in the companion case to this matter (Control Nos. 90/007,746 and 90/008,544). Given the complex nature of the reexamination proceeding and the fact that the shortest period of time allowed for response has been issued, together with the fact that a response is also due in the companion proceeding, Patent Owner and its undersigned counsel request these thirty-five additional days in order to submit the Response." However, this is incorrect as the final rejection in the merged '7746 and '8544 proceedings was mailed on February 8, 2008 and the advisory action of March 25, 2008 extended the period for response to run three months from the mailing date of the final rejection. Therefore, the response in the merged '7746 and '8544 proceedings is due on or before May 8, 2008.

Accordingly, the time for filing the response is extended for thirty days and therefor the response is due on or before May 27, 2008 (May 25th being a Sunday and May 26th being a national holiday).

Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

It is also noted that the '160 patent expires on August 29, 2008.

37 CFR 1.530(j) states:

No enlargement of claim scope. No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

MPEP 2250 (III) states, in part:

Pursuant to 37 CFR 1.530(j), "[n]o amendment may be proposed for entry in an expired patent." Thus, if a patent expires during the pendency of a reexamination proceeding for a patent, all

amendments to the patent claims and all claims added during the proceeding are withdrawn. This is carried out by placing a diagonal line across all amended and new claims (and text added to the specification) residing in the amendment papers. The patent owner should be notified of this in the next Office action. The Office action will hold the amendments to be improper, and state that all subsequent reexamination will be on the basis of the unamended patent claims. This procedure is necessary since no amendments will be incorporated into the patent by a certificate after the expiration of the patent.

Since an appeal by Patent Owner can extend the pendency of the reexamination beyond the expiration of the '160 patent (i.e. 2 months to file an appeal brief after the Notice of Appeal and 2 months to file a reply brief after the examiner's answer would prolong prosecution into at least September 2008), the Office will entertain an after-final amendment to return the claims to the original, unamended patent claims at the present time.

CONCLUSION

1. Petitioner's request is granted-in-part. The period during which Patent Owner may file a response has been extended to May 27, 2008.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

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.
90/008,248	09/28/2006	7065935	2546.001REX0/DKSC/MWR	8907

26111 7590 01/19/2007

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/19/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent under reexamination 7065935	:	
Reexam Control No.: 90/008,248	:	**RESPONSE TO PETITION**
Filed: September 28, 2006	:	**UNDER 37 CFR 1.59**
For: Method for Laying and Interlocking Panels	:	
	:	
	:	
	:	
	:	

This is a response to the petition under 37 CFR 1.182, which is being treated as a petition under 37 CFR 1.59(b), filed November 17, 2006, to expunge information from the above identified reexamination.

The decision on the petition will be held in abeyance until the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), at which time the petition will be decided.

Petitioner requests that following documents filed November 17, 2006, be expunged from the record:
(1) the confidential deposition transcript of Stefan Moriau taken on April 2, 2001 *In the Matter of Certain Flooring Products*, Investigation No. 337-TA-443, a copy of which is filed under seal as Exhibit U;
(2) the confidential deposition transcript of Bernard Thiers taken on August 24, 2006 in the *Akzenta v. Unilin et al.* litigation, a copy of which is filed under seal as Exhibit V;
(3) the confidential deposition transcript of Stefan Moriau taken on August 25, 2006 in the *Akzenta v. Unilin et al.* litigation, a copy of which is filed under seal as Exhibit W; and
(4) the confidential Unilin's Response to Complainants' First Set of Written Interrogatories *In the Matter of Certain Flooring Products*, Investigation No. 337-TA-443, a copy of which is filed under seal as Exhibit X.

Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During the reexamination proceeding, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

It is noted that the petition under 37 CFR 1.182 is being treated as a petition under 37 CFR 1.59(b). The petition as filed is lacking two of the requirements under 37 CFR 1.59(b), namely (1) making a statement regarding 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, and (2) a statement regarding whether the petition to expunge under 37 CFR 1.59 is being submitted on behalf of the party in interest who originally submitted the information requested to be expunged. See 37 CFR 1.59 and MPEP 724.05 for more information. Petitioner is invited to file a corrected petition prior to the mailing of a NIRC in order to fully comply with the requirements of 37 CFR 1.59. Petitioner will also receive a refund of $200 because petitioner paid the $400 fee under 37 CFR 1.17(f), which is required for a petition under 37 CFR 1.182. A petition under 37 CFR 1.59(b), however, requires a $200 petition fee under 37 CFR 1.17(g). Accordingly, the credit card from which the $400 petition fee was paid will be credited $200 in due course.

Any telephone inquiries related to this correspondence should be directed to Jeanne Clark at (571) 272-7714, or in her absence, to the undersigned.

Lissi Mojica Marquis
Director
Central Reexamination Unit
(571) 272-1596

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,248	01/22/2007	7065935	2546.001REX0/DKSC/MWR	8907

26111 7590 08/20/2008

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/20/2008

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

In re Application of 7065935
Appl. No.: 90/008,248
Filed: January 22, 2007
For: Method for Laying and Interlocking Panels

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the renewed petition under 37 CFR 1.59(b), filed July 31, 2008, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents entitled (1) the confidential deposition transcript of Stefan Moriau taken on April 2, 2001 *In the Matter of Certain Flooring Products*, Investigation No. 337-TA-443, a copy of which was filed under seal as Exhibit U; (2) the confidential deposition transcript of Bernard Thiers taken on August 24, 2006 in the *Akzenta v. Unilin et al.* litigation, a copy of which was filed under seal as exhibit V; (3) the confidential deposition transcript of Stefan Moriau taken on August 25, 2006 in the *Akzenta v. Unilin et al.* litigation, a copy of which was filed under seal as exhibit W; and (4) the confidential Unilin's Response to Complainants' First Set of Written Interrogatories *In the Matter of Certain Flooring Products*, Investigation No. 337-TA-443, a copy of which was filed under seal as Exhibit X , which items were filed November 17, 2006, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been removed from the official file.

Gregory Morse, Director
Central Reexamination Unit

Enclosure: Items identified as 1-4 above.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,250	09/28/2006	6804926	2546.002REXO/DKSC/MWR	9327

26111 7590 01/19/2007

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/19/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent Under Reexamination 6804926	:	
Reexam Control. No.: 90/008,250	:	**RESPONSE TO PETITION**
Filed: September 28, 2006	:	**UNDER 37 CFR 1.59**
For: Method for Laying and Interlocking Panels	:	
	:	
	:	
	:	
	:	

This is a response to the petition under 37 CFR 1.182, which is being treated as a petition under 37 CFR 1.59(b), filed November 17, 2006, to expunge information from the above identified reexamination.

The decision on the petition will be held in abeyance until the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), at which time the petition will be decided.

Petitioner requests that following documents filed November 17, 2006, be expunged from the record:
(1) the confidential deposition transcript of Stefan Moriau taken on April 2, 2001 *In the Matter of Certain Flooring Products*, Investigation No. 337-TA-443, a copy of which is filed under seal as Exhibit U;
(2) the confidential deposition transcript of Bernard Thiers taken on August 24, 2006 in the *Akzenta v. Unilin et al.* litigation, a copy of which is filed under seal as Exhibit V;
(3) the confidential deposition transcript of Stefan Moriau taken on August 25, 2006 in the *Akzenta v. Unilin et al.* litigation, a copy of which is filed under seal as Exhibit W; and
(4) the confidential Unilin's Response to Complainants' First Set of Written Interrogatories *In the Matter of Certain Flooring Products*, Investigation No. 337-TA-443, a copy of which is filed under seal as Exhibit X.

Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During the reexamination proceeding, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

It is noted that the petition under 37 CFR 1.182 is being treated as a petition under 37 CFR 1.59(b). The petition as filed is lacking two of the requirements under 37 CFR 1.59(b), namely (1) making a statement regarding 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, and (2) a statement regarding whether the petition to expunge under 37 CFR 1.59 is being submitted on behalf of the party in interest who originally submitted the information requested to be expunged. See 37 CFR 1.59 and MPEP 724.05 for more information. Petitioner is invited to file a corrected petition prior to the mailing of a NIRC in order to fully comply with the requirements of 37 CFR 1.59. Petitioner will also receive a refund of $200 because petitioner paid the $400 fee under 37 CFR 1.17(f), which is required for a petition under 37 CFR 1.182. A petition under 37 CFR 1.59(b), however, requires a $200 petition fee under 37 CFR 1.17(g). Accordingly, the credit card from which the $400 petition fee was paid will be credited $200 in due course.

Any telephone inquiries related to this correspondence should be directed to Jeanne Clark at (571) 272-7714, or in her absence, to the undersigned.

Lissi Mojica Marquis
Director
Central Reexamination Unit
(571) 272-1596

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.
90/008,250	09/28/2006	6804926	2546.002REXO/DKSC/MWR	9327

26111 7590 01/15/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/15/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Application of 6,804,926
Appl. No.: 90/008,250
Filed: September 28, 2006
For: Method for Laying and Interlocking Panels

DECISION ON PETITION UNDER 37 CFR 1.59

MAILED

JAN 15 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the renewed petition under 37 CFR 1.59(b), filed August 1, 2008, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents entitled (1) the confidential deposition transcript of Stefan Moriau taken on April 2, 2001 *In the Matter of Certain Flooring Products*, Investigation No. 337-TA-443, a copy of which was filed under seal as Exhibit U; (2) the confidential deposition transcript of Bernard Thiers taken on August 24, 2006 in the *Akzenta v. Unilin et al.* litigation, a copy of which was filed under seal as exhibit V; (3) the confidential deposition transcript of Stefan Moriau taken on August 25, 2006 in the *Akzenta v. Unilin et al.* litigation, a copy of which was filed under seal as exhibit W; and (4) the confidential Unilin's Response to Complainants' First Set of Written Interrogatories *In the Matter of Certain Flooring Products*, Investigation No. 337-TA-443, a copy of which was filed under seal as Exhibit X , which items were filed November 17, 2006, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been removed from the official file.

Gregory Morse, Director
Central Reexamination Unit

Enclosure: Items identified as 1-4 above.

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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Michael E.Dergosits Dergosits & Noah Four Embarcadero Center, Suite 510 San Francisco, CA 94111	:	For Patent Owner
Judith S.H. Hom Bingham McCutchen, LLP 1900 University Ave., East Palo Alto, CA 94303	:	For Requester
In re Smith *Ex Parte* Reexamination Proceeding Control No. 90/008,252 Filed: September 28,2006 For: US Patent No. 5,480,665	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]

MAILED

AUG 02 2007

CENTRAL REEXAMINATION UNIT

This is a decision on the July 25, 2007, "Petition for Extension of Time in Ex Parte Reexamination Proceeding Under 37 CFR 1.550(c)" requesting that the time for responding to the Office action of June 29, 2007 be extended by 21 days.

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 action dated June 29, 2007, which set a one month date for the response. The request for extension is the first request for an extension of time with respect to the action, and was timely filed on July 25, 2007, together with authorization to charge a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...
>
> The reasons stated in the request will be evaluated by the TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

The petition notes that the attorney of record, the inventor, and the principal client contact were all unavailable for significant portions of the original one month response period. Further, the petition describes reasonably diligent behavior by those responsible for preparing a response.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why an extension of time should be granted for the reasons outlined above, particularly given the original one month response period and the mere 21 days requested.

Accordingly, the time for filing a response to the action is extended for 21 days and therefore the response is due on August 20, 2007. Patent Owner may expect that any further extensions of time to respond to the Office action will be granted only in an extraordinary situation. See MPEP 2665.

Conclusion

1. The Patent Owner's petition for extension of time filed on July 25, 2007 is <u>granted</u> for 21 days.

2. The Patent Owner's response is due August 20, 2007.

3. The response may be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
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 Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,257	10/05/2006	6406499	OHI 1717-061B	4555

8698 7590 06/02/2008

STANDLEY LAW GROUP LLP
495 METRO PLACE SOUTH
SUITE 210
DUBLIN, OH 43017

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2008

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

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Dr. Aldo A. Laghi
c/o Ronald A. Christaldi
P.O. Box 2350
Tampa, FL 33601-2350

MAILED

JUN 02 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,257*.

PATENT NO. *6406499*.

ART UNIT *3993*.

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

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

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

STANDLEY LAW GROUP, LLP 495 Metro Place South Suite 210 Dublin, OH 43017	:	(for Patent Owner)
Dr. Aldo A. Laghi c/o Ronald A. Christaldi P.O. Box 2350 Tampa, FL 33601-2350	:	(for Third Party Requester)
In re Kanin *Ex Parte* Reexamination Proceeding Control No.: 90/008,257 Filed: October 5, 2006 For: U.S. Patent 6,406,499	:	DECISION MERGING REEXAMINATION PROCEEDINGS
In re Kanin *Ex Parte* Reexamination Proceeding Control No.: 90/008,570 Filed: March 28, 2007 For: U.S. Patent 6,406,499	:	

The above noted reexamination files are before the Director of Technology Center 3900 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 6,406,499 which issued June 18, 2002, is the subject of Reexamination Control Nos. 90/008,257 and 90/008,570.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,257 ('8257), was filed October 5, 2006, by Dr. Aldo A. Laghi of Tampa, Florida. The request urged that a substantial new question of patentability was raised by two industry catalogs, U.S. Patent No. 4,822,371 to Jolly *et al.* and U.S. Patent No. 5,633,286 to Chen. None of these references were cited in the prosecution of U.S. Patent No. 6,406,499.

3. Reexamination was ordered for '8257 on December 1, 2006.

4. A second request for reexamination, assigned Reexamination Control No. 90/008,570 ('8570), was filed March 28, 2007, Dr. Aldo A. Laghi of Tampa Florida. The request urged that a substantial new question of patentability was raised by two advertisements and the teachings of US. Patent No. 5,258,037 to Caspers in addition to the two catalogs and two patents cited in the first request for reexamination. None of these references were cited in the prosecution of U.S. Patent No. 6,406,499.

5. Reexamination was ordered for '8570 on May 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 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 90/008,257 and 90/008,570 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 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 No. 90/008,257 as:

Reexamination Control Ns. 90/008,257 and 90/008,570

Standley Law Group LLP
495 Metro Place South
Suite 210
Dublin, OH 43017

A copy of all correspondence from the USPTO will be served on the third party requesters at the address listed in Reexamination Control Nos. 90/008,257 and 90/008,570, respectively as:

Dr. Aldo A. Laghi
c/o Ronald A. Christaldi
PO Box 2350
Tampa, FL 33601-2350

CONCLUSION

Reexamination Control Nos. 90/008,257 and 90/008,570 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

Lissi M. Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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AUG 03 2007

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	:	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	:	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	:	For Third Party Requester
HAYNES AND BOONE LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202	:	For Third Party Requester
DAVID J. MCKENZIE FOR ENC Technology Corp.: 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Freeny *Ex Parte* Reexamination Proceeding Control No. 90/008,052 Filed: June 6, 2006 For: US Patent No. 6,360,253	:	

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,262 :
Filed: February 2, 2007 :
For: US Patent No. 6,360,253 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,265 :
Filed: October 6, 2006 :
For: US Patent No. 6,360,253 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,272 :
Filed: October 6, 2006 :
For: US Patent No. 6,360,253 :

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. 6,360,253 issued on March 19, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,052 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,052 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,052.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,262 was requested by a third party requester filed on February 2, 2007.

6. The Reexamination Order was granted in proceeding, control no. 90/008,262 on March 23, 2007.

7. There are currently no amendments proceeding control number 90/008,262.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,265 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,265 on January 3, 2007.

10 There are currently no amendments proceeding control number 90/008,265.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,272 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,272 on December 8, 2006.

13. There are currently no amendments proceeding control number 90/008,272.

14. Proceedings control numbers 90/008,052; 90/008,262; 90/008,265; and 90/008,272 await 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 90/008,052; 90/008,262; 90/008,265; and 90/008,272 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. 90/008,052; 90/008,262; 90/008,265; and 90/008,272 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

MRehr 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.
90/008,262	02/02/2007	6360253	077482.0101	7010

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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.
90/008,052	06/06/2006	6360253	LMI 001	7415

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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.
90/008,265	10/06/2006	6360253	38653.2.14	3829

30589 7590 11/23/2007
DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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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.
90/008,272	10/06/2006	6360253	2231.7.1	8070

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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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

Dunlap, Codding, & Rogers PC
PO Box 16370
Oklahoma City, OK 73113 (For Patent Owner)

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NOV 23 2007

CENTRAL REEXAMINATION UNIT

Law Office of David H. Judson
15455 Dallas Parkway
Addison, TX 75001 (For First Requester)

Baker Botts LLP
910 Louisiana
Houston, TX 77005 (For Second Requester)

Haynes and Boone LLP
901 Main Street, Suite 3100
Dallas, TX 75202 (For Third Requester)

ENC Technology Corp.
8 East Broadway, Suite 600
Salt Lake City, UT 84111 (For Fourth Requester)

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,052
Filed: June 6, 2006
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,262
Filed: February 2, 2007
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,265
Filed: October 6, 2006
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,272
Filed: October 6, 2006
For: U.S. Patent No. 6,360,253 B1

DECISION DISMISSING

PETITION UNDER

37 CFR § 1.183

This is a decision on the November 1, 2007 patent owner petition entitled "PETITION TO WAIVE THE SUBMISSION REQUIREMENTS OF 37 CFR §1.98 (37 CFR 1.183)" The petition requests waiver of the formal submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in a related case.

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

The petition is dismissed as moot.

REVIEW OF FACTS

1. U.S. Patent No. 6,360,253 (the '253 patent) issued on March 19, 2002.

2. A request for *ex parte* reexamination of the '253 patent was filed on June 6, 2006. The request was assigned control No. 90/008,052 (the '8052 reexamination proceeding).

3. Reexamination was ordered for the '8052 proceeding on August 11, 2006.

4. A second request for *ex parte* reexamination of the '253 patent was filed on February 2, 2007. The request was assigned control No. 90/008,262 (the '8262 reexamination proceeding).

5. Reexamination was ordered for the '8262 proceeding on March 23, 2007.

6. A third request for *ex parte* reexamination of the '253 patent was filed on October 6, 2006. The request was assigned control No. 90/008,265 (the '8265 reexamination proceeding).

7. Reexamination was ordered for the '8265 proceeding on January 3, 2007.

8. A fourth request for *ex parte* reexamination of the '253 patent was filed on October 6, 2006. The request was assigned control No. 90/008,272 (the '8272 reexamination proceeding).

9. Reexamination was ordered for the '8272 proceeding on December 8, 2006.

10. On August 3, 2007, the Office issued a decision entitled "*Sua Sponte* Merging Reexamination Proceedings," which merged the '8052, '8262, '8265 and '8272 reexamination proceedings (hereinafter, the merged proceeding).

11. On November 1, 2007, patent owner filed an Information Disclosure Statement (IDS) under 37 CFR 1.555, 1.97 and 1.98 in the merged proceeding.

12. Concurrent with the IDS submissions of November 1, 2007, patent owner filed a petition under 37 CFR 1.183 requesting waiver of the formal submission requirements for an IDS under 37 CFR 1.555 and 1.98 in terms of supplying copies for all four reexamination proceeding.

DECISION

37 CFR 1.555(a) states (in part):

> . . . .
> Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.98 states (in part):

> (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.
> . . . .
> (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.
> . . . .

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that a separate IDS with copies of certain types of references must be provided in each separate application/proceeding to constitute a proper IDS. By filing an IDS with all necessary copies after the merger of the four previously separate proceedings, patent owner has satisfied this formal requirement. Accordingly, the petition is moot.

It is to be noted that this decision is not an acknowledgement that patent owner's November 1, 2007 submission complies with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of this decision.

A fee o f $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's November 1, 2007 petition submission. A review of Office records indicates that one fee has been charged, which is proper as the proceedings were merged at the time of the November 1, 2007 submission. If additional petition fees related to the November 1, 2007 petition filing occur, in the other listed but now merged proceedings, patent owner may wish to seek a refund of those fees at that time.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is dismissed as moot.

2. The requirement for providing copies of IDS information of 37 CFR 1.98(a) is satisfied by the single submission of the copies, since the four reexamination proceedings have been merged into one consolidated proceeding.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers at the point when 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 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

11-21-07
c:\Kiva\kenids\decisions\90_8052_8262_8265_8272-1.183(merged) moot petit waive copy ref req 1.98.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

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AUG 0 9 2007

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	For Third Party Requester
DAVID J. MCKENZIE FOR ENC Technology Corp.: 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	For Third Party Requester
J Andrew Lowes, Esq. HAYNES AND BOONE LLP 901 Main Street Suite 3100 Dallas, TX 75202	For Third Party Requester

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Freeny
Ex Parte Reexamination Proceeding
Control No. 90/008,053
Filed: June 6, 2006

For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,263 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,273 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,264 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

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. 7,016,943 issued on March 21, 2006.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,053 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,053 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,053.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,263 was requested by a third party requester filed on October 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,263 on December 8, 2006.

7. There are currently no amendments proceeding control number 90/008,263.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,273 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,273 on December 8, 2006

10 There are currently no amendments proceeding control number 90/008,273.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,264 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,264 on December 8, 2006

13 There are currently no amendments proceeding control number 90/008,264.

14. Proceedings control numbers 90/008,053; 90/008,263; 90/008,264 and 90/008,273 await 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 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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. 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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
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.
90/008,263	10/06/2006	7016943	077482.0101	2421

30589 7590 08/09/2007

DUNLAP, CODDING & ROGERS P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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AUG 0 9 2007

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	For Third Party Requester
DAVID J. MCKENZIE FOR ENC Technology Corp.: 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	For Third Party Requester
J Andrew Lowes, Esq. HAYNES AND BOONE LLP 901 Main Street Suite 3100 Dallas, TX 75202	For Third Party Requester
	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Freeny
Ex Parte Reexamination Proceeding
Control No. 90/008,053
Filed: June 6, 2006

For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,263 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,273 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,264 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

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. 7,016,943 issued on March 21, 2006.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,053 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,053 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,053.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,263 was requested by a third party requester filed on October 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,263 on December 8, 2006.

7. There are currently no amendments proceeding control number 90/008,263.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,273 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,273 on December 8, 2006

10 There are currently no amendments proceeding control number 90/008,273.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,264 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,264 on December 8, 2006

13 There are currently no amendments proceeding control number 90/008,264.

14. Proceedings control numbers 90/008,053; 90/008,263; 90/008,264 and 90/008,273 await 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 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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.

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CONCLUSION

1. Reexamination Control Nos. 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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:

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Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

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

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

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

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

Lissi 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

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	:	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	:	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	:	For Third Party Requester
DAVID J. MCKENZIE FOR ENC Technology Corp.: 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	:	For Third Party Requester
J Andrew Lowes, Esq. HAYNES AND BOONE LLP 901 Main Street Suite 3100 Dallas, TX 75202	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

MAILED

AUG 0 9 2007

CENTRAL REEXAMINATION UNIT

In re: Freeny
Ex Parte Reexamination Proceeding
Control No. 90/008,053
Filed: June 6, 2006

Copied from 90008053 on 10/11/2007

For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,263 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,273 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,264 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

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. 7,016,943 issued on March 21, 2006.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,053 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,053 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,053.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,263 was requested by a third party requester filed on October 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,263 on December 8, 2006.

Copied from 90008053 on 10/11/2007

7. There are currently no amendments proceeding control number 90/008,263.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,273 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,273 on December 8, 2006

10 There are currently no amendments proceeding control number 90/008,273.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,264 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,264 on December 8, 2006

13 There are currently no amendments proceeding control number 90/008,264.

14. Proceedings control numbers 90/008,053; 90/008,263; 90/008,264 and 90/008,273 await 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.

Copied from 90008053 on 10/11/2007

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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. 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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

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

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

Lissi M. Marquis,
Director,
Central Reexamination Unit

Copied from 90008053 on 10/11/2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 03 2007

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C.
PO BOX 16370
OKLAHOMA CITY OK 73113 : For Patent Owner

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248 : For Third Party Requester

MICHAEL HAWES
BAKER BOTTS L. L. P.
910 LOUISIANA
HOUSTON, TX 77005 : For Third Party Requester

HAYNES AND BOONE LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202 : For Third Party Requester

DAVID J. MCKENZIE FOR ENC Technology Corp.:
8 EAST BROADWAY
SUITE 600
SALT LAKE CITY, UT 84111 : For Third Party Requester

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Freeny
Ex Parte Reexamination Proceeding
Control No. 90/008,052
Filed: June 6, 2006
For: US Patent No. 6,360,253

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,262 :
Filed: February 2, 2007 :
For: US Patent No. 6,360,253 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,265 :
Filed: October 6, 2006 :
For: US Patent No. 6,360,253 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,272 :
Filed: October 6, 2006 :
For: US Patent No. 6,360,253 :

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. 6,360,253 issued on March 19, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,052 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,052 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,052.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,262 was requested by a third party requester filed on February 2, 2007.

6. The Reexamination Order was granted in proceeding, control no. 90/008,262 on March 23, 2007.

7. There are currently no amendments proceeding control number 90/008,262.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,265 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,265 on January 3, 2007.

10 There are currently no amendments proceeding control number 90/008,265.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,272 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,272 on December 8, 2006.

13. There are currently no amendments proceeding control number 90/008,272.

14. Proceedings control numbers 90/008,052; 90/008,262; 90/008,265; and 90/008,272 await 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 90/008,052; 90/008,262; 90/008,265; and 90/008,272 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. 90/008,052; 90/008,262; 90/008,265; and 90/008,272 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

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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,265	10/06/2006	6360253	38653.2.14	3829

30589 7590 11/23/2007
DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,262	02/02/2007	6360253	077482.0101	7010

30589 7590 11/23/2007
DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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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.
90/008,052	06/06/2006	6360253	LMI 001	7415

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,272	10/06/2006	6360253	2231.7.1	8070

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

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NOV 23 2007
CENTRAL REEXAMINATION UNIT

Dunlap, Codding, & Rogers PC
PO Box 16370
Oklahoma City, OK 73113 (For Patent Owner)

Law Office of David H. Judson
15455 Dallas Parkway
Addison, TX 75001 (For First Requester)

Baker Botts LLP
910 Louisiana
Houston, TX 77005 (For Second Requester)

Haynes and Boone LLP
901 Main Street, Suite 3100
Dallas, TX 75202 (For Third Requester)

ENC Technology Corp.
8 East Broadway, Suite 600
Salt Lake City, UT 84111 (For Fourth Requester)

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,052
Filed: June 6, 2006
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,262
Filed: February 2, 2007
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,265
Filed: October 6, 2006
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,272
Filed: October 6, 2006
For: U.S. Patent No. 6,360,253 B1

DECISION DISMISSING

PETITION UNDER

37 CFR § 1.183

This is a decision on the November 1, 2007 patent owner petition entitled "PETITION TO WAIVE THE SUBMISSION REQUIREMENTS OF 37 CFR §1.98 (37 CFR 1.183)" The petition requests waiver of the formal submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in a related case.

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

The petition is dismissed as moot.

REVIEW OF FACTS

1. U.S. Patent No. 6,360,253 (the '253 patent) issued on March 19, 2002.

2. A request for *ex parte* reexamination of the '253 patent was filed on June 6, 2006. The request was assigned control No. 90/008,052 (the '8052 reexamination proceeding).

3. Reexamination was ordered for the '8052 proceeding on August 11, 2006.

4. A second request for *ex parte* reexamination of the '253 patent was filed on February 2, 2007. The request was assigned control No. 90/008,262 (the '8262 reexamination proceeding).

5. Reexamination was ordered for the '8262 proceeding on March 23, 2007.

6. A third request for *ex parte* reexamination of the '253 patent was filed on October 6, 2006. The request was assigned control No. 90/008,265 (the '8265 reexamination proceeding).

7. Reexamination was ordered for the '8265 proceeding on January 3, 2007.

8. A fourth request for *ex parte* reexamination of the '253 patent was filed on October 6, 2006. The request was assigned control No. 90/008,272 (the '8272 reexamination proceeding).

9. Reexamination was ordered for the '8272 proceeding on December 8, 2006.

10. On August 3, 2007, the Office issued a decision entitled "*Sua Sponte* Merging Reexamination Proceedings," which merged the '8052, '8262, '8265 and '8272 reexamination proceedings (hereinafter, the merged proceeding).

11. On November 1, 2007, patent owner filed an Information Disclosure Statement (IDS) under 37 CFR 1.555, 1.97 and 1.98 in the merged proceeding.

12. Concurrent with the IDS submissions of November 1, 2007, patent owner filed a petition under 37 CFR 1.183 requesting waiver of the formal submission requirements for an IDS under 37 CFR 1.555 and 1.98 in terms of supplying copies for all four reexamination proceeding.

DECISION

37 CFR 1.555(a) states (in part):

> . . . .
> Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.98 states (in part):

> (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.
> . . . .
> (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.
> . . . .

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that a separate IDS with copies of certain types of references must be provided in each separate application/proceeding to constitute a proper IDS. By filing an IDS with all necessary copies after the merger of the four previously separate proceedings, patent owner has satisfied this formal requirement. Accordingly, the petition is moot.

It is to be noted that this decision is not an acknowledgement that patent owner's November 1, 2007 submission complies with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of this decision.

A fee o f $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's November 1, 2007 petition submission. A review of Office records indicates that one fee has been charged, which is proper as the proceedings were merged at the time of the November 1, 2007 submission. If additional petition fees related to the November 1, 2007 petition filing occur, in the other listed but now merged proceedings, patent owner may wish to seek a refund of those fees at that time.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is dismissed as moot.

2. The requirement for providing copies of IDS information of 37 CFR 1.98(a) is satisfied by the single submission of the copies, since the four reexamination proceedings have been merged into one consolidated proceeding.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers at the point when 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 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

11-21-07
c:\Kiva\kenids\decisions\90_8052_8262_8265_8272-1.183(merged) moot petit waive copy ref req 1.98.doc

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.
90/008,270	11/30/2006	6848370		8914

7590 06/05/2008

WORKMAN NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ERIC A. LAMORTE
LAMORTE & ASSOCIATES, PC
P.O. BOX 434
YARDLEY, PA 19067

Date:
MAILED
JUN 05 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008270
PATENT NO. : 6848370
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
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WORKMAN NYDEGGER & SEELEY (For Patent Owner)
1000 EAGLE GATE TOWER
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SALT LAKE CITY UT 84111

ERIC A. LAMORTE (For Third Party Requester)
LAMORTE & ASSOCIATES, PC
PO BOX 434
YARDLEY, PA 19067

MAILED
JUN 05 2008
CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
C. Stanford :
Control No. 90/008,270 : DECISION GRANTING PETITION
Filed: October 10, 2006 :
U.S. Patent No. 6,848,370 :
Attorney Docket No. 15499.935 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 8, 2008, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states, in part:

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

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (Amendment And Response To Office Action Mailed December 10, 2007 ("Amendment") - item 1), a $1,540.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3) but no Certificate of Service on the Third Party Requester.

On May 27, 2008, a Response To Ex Parte Reexamination Communication Mailed My 7, 2008 ("Response") was filed.

On May 29, 2008, in response to a telephone communication between Counsel, Richard Gilmore and Senior Legal Advisor, Fred Silverberg, the Certificate of Service on the Third Party Requester regarding the May 8, 2008 petition was submitted by facsimile transmission.

The petition for entry of the late papers is granted.

No terminal disclaimer and disclaimer fee are due on this application, as the utility application was filed after June 8, 1995.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the "Amendment" and "Response" filed May 8, 2008 and May 27, 2008, respectively, in due course.

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

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

Fred A. Silverberg

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Standley Law Group LLP
495 Metro Place South
Suite 210
Dublin, OH 43017

(For Patent Owner)

MAILED

OCT 2 6 2007

CENTRAL REEXAMINATION UNIT

Enclosure: copy of third party requester's Change of Correspondence Address filed September14, 2007.

Dr. Aldo Laghi
c/o Ronald A. Christaldi
101 East Kennedy Boulevard, Suite 2800
Tampa, FL 33602[1]

(For 3rd Party Requester)

Reexam Control No.: 90/008,271
Filed : October 5, 2006
For U.S. Patent No. : 6,964,688

Reexam Control No.: 90/008,578
Filed : May 7, 2007
For U.S. Patent No. : 6,964,688

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. 90/008,271 was ordered in a decision mailed December 1, 2006 indicating that claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69 would be reexamined. A non-final Office action was mailed June 21, 2007. On July 30, 2007 an amendment was filed. The amendment amended claim 1. No further action has taken place in this reexamination proceeding.

[1] Third party requester filed a Change of Correspondence Address on September 14, 2007. The submission did not include an indication that it had been served on patent owner as is required by 37 CFR 1.550(f). A copy of the September 14, 2007 communication is being sent with this decision to patent owner.

Reexamination in application control No. 90/008,578 was ordered in a decision mailed June 20, 2007 indicating that claims 4-7, 9, 20-22, 24, 25, 28, 48, 57-59, 61 and 67 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. An Information Disclosure Statements was filed October 3, 2007. Thus, there have been no changes made to the specification, claims, or drawings.

As evidenced by the above facts, reexamination control No. 90/008,271 and reexamination control No. 90/008,578 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

As noted above, claim 1 has been amended in the '271 reexamination proceeding by virtue of the amendment filed July 30, 2007. No amendments have been filed in the '578 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1, 2, 4-13, 16-28, 48, 50, 51, 54-67 and 69, the only claims 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 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. 90/008,271 and 90/008,578 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files**. Upon receipt of the response, an Office action will issue in due course.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

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Patent Number	6984688
Issue Date	November 15, 2005
Reexam Control Number	90/008,578
Filing Date	October 15, 1989
First Named Inventor	Bruce G. Kania
Attorney Docket Number	

THIRD PARTY PAPER
3PR

Please change the Correspondence Address for the above-identified patent to:

☐ The address associated with Customer Number:

OR

☑ Firm or Individual Name Dr. Aldo A. Laghi

Address C/O Ronald A. Christaldi, 101 East Kennedy Boulevard, Suite 2800

33602

City Tampa | State Florida | ZIP 33602

Country USA

Telephone 813-229-7600 | Email rchristaldi@alk-law.com

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I am the:

☐ Patentee.

☐ Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ Third Party Requestor

Signature

Typed or Printed Name Dr. Aldo A. Laghi

Date 9/14/07 | Telephone (727) 528-8566

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Post Issue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Standley Law Group LLP
495 Metro Place South
Suite 210
Dublin, OH 43017

(For Patent Owner)

Dr. Aldo Laghi
c/o Ronald A. Christaldi
101 East Kennedy Boulevard, Suite 2800
Tampa, FL 33602

(For 3rd Party Requester)

Reexam Control No.: 90/008,271
Filed : October 5, 2006
For U.S. Patent No. : 6,964,688

Reexam Control No.: 90/008,578
Filed : May 9, 2007
For U.S. Patent No. : 6,964,688

Reexam control No.: 90/008,979
Filed : January 2, 2008
For U.S. Patent No. : 6,964,688

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. 90/008,271 was ordered in a decision mailed December 1, 2006 indicating that claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69 would be reexamined. A non-final Office action was mailed June 21, 2007. On July 30, 2007 an amendment was filed. The amendment amended claim 1.

Reexamination in application control No. 90/008,578 was ordered in a decision mailed June 20, 2007 indicating that claims 4-7, 9, 20-22, 24, 25, 28, 48, 57-59, 61 and 67 would be reexamined.

In a decision mailed October 26, 2007, reexamination proceedings 90/008,271 and 90/008,578 were merged. A condition for the merger was the filing of a housekeeping amendment placing identical claims in each of the two proceedings. A housekeeping amendment was received December 6, 2007 (informal), and a corrected housekeeping amendment was received December 10, 2007. In addition a "Terminal Disclaimer to Obviate a Double Patenting Rejection Over a "Prior Art"" was filed December 14, 2007 (approved December 17, 2007), and a "Supplemental Notification of Prior and/or Concurrent Proceedings" was filed March 3, 2008.

Reexamination in application control 90/008,979 was ordered in a decision mailed February 6, 2008 indicating that claims 2, 8, 10, 12, 13, 16-19, 23, 26, 27, and 69 would be reexamined. A "Waiver of Right to File Patent Owner Statement and Notification of Prior and/or Concurrent Proceedings' was filed on March 3, 2008. An Information Disclosure Statement was filed July 28, 2008. No amendments to the claims, specification and/or drawings have been filed 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. 90/008,271, reexamination control No. 90/008,578, and reexamination control No. 90/008,979 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

As noted above, claim 1 has been amended in the '271 and '578 reexamination proceedings by virtue of the amendment filed December 10, 2007. No amendments have been filed in the '979 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the three files**. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1, 2, 4-13, 16-28, 48, 50, 51, 54-67 and 69, the only claims 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 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. 90/008,271, 90/008,578, and 90/008,979 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files.** Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

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AUG 03 2007

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C.
PO BOX 16370
OKLAHOMA CITY OK 73113 : For Patent Owner

LAW OFFICE OF DAVID H. JUDSON
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MICHAEL HAWES
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HOUSTON, TX 77005 : For Third Party Requester

HAYNES AND BOONE LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202 : For Third Party Requester

DAVID J. MCKENZIE FOR ENC Technology Corp.:
8 EAST BROADWAY
SUITE 600
SALT LAKE CITY, UT 84111 : For Third Party Requester

: DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Freeny
Ex Parte Reexamination Proceeding
Control No. 90/008,052
Filed: June 6, 2006
For: US Patent No. 6,360,253

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,262 :
Filed: February 2, 2007 :
For: US Patent No. 6,360,253 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,265 :
Filed: October 6, 2006 :
For: US Patent No. 6,360,253 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,272 :
Filed: October 6, 2006 :
For: US Patent No. 6,360,253 :

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. 6,360,253 issued on March 19, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,052 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,052 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,052.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,262 was requested by a third party requester filed on February 2, 2007.

6. The Reexamination Order was granted in proceeding, control no. 90/008,262 on March 23, 2007.

7. There are currently no amendments proceeding control number 90/008,262.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,265 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,265 on January 3, 2007.

10 There are currently no amendments proceeding control number 90/008,265.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,272 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,272 on December 8, 2006.

13. There are currently no amendments proceeding control number 90/008,272.

14. Proceedings control numbers 90/008,052; 90/008,262; 90/008,265; and 90/008,272 await 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 90/008,052; 90/008,262; 90/008,265; and 90/008,272 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. 90/008,052; 90/008,262; 90/008,265; and 90/008,272 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

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
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,272	10/06/2006	6360253	2231.7.1	8070

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,262	02/02/2007	6360253	077482.0101	7010

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,052	06/06/2006	6360253	LMI 001	7415

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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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
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,265	10/06/2006	6360253	38653.2.14	3829

30589 7590 11/23/2007

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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Dunlap, Codding, & Rogers PC
PO Box 16370
Oklahoma City, OK 73113 (For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Law Office of David H. Judson
15455 Dallas Parkway
Addison, TX 75001 (For First Requester)

Baker Botts LLP
910 Louisiana
Houston, TX 77005 (For Second Requester)

Haynes and Boone LLP
901 Main Street, Suite 3100
Dallas, TX 75202 (For Third Requester)

ENC Technology Corp.
8 East Broadway, Suite 600
Salt Lake City, UT 84111 (For Fourth Requester)

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,052
Filed: June 6, 2006
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,262
Filed: February 2, 2007
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,265
Filed: October 6, 2006
For: U.S. Patent No. 6,360,253 B1

In re Charles C. Fenny, Jr.
Reexamination Proceeding
Control No.: 90/008,272
Filed: October 6, 2006
For: U.S. Patent No. 6,360,253 B1

DECISION DISMISSING

PETITION UNDER

37 CFR § 1.183

This is a decision on the November 1, 2007 patent owner petition entitled "PETITION TO WAIVE THE SUBMISSION REQUIREMENTS OF 37 CFR §1.98 (37 CFR 1.183)" The petition requests waiver of the formal submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in a related case.

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

The petition is dismissed as moot.

REVIEW OF FACTS

1. U.S. Patent No. 6,360,253 (the '253 patent) issued on March 19, 2002.

2. A request for *ex parte* reexamination of the '253 patent was filed on June 6, 2006. The request was assigned control No. 90/008,052 (the '8052 reexamination proceeding).

3. Reexamination was ordered for the '8052 proceeding on August 11, 2006.

4. A second request for *ex parte* reexamination of the '253 patent was filed on February 2, 2007. The request was assigned control No. 90/008,262 (the '8262 reexamination proceeding).

5. Reexamination was ordered for the '8262 proceeding on March 23, 2007.

6. A third request for *ex parte* reexamination of the '253 patent was filed on October 6, 2006. The request was assigned control No. 90/008,265 (the '8265 reexamination proceeding).

7. Reexamination was ordered for the '8265 proceeding on January 3, 2007.

8. A fourth request for *ex parte* reexamination of the '253 patent was filed on October 6, 2006. The request was assigned control No. 90/008,272 (the '8272 reexamination proceeding).

9. Reexamination was ordered for the '8272 proceeding on December 8, 2006.

10. On August 3, 2007, the Office issued a decision entitled "*Sua Sponte* Merging Reexamination Proceedings," which merged the '8052, '8262, '8265 and '8272 reexamination proceedings (hereinafter, the merged proceeding).

11. On November 1, 2007, patent owner filed an Information Disclosure Statement (IDS) under 37 CFR 1.555, 1.97 and 1.98 in the merged proceeding.

12. Concurrent with the IDS submissions of November 1, 2007, patent owner filed a petition under 37 CFR 1.183 requesting waiver of the formal submission requirements for an IDS under 37 CFR 1.555 and 1.98 in terms of supplying copies for all four reexamination proceeding.

DECISION

37 CFR 1.555(a) states (in part):

> . . . .
> Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.98 states (in part):

> (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.
> . . . .
> (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.
> . . . .

37 CFR 1.555 requires that information material to patentability must be filed in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that a separate IDS with copies of certain types of references must be provided in each separate application/proceeding to constitute a proper IDS. By filing an IDS with all necessary copies after the merger of the four previously separate proceedings, patent owner has satisfied this formal requirement. Accordingly, the petition is moot.

It is to be noted that this decision is not an acknowledgement that patent owner's November 1, 2007 submission complies with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of this decision.

A fee o f $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's November 1, 2007 petition submission. A review of Office records indicates that one fee has been charged, which is proper as the proceedings were merged at the time of the November 1, 2007 submission. If additional petition fees related to the November 1, 2007 petition filing occur, in the other listed but now merged proceedings, patent owner may wish to seek a refund of those fees at that time.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is dismissed as moot.

2. The requirement for providing copies of IDS information of 37 CFR 1.98(a) is satisfied by the single submission of the copies, since the four reexamination proceedings have been merged into one consolidated proceeding.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await the filing of any additional party papers, and to process any and all party papers at the point when 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 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

11-21-07
c:\Kiva\kenids\decisions\90_8052_8262_8265_8272-1.183(merged) moot petit waive copy ref req 1.98.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,273	10/06/2006	7016943	2231.7.1	8068

30589 7590 08/09/2007
DUNLAP, CODDING & ROGERS P.C.
PO BOX 16370
OKLAHOMA CITY, OK 73113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2007

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AUG 0 9 2007

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	For Third Party Requester
DAVID J. MCKENZIE FOR ENC Technology Corp.: 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	For Third Party Requester
J Andrew Lowes, Esq. HAYNES AND BOONE LLP 901 Main Street Suite 3100 Dallas, TX 75202	For Third Party Requester

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Freeny
Ex Parte Reexamination Proceeding
Control No. 90/008,053
Filed: June 6, 2006

For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,263 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,273 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,264 :
Filed: October 6, 2006 :
For: US Patent No. 7,016,943 :

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. 7,016,943 issued on March 21, 2006.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,053 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,053 on August 11, 2006.

4. There are currently no amendments proceeding control number 90/008,053.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,263 was requested by a third party requester filed on October 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,263 on December 8, 2006.

7. There are currently no amendments proceeding control number 90/008,263.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,273 was requested by a third party requester on October 6, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,273 on December 8, 2006

10 There are currently no amendments proceeding control number 90/008,273.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,264 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,264 on December 8, 2006

13 There are currently no amendments proceeding control number 90/008,264.

14. Proceedings control numbers 90/008,053; 90/008,263; 90/008,264 and 90/008,273 await 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 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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. 90/008,053; 90/008,263; 90/008,264 and 90/008,273 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

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

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,275	10/02/2006	6557686	RBI-1Z	1278

7590 02/28/2007

EXAMINER

Thomas N. Young
YOUNG & BASILE PC
3001 West Big Beaver Road
Suite 624
Troy, MI 48084

ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2007

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3/1/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Anthony S. Volpe

Volpe and Koeing, P.C.

United Plaza, Suite 1600, 30 South 17th St.

Philadelphia, PA 19103-4009

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008275

PATENT NO. 6,557,686

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
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Thomas N. Young (For Patent Owner)
Young & Basile P.C.
3001 West Big Beaver Road
Suite 624
Troy, MI 48084

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FEB 28 2007

CENTRAL REEXAMINATION UNIT

Enclosure: Copy of Third Party Requester's February 20, 2007 petition.

Anthony S. Volpe (For Third Party Requester)
Volpe and Koenig, P.C.
United PLaza, Suite 1600
30 South 17th Street
Philadelphia, PA 19103-4009

Enclosure: Third Party Requester's February 20, 2007 petition.

In re Budd et al	:
Ex Parte Reexamination Proceeding	:
Control No.: 90/008,275	: **DECISION DISMISSING**
Filed: October 2, 2006	: **AND RETURNING**
For: U.S. Patent No. 6,557,686	: **PETITION**
	:

This is a decision on the February 20, 2007 third party requester request entitled "PETITION PURSUANT TO 37 CFR § 1.182 FOR WITHDRAWAL OF REQUEST FOR REEXAMINATION."

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

The petition is dismissed and is being returned to the requester for the reasons pointed out below.

DECISION RETURNING IMPROPER SUBMISSION

The present petition for withdrawal of the reexamination request filed October 2, 2006, is being returned with this decision, since the request is an improper submission:

1. Pursuant to the second sentence of 37 CFR 1.540:

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

Under 37 CFR 1.540, the present petition does not have an entry right, since it is not a statement under 37 CFR 1.530, nor is it a reply under 37 CFR 1.535, and it has been filed prior to the start of *ex parte* examination on the merits. It is also to be noted that, except for the right to file a reply under 37 CFR 1.535 where appropriate, a third party requester has no right to comment or participate in a reexamination proceeding.

2. As to third parties in general, 37 CFR 1.550 provides:

> (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 petition is not entitled to entry under 37 CFR 1.550, as a submission by a third party in general, since it is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, it is not a reply to a patent owner's statement pursuant to 37 CFR 1.535, and it does not qualify as a prior art citation under 37 CFR 1.501.

3. Accordingly, the present petition does not have an entry right under the rules, it will not be made of record in the reexamination file, and it is being returned with this decision. See MPEP 2267. This decision returning the improper petition submission is, however, being made of record in the reexamination file.

ADDITIONAL DISCUSSION

The third party requester has not requested the waiver of any regulation precluding entry of the present petition; however, no such waiver would be appropriate even if requested. Neither the statute, nor the rules, provide for the withdrawal of a request for reexamination that is presently sought. In fact, no withdrawal of a request for reexamination is possible. As stated in MPEP 2210:

> "After the request for reexamination, including the entire fee for requesting reexamination is received in the Office, no abandonment, withdrawal or striking of the request is possible, regardless of who requests the same."

See also *Joy Manufacturing Co. v National Mine Service Co,* 810 F.2d 1127 (Fed. Cir. 1987), where the court stated:

> "In this connection, we also note that the principal relief which Joy seeks -- namely, stopping the re-examination of its patent -- is not available in these proceedings. Accord Manual of Patent Examining Procedure § 2210 (5th ed. 1983);..."

The statement in MPEP 2210 is grounded upon the following analysis:

35 U.S.C. § 302 states, in pertinent part:

> "Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

35 U.S.C. § 303(a) states, in pertinent part:

> "Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director **will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request**, with or without consideration of other patents or printed publications. ... **On his own initiative, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title**." (Emphasis supplied.)

35 U.S.C. § 304 states, in pertinent part:

> "If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination **will include an order for reexamination of the patent for resolution of the question**." (Emphasis supplied.)

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

> "After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination **will** be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. ... In any reexamination proceeding under this chapter, **the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto**, ..." (Emphasis supplied.)

35 U.S.C. §§ 302–305 provide, *inter alia*, that when a request for reexamination is filed, the Director <u>will</u> determine whether a substantial new question of patentability exists. [1] Thereafter, if the Director has determined that a substantial new question of patentability exists, that determination <u>will</u> include an order for reexamination of <u>the patent</u>. [2] Thereafter, reexamination <u>will</u> be conducted, and patent owner <u>will</u> be permitted to propose amendment of <u>his patent</u> and addition of a new claim or claims <u>thereto</u>. [3]

A request to withdraw an *ex parte* reexamination request is not permitted in view of that enacted legislation and the implementing rules which require that (1) once an *ex parte* reexamination request is filed, it will be decided, and (2) once the request is determined to raise a substantial new question of patentability of a claim of the patent, the request *will* result in an order for reexamination to resolve the substantial new question, which in turn *will* be followed by reexamination in accordance with 35 U.S.C. §§ 303-305.

The statutory language is based on the public interest in resolving any reexamination proceeding that is filed. Withdrawal of a third party requested reexamination proceeding would leave both the public and the patent owner with an unresolved request for reexamination. Both the public and the patent owner have a right to such a resolution. Further, in the event a substantial new

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[1] 35 U.S.C. § 303
[2] 35 U.S.C. § 304
[3] 35 U.S.C. § 305

question of patentability is raised by the request, the patent owner has a statutory right to have that question resolved, including amending the patent as patent owner deems necessary. All of this would be abrogated by "withdrawing" or otherwise "abandoning" or "terminating" a reexamination.

It is finally to be noted that, even **if** a reexamination request could be withdrawn, the Director is authorized under 35 U.S.C. § 303(a) to order reexamination on his own initiative, based on any substantial new question of patentability which might be raised by such a request. [4] As a matter of administrative convenience, the Office need not, and does not, expend the additional resources needed to terminate one reexamination proceeding only to institute (on its own initiative) another one based on the same substantial new question of patentability that exists in a reexamination sought to be withdrawn.

SERVICE

Under 37 CFR 1.550(f):

> After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

A review of the petition paper filed on February 20, 2007, shows that it does not reflect service on the patent owner as required by 37 CFR 1.550(f). A certificate of service for the third party requester petition paper filed February 20, 2007, has not been found present as part of the paper. Accordingly, a copy of the February 20, 2007 petition paper is being supplied to patent owner with this decision.

In the future, any submission by the third party requestor for the present reexamination proceeding must be served on the patent owner, and such service must be evidenced by the inclusion of a certificate of service on the patent owner.

CONCLUSION

1. The third party requester petition filed February 20, 2007, is <u>dismissed</u> as not having an entry right.

2. The February 20, 2007 petition is being <u>returned</u> to the requester with the present decision.

3. A copy of the February 20, 2007 petition is being provided to the patent owner with the present decision.

4. No copy of the petition will be maintained in the electronic Image File Wrapper, or elsewhere in the Office.

---

[4] And such would serve the public interest on which the Director-initiated-reexamination enactment is grounded.

5. A copy of this decision will be made of record in the electronic Image File Wrapper for the present reexamination proceeding.

6. Jurisdiction over the present *ex parte* reexamination proceeding is being returned to the Central Reexamination Unit (CRU), for appropriate action in due course.

7. Telephone inquiries related to the present decision should be directed to the undersigned at 571-272-7710.

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

C:\kiva\kenWD\ 8275 Withdraw Request.doc
February 27, 2007

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,275	10/02/2006	6557686	RBI-1Z	1278

7590 01/31/2008

EXAMINER

Thomas N. Young
YOUNG & BASILE PC
3001 West Big Beaver Road
Suite 624
Troy, MI 48084

ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Anthony S. Volpe
Volpe and Koeing, P.C.
United Plaza, Suite 1600, 30 South 17th St.
Philadelphia, PA 19103-4009

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008275
PATENT NO. : 6557686
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Thomas N. Young YOUNG & BASILE PC 3001 West Big Beaver Road Suite 624 Troy MI 48084	:	(For Patent Owner)
VOLPE & KOENIG, P. C. United Plaza, Suite 1600 30 South 17th Street Philadelphia, PA 19103-4009	:	(For Third Party Requester)
	:	DECISION GRANTING PETITION TO ACCEPT RESPONSE
In re: Budd *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/008,275 Deposited: 2 October 2006 For: US Patent No. 6.557,686	:	

MAILED

JAN 31 2008

CENTRAL REEXAMINATION UNIT

This is a decision on the 2 January 2008, petition for "Patent Owner's Petition To The Commissioner To Accept The Response Timely Filed On August 28, 2007 Under 37 CFR 1.550 (f) Or, Provisionally, To Revise And Continue The Reexamination Proceeding On The Basis Of The Timely Filed Response Pursuant To 37 CFR 1.137 (b)."

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

The petition to revive under 37 CFR 1.137 (b) is hereby dismissed pursuant to 37 CFR 1.4 (c).

The petition to accept the Patent Owner's response as timely is treated under 37 CFR 1.181 and is hereby granted.

Decision

The Patent Owner requests that the 28 August 2007 Patent Owner's response be accepted as timely due to mitigating circumstances. Further in the event that the response is not accepted the petitioner requests that the proceeding be revived under 37 CFR 1.137 (b). The petition for extension of time was timely filed on 2 January 2008, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.17(g).

37 CFR § 1.137 Revival of abandoned application, terminated or limited reexamination prosecution, or lapsed patent
(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.

37 CFR § 1.4 Nature of Correspondence.
(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.

37 CFR § 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. I

Analysis and Findings

As required by 37 CFR 1.4(c) only a single matter may be petitioned in any given paper. As such the second petition to revive under 37 CFR 1.137 (b) is dismissed and only the petition to accept the 28 August 2007 response as timely will be considered in this petition decision. The petition under 37 CFR 1.137 (B) is hereby **dismissed**.

The petition to accept the 28 August 2007 response as complete and timely under consideration of mitigating circumstances is hereby considered and granted. The petition is treated under 37 CFR 1.181 as a petition to the director of the Central Reexamination Unit. The mitigating circumstances regarding the confusion to whom the papers should be served are considered to be sufficiently mitigating circumstances beyond the control of the patent owner and the later service of the papers considered to be acceptable.

The petition request to accept the 28 August 2007 Patent Owner's response as timely and complete is hereby **granted.**

Conclusion

1. The patent owner's petition to accept the 28 August 2007 response as timely is hereby **granted.**

2. This proceeding is being returned to the examiner assigned to this proceeding for further action.

3. Future correspondence may be submitted as follows:

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

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

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

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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United States Patent and Trademark Office
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MORGAN, LEWIS & BOCKIUS, LLP.
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO CA 94306

(For Patent Owner)

Greenblum & Bernstein, P.L.C.
1950 Roland Clark Place
Reston, VA 20191

(For Third Party Requester)

In re Application of 5404505
Appl. No.: 90/008,282
Filed: October 05, 2006
For: **SYSTEM FOR SCHEDULING TRANSMISSION OF INDEXED AND REQUESTED DATABASE TIES ON DEMAND AT VARYING REPETITION RATES**

RESPONSE TO PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed August 31, 2007, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate, at which time the petition will be decided.

Petitioner requests that a document entitled Via Cable Vol. I No. 12 dated December 1981, pp. COMF1N01670923-01670933, HTU Delivery System Overview, pp. COMF1N00702581-00702583, CableVision dated February 9, 1981 pp. L10523-10525, The CableComputer dated November, 1984 pp. COMF1N00702584-00702595 , filed August 31, 2007, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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.
90/008,282	10/05/2006	5404505	060900-5021US	5471

24341 7590 02/12/2008

MORGAN, LEWIS & BOCKIUS, LLP.
2 PALO ALTO SQUARE
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PALO ALTO, CA 94306

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2008

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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.
90/008,408	01/12/2007	5404505	060900-5020US	4280

24341 7590 02/12/2008

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PALO ALTO, CA 94306

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,807	08/01/2007	5404505		5300

22913 7590 02/12/2008

WORKMAN NYDEGGER
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Greenblum & Bernstein, P.L.C.
Attn: Bruce H. Stoner
1950 Roland Clarke Place
Reston, VA 20191

Date:
MAILED
FEB 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008282
PATENT NO. : 5404505
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NONE

Date:
MAILED
FEB 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008408
PATENT NO. : 5404505
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Steven B. Samuels
WOODCOCK WASHBURN LLP
2929 Arch Street 12th Floor, Cira Centre
Philadelphia, PA. 19104-2891

Date:

MAILED
FEB 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008807
PATENT NO. : 5404505
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
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MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

Morgan, Lewis & Brockius, LLP (For Patent Owner)
2 Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306

Greenblum & Bernstein, PLC (For Third Party Requester)
Attn: Bruce Stoner
1950 Roland Clarke Place
Reston, VA 20191

Steven B. Samuels (For Third Party Requester)
Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th floor
Philadelphia, PA 19104-2891

In re Levinson Reexamination Proceeding Control No. 90/008,282 Request Deposited: October 5, 2006 For: U.S. Patent No. 5,404,505	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Levinson Reexamination Proceeding Control No. 90/008,408 Request Deposited: January 12, 2007 For: U.S. Patent No. 5,404,505	
In re Levinson Reexamination Proceeding Control No. 90/008,807 Corrected Request Deposited: August 1, 2007 For: U.S. Patent No. 5,404,505	

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. 5,404,505 (hereinafter, the '505 patent), issued to Levinson, on April 4, 1995.

2. On October 5, 2006, a third party requester deposited a Request for *Ex Parte* Reexamination of the '505 patent. The reexamination proceeding was assigned Control No. 90/008,282 (hereinafter, the '8282 proceeding).

3. The Reexamination Order was granted in the '8282 proceeding on December 11, 2006.

4. There are currently no amendments in the '8282 proceeding.

5. On January 12, 2007, a third party requester deposited a Request for *Ex Parte* Reexamination of the '505 patent. The reexamination proceeding was assigned Control No. 90/008,408 (hereinafter, the '8408 proceeding).

6. The Reexamination Order was granted in the '8408 proceeding on March 21, 2007.

7. There are currently no amendments in the '8408 proceeding.

8. On August 1, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '505 patent. The reexamination proceeding was assigned Control No. 90/008,807 (hereinafter, the '8807 proceeding).

9. The Reexamination Order was granted in the '8807 proceeding on September 28, 2007.

10. There are currently no amendments in the '8807 proceeding.

11. The '8282, 8408, and '8807 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 '8282, '8408, and the '8807 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. 90/008,282, 90/008,408, and 90/008,807 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

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.
90/008,282	10/05/2006	5404505	060900-5021US	5471

24341 7590 10/20/2009

MORGAN, LEWIS & BOCKIUS, LLP. (PA)
2 PALO ALTO SQUARE
3000 EL CAMINO REAL, SUITE 700
PALO ALTO, CA 94306

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/20/2009

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

Workman Nydegger (For Patent Owner)
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

MAILED

OCT 20 2009

CENTRAL REEXAMINATION UNIT

Bruce H. Stoner (For Requester)
Greenblum & Bernstein, P.L.C.
1950 Roland Clark Place
Reston, VA 20191

Steven B. Samuels (For Requester)
Woodcock Washburn LLP
Cira Centre 2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891

Morgan, Lewis & Bockius, LLP (Courtesy Copy)
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, CA 94306

In re Frank H. Levinson :
Ex Parte Reexamination Proceeding :
Control No. 90/008,282 :
Filed: October 5, 2006 :
For: U.S. Patent No. 5,404,505 :
:
In re Frank H. Levinson : **DECISION**
Ex Parte Reexamination Proceeding : **GRANTING**
Control No. 90/008,408 : **PETITION UNDER**
Filed: January 12, 2007 : **37 CFR 1.137(b)**
For: U.S. Patent No. 5,404,505 :
:
In re Frank H. Levinson :
Ex Parte Reexamination Proceeding :
Control No. 90/008,807 :
Filed: August 1, 2007 :
For: U.S. Patent No. 5,404,505 :

In re Frank H. Levinson :
Ex Parte Reexamination Proceeding :
Control No. 90/009,318 :
Filed: November 5, 2008 :
For: U.S. Patent No. 5,404,505 :

This is a decision on the July 15, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Patent Owner's Statement of Interview and revive the present terminated merged reexamination ("the July 15, 2009 patent owner petition to revive").[1]

The July 15, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

The July 15, 2009 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.

---

[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" 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 May 20, 2009.

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

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

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*
*

(d) *Terminal disclaimer.*

*
*

(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

(e) If a response by the patent owner is not timely filed in the Office,

*
*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 1.560(b) provides:

In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as

warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).
*
*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), *>subsection< III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the July 15, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this merged reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the May 20, 2009 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the

statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until July 15, 2009, which was untimely. For the purpose of evaluating whether the July 15, 2009 patent owner petition to revive is a grantable petition, the submission of the statement under 37 CFR 1.560(b) on July 15, 2009, satisfies item (1).

Accordingly, the July 15, 2009 patent owner petition to revive is **granted**.

Because the present merged reexamination proceeding is revived, all proceeding papers that would have been proper but for the unintentional termination, including the October 9, 2009 final Office action, are hereby ratified. The mailing date of the October 9, 2009 final Office action is, accordingly, the mailing date of this decision.

PATENT OWNER'S CORRESPONDENCE ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 5,404,505 patent file is that of Workman Nydegger, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, UT 84111.

As a courtesy, this decision is being mailed to the address of Morgan, Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Suite 700, Palo Alto, CA 94306, in view of the Powers of Attorney present in the files of the merged reexamination proceeding.

The address of Workman Nydegger, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, UT 84111, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '505 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The July 15, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this merged reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for processing of the July 15, 2009 Patent Owner's Statement of Interview.

3. All proceeding papers that would have been proper but for the unintentional termination, including the October 9, 2009 final Office action, are ratified. The mailing date of the October 9, 2009 final Office action is accordingly, the mailing

date of this decision. Accordingly, a response to the October 9, 2009 final Office action is due two (2) months from the mailing date of this decision.

4. The address of Workman Nydegger, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, UT 84111, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '505 patent file is made in accordance with 37 CFR 1.33(c).

5. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Majid A. Banankhah, of CRU Art Unit 3992, at (571) 272-3770.

6. 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

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	:	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	:	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	:	For Third Party Requester
J. ANDREW LOWES HAYNES AND BOONE LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202	:	For Third Party Requester
DAVID J. MCKENZIE 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Freeny *Ex Parte* Reexamination Proceeding Control No. 90/008,122 Filed: June 6, 2006 For: US Patent No. 6,999,945	:	

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,286 :
Filed: October 6, 2007 :
For: US Patent No6,999,945 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,287 :
Filed: October 6, 2006 :
For: US Patent No. 6,999,945 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,288 :
Filed: October 6, 2006 :
For: US Patent No. 6,999,945 :

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. 6,999,945 issued on February 14, 2006.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,122 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,122 on October 20, 2006.

4. There are currently no amendments proceeding control number 90/008,122.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,286 was requested by a third party requester filed on October 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,286 on December 8, 2006.

7. There are currently no amendments proceeding control number 90/008,286.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,287 was requested by a third party requester on October 6, 2006, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,287 on December 8, 2006.

10 There are currently no amendments proceeding control number 90/008,287.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,288 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,288 on December 8, 2006.

13. There are currently no amendments proceeding control number 90/008,288.

14. Proceedings control numbers 90/008,122; 90/008,286; 90/008,287; and 90/008,288 await 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 90/008,122; 90/008,286; 90/008,287; and 90/008,288 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. 90/008,122; 90/008,286; 90/008,287; and 90/008,288 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

MRhn for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

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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AUG 03 2007

CENTRAL REEXAMINATION UNIT

DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY OK 73113	:	For Patent Owner
LAW OFFICE OF DAVID H. JUDSON 15950 DALLAS PARKWAY SUITE 225 DALLAS, TX 75248	:	For Third Party Requester
MICHAEL HAWES BAKER BOTTS L. L. P. 910 LOUISIANA HOUSTON, TX 77005	:	For Third Party Requester
J. ANDREW LOWES HAYNES AND BOONE LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202	:	For Third Party Requester
DAVID J. MCKENZIE 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111	:	For Third Party Requester
	:	DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re: Freeny *Ex Parte* Reexamination Proceeding Control No. 90/008,122 Filed: June 6, 2006 For: US Patent No. 6,999,945	:	

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,286 :
Filed: October 6, 2007 :
For: US Patent No6,999,945 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,287 :
Filed: October 6, 2006 :
For: US Patent No. 6,999,945 :

In re: Freeny :
Ex Parte Reexamination Proceeding :
Control No. 90/008,288 :
Filed: October 6, 2006 :
For: US Patent No. 6,999,945 :

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. 6,999,945 issued on February 14, 2006.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,122 was requested by a third party requester on June 6, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,122 on October 20, 2006.

4. There are currently no amendments proceeding control number 90/008,122.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,286 was requested by a third party requester filed on October 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,286 on December 8, 2006.

7. There are currently no amendments proceeding control number 90/008,286.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,287 was requested by a third party requester on October 6, 2006, 2006.

9. The Reexamination Order was granted in proceeding, control no. 90/008,287 on December 8, 2006.

10 There are currently no amendments proceeding control number 90/008,287.

11. *Ex Parte* Reexamination Proceeding, control no. 90/008,288 was requested by a third party requester on October 6, 2006.

12. The Reexamination Order was granted in proceeding, control no. 90/008,288 on December 8, 2006.

13. There are currently no amendments proceeding control number 90/008,288.

14. Proceedings control numbers 90/008,122; 90/008,286; 90/008,287; and 90/008,288 await 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 90/008,122; 90/008,286; 90/008,287; and 90/008,288 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. 90/008,122; 90/008,286; 90/008,287; and 90/008,288 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
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,290	12/05/2006	5068846	08341.0021	2444

22852 7590 07/30/2007

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/30/2007

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

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON DC 20001-4413	: : : :	For Patent Owner
In re: Kramer *Ex Parte* Reexamination Proceeding Control No. 90/008,290 Filed: December 5, 2006 For: US Patent No. 5,068,846	: : : : :	DECISION DENYING PETITION UNDER 37 CFR 1.181 & 37 CFR 1.515 (c)

This is a decision on the March 9, 2007, "Petition to the Director Under 37 CFR 1.515(c) and 1.181 to Review of a Denial of a Request for Reexamination." Petitioner, the Patent Owner, requests that the decision denying the request for reexamination of US Patent 5,068,846 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 December 5, 2006, the patent owner requested *ex parte* reexamination of U.S. Patent No. 5,068,846.

2. 2. On February 13, 2007, the examiner denied the request for reexamination on the grounds that the US Patent 5,068,846 for which the patent owner seeks reexamination. The examiner determined that the array of references cited alone or in combination did not support a substantial new question for patentability for which reexamination should be ordered.

3. On March 9, 2007, the present petition was timely filed by the patent owner requester.

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 patent owner in the petition filed on March 9, 2007, has not presented sufficient evidence that the documents provided to support a substantial new question of patentability with respect to patent no. 5,068,846 for which reexamination is sought were publicly available.

The petition filed March 9, 2007, does not provide any specific evidence as to where the examiner erred in the decision considering the array of cited references. The statement that "only a subset of the references cited in the August 15 Petition were put at issue by the October 11, 2006 request..." does not provide any specific evidence for which the substantial new question may be raised with respect to any specific claim for which reexamination is sought.

Considering the petition filed March 9, 2006 there is insufficient evidence to provide for a substantial new question of patentability with respect to patent no. 5,068,846. As such the petition is hereby DENIED.

Conclusion

A substantial new question of patentability affecting the claims of U.S. patent 5,068,846 has been presented by requester for the reasons set forth above.

The petition is **DENIED**

This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

for
Mark Reinhart
SPE 3992

Lissi Mojica Marquis, Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Keith E. George
McDermott, Will & Emery
600 13th St., N.W.
Washington, D.C. 20005 (For Patent Owner)

W. Scott Petty
King & Spalding LLP
191 Peachtree St., N.E.
Atlanta, GA 30303 (For Third Party Requester)

In re Kanterakis et al.
Ex parte Merged Reexamination Proceedings
Control Nos: 90/007,767 & 90/008,291
Filed: Oct. 20, 2005 & Nov. 14, 2006
For: U.S. Patent No.: 6,574,267

DECISION DISMISSING REQUEST TO SUSPEND *EX PARTE* REEXAMINATION PROCEEDINGS

This is a decision on the patent owner papers filed on January 2, 2008, entitled "Petition for Suspension Under 37 C.F.R. 1.103."

The patent owner papers are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition to suspend *ex parte* reexamination is dismissed. The *ex parte* merged reexamination proceeding for Control No. 90/007,767 & 90/008,291 will proceed with special dispatch.

FEES

The petition fee of $400 for the merged proceeding has been charged to patent owner's deposit account, pursuant to the authorization for same on page 2 of the Jan. 2, 2008, petition.

BACKGROUND

1. Patent number 6,574,267 (the '267 patent) issued on June 3, 2003, with claims 1-29.

2. A third party, Nokia, Inc., filed a request for *ex parte* reexamination of claims 1-29 on October 20, 2005 that was assigned control no. 90/007,767 (the '7767 proceeding.)

3. A concurrent litigation was identified in the U.S. District Court for the Eastern District of Texas, as Case No. 2:05-CV-151, styled *Golden Bridge Technology, Inc. v. Nokia, Inc. et al.*, filed May 6, 2005. The decision of the District Court that claims 13 and 23 of the '267

patent are anticipated is currently on appeal at the U.S. Court of Appeals for the Federal Circuit, Appeal No. 2007-1215 with oral arguments scheduled for Feb. 5, 2008.

4. Reexamination of claims 1-29 was ordered on Dec. 29, 2005, for the'7767 proceeding.

5. A first Office action was issued on July 25, 2006, rejecting all claims of the '267 patent, in the'7767 proceeding.

6. The third party, Nokia Inc., filed a second request for *ex parte* reexamination of claims 13 and 23-29 of the '267 patent on October 20, 2006 that was assigned control no. 90/008,291 (the '8291 proceeding.)

7. Reexamination of claims 13 and 23-29 was ordered on Feb. 2, 2007, for the'8291 proceeding.

8. The '7767 and '8291 proceedings were merged, *sua sponte*, in a decision mailed August 22, 2007.

9. A final rejection was mailed Oct. 15, 2007, in which claims 1-26 and 30-58 were finally rejected and claims 27-29 and 59-74 were indicated as being patentable.

10. A Notice of Appeal was filed in the merged proceeding on Dec. 17, 2007.

11. On Jan. 10, 2008, patent owner filed this petition to suspend reexamination proceedings until the Federal Circuit has decided the appeal with regard to claims 13 and 23 of the '267 patent.

DECISION

I. Pertinent Regulations

35 U.S.C. § 305 Conduct of reexamination proceedings.

After the times for filing the statement and reply provided for by **section 304** of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of **sections 132** and **133** of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of **section 301** of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 C.F.R. 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. 1.565 Concurrent office proceedings which include an *ex parte* reexamination proceeding.

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

(b) If a patent in the process of *ex parte* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the reexamination. See § **1.987** for *inter partes* reexamination proceedings.

II. The Nature of the Petition

A suspension for cause under 37 CFR 1.103 is not available in reexamination proceedings. 37 CFR 1.103(a) refers throughout to "applicant" not "patent owner." This indicates that the rule is applicable in original prosecution of an application and by implication is not applicable to reexamination proceedings. Furthermore, 37 CFR 1.550 (a) which governs the conduct of *ex parte* reexamination proceedings states that "the examination will be conducted in accordance with §§ 1.104 through 1.116". Thus, in implementing the regulations for the conduct of *ex parte* reexamination proceedings, specific sections of the regulations were specifically incorporated to the exclusion of other sections. 37 CFR 1.103 is not included among the sections governing examination of *ex parte* reexaminations, despite the fact that the regulations that directly follow it are so included. This must be construed such that, in drafting and implementing the regulations regarding the conduct of reexamination, a decision was made not to allow for suspension of action under 37 CFR 1.103. The clear implication of these regulations read in context is that rule 103 is not applicable in reexamination proceedings.

Rather, the present petition should have been filed under 37 CFR 1.182 with the fee set forth in 37 CFR 1.17(f) requesting relief not otherwise provided for in the rules. As the petition appears to be a *bona fide* attempt at requesting relief, and in view of the Office's duty to conduct ex parte reexamination proceedings with special dispatch within the Office under 35 U.S.C. § 305, the petition is being taken as a petition under § 1.182.

III. Findings and Analysis

Pursuant to 37 CFR 1.565(a), patent owner has advised the Office of concurrent proceedings in the U.S. District Court for the Eastern District of Texas and the Court of Appeals for the Federal Circuit. Petitioner patent owner requests that the present "reexamination proceeding be suspended until the Federal Circuit has decided the appeal of the District Court decision."

In *Ethicon v. Quigg*[1] the Federal Circuit addressed the propriety of the Office suspending reexamination proceedings. The court considered whether the Commissioner had "authority to stay reexamination pending the outcome of district court litigation."[2]

---

[1] *Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1988)*
[2] *Id. at 1425*

The Federal circuit held that an indefinite suspension, granted under the authority of 37 CFR 1.565(b) was not consistent with the statutory requirement of 35 U.S.C. 305 of conducting reexamination proceedings in the Office with special dispatch.

> "Special dispatch" is not defined in the statute. However, "a fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning." *Perrin v. United States, 444 U.S. 37, 42, 62 L. Ed. 2d 199, 100 S. Ct. 311 (1979); see LSI Computer Systems, Inc. v. United States Int'l Trade Comm'n, 832 F.2d 588, 590, 4 USPQ2d 1705, 1707 (Fed.Cir. 1987).* According to Webster's New World Dictionary, special means distinctive, unique, exceptional, or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary, and common meaning of special dispatch envisions some type of unique, extraordinary, or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that "reexamination proceedings will be 'special' throughout their pendency" in the office, and provides for an accelerated schedule. MPEP § 2261. ***Whatever else special dispatch means, it does not admit of an indefinite suspension of reexamination proceedings pending conclusion of litigation.*** If it did, one would expect to find some intimation to that effect in the statute, for it would suggest the opposite of the ordinary meaning. But there is none. [Emphasis added] *(Ethicon, at 1426.)*

Petitioner has requested an indefinite suspension in this merged proceeding, and this request will not be granted.

In addition, the issues on appeal at the Federal Circuit for which a final decision could issue are limited to only two patent claims, while the present merged reexamination proceeding involves 74 patent claims, including original patent claims and new proposed patent claims. Presently, in the reexamination proceedings, claims 1-25 and 30-58 are finally rejected, and claims 27-29 and 59-74 have been confirmed as patentable over the prior art. Patent owner has filed a Notice of Appeal pertaining to the final rejection of claims 1-25 and 30-58. Regardless of the outcome of the Federal Circuit appeal pertaining to claims 13 and 23, reexamination must continue for claims 1-12, 14-22, and 24-74. The issuance of a final decision in the related Federal Circuit case will, at most cause, reexamination of claims 13 and 23 only to be terminated, and will have no effect on the remaining 72 claims in the proceeding.

Should the Federal Circuit finally decide that claims 13 and 23 are invalid, reexamination of these claims will cease, as a final Federal Court holding of invalidity or unenforceability (after all appeals) is binding on the Office. Upon the issuance of the final holding, reexamination of the claims 13 and 23 would be terminated. However, the concurrent Federal Court case only pertains to claims 13 and 23. Therefore, reexamination of the remaining 72 claims will continue through the appeal process and ultimately to the issuance of a reexamination certificate regardless of the outcome of the litigation. Should the Federal Circuit finally decide that claims 13 and 23 are valid, termination of the reexamination as to those claims will not be mandated. Issuance of a final Federal Court

decision upholding the validity during an *ex parte* reexamination has no binding effect on the reexamination proceeding. *See Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988).

In view of the above, the petition is dismissed, and the reexamination proceeding will be continued with special dispatch within the Office.

CONCLUSION

1. The patent owner petition filed on Jan. 2, 2008, is dismissed.

2. The merged '7767 and '8291 *ex parte* reexamination proceeding will not be suspended and will proceed with special dispatch.

3. Jurisdiction over the proceedings is being returned to the Central Reexamination Unit, Art Unit 3992, for appropriate action in due course.

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

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

cdd

2-7-08
C:\Kiva\Kenpet6\8291 & 7767_ decision dismissing suspension req.doc

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1001 PAGE MILL ROAD
BUILDING 2
PALO ALTO, CA 94304

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APR 09 2007

CENTRAL REEXAMINATION UNIT

In re Application of	:	
Daniel J. **MENDEZ**	:	
Control No. 90/008,292 (U.S. Patent 6,151,606)	:	DECISION ON PETITION
Filed: October 11, 2006	:	TO WITHDRAW
Attorney Docket No. 25587-033-022RE1	:	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 27, 2007.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). While the reasons may be provided by referencing a specific portion of 37 CFR 10.40, the reasons must deal with actions by the client. The reasons set forth in the request, "Attorneys are no longer representing Applicant" are not appropriate since it is not clear that the client initiated the transfer, or that the client knowingly or freely assents to the transfer to new counsel.

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

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

Patricia Volpe for

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: **SCOTT MCKEOWN**
OBLON, SPIVAK, MCCLELLAND, MAIER
& NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314-3412

cc: **NOVAK DRUCE & QUIGG, LLP** (Third Party Requester)
1300 Eye Street, NW
Suite 1000 West Tower
Washington, DC 20005

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on March 27, 2007. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,292	10/11/2006	6151606	6082.007RXUS00	2743

22850 7590 08/29/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/29/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUSIANA AVE. 53RD
HOUSTON, TX 20005

Date:
MAILED

AUG 29 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008292
PATENT NO. : 6151606
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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AUG 29 2008

CENTRAL REEXAMINATION UNIT

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. (For Patent Owner)
1940 Duke Street
Alexandria, VA 22314

NOVAK, DRUCE, DeLUCA & QUIGG, LLP (For Requester)
1300 Eye St., NW
Suite 400 East Tower
Washington, DC 20005

In re Mendez	: DECISION GRANTING
Reexamination Proceeding	: IN PART PETITION
Control No. 90/008,292	: FOR EXTENSTION OF TIME
For: U.S. Patent No. 6,151,606	: [37 CFR 1.550(c)]

This is a decision on the August 13, 2008, "PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R 1.550(c)" requesting that the time to submit a Patent Owner response be extended an additional one month.

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

The petition is granted-in-part and a two-week extension of time is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,151,606 (hereinafter, the '606 patent), issued to Mendez, on November 21, 2000.

2. On October 11, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '606 patent. The reexamination proceeding was assigned Control No. 90/008,292 (hereinafter, the '8292 proceeding).

3. The reexamination order was granted in the '8292 proceeding on December 14, 2006.

4. Later in prosecution, a final rejection was mailed on March 14, 2008 setting a two-month period for response.

5. On May 14, 2008, Patent Owner filed an after-final response, an IDS containing information that was labeled confidential and information that was labeled non-confidential, and a petition to expunge the information "to avoid the public disclosure of confidential materials". The information that was labeled confidential included information that appeared to have been publicly available material (e.g. US patents and guides to commercially available software packages).

6. On June 13, 2008, a Notice of Appeal was filed.

7. A petition for extension of time was filed on August 13, 2008.

8. On August 19, 2008, a revocation of the petition to expunge was filed.

DECISION

The Patent Owner requests an extension of time after Patent Owner filed a Notice of Appeal on June 13, 2008. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on August 13, 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.

An extension of time of two weeks is granted.

Accordingly, the time for filing the response is extended for two weeks and therefor the response is due on or before August 27, 2008.

CONCLUSION

1. Petitioner's request is granted in part. The period during which Patent Owner may file a response has been extended to August 27, 2008.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel for

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.
90/008,292	10/11/2006	6151606	6082.007RXUS00	2743

7590 10/02/2008

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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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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HOUSTON, TX 20005

Date:
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008292
PATENT NO. : 6151606
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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Date:

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CENTRAL REEXAMINATION UNIT

SCOTT MCKEOWN
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008292
PATENT NO. : 6151606
ART UNIT : 3900

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

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

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CENTRAL REEXAMINATION UNIT

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(For Requester)

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Alexandria, VA 22314

(Courtesy Copy)

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,292
Filed: October 11, 2006
For: U.S. Patent No. 6,151,606

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the September 29, 2008 patent owner petition to revive").

This decision also addresses the May 4, 2007 power of attorney and change of correspondence address for the patent owner, and the May 4, 2007 statement under 37 CFR 3.73(b).

The September 29, 2008 patent owner petition to revive, the May 4, 2007 power of attorney and change of correspondence address, the April 20, 2007 statement under 37 CFR 3.73(b), 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 paid by credit card.

SUMMARY

The September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The May 4, 2007 power of attorney and change of correspondence address for the patent owner, and the May 4, 2007 statement under 37 CFR 3.73(b), are **ineffective**.

The August 21, 2007 Notice of Intent to Issue a Reexamination Certificate (NIRC) is **vacated** based on the termination of prosecution for failure to timely respond.

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).

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.

37 CFR 3.21 provides, in pertinent part:

An assignment relating to a patent must identify the patent by the patent number.

37 CFR 3.71(b) provides, in pertinent part:

(b) *Patents* — assignee(s) who can prosecute. The assignee(s) who may conduct . . . the prosecution of a . . . reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest . . . **in the patent being reexamined** who is of record . . .

37 CFR 3.73(b) provides (emphasis added):

(b)

(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by **a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11**; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

MPEP 2222 provides, in pertinent part:

> Address of Patent Owner: The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.

MPEP 2268 provides, in pertinent part:

> II. PETITION BASED ON UNINTENTIONAL DELAY
>
> The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).
>
> *
>
> *
>
> IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS
>
> See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. A petition fee and a proper statement under 37 CFR 1.137(b)(3) have also been submitted with the September 29, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was technically terminated due to the failure to timely submit a statement of the substance of the June 24, 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), however, was not timely filed. The patent owner has submitted a statement under 37 CFR 1.560(b) with the September 29, 2008 patent owner petition to revive, which satisfies item (1).

Accordingly, the September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The August 21, 2008 Notice of Intent to Issue a Reexamination Certificate (NIRC) is **vacated** based on the termination of prosecution for failure to timely respond.

The May 4, 2007 Power of Attorney, Change of Correspondence Address, and Statement Under 37 CFR 3.73(b) Are Ineffective

The change of correspondence address for the patent owner, filed on May 4, 2007 in this reexamination proceeding, is **ineffective** because the official correspondence address of record for the patent owner in a reexamination proceeding is the correspondence address of record **in the patent file,**[1] and is shown on the first page of this decision. See 37 CFR 1.33(c) and MPEP 2222.[2]

The change of correspondence address for the patent owner, filed on May 4, 2007 in this reexamination proceeding, is also ineffective because it is not signed by a person authorized to change the correspondence address, such as the attorney of record, the assignee of record, or all of the joint inventors of the patent under reexamination. Furthermore, the power of attorney for the patent owner, filed on May 4, 2007 in this reexamination proceeding, is **ineffective** because it is not signed by an assignee of record or by all of the joint inventors of the patent under reexamination. For an assignee to establish the right to take action in the reexamination proceeding, the assignee must file a proper statement under 37 CFR 3.73(b). The statement under 37 CFR 3.73(b), filed on May 4, 2007, is **ineffective** for the following reasons:

1. The May 4, 2007 statement under 37 CFR 3.73(b) fails to identify the patent over which the assignee wishes to establish ownership, as required by 37 CFR 3.21. The identification of a control number of a reexamination proceeding is not sufficient to establish ownership over the patent. 37 CFR 3.71(b)(1) expressly defines an assignee who may conduct prosecution in a reexamination proceeding as one who has the entire right, title, and interest **in the patent being reexamined**, and who is of record.

Accordingly, the attorney who submitted the September 29, 2008 petition, Mr. Scott McKeown, is not of record in this reexamination proceeding, and is considered to have filed the September 29, 2008 petition by acting in a representative capacity pursuant to 37 CFR 1.34. A courtesy copy of this decision will be mailed to Mr. McKeown. **In the absence of a change of power of attorney and correspondence address in patent file 09/008354, listing Mr. McKeown as an attorney of record, however, any future decisions regarding this matter will be mailed only to the correspondence addresses of record for the patent owner and for the third party requester.**

CONCLUSION

- The September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

---

[1] The change of power of attorney and correspondence address, filed on March 27, 2007 in patent file 09/008354, is ineffective because the person signing the change of power of attorney is not of record in the patent file, as stated in the denial of request for withdrawal of attorney or agent, mailed on April 30, 2007 in the patent file.

[2] See also *Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*, 72 FR 18892 (April 16, 2007) (final rule).

- The power of attorney, change of correspondence address, and statement under 37 CFR 3.73(b), filed by the patent owner on May 4, 2007, are **ineffective.**

- The August 21, 2008 Notice of Intent to Issue a Reexamination Certificate (NIRC) is **vacated** based on the termination of prosecution for failure to timely respond.

- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3992 for issuance of a new Office action to replace the vacated August 21, 2007 NIRC.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Ovidio Escalante, of CRU Art Unit 3992, at (571) 272-7537.

- 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,292	10/11/2006	6151606	6082.007RXUS00	2743

7590 10/03/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/03/2008

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

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MAILED

OCT 03 2008

CENTRAL REEXAMINATION UNIT

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(Courtesy Copy)

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,292
Filed: October 11, 2006
For: U.S. Patent No. 6,151,606

: **DECISION**
: **DISMISSING AND EXPUNGING**
: **PETITION**

This is a decision on the September 2, 2008 third party requester petition entitled "PETITION UNDER 37 CFR § 1.182 AND/OR § 1.183."

This is also a decision on the September 5, 2008 third party requester petition entitled "SUPPLEMENT TO PETITION UNDER 37 CFR § 1.182 AND/OR § 1.183."

The September 2, 2008 third party requester petition and the September 5, 2008 third party requester petition are before the Office of Patent Legal Administration.

The September 2, 2008 third party requester petition and the September 5, 2008 third party requester petition are **dismissed**.

The third party requester petition papers are improper papers. Because the present petition papers have been scanned into the electronic Image File Wrapper (IFW), the petition papers cannot be physically returned to the third party requester. Thus, the present petition papers will be marked "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

BACKGROUND

- On November 21, 2000, U.S. Patent 6,151,606 ("the '606 patent) issued to Mendez et al.
- On October 11, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,292 ("the '8292 proceeding").

[1] See MPEP 2267.

- On December 14, 2006, an order granting *ex parte* reexamination was mailed.
- On September 20, 2007, a first Office action on the merits was mailed.
- Prosecution progressed until, on September 2, 2008, the third party requester filed the present petition entitled "Petition Under 37 CFR § 1.182 and/or § 1.183" to vacate the August 21, 2008 NIRC ("the September 2, 2008 requester petition to vacate the August 21, 2008 NIRC").
- On September 5, 2008, the third party requester filed the present petition entitled "Supplement to Petition Under 37 CFR § 1.182 and/or § 1.183."
- On September 29, 2008, the patent owner filed a petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding, accompanied by a statement under 37 CFR 1.560(b) of the substance of the June 24, 2008 interview.
- On October 2, 2008, a decision granting the September 29, 2008 patent owner petition under 37 CFR 1.137(b) was mailed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

35 U.S.C § 304 provides:

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

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).

DECISION

The September 2, 2008 third party requester petition and the September 5, 2008 third party requester petition are filed under 37 CFR 1.183; however, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '8292 proceeding.

Waiver/suspension of the rules to permit the third party submission via the petitions is not 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]

Pursuant to 35 U.S.C. § 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends either: (1) upon expiration of the patent owner's time for filing a statement in response to the order for reexamination, or (2) if the patent owner files such a statement, upon expiration of the third party requester's time for filing a reply to the patent owner's statement (i.e., within two months from the date of service of the patent owner's statement).

On its face, the third party requester's September 2, 2008 petition and September 5, 2008 petition papers were filed after the statutory statement and reply period ended in the '8292 proceeding. The statutory statement and reply period ended in the '8292 proceeding when the patent owner did not file a statement in response to the December 14, 2006 order granting reexamination within the two-month response period set forth in the order for filing such a statement. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's September 2, 2008 petition and September 5, 2008 petition papers, and both petitions are **dismissed**.

A courtesy copy of this decision will be mailed to Mr. Scott McKeown, who is not of record in this reexamination proceeding. **In the absence of a change of power of attorney and correspondence address in patent file 09/008354, listing Mr. McKeown as an attorney of record, however, any future decisions regarding this matter will be mailed only to the correspondence addresses of record for the patent owner and for the third party requester.**

CONCLUSION

- The September 2, 2008 third party requester petition and the September 5, 2008 third party requester petition are **dismissed**.

- The petition papers filed by the third party requester on September 2 and 5, 2008, respectively, are being expunged as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '8292 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."

- No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.

- A copy of this decision will be made of record in the reexamination file.

- 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,292	10/11/2006	6151606	6082.007RXUS00	2743

7590 10/03/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/03/2008

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OCT 03 2008

CENTRAL REEXAMINATION UNIT

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,292
Filed: October 11, 2006
For: U.S. Patent No. 6,151,606

: **DECISION**
: **DISMISSING AND EXPUNGING**
: **PETITION**

This is a decision on the October 1, 2008 third party requester petition entitled "INFORMATION SUPPLEMENT TO PETITION UNDER 37 CFR § 1.183," taken as a supplemental petition under 37 CFR § 1.183.

The third party requester petition 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 is **expunged** from the record by marking it "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

BACKGROUND

- On November 21, 2000, U.S. Patent 6,151,606 ("the '606 patent) issued to Mendez et al.
- On October 11, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,292 ("the '8292 proceeding").
- On December 14, 2006, an order granting *ex parte* reexamination was mailed.
- On September 20, 2007, a first Office action on the merits was mailed.

[1] See MPEP 2267.

- Prosecution progressed until, on September 2, 2008, the third party requester filed a petition entitled "Petition Under 37 CFR § 1.182 and/or § 1.183" to vacate the August 21, 2008 NIRC ("the September 2, 2008 requester petition to vacate the August 21, 2008 NIRC").

- On September 5, 2008, the third party requester filed a petition entitled "Supplement to Petition Under 37 CFR § 1.182 and/or § 1.183."

- On September 29, 2008, the patent owner filed a petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding, accompanied by a statement under 37 CFR 1.560(b) of the substance of the June 24, 2008 interview.

- On October 1, 2008, the third party requester filed the present petition entitled "Information Supplement to Petition under 37 CFR § 1.183."

- On October 2, 2008, a decision granting the September 29, 2008 patent owner petition under 37 CFR 1.137(b) was mailed.

- On October 3, 2008, a decision dismissing and expunging the September 2, 2008 and the September 5, 2008 third party requester petitions, was mailed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

35 U.S.C § 304 provides:

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

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).

DECISION

The October 1, 2008 third party requester 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 at the present stage in the '8292 proceeding.

Waiver/suspension of the rules to permit the third party submission via the petition is not 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]

Pursuant to 35 U.S.C. § 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends either: (1) upon expiration of the patent owner's time for filing a statement in response to the order for reexamination, or (2) if the patent owner files such a statement, upon expiration of the third party requester's time for filing a reply to the patent owner's statement (i.e., within two months from the date of service of the patent owner's statement).

On its face, the third party requester's October 1, 2008 petition paper was filed after the statutory statement and reply period ended in the '8292 proceeding. The statutory statement and reply period ended in the '8292 proceeding when the patent owner did not file a statement in response to the December 14, 2006 order granting reexamination within the two-month response period set forth in the order for filing such a statement. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's October 1, 2008 petition paper, and the petition is **dismissed**.

A courtesy copy of this decision will be mailed to Mr. Scott McKeown, who is not of record in this reexamination proceeding. **In the absence of a change of power of attorney and correspondence address in patent file 09/008354, listing Mr. McKeown as an attorney of record, however, any future decisions regarding this matter will be mailed only to the correspondence addresses of record for the patent owner and for the third party requester.**

CONCLUSION

- The petition is **dismissed**.
- The petition paper filed by the third party requester on October 1, 2008 is **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '8292 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."
- No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.
- A copy of this decision will be made of record in the reexamination file.
- 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

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Commissioner for Patents
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OCT 06 2008

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Requester)

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

(Courtesy Copy)

In re Mendez Reexamination Proceeding Control No. 90/008,292 For: U.S. Patent No. 6,151,606	: : DECISION DISMSSING : PETITION UNDER : 37 CFR 1.59(b)

This is a decision on the May 14, 2008 "PETITION FOR EXPUNGMENT OF PROTECTIVE ORDER MATERIALS UNDER 37 C.F.R. §1.59(B)".

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

The petition to expunge is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,151,606 (hereinafter, the '606 patent), issued to Mendez, on November 21, 2000.

2. On October 11, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '606 patent. The reexamination proceeding was assigned Control No. 90/008,292 (hereinafter, the '8292 proceeding).

3. The reexamination order was granted in the '8292 proceeding on December 14, 2006.

4. Later in prosecution, on May 14, 2008, Patent Owner filed an after-final response, an IDS containing information that was labeled confidential and information that was labeled non-confidential, and a petition to expunge the information "to avoid the public disclosure of confidential materials".

5. On August 19, 2008, a revocation of the petition to expunge was filed.

DECISION

MPEP 724.05 states, in part:

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP §724.02...must contain:
(A) a clear identification of the information to be expunged without disclosure of the details thereof;
(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
(E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

The petition of May 14, 2008 lacks at least items (B), (C), and (D).

On August 19, 2008, Patent Owner filed a paper entitled "REVOCATION OF PETITION TO EXPUNGE", which states, in part, "[i]t is Patent Holder's intention to moot the Petition for Expungement."

The petition to expunge, filed May 14, 2008 is <u>dismissed as moot</u>, as per the revocation filed August 19, 2008.

The materials submitted on May 14, 2008 will not be expunged, will be unsealed, and will be made available to the public after the mailing of this decision.

CONCLUSION

1. The petition to expunge filed May 14, 2008 is dismissed as moot, as per the revocation filed August 19, 2008.

2. The materials submitted on May 14, 2008 will not be expunged, will be unsealed, and will be made available to the public after the mailing of this decision.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,292	10/11/2006	6151606	6082.007RXUS00	2743

7590 12/19/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/19/2008

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Date: MAILED
DEC 19 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008292
PATENT NO. : 6151606
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)

MAILED

DEC 19 2008

CENTRAL REEXAMINATION UNIT

Novak, Druce, DeLuca & Quigg, LLP
1300 Eye Street NW
Suite 1000 West Tower
Washington, DC 20005

(For Requester)

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,292
Filed: October 11, 2006
For: U.S. Patent No. 6,151,606

: **DECISION**
: **DISMISSING AND EXPUNGING**
: **PETITION**

This is a decision on the October 22, 2008 third party requester petition entitled "PETITION UNDER 37 CFR § 1.182 AND/OR § 1.183."

The third party requester petition 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 is being **expunged** from the record by marking it "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

BACKGROUND

- On November 21, 2000, U.S. Patent 6,151,606 ("the '606 patent) issued to Mendez et al.
- On October 11, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,292 ("the '8292 proceeding").
- On December 14, 2006, an order granting *ex parte* reexamination was mailed.
- On September 20, 2007, a first Office action on the merits was mailed.
- Prosecution progressed until, on March 14, 2008, a final Office action was issued.
- On May 14, 2008, patent owner filed a paper in response to the final Office action.

[1] See MPEP 2267.

- On June 24, 2008, a telephone interview was conducted, during which patent owner's representative agreed to an Examiner's Amendment to the claims. The Office's interview summary record for the June 24, 2008 interview reflects this fact.

- After July 24, 2008, due to patent owner's failure to provide a statement under 37 CFR 1.560(b) of the substance of the June 24, 2008 interview, prosecution of the proceeding terminated in accordance with the one month time limit set in 1.560(b).

- On August 21, 2008, a Notice of Intent to Issue a Reexamination Certificate ("NIRC") was mailed.

- On September 2, 2008, the third party requester filed a petition entitled "Petition Under 37 CFR § 1.182 and/or § 1.183" to vacate the August 21, 2008 NIRC ("the September 2, 2008 requester petition to vacate the August 21, 2008 NIRC"). This petition was supplemented by a filing on September 5, 2008.

- On September 29, 2008, the patent owner filed a petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding, accompanied by a statement under 37 CFR 1.560(b) of the substance of the June 24, 2008 interview.

- On October 2, 2008, the Office mailed a decision entitled "Decision Granting Petition Under 37 CFR 1.137(b)," granting the September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive the proceeding, and vacating the August 21, 2008 NIRC.

- On October 3, 2008, the Office mailed a decision dismissing and expunging the September 2, 2008 and September 5, 2008 requester petitions.

- On October 4, 2008, a NIRC was issued.

- On October 22, 2008, the third party requester filed the instant petition entitled "Petition Under 37 CFR § 1.182 and/or § 1.183" to vacate the October 4, 2008 NIRC ("the October 22, 2008 requester petition to vacate the October 4, 2008 NIRC").

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

35 U.S.C § 304 provides:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given

a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

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 1.137 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 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;

DECISION

The Office Lacks Statutory Authority to Consider the Substance of the Petition

The October 22, 2008 third party requester 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 at the present stage in the '8292 proceeding.

Waiver/suspension of the rules to permit the third party submission via the petition is not 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]

Pursuant to 35 U.S.C. § 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends either: (1) upon expiration of the patent owner's time for filing a statement in response to the order for reexamination, or (2) if the patent owner files such a statement, upon expiration of the third party requester's time for filing a reply to the patent owner's statement (i.e., within two months from the date of service of the patent owner's statement).

On its face, the third party requester's October 22, 2008 petition paper was filed after the statutory statement and reply period ended in the '8292 proceeding. The statutory statement and reply period ended in the '8292 proceeding when the patent owner did not file a statement in response to the December 14, 2006 order granting reexamination within the two-month response period set forth in the order for filing such a statement. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's October 22, 2008 petition paper. In this respect, the requester stands on a footing no different from any other member of the public who wishes to challenge a procedural action taken by the Office in a proceeding. The patent statute simply does not provide for such intervention.

Accordingly, the petition is **dismissed**.

Sua Sponte Clarification As to the Propriety of the Issuance of The October 4th NIRC

To *sua sponte* clarify the record on the issuance of the October 4, 2008 NIRC, the following discussion is provided:

As stated in the Office decision entitled "Decision Granting Petition Under 37 CFR 1.137(b)", issued October 2, 2008, the reexamination proceeding was technically terminated due to the failure to timely submit a statement of the substance of the June 24, 2008 interview pursuant to 37 CFR 1.560(b). Revival of a terminated proceeding under 37 CFR 1.137 requires the reply to the outstanding Office action or notice, unless previously filed. The reply that was required was the written statement of the substance of the interview, and patent owner's inclusion of that statement with the petition under 37 CFR 1.137 met the "response" requirement for revival.

At the time of revival, the case included a final rejection issued March 14, 2008, a response to that rejection filed May 14, 2008, an authorization for an examiner's amendment given on June 24, 2008, and a written statement of the substance of that interview. These papers were properly of record on July 24, 2008, i.e., prior to termination of the proceeding prosecution for failure to file the patent owner interview statement, except for the written statement, which was provided with the petition for revival. Since the authorization for the examiner's amendment was in effect on the date the proceeding was revived, the response was therefore complete as to that matter.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required "reply" (response – in reexamination) from the due date for the "reply" (response – in reexamination) until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The statement contained in the September 29, 2008 patent owner petition is being construed as the statement required by 37 CFR 1.137(b)(3) with respect to any aspect of the delay in returning this proceeding to pendency. Patent owner must notify the Office if this is not a correct interpretation of the statement contained in the September 29, 2008 petition, within ten (10) days of this decision. The Office possessed jurisdiction to act upon the proceeding by issuing a NIRC after revival of the proceeding, in view of the complete response by the patent owner. The NIRC issued by the Office was therefore proper.

This decision hereby grants, *nunc pro tunc*, an extension of time (from the expiration of the two-month period after the Notice of Appeal was filed) to the extent needed to support the issuance of the October 4, 2008 NIRC.

CONCLUSION

- The petition is **dismissed**.
- The petition paper filed by the third party requester on October 22, 2008 is **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '8292 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."
- No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.
- A copy of this decision will be made of record in the reexamination file.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, 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

December 18, 2008
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,292	10/11/2006	6151606	6082.007RXUS00	2743

7590 02/24/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2009

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FEB 24 2009

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,292
Filed: October 11, 2006
For: U.S. Patent No. 6,151,606

: **DECISION DENYING**
: **AND EXPUNGING**
: **PETITION**

This is a decision on the October 8, 2008 third party requester petition entitled "Request for Reconsideration of Decision Dismissing and Expunging Petition Under 37 CFR § 1.182 and/or § 1.183."

The third party requester petition is before the Office of Patent Legal Administration.

SUMMARY

The petition is **granted to the extent** that the October 3, 2008 decisions dismissing and expunging the requester petition have been reconsidered, but is **denied** as to the underlying relief requested.

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 present petition paper is **expunged** from the record by marking it "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. On November 21, 2000, U.S. Patent 6,151,606 ("the '606 patent) issued to Mendez et al.

[1] See MPEP 2267.

2. On October 11, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,292 ("the '8292 proceeding").

3. On December 14, 2006, an order granting *ex parte* reexamination was mailed by the Office.

4. The proceeding progressed until, on March 14, 2008, a final rejection was mailed by the Office.

5. On May 14, 2008, the patent owner filed a response after final rejection.

6. On June 13, 2008, the patent owner filed a notice of appeal.

7. On June 24, 2008, an *ex parte* reexamination interview summary was mailed by the Office, in which the examiner summarized an interview with Mr. McKeown, attorney of record for patent owner during which the examiner obtained the patent owner's authorization for an examiner's amendment ("the June 24, 2008 interview").

8. On August 13, 2008, the patent owner filed a petition for extension of time under 37 CFR 1.550(c).

9. On August 21, 2008, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed ("the August 21, 2008 NIRC") by the Office, in response to the May 14, 2008 patent owner response. The August 21, 2008 NIRC was accompanied by the examiner's amendment authorized during the June 24, 2008 interview.

10. On August 29, 2008, a decision granting-in-part the August 13, 2008 patent owner petition for extension of time was mailed by the Office.

11. On September 2, 2008, the third party requester filed a petition entitled "Petition Under 37 CFR § 1.182 and/or § 1.183" to vacate the August 21, 2008 NIRC ("the September 2, 2008 requester petition").

12. On September 5, 2008, the third party requester filed a petition entitled "Supplement to Petition Under 37 CFR § 1.182 and/or § 1.183" ("the September 5, 2008 supplemental requester petition").

13. On September 29, 2008, the patent owner filed a petition entitled "Petition under 37 CFR 1.137(b) for Acceptance of Unintentionally Delayed Papers" ("the September 29, 2008 patent owner petition under 37 CFR 1.137(b)"), accompanied by the patent owner's statement under 37 CFR 1.560(b) of the June 24, 2008 interview.

14. On October 1, 2008, the third party requester filed a petition entitled "Information Supplement to Petition under 37 CFR § 1.183" ("the October 1, 2008 requester petition").

15. On October 2, 2008, a decision granting the September 29, 2008 patent owner petition under 37 CFR 1.137(b) was mailed by the Office.

16. On October 3, 2008, a decision dismissing and expunging the September 2, 2008 requester petition and the September 5, 2008 supplemental requester petition was mailed by the Office.

17. Also on October 3, 2008, a decision dismissing and expunging the October 1, 2008 requester petition was mailed by the Office.

18. On October 4, 2008, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed by the Office ("the October 4, 2008 NIRC").

19. On October 8, 2008, the third party requester filed the present petition entitled "Request for Reconsideration of Decision Dismissing and Expunging Petition Under 37 CFR § 1.182 and/or § 1.183," for reconsideration of the October 3, 2008 decisions ("the October 8, 2008 requester request for reconsideration").

20. On October 20, 2008, the third party requester filed a petition entitled "Petition Under 37 CFR § 1.182 and/or 37 CFR § 1.183" ("the October 20, 2008 requester petition").

21. On December 19, 2008, a decision dismissing and expunging the October 20, 2008 requester petition was mailed by the Office.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 122(c) provides (emphasis added in bold):

PROTEST AND PRE-ISSUANCE OPPOSITION. — The Director shall establish appropriate procedures to ensure that **no protest or other form of pre-issuance opposition** to the grant of a patent on an **application may be initiated after publication of the application** without the express written consent of the applicant.

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

Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

35 U.S.C § 304 provides:

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

file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. . . All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 CFR 1.137(b) provides, in pertinent part:

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) . . . 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 . . .

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 1.291(b) provides, in pertinent part (emphasis added in bold):

The protest will be entered into the record of the **application if** . . . except for paragraph (b)(1) of this section, **the protest was filed prior to the date the application was published** . . .

(1) If a protest is accompanied by the written consent of the applicant . . .

37 CFR 1.550(f) provides:

The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

37 CFR 1.560 provides:

(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.

DECISION

The third party requester requests reconsideration of the October 3, 2008 Office decisions dismissing requester's petitions under 37 CFR 1.183 filed on September 2, 2008, September 5, 2008, and October 1, 2008. The requester has specifically requested relief from the dismissal of the September 2, 2008 petition only. However, as each of the "supplemental" petitions filed on September 5 and October 1 were also dismissed by the Office on October 3, 2008, the present request for reconsideration, filed by the third party requester on October 8, 2008, is taken as a request for reconsideration of all three petitions, i.e., the September 2, 2008, September 5, 2008, and October 1, 2008 requester petitions.

Based on 35 U.S.C. 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends: (1) upon expiration of the patent owner's time for filing a statement in response to the order for reexamination – if no such patent owner statement is filed, or (2) upon expiration of the third party requester's time for filing a reply to a patent owner's statement which has been filed (i.e., the expiration of two months from the date of service of the patent owner's statement) or (3) after the third party requester has filed a reply to a patent owner's statement, if a reply is filed. In the present '8292 proceeding, the statutory statement and reply period ended when the patent owner did not file a statement in response to the December 14, 2006 order granting reexamination, and the two month period for doing so expired.

On their face, the third party requester's September 2, 2008, September 5, 2008, and October 1, 2008 petitions were all filed after the statutory statement and reply period ended for the '8292 proceeding. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's September 2, 2008, September 5, 2008, and October 1, 2008 petitions.

The present petition for reconsideration asserts that the *ex parte* reexamination statute does not prohibit the third party requester from filing the September 2, September 5, and October 1, 2008 petitions under 37 CFR 1.183 in this *ex parte* reexamination proceeding. The requester argues that there is no mention in 35 U.S.C. 305 of third party requester submissions, and that 35 U.S.C. 305 states only that reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of title 35.

This argument is not persuasive, because the statutory procedures established for initial examination, including the procedures under 35 U.S.C. 132 and 133 are ***ex parte*** procedures. See, e.g., *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996) (referring to the "*ex parte* process of examining a patent application"); *Chicago Rawhide Manufacturing Co. v. Crane Packing Co.*, 523 F.2d 452, 458 (7th Cir. 1975) (referring to the "*ex parte* character of the normal Patent Office prosecution" [italics added]). There is nothing in the statute to indicate

that procedures under 35 U.S.C. 132 and 133 are open to ***inter partes*** prosecution in an *ex parte* reexamination.

As stated in the October 3, 2008 decisions, waiver or suspension of the rules to permit entry of the September 2, September 5, and October 1, 2008 requester petitions is not 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*, 882 F.2d 1570, 1573; 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989). In *Syntex*, the Federal Circuit stated:

> 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.**" [Citations omitted] [Emphasis added in bold].

The *Syntex* opinion cited *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1, 5-6 n.6 (Fed. Cir. 1985), *cert.* denied, 474 U.S. 828 (1985). In *Etter*, the Federal Circuit stated:

> **When a third party** (whether or not an alleged infringer, and whether or not suit has been filed) **is the requestor, that party is heard only on whether "a substantial new question" exists.** Absent a "substantial new question", an alleged infringer cannot "force" a patentee back into the PTO. Contrary to indications in the concurrence, **the reexamination *per se* of the claims is entirely *ex parte***" [Emphasis added in bold].

See also *Boeing Co. v. Commissioner of Patents and Trademarks*, 853 F.2d 878, 881, 7 USPQ2d 1487, 1489 (Fed. Cir. 1988). In *Boeing*, the Federal Circuit stated:

> "While [the third party requester] had a right to file a request for reexamination under *35 U.S.C. § 302* and a contingent right to file a reply statement under *35 U.S.C. § 304*, [the third party requester] **had no right thereafter to participate in the reexamination process**, *35 U.S.C. § 305*." [Italics in original] [Emphasis added in bold].

The September 2, September 5, and October 1, 2008 requester petitions are clearly an attempt by the third party requester to participate in the *ex parte* reexamination process. In these petitions, the requester requests the Office to:

(1) vacate an Office action, i.e., the August 21, 2008 Notice of Intent to Issue a Reexamination Certificate (NIRC);

(2) cancel all of the '679 patent claims; [2]

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[2] The alleged basis for such cancellation would **only be highly technical procedural omissions**; however, the request to cancel the claims clearly goes to the substance of the proceeding.

(3) terminate the *ex parte* reexamination proceeding; and

(4) issue an *ex parte* reexamination certificate reflecting the cancellation of all of the patent claims.[3]

As pointed out above, there are no provisions in the *ex parte* reexamination statute that permit the third party requester to participate in the *ex parte* reexamination, other than the right to file a request for *ex parte* reexamination under 35 U.S.C. 302 and a reply to the patent owner's statement under 35 U.S.C. 304 (if a patent owner's statement is filed). It is to be noted that it was necessary for Congress to amend the statute in 1999 in order to permit participation in the examination stage (and appeal stage) by the third party requester, and those provisions were only provided for *inter partes* reexamination in the newly created *inter partes* reexamination statute, particularly, in 35 U.S.C. 314(b)(2) and U.S.C. 315(b).[4] If further participation by the third party requester were applicable to *ex parte* reexamination, then there would have been no need for Congress to expressly provide for such provisions in the *inter partes* reexamination statute. Also, the fact that Congress provided for increased third party requester participation in the *inter partes* reexamination statute via the American Inventors Protection Act (AIPA), signed into law on November 29, 1999,[5] but did not do so for *ex parte* reexamination,[6] shows an intent of Congress that third party requester participation in the examination stage is not authorized in *ex parte* reexamination.

The requester urges that justice requires that the rules be waived in order to consider and act on the September 2, September 5, and October 1, 2008 petitions. However, the rules cannot be waived to provide the third party requester the right to file a paper in the examination stage of the '8292 proceeding (during which the petitions have been filed), since such is not authorized by statute. In this respect, the requester stands on a footing no different from any other member of the public who wishes to challenge a procedural action taken by the Office in a proceeding. The patent statute simply does not provide for such intervention. It is observed that the requester's attempt to intervene in an *ex parte* reexamination at this stage of the proceeding (i.e., after the statement and reply stage) is equivalent to the attempt by a third party to intervene in the *ex parte* prosecution of a nonprovisional utility application, where the third party has no legal standing.[7]

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[3] The requester states, on page 1 of the September 2, 2008 requester petition, that "Third Party Requester Research in Motion Limited hereby petitions the Director pursuant to 37 CFR . . . § 1.183 to vacate the Notice of Intent to Issue Ex Parte Reexamination Certificate mailed August 21, 2008, and to terminate the present reexamination proceeding . . .". The requester also states, on page 8 of the September 2, 2008 requester petition, that ". . . the present reexamination proceeding should have been terminated . . . and a Reexamination Certificate canceling all claims should be issued . . ." See also page 3 of the September 5 and October 1, 2008 requester petitions.

[4] See, generally, 35 U.S.C. 311-318.

[5] P.L. No. 106-113, 113 STAT. 1501A-571.

[6] Compare the provisions of 35 U.S.C. 302-307 of the *ex parte* reexamination statute, with those of the *inter partes* reexamination statute, particularly, 35 U.S.C. 314(b) and 35 U.S.C. 315(b).

[7] The filing of the September 2, September 5, and October 1, 2008 requester petitions cannot be analogized to the filing of a protest by a third party in an application under 35 U.S.C. 122(c) and 37 CFR 1.291, since 35 U.S.C. 122(c) and 37 CFR 1.291 specifically refer to the filing of a protest in an *application*, and a reexamination proceeding is not an application. In addition, 35 U.S.C. 122(c) expressly *prohibits* the filing of a protest *after publication of the application*, without the express consent of the applicant. After the patent has been granted, the application clearly has been published, and there is no new unpublished application to support a protest without consent.

Because the statute does not authorize the requested intervention by the present petition, the underlying relief requested in the October 8, 2008 requester request for reconsideration must be denied.

A brief discussion as to the history of reexamination impacts on the intervention requested by the petition: To permit a third party requester to participate in an *ex parte* reexamination by requesting the Office to (1) vacate an Office action, (2) cancel all pending patent claims, (3) terminate the proceeding, and (4) issue a reexamination certificate reflecting the cancellation of all of the pending patent claims, is clearly without statutory authority. The Office is required under 35 U.S.C. 305 to conduct reexamination proceedings with special dispatch. To permit third parties to challenge all actions taken by the Office, or all submissions, or the lack thereof, by the patent owner in an *ex parte* reexamination proceeding at any stage in the proceeding would cause unnecessary delay and would be contrary to the Congressional mandate for special dispatch in a proceeding that was legislated to be *ex parte* in the examination stage. The legislative history of the *ex parte* reexamination statute reflects an intent by Congress that the *ex parte* reexamination process would not create new opportunities to harass the patent owner. See, e.g., *Industrial Innovation & Patent & Copyright Law Amendments: Hearings on H.R. 6933, 6934, 3806, & 214 Before the Subcommittee on Courts, Civil Liberties and the Administration of Justice of the House Committee on the Judiciary*, 96th Cong., 2nd Sess. 594 (1980) (statement of Sidney Diamond, Commissioner of Patents & Trademarks, April 24, 1980):

> [The proposed *ex parte* reexamination statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.

To prevent the use of the reexamination process to harass the patent owner, Congress included the requirement that a substantial new question of patentability, based only on patents and printed publications, must be raised by the request. Unauthorized "protest" participation by a third party in an *ex parte* proceeding represents yet another form of harassment of the patent owner. The *inter partes* reexamination statute permits participation of a third party who requested the reexamination in the examination stage (and appeal stage); however, in return for that participation, the *inter partes* reexamination statute attaches estoppel provisions to prevent third party challenges to the patent as to the facts and issues of the reexamination proceeding, once the *inter partes* reexamination process has concluded. See 35 U.S.C. 317. There are no such estoppel provisions in the *ex parte* reexamination statute. To permit the present *ex parte* reexamination requester to intervene at this point (or any other point after requester participation is barred) would permit a circumvention of the *inter partes* reexamination statute, without attachment of the *inter partes* reexamination estoppel provisions. It is to be noted that Congress did not combine *ex parte* reexamination with *inter partes* reexamination to provide one process, but left *ex parte* reexamination in place to continue a direct process without intervention (and resulting delay) from third parties during the examination stage of the proceeding. The present requester must not be permitted to provide such intervention in the present process. To enter and consider the September 2, September 5, and October 1, 2008 petitions, at the stage at which these petitions were filed in this proceeding, would cause

significant delay, and would appear to create an opportunity for harassment, both of which Congress intended to prevent in what was legislated to be a direct process with a statutory special dispatch having no exceptions.

For the reasons given above, the October 8, 2008 petition for reconsideration of the October 3, 2008 decisions is **denied** as to the underlying relief requested. Since the petition is not authorized by statute, the third party requester petition paper is an **improper paper**. Accordingly, the present petition paper is **expunged** from the electronic Image File Wrapper (IFW) record by marking it "closed" and "non-public," and it will not constitute part of the record of the present reexamination proceeding.[8]

Sua Sponte Clarification as to the Propriety of the Office's Intent to Issue a Reexamination Certificate in this Proceeding

This decision does not treat the substance of the September 2, September 5, and October 1, 2008 petitions. The record is, however, *sua sponte* being clarified to show that the Office's intent to issue a reexamination certificate in this proceeding is consistent with the statute.

The August 21, 2008 NIRC was vacated by the Office's October 2, 2008 decision, entitled "Decision Granting Petition Under 37 CFR 1.137(b)," which sets forth that the prosecution of the present reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the June 24, 2008 interview pursuant to 37 CFR 1.560(b). Revival of a terminated prosecution under 37 CFR 1.137 requires a proper response to the outstanding Office action or notice, unless previously filed. The response that was required in this instance was the written statement of the substance of the interview, and patent owner's inclusion of that statement with the petition under 37 CFR 1.137 met the "response" requirement for revival.[9]

Also, at the time of revival, the proceeding was in a condition in which all pending claims would be found patentable (i.e., the proceeding was "in condition for allowance"). The proceeding included a final rejection issued March 14, 2008, a response to that rejection filed May 14, 2008, an authorization for an examiner's amendment given on June 24, 2008, and a written statement of the substance of that interview. These papers were properly of record on July 24, 2008, i.e., prior to termination of the prosecution for failure to file the patent owner interview statement, except for the written statement, which was provided with the petition for revival. Since the authorization for the examiner's amendment was in effect on the date the proceeding was revived, the response was therefore complete as to that matter.[10] On October 4, 2008, the Office issued a NIRC in this reexamination proceeding. The Office possessed jurisdiction to act upon the proceeding by issuing the October 4, 2008 NIRC after revival of the proceeding, in view of the complete response by the patent owner. The October 4, 2008 NIRC issued by the Office was therefore proper.

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[8] See MPEP 2267.

[9] See page 4 of the December 19, 2008 decision, entitled "Decision Dismissing and Expunging Petition," under the heading "*Sua Sponte* Clarification As to the Propriety of the Issuance of the October 4rd NIRC".

[10] *Id.*

Furthermore, 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required "reply" (response – in reexamination) from the due date for the "reply" (response – in reexamination) until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The December 19, 2008 decision, entitled "Decision Dismissing and Expunging Petition," states that the statement contained in the September 29, 2008 patent owner petition under 37 CFR 1.137(b) is being construed as the statement required by 37 CFR 1.137(b)(3) with respect to *any aspect of the delay in returning this proceeding to pendency.*[11] This statement covers *any reason* for the delay. Finally, purely out of an abundance of caution, the December 19, 2008 decision also granted, *nunc pro tunc*, an extension of time (from the expiration of the two-month period for response after the Notice of Appeal was filed) to the extent needed to support the issuance of the October 4, 2008 NIRC.

Additional Comments

1. It was not necessary, under the circumstances of this proceeding, that the August 13, 2008 patent owner petition for extension of time specifically relate to the filing of an appeal brief or to any other specific paper. It is within the Office's discretion to address a requested extension of time for any reason, or even to grant an extension of time *sua sponte*. The treatment of a request for an extension of time is within the sole discretion of the Office, and is not subject to challenge by a third party.[12] Again, however, as pointed out above, the December 19, 2008 decision granted, *nunc pro tunc*, an extension of time (from the expiration of the two-month period for response after the Notice of Appeal was filed) purely out of a abundance of caution,[13] to the extent needed to support the issuance of the October 4, 2008 NIRC.

2. It is also not necessary that the "required reply" under 37 CFR 1.137(b)(1) must be an appeal brief, in a proceeding in which a notice of appeal had been filed prior to termination of the prosecution. If the patent owner wishes to revive, the patent owner may either file an appeal brief, or file a response that places the proceeding in a condition for finding all pending claims patentable (i.e., places the proceeding "in condition for allowance"). In the present instance, the authorization of the examiner's amendment on June 24, 2008, placed the case in condition for issuing a NIRC containing the authorized examiner's amendment. To require that reexamination

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[11] *Id.* Patent owner was given a time period of 10 days from the mail date of the December 19, 2008 decision to notify the Office if this is not a correct interpretation of the statement contained in the September 29, 2008 patent owner petition. No response by the patent owner was received within the time period for response to the December 19, 2008 decision. The statement contained in the September 29, 2008 patent owner petition is therefore construed as the statement required by 37 CFR 1.137(b)(3) with respect to any aspect of the delay in returning this proceeding to pendency.

[12] The Office notes that the August 13, 2008 patent owner request for extension of time did not reflect service on August 13, 2008. The patent owner, however, did file a certificate of service for this document on August 14, 2008. 37 CFR 1.550(f) states that the "document must reflect service or the document ***may*** be refused consideration by the Office" [emphasis added]. There is no requirement that the Office refuse consideration of a document for failure to provide a certificate of service. (See the procedure set forth in MPEP 2266.03, which expressly permits the Office reexamination clerk to telephone the party making the submission to obtain the missing certificate of service, if actual service was made, and if the certificate of service was inadvertently omitted from the submission.) In the present instance, the Office exercised its option to accept the August 13, 2008 patent owner request for extension of time, in view of the facts and circumstances of the present proceeding.

[13] This was not, however, necessary, since the grant of the September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive obviated the need for the grant of an extension of time.

proceedings (that are terminated after a notice of appeal had been filed) must only be revived by filing an appeal brief and by continuing with the appeal, without providing an option to quickly conclude the proceedings by placing the proceeding in condition for allowance (issue of a reexamination certificate), would be contrary to the Congressional mandate for special dispatch in reexamination.[14] In this respect, the response required for revival where a notice of appeal has been filed in a reexamination proceeding is analogous to the reply where a notice of appeal has been filed in a nonprovisional application, to the extent that an appeal brief is not the only reply that satisfies the rule.[15] And, in the present instance, as a result of the authorization of the examiner's amendment on June 24, 2008, the only remaining response required under 37 CFR 1.137(b)(1) to place the proceeding in condition for allowance was the statement under 37 CFR 1.560(b) which accompanied September 29, 2008 patent owner petition under 37 CFR 1.137(b).

3. Regarding any requirement for a written statement under 37 CFR 1.560(b) of the August 12, 2008 "interview", i.e., of the examiner's confirmance on August 12, 2008 that a NIRC would issue - the same information (that a NIRC would issue) was also indicated in the June 24, 2008 interview, during which an examiner's amendment was authorized,[16] and for which a statement under 37 CFR 1.560(b) was provided by the patent owner with the September 29, 2008 petition under 37 CFR 1.137(b) to revive. Further, the patent owner also provided a written statement of the August 12, 2008 "interview" in the August 13, 2008 patent owner petition for extension of time. The technical requirement that the statement under 37 CFR 1.560(b) be filed as a separate part of a response is hereby waived *nunc pro tunc*, to obviate any argument that the revival might somehow be construed to omit, to any extent necessary, the examiner's prior confirmance that a NIRC would issue.

CONCLUSION

1. The petition is **granted to the extent** that the October 3, 2008 decisions dismissing and expunging the requester petition have been reconsidered, but is **denied** as to the underlying relief requested.

2. The petition paper filed by the third party requester on October 8, 2008 is **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '8292 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."

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[14] See 35 U.S.C. 305.

[15] See MPEP 711.03(c) II A 2(b) and (c). In a nonprovisional application in which a notice of appeal had been filed prior to abandonment, for example, a Request for Continued Examination (RCE), with an appropriate submission, may be filed as the required reply. An RCE, however, cannot be filed in a reexamination proceeding. A required reply in a nonprovisional application that was abandoned for failure to reply to a final Office action, however, may be a reply that *prima facie* places the application in condition for allowance. In a reexamination proceeding in which a notice of appeal has been filed prior to termination, the response required by 37 CFR 1.137(b)(1) may be satisfied by either filing an appeal brief, or by filing a response that places the proceeding in condition for allowance.

[16] The sole purpose of obtaining authorization for an examiner's amendment is to issue a NIRC containing the authorized examiner's amendment. Stated another way, an examiner does not initiate an interview to obtain authorization for an examiner's amendment, unless the examiner intends to issue a NIRC containing the authorized examiner's amendment

3. No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.

4. A copy of this decision will be made of record in the reexamination file.

5. This decision is designated as a final agency action under 5 U.S.C. § 704.

6. Any further correspondence with respect to this matter should be addressed as follows:

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

By Mail: Mail Stop *Ex Parte* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By Fax: (571) 273-9900

By Hand: Customer Service Window
Attn.: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

7. Any inquiry concerning this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or to Michael Cygan, Legal Advisor, at (571) 272-7700, or in their absence, to the undersigned at (571) 272-7710.

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

February18, 2009
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Date Mailed : December 23, 2009

Patent No. :6,151,606 C1
Inventor :Mizrahi, Diane D.
Patent Issued :March 24, 2009
:SYSTEM AND METHOD FOR USING A WORKSPACE DATA MANAGER TO
:ACCESS, MANIPULATE AND SYNCHRONIZE NETWORK DATA

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.

Review of the application file reveals that correspondence to support entry of reference data, item (56) of Title page. as noted in applicants' request for correction is not found in the records of the Patent and Trademark office. Accordingly, a signed and dated copy of applicants 1449 or PTO-892 reflecting the requested references considered by the examiner is required for further consideration. If omitted references were submitted by applicant, a copy of the receipt obtained from this office should be included.

In view of of the foregoing, applicants request is hereby denied. Any telephone inquiries concerning this communication should be directed to Ms. A. Green at (703) 756-1541.

Mary Diggs, Supervisor
Decisions and Certificates of
Correction Branch
(703) 756-1580 or (703) 756-1541

Scott A. McKeown
Oblon, Spivak, McClelland, Maier
& Neustadt, LLP
1940 Duke Street
Alexandria, VA 22314

/arg

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,293	11/14/2006	6625609	027628-000420US	2782

20350 7590 03/31/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2010

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GEOFFREY DEKLEINE
PERRY & PARTNERS
1300 YONGE STREET, SUITE 500
TORONTO, M4T 1X3 CANADA

Date:
MAILED
MAR 3 1 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008293
PATENT NO. : 6625609
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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COMMISSIONER FOR PATENTS
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MAILED

MAR 31 2010

CENTRAL REEXAMINATION UNIT

Geoffrey deKleine (Third Party Requester)
Perry & Partners
1300 Yonge Street
Suite 500
Toronto, M4T 1X3 CANADA

In re Robert W. McDade et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,293 : **GRANTING**
Filed: November 14, 2006 : **PETITION UNDER**
For: U.S. Patent No. 6,625,609 : **37 CFR 1.137(b)**

This is a decision on the December 14, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response and revive the present terminated reexamination[1], as supplemented on March 24, 2010 ("the supplemented December 14, 2009 patent owner petition to revive").

The supplemented December 14, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The supplemented December 14, 2009 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of February 27, 2009.

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.
*
*
(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*
*
(d) *Terminal disclaimer.*
*
*
(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

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 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).

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 Supplemented 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 reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the February 27, 2009 final Office action. Although patent owner filed a Notice of Appeal on August 27, 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 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 on March 24, 2010, a Supplemental Amendment. The primary examiner for the instant reexamination proceeding has confirmed that the March 24, 2010 Supplemental Amendment cancels all the rejected claims and would *prima facie* place the proceeding in condition for issuance of a reexamination certificate by making all pending claims patentable (once the present proceeding is restored to pendency). Therefore, item (1) is deemed to have been satisfied.[2]

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the December 14, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the supplemented December 14, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The supplemented December 14, 2009 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 24, 2010 Supplemental Amendment.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Samuel Rimell, of CRU Art Unit 3992, at (571) 272-4084.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

[2] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,294	10/23/2006	6289460	5898	4078

25315 7590 07/14/2009

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/14/2009

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
CHARLES W. FALLOW
SHOEMAKER AND MATTARE, LTD.
10 POST OFFICE ROAD - SUITE 100
SILVER SPRING, MD 20910

Date:

MAILED

JUL 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008294
PATENT NO. : 6289460
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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JUL 14 2009

CENTRAL REEXAMINATION UNIT

DAVID A. LOWE
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701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

(For Patent Owner)

CHARLES W. FALLOW
SHOEMAKER AND MATTARE, LTD.
10 POST OFFICE ROAD SUITE 100
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(For Third Party Requester)

In re Hajmiragha	: **DECISION ON PETITION**
Ex Partes Reexamination Proceeding	: **TO CONTINUE**
Control No.: 90/008,294	: ***EX PARTES***
Filing Date: October 23, 2006	: **REEXAMINATION**
For: U.S. Patent No. 6,289,460	: **PROCEEDING**

This is a decision on the June 26, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 - REQUEST FOR CONTINUED REEXAMINATION," filed concurrently with a petition pursuant to 37 CFR 1.181 to request entry of amendments after final Office action. The § 1.181 and § 1.182 petitions also request entry of a supplemental 37 CFR 1.131 declaration and a supplemental response that were filed on June 26, 2009.

The present petition under 37 CFR 1.182 is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The present petition under 37 CFR 1.182 to request for continued reexamination is **dismissed.**

FEES

The requisite petition fee for a petition under 37 CFR 1.182 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee is being charged to petitioner's Deposit Account No. 50-1050 as authorized on page 5 of the petition.

DECISION

I A PETITION UNDER 37 CFR 1.182 WILL NOT BE GRANTED WHERE ANOTHER RULE APPLIES

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.]

In the present petition under 37 CFR 1.182, it is requested that the Office grant continued reexamination of the above-captioned *ex partes* reexamination proceeding and to enter the Amendment and Response submitted on April 21, 2009, and the supplemental response and 37 CFR 131 Declaration submitted on June 26, 2009. Filed concurrently with the present petition under 37 CFR 1.182, is a petition under 37 CFR 1.181 to also seek entry of the April 21, 2009 and June 26, 2009 papers.

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.

In this instance, the patent owner has concurrently pursued alternative relief via a 37 CFR 1.181 petition for entry of the April 21, 2009 amendment and the June 26, 2009 Declaration filed after a final rejection. Since the concurrently filed June 26, 2009 petition under 37 CFR 1.181 to request entry of the amendment and Declaration has not yet been decided, the §1.182 petition is premature – if the §1.181 petition should be granted, then relief will be "specifically provided for in the regulations," i.e., under §1.181. Since the present § 1.182 petition is premature, it is dismissed as such. Stated another way, the relief requested in the petition under 37 CFR 1.182 would be moot, should relief be granted under 37 CFR 1.181. Since the entry of the April 21, 2009 submission is currently in the process of being addressed through 37 CFR 1.181, consideration of this situation under 37 CFR 1.182 would be premature. Patent owner retains the option of seasonably filing a renewed petition under 37 CFR 1.182, if at some future date relief has not been granted under 37 CFR 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.182.

---

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

In view of the above, the petition under 37 CFR 1.182 is **dismissed** as premature.

II. SERVICE OF COPIES

37 CFR 1.550(f) states as follows:

> (f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

37 CFR 1.248(a) states as follows:

> "(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:
> (1) By delivering a copy of the paper to the person served;
> (2) By leaving a copy at the usual place of business of the person served with someone in his employment;
> (3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;
> (4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;
> (5) Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the *Official Gazette*."

The requisite proof of service on third party requester is not included with the instant petition papers, or with its attachments. Such proof was also not included with the April 21, 2009 and June 26, 2009 papers filed by patent owner.

Since there is no indication that the third party requester was provided with a copy of these papers, any response by patent owner to this decision must include a Certificate that the present petition papers and the April 21, 2009, and June 26, 2009 papers have been served on the third party requester in the manner provided by § 1.248.[2]

Therefore, the present petition under 37 CFR 1.182 is **alternatively dismissed as being defective** for lack of service as set forth in 37 CFR 1.550(f).

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).

---

[2] Obviously, if the papers have not yet been served, patent owner must first do so, before providing the Certificate to the Office.

CONCLUSION

1. The patent owner petition under 37 CFR 1.182 for continued reexamination filed on June 26, 2009 is **dismissed** as (a) being premature, and (b) being defective for lack of service as set forth in 37 CFR 1.550(f).

2. Jurisdiction for the instant *ex partes* reexamination proceeding is being transferred to the Central Reexamination Unit (CRU) for consideration of the June 26, 2009 patent owner petition filed under 37 CFR 1.181.

3. Telephone inquiries related to 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

Kenpet7
7-13-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,294	10/23/2006	6289460	5898	4078

25315 7590 04/19/2010

BLACK LOWE & GRAHAM, PLLC
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SEATTLE, WA 98104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2010

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APR 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008294

PATENT NO. 6,289,460

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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CENTRAL REEXAMINATION UNIT

DAVID A. LOWE BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATRTLE, WA 98104	: (For Patent Owner) : : :
CHARLES W. FALLOW SHOEMAKER AND MATTARE, LTD. 10 POST OFFICE ROAD SUITE 100 SILVER SPRING, MD 20901	: (For Third-Party Requester) : : :
In re HAJMIRAGHA *et alia* Reexamination Proceeding Control No. 90 / 008,294 Request Deposited: October 23, 2006 For: U.S. Patent No. 6,289,460	: DECISION GRANTING-IN- : PART PETITION UNDER 37 : CFR 1.181 FOR ADMISSION : OF AMENDMENT : UNDER 37 CFR 1.116

This is a decision on patent owner's petition under 37 CFR 1.181 filed on June 26, 2009 for entry of the amendment and response of April 21, 2009. The response in question was filed after final Office action. 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.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 6,289,460 was ordered in the Determination mailed January 12, 2007.

2. Prosecution of the reexamination proceeding was closed with the issuance of a final Office action on February 27, 2009.

3. An amendment and response was filed by owner after final Office action on April 21, 2009. The response included claim amendments and evidence submitted to the record for the first time under 37 CFR 1.131.

4. On May 12, 2009, the Office issued an Advisory Action indicating the claim amendments would not be entered as they did not materially reduce or simplify the issues for appeal. The Advisory Action further entered to the record the evidence submitted under 37 CFR 1.131 and considered and treated the evidence with a conclusion the evidence was not persuasive.

5. On June 26, 2009 the instant petition under 37 CFR 1.181 was timely filed.

Applicable Statute or Regulation

37 CFR 1.116 states in pertinent part:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

*(a) An amendment after final action must comply with § **1.114** or this section.*

*(b) After a final rejection or other final action (§ **1.113**) in an application or in an ex parte reexamination filed under § **1.510**, or an action closing prosecution (§ **1.949**) in an inter partes reexamination filed under § **1.913**, but before or on the same date of filing an appeal (§ **41.31** or § **41.61** of this title):*

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

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

(d)

(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

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

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.
(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.
[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

DECISION

Patent Owner petitions for relief and requests withdrawal of the advisory action, the final rejection, and a reopening of prosecution for purposes of entering the April 21, 2009 claim amendments and consideration thereof and the ability to enter supplemental declarations under 37 CFR 1.131. Alternatively, the patent owner requests entry of the April 21, 2009 claim amendments for purposes of placing the [case] proceeding in better form for appeal. Owner begins his presentation arguing that the closing of prosecution without entering the April 21, 2009 amendments substantially deprives the patent owner of its statutory rights. Owner further submits entry of the April 21, 2009 amendments do not present new issues requiring further consideration of the existing prior art and concludes with the argument that entry of the April 21, 2009 amendments would place the [case] proceeding in better form for appeal.

Initially, Owner faults the Office for not implementing rules which allow owner a right to continued prosecution in reexamination and essentially argues he should be allowed to enter amendments after close of prosecution. Reexamination proceedings are by nature limited inquiries into the patentability of issued claims. These proceedings are to be conducted with special dispatch. Owner is reminded that he was fairly noticed in the first office action on the merits of July 11,2008:

> " In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action; which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced."

Entry of amendments after close of prosecution is not forbidden by the rules but limited and governed by the requirements of 37 CFR 1.116. Moreover, it appears that the examiner complied with the pertinent USPTO policies. Accordingly, no basis for the requested relief is seen based upon this argument.

Owner's second contention that the April 21, 2009 amendments do not present new issues requiring further consideration of the existing prior art, and that the examiner's statement falls short of his duty under MPEP 2272 (II) is not persuasive in as much as it appears owner is selectively reading the examiner's position. As MPEP 2272 points out: "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." Further the aforementioned MPEP sections states "For example, if the claims as amended present a new issue requiring further consideration or search, the new issue should be identified and a brief explanation provided as to why a new search or consideration is necessary." In the Advisory action of May 12, 2009 the examiner stated the proposed rejections do not avoid any of the rejections set forth in the final office action. Thus, entry of the proposed amendment would result new consideration of the rejections of record and issuance of the same final rejection.

Further, owner argues that "proper" consideration of the 37 CFR 1.131 declarations would remove US Patent No. 6.671,805 to *Brown et al.* as a reference. However, it is clear from the record that the evidence submitted under 37 CFR 1.131 was entered and considered on the record as the examiner's advisory action devotes more than two full pages to an analysis of the submission and explains why the submission is not found persuasive in overcoming the *Brown et al* reference.

Finally, owner opines entry of the April 21, 2009 amendments would place the [case] proceeding in better form for appeal. Owner submits entry of the amendments would remove US Patent No. 6,199,052 to *Mitty et al.* as a 35 USC 102 (b) reference. However, the examiner has concluded on the record the proposed amendments do not overcome the rejections of record. Owner contests this determination.

Review of the record shows claims 6 and 7 were not rejected based upon Mitty in the final Office action. Thus the inclusion of the subject matter of claim 6 into claim 1 would appear to reduce issues for appeal as it would remove some of the rejections of claims based upon the Mitty reference. As newly proposed claim 21 appears to be claim 15 (dependent upon prior claim 12 and 1) re-written in independent form, the prior rejection applied to claim 15 would stand and be applied to new claim 21. Thus it can not be said that claim 21 presents additional issues for consideration prior to appeal. Thus while the proposed amendment does not overcome all rejections of record, it is reasonable to enter the proposed amendment solely upon appeal as it appears it would reduce at least some of the issues for consideration by removal of some of the rejections based upon the Mitty reference.

Accordingly, owner's petition for relief and request for withdrawal of the advisory action, the final rejection, and a reopening of prosecution for purposes of entering the April 21, 2009 claim amendments and consideration thereof, and for the ability to enter supplemental declarations under 37 CFR 1.131, will not be granted. However, owner's petition and request for entry of the April 21, 2009 claim amendments for purposes of placing the [case] proceeding in better form for appeal appears reasonable as it would reduce issues for appeal. Should patent owner perfect his appeal, the amendment would be entered and the status of the rejections against the claims would be as follows:
With claim 6 cancelled and incorporated into claim 1 the status of the rejections would be:

Claims 1-12 rejected under 35 USC 102(e)/ 103 in view of Brown : MAINTAINED

Claims 1-5, 8-10, 12 and 20 rejected under 35 USC 102(e) in view of Mitty: WITHDRAWN
Claim 11 rejected under 35 USC 103 in view of Mitty: WITHDRAWN
Claim 20 would be confirmed as patentable.

Newly entered claim 21 (prior claim 15 rewritten in independent form) and newly amended claims 13, 14, 16-19 dependent therefrom would be rejected as follows:

Claim 21, 13 and 16 – 19 rejected under 35 USC 102(e)/ 103 in view of Brown
Claim 14 rejected under 35 USC 103 in view of Brown and Hino
Claim 14 rejected under 35 USC 103 in view of Brown and Bly
Claim 21, 13, 16 and 19 rejected under 35 USC 103 in view of Mitty and Brown
Claim 14 rejected under 35 USC 103 in view of Mitty and Brown and Hino
Claim 14 rejected under 35 USC 103 in view of Mitty and and Brown and Bly
Claims 17 and 18 rejected under 35 USC 103 in view of Mitty and Brown and Bendik

Note as claims 14 and 16 -19 would be amended to depend upon new claim 21 and this claim does not incorporate the limitations of prior claim 6, the rejections based upon Mitty to these claims would remain pending. As identified in MPEP 1207.03 III, these rejections will not constitute new grounds of rejection in any resulting examiners answer.

Additional Observations

The April 21, 2009 amendment fails to conform with 37 CFR 1.530 (d)(2) and (f) in as much as at least new claim 21 does not include proper markings to identify it as a new claim. Note further that double bracketing is not an acceptable form of deletion in reexamination. Any future submissions of claim amendments must be made in accord with 37 CFR 1.530 or they will not be entered.

37 CFR 1.181 (f) states in pertinent part:

> *(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.*

Patent Owner filed a Notice of Appeal on June 26, 2009. Thus, patent Owner's Brief was due on or before August 26, 2009. As no such Brief has been received by the Office, the instant appeal of the proceeding, as explained in MPEP 2273 stands dismissed and the reexamination is terminated. A Notice of Intent to issue Reexamination Certificate (NIRC) will issue in due course absent patent Owner action under 37 CFR 1.137(b) to revive the proceeding. See also MPEP 2278.

CONCLUSION

1. Petitioner's request is **granted – in - part**. However, as outlined above, the status of the proceeding is terminated and owner must take remedial steps to revive the proceeding in a timely

manner to avoid issuance of a Notice of Intent to issue Reexamination Certificate. Absent owner action, the Certificate will reflect the status of the claims as set forth in the final rejection. Should the proceeding by revived, the amendment submitted April 21.2009 will be entered for purposes of appeal only.

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 Jessica Harrison at (571) 272-4449, Mark Reinhart at (571) 272-1611, or Eric Keasel, at (571) 272-4929.

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.
90/008,294	10/23/2006	6289460	DOCU-1-1003	4078

25315 7590 07/13/2010

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2010

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
CHARLES W. FALLOW
SHOEMAKER AND MATTARE, LTD.
10 POST OFFICE ROAD - SUITE 100
SILVER SPRING, MD 20910

Date:
MAILED
JUL 13 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008294
PATENT NO. : 6289460
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

Black Lowe & Graham, PLLC
701 Fifth Avenue
Suite 4800
Seattle, WA 98104

(For patent owner)

Charles W. Fallow
Shoemaker and Mattare, LTD.
10 Post Office Road
Suite 100
Silver Springs, MD 20910

(For third party requester)

MAILED

JUL 13 2010

CENTRAL REEXAMINATION UNIT

In re Mir Hajmiragha
Ex Parte Reexamination Proceeding
Control No. 90/008,294
Filed: October 23, 2006
For: U.S. Patent No. 6,289,460

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on (i) the May 12, 2010 patent owner petition titled "Petition Under 37 CFR § 1.313(a) – Request That Notice Of Intent To Issue *Ex Parte* Reexamination Certificate Be Set Aside And Prosecution Be Reopened" and (ii) the May 21, 2010 patent owner petition titled "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)." Patent owner's petitions (i) and (ii) are treated together herein as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated reexamination ("the May 2010 patent owner petition to revive").

The May 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 2010 patent owner petition to revive is **granted**.

The May 7, 2010 Notice of Intent to Issue a Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an Appeal Brief is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.113 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 reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the February 27, 2009 final Office action. Although patent owner timely filed a Notice of Appeal on June 26, 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 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).[1]

Patent owner submitted an Appeal Brief and provided authorization for payment of the corresponding fee of $270.00 on May 21, 2010, thereby satisfying item (1).

---

[1] *See*: April 19, 2010 Decision Granting-In-Part Petition Under 37 CFR 1.181 For Admission Of Amendment Under 37 CFR 1.116.

A petition fee of $810.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the May 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the May 2010 patent owner petition to revive is **granted**.

The May 7, 2010 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an Appeal Brief is **withdrawn**.

CONCLUSION

1. The May 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. The May 7, 2010 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an Appeal Brief is **withdrawn**.

3. Jurisdiction over this reexamination proceeding is being retained in OPLA for treatment in due course of the May 13, 2010 Petition Under 37 CFR 1.182 – Request For Continued Reexamination.

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Samuel Rimell, of CRU Art Unit 3992, at (571) 272-4084.

5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

JUN 14 2007

Matthew A. Smith
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(For 3rd Party Requester)

Michael Hawes
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910 Louisiana
Houston, TX 77002

(For 3rd Party Requester)

Reexam Control No.: 90/008,225
Filed : November 15, 2006
For U.S. Patent No. : 5,784,584

Reexam Control No.: 90/008,299
Filed : October 19, 2006
For U.S. Patent No. : 5,784,584

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. 90/008,225 was ordered in a decision mailed February 12, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/008,299 was ordered in a decision mailed December 22, 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. 90/008,225 and reexamination control No. 90/008,299 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 each of the third party requesters and each 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. 90/008,225 and 90/008,299 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.

Andres Kashnikow

for Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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JUL 15 2009

CENTRAL REEXAMINATION UNIT

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
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MATTHEW A. SMITH
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3000 K STREET NW, SUITE 500
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MICHAEL HAWES
BAKER BOTTS L.L.P.
910 LOUISIANA
HOUSTON, TX 77002 (For 3rd Party Requester)

In re Moore et al.
Reexamination Proceeding
Control No.: 90/008,225
Filed: November 15, 2006
For: U.S. Patent No.: 5,784,584

In re Moore et al.
Reexamination Proceeding
Control No.: 90/008,299
Filed: October 19, 2006
For: U.S. Patent No.: 5,784,584

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the June 17, 2009 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this merged reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

BACKGROUND

1. Patent number 5,784,584 (the '584 patent) issued on July 21, 1998.

2. On December 22, 2006, the Office issued an order granting an October 19, 2006 request for reexamination of claim 29 by a third party requester, which was accorded control number 90/008,299.

3. On February 12, 2007, the Office issued an order granting a November 15, 2006 request for reexamination of claim 29 by a third party requester, which was accorded control number 90/008,225.

4. Reexamination Control Numbers 90/008,225 and 90/008,299, addressed to the '584 patent, were merged on June 14, 2007 (the merged '8225/'8299 proceeding).

5. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the merged '8225/'8299 proceeding on April 21, 2009.

6. On April 24, 2009, the '8225/'8299 proceeding was forwarded to the Office of Publications.

7. The instant petition was filed on June 17, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

8. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle), which is currently scheduled for July 21, 2009.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

. . . All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2256 provides, (in part):

. . . Once the reexamination has entered the Reexamination Certificate printing cycle (452 status), 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 printing cycle 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 printing cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its printing 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 printing 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 (see item (A) above) 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 printing cycle for entry and consideration of the information submitted by patent owner. A grantable petition must

provide the requisite showing discussed in this paragraph.
(latter emphasis added)

DECISION

There is no issue fee in reexamination, and, in this instance, the reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present merged proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 has provided such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256, which requires that 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.

In the present instance, the submission fails to satisfy the above-quoted criteria. The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. To the contrary, patent owner merely provides Office actions from applications having a common parent application with the '584 patent. Patent owner submits these documents not out of a belief that the documents would make at least one claim unpatentable, but instead "out of an abundance of caution." Petition at 3. There are no statements by the patent owner that unequivocally state why the art submitted makes at least one claim unpatentable.

Furthermore, patent owner has failed to present a sufficient factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. Patent owner states that the information could not have been presented earlier because of a belief that previous IDS submissions were "believed to be adequate to conform with the duty to disclose." Patent owner's instant submission was stated to be made due to "the recently expanded scope of information required by the recent decisions of the Court of Appeals for the Federal Circuit, and out of an abundance of caution." Neither of these reasons shows why the submission could not have been submitted earlier. Rather, these reasons provide patent owner's rationale for deciding (choosing) not to submit the information earlier. Patent owner has not, for instance, asserted that each of the items in the current submission were unknown or unavailable to the patent owner at an earlier date. Therefore, the petition fails to present a sufficient explanation of why the information submitted could not have been submitted earlier. For these reasons, the petition fails to conform to the requirements set forth in MPEP 2256.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Since it has been required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory provision for special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2256, as reproduced above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on April 21, 2009, and the proceeding has now entered the final stages of the publication process, with the reexamination certificate scheduled to be printed on July 21, 2009. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding and the failure to identify a question of patentability of the claim under reexamination, the present merged reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers.

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

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on June 17, 2009.

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

3. Telephone inquiries related to 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 14, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 04 2009

CENTRAL REEXAMINATION UNIT

Joseph P O'Malley FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO CA 94108	: : : : :	(For Patent Owner)

In re: Richard M Ehrlich *Ex Parte* Reexamination Proceeding Control No. 90/008,302 Deposited: 27 October 2006 For: US Patent No. 6,995,940	: : : : :	DECISION DISMISSING PETITION FOR EXTENSION OF TIME 37 CFR § 1.550(c) & 1.181

This is a decision on the 16 July 2009, "Patentee's Petition for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the Final Office action mailed 16 March 2009, be extended to (6) months. The petition was timely filed with the petition fee.

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 be extended in which to file a response to the Office action mailed 16 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a Final Office action. The patent owner submitted an after Final amendment on 15 May 2009. The advisory action mailed 28 May 2009 extended the response period to four (4) months. The patent owner's petition for extension of time was timely filed on 16 July 2009, together with the proper fee as required by 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. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. ...
>
> *Ex parte* prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement (by statute (35 U.S.C. 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR § 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. <u>Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.</u> (emphasis added)...

ANALYSIS AND FINDINGS

The patent owner's petition to extend the period for response to six (6) months is before the Director of the CRU. 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 Final Office action was mailed 16 March 2009. The patent owner submitted a timely filed after Final amendment on 15 May 2009. The examiner's advisory action extended the period for response to four (4) months. The patent owner submitted a timely filed a petition for extension of time on 16 July 2009 with the appropriate fee.

The examiner once extended the period for response. MPEP § 2265 states that second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in

extraordinary situations. The petitioner stated that "The attorneys have diligently attempted to prosecute this application." MPEP § 2265 requires:

> "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."

The petition contains only the allegation that the applicant has diligently attempted to prosecute the proceeding. There is no factual accounting to support the allegation. Further, there is no statement as to "in spite of the action taken thus far, the request for additional time is needed."

Additionally there is required "sufficient cause" for granting any extension of time, the statement that the petitioner is contacting the inventor to obtain an affidavit does not address why this was not earlier needed since the proceeding is not after Final.

Lastly, "[s]econd or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations." There is no indication as to how this situation is extraordinary.

The petition request to extend the response time to six (6) months is hereby dismissed.

CONCLUSION

1. The patent owner's petition for extension of six (6) months time in which to file a response to the Final Office action dated 16 March 2009 is hereby **dismissed**

2. The Patent Owner's response was due **16 July 2009.**

3. The proceeding is hereby returned to the examiner for further handling.

4. Correspondence to the Office should be addressed as follows:

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

By Fax to: (571) 273-9900

Central Reexamination Unit

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
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
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,304	10/27/2006	6,987,632	PANAP-1075USP	9737

23910 7590 07/23/2009

FLIESLER MEYER LLP
650 CALIFORNIA STREET
14TH FLOOR
SAN FRANCISCO, CA 94108

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2009

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

Joseph P O'Malley
FLIESLER MEYER LLP
650 CALIFORNIA STREET
14TH FLOOR
SAN FRANCISCO CA 94108

(For Patent Owner)

MAILED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

In re: Richard M Ehrlich
Ex Parte Reexamination Proceeding
Control No. 90/008,304
Deposited: 27 October 2006
For: US Patent No. 6,987,632

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
37 CFR § 1.550(c) & 1.181

This is a decision on the 16 July 2009, "Patentee's Petition for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the Final Office action mailed 16 March 2009, be extended to (6) months. The petition was timely filed with the petition fee.

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 be extended in which to file a response to the Office action mailed 16 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a Final Office action. The patent owner submitted an after Final amendment on 15 May 2009. The advisory action mailed 28 May 2009 extended the response period to four (4) months. The patent owner's petition for extension of time was timely filed on 16 July 2009, together with the proper fee as required by 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. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. ...
>
> *Ex parte* prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement (by statute (35 U.S.C. 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR § 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. <u>Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.</u> (emphasis added)...

ANALYSIS AND FINDINGS

The patent owner's petition to extend the period for response to six (6) months is before the Director of the CRU. 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 Final Office action was mailed 16 March 2009. The patent owner submitted a timely filed after Final amendment on 15 May 2009. The examiner's advisory action extended the period for response to four (4) months. The patent owner submitted a timely filed a petition for extension of time on 16 July 2009 with the appropriate fee.

The examiner once extended the period for response. MPEP § 2265 states that second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in

extraordinary situations. The petitioner stated that "The attorneys have diligently attempted to prosecute this application." MPEP § 2265 requires:

> "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."

The petition contains only the allegation that the applicant has diligently attempted to prosecute the proceeding. There is no factual accounting to support the allegation. Further, there is no statement as to "in spite of the action taken thus far, the request for additional time is needed."

Additionally there is required "sufficient cause" for granting any extension of time, the statement that the petitioner is contacting the inventor to obtain an affidavit does not address why this was not earlier needed since the proceeding is not after Final.

Lastly, "[s]econd or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations." There is no indication as to how this situation is extraordinary.

The petition request to extend the response time to six (6) months is hereby dismissed.

CONCLUSION

1. The patent owner's petition for extension of six (6) months time in which to file a response to the Final Office action dated 16 March 2009 is hereby **dismissed**

2. The Patent Owner's response was due **16 July 2009.**

3. The proceeding is hereby returned to the examiner for further handling.

4. Correspondence to the Office should be addressed as follows:

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

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Central Reexamination Unit

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/008,474	01/30/2007	5809336		2845

40972 7590 04/11/2008

HENNEMAN & ASSOCIATES, PLC
714 W. MICHIGAN AVENUE
THREE RIVERS, MI 49093

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/11/2008

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

Copied from 90008237 on 04/24/2008

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.
90/008,237	11/17/2006	5809336	069974-0160	8857

40972 7590 04/11/2008
HENNEMAN & ASSOCIATES, PLC
714 W. MICHIGAN AVENUE
THREE RIVERS, MI 49093

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/11/2008

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Copied from 90008237 on 04/24/2008

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:

Matthew A. Smith
FOLEY & LARDNER LLP
3000 K Street NW, Suite 500
Washington, DC 20007

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008237
PATENT NO. : 5809336
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)).

Copied from 90008237 on 04/24/2008

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:

MICHAEL HAWES
BAKER BOTTS L.L.P.
910 LOUISANA
HOUSTON, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008306
PATENT NO. : 5809336
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)).

Copied from 90008237 on 04/24/2008

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:

DANIEL B. RAVICHER
PUBLIC PATENT FOUNDATION, INC.
1375 BROADWAY, SUITE 600
NEW YORK, NY 10018

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008474
PATENT NO. : 5809336
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)).

Copied from 90008237 on 04/24/2008

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

Henneman & Associates, PLC (For Patent Owner)
714 W. Michigan Avenue
Three Rivers, MI 49093

Matthew A. Smith (For Third Party Requester)
Foley & Lardner LLP
3000 K Street NW, Suite 500
Washington, DC 20007

Michael Hawes (For Third Party Requester)
Baker Botts LLP
910 Louisiana
Houston, TX 77002

Daniel B. Ravicher (For Third Party Requester)
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

In re Moore *et alia* :
Reexamination Proceeding : DECISION *SUA SPONTE*
Control No. 90/008,237 : MERGING
Corrected Request Deposited: November 17, 2006 : REEXAMINATION
For: U.S. Patent No. 5,809,336 : PROCEEDINGS

In re Moore *et alia* :
Reexamination Proceeding :
Control No. 90/008,306 :
Request Deposited: October 19, 2006 :
For: U.S. Patent No. 5,809,336 :

In re Moore *et alia* :
Reexamination Proceeding :
Control No. 90/008,474 :
Request Deposited: January 30, 2007 :
For: U.S. Patent No. 5,809,336 :

Copied from 90008237 on 04/24/2008

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;809,336 (hereinafter, the '336 patent), issued to Moore *et alia*, on September 15, 1998.

2. On November 17, 2006, a third party deposited a corrected Request for *Ex Parte* Reexamination of claims 1-10 of the '336 patent. The reexamination proceeding was assigned Control No. 90/008,237 (hereinafter, the '8237 proceeding).

3. The Reexamination Order was granted in the '8237 proceeding on January 19, 2007.

4. There are currently no amendments in the '8237 proceeding.

5. On October 19, 2006, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-10 of the '336 patent. The reexamination proceeding was assigned Control No. 90/008,306 (hereinafter, the '8306 proceeding).

6. The Reexamination Order was granted in the '8306 proceeding on January 16, 2007.

7. There are currently no amendments in the '8306 proceeding.

8. On January 30, 2007, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-10 of the '336 patent. The reexamination proceeding was assigned Control No. 90/008,474 (hereinafter, the '8474 proceeding).

9. The Reexamination Order was granted in the '8474 proceeding on April 5, 2007.

10. There are currently no amendments in the '8474 proceeding.

11. The '8237, '8306, and '8474 proceedings await the first action on the merits from the assigned examiner.

Copied from 90008237 on 04/24/2008

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 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 '8237, '8306, and '8474 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. 90/008,237, 90/008,306, and 90/008,474 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:

Copied from 90008237 on 04/24/2008

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

Copied from 90008237 on 04/24/2008

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 : February 23, 2009

Patent No. :C1-6463324
Inventor(s) :Chlomo Ben-Haim et al.
Issued :October 8, 2002
Title :CARDIAC OUTPUT ENHANCED PACEMAKER

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 37 CFR 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent are based *solely* on information supplied and retained in the records of the U.S. Patent and Trademark Office identifying the assignment data. In this case, records reveal that the assignment data as presented in the Letters Patent is in accordance with records within the Assignment Division. With respect to applicants request filed January 27, 2009, further consideration to correct and receive a certificate of correction for this re-examination application file no. 90/008312, a petition filing under 37 CFR. 1.181 and 37 CFR 1.322 is required . The petition should be directed to the attention of the Assistant Commissioner for Patents using one of the following methods:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

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

By fax: 571-273-8300
ATTN: Office of Petitions

EFS web uspto.gov/ebc/index.html
(must be registered as an e-filer to submit responses)
Technical Support 1-866-217-9197

In view of the foregoing, applicants request for correction is hereby denied. Any telephone inquiries concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123.

Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 308-9390 or (703) 308-9380 Ext. 123

William H. Dippert
Eckert, Seamans, Cherin & Mellot, LLC
10 Bank Street
Ste 106
White Plains, NY 10606

/arg

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 M. SAUNDERS
SEYFARTH SHAW LLP
WORLD TRADE CENTER EAST
TWO SEAPORT LANE, SUITE 300
BOSTON, MA 02210-2028

MAILED

MAR 12 2008

CENTRAL REEXAMINATION UNIT

In re Application of
HOWARD N. STRAUB
Control No. 90/008,315 (U.S. Patent 7,008,396 B1)
Filed: November 03, 2006
Attorney Docket No. PRES06-00398

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 27, 2007 and Change of Correspondence address filed November 02, 2007.

The request is **NOT APPROVED**.

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

Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in a matter pending before the Office unless such request or such withdrawal is" for one of the permissive reasons listed in 37 CFR 10.40(c). While the reasons may be provided by referencing a specific portion of 37 CFR 10.40, the reasons must deal with actions by the client.

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request For Withdrawal as Attorney or Agent) to supply practitioner's reasons.

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

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

Patricia Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: BROWN RUDNICK BERLACK ISRAELS LLP
ONE FINANCIAL CENTER, BOX IP
BOSTON, MA 02111

cc: WILLIAM A. MUNCK (Third Party Requester)
DOCKET CLERK
P.O. DRAWER 800889
DALLAS, TX 75380

cc: MR. LAWRENCE JAY DEUTSH
1 MOUNTAINVIEW ROAD
GREENWOOD VILLAGE, CO 80111

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on February 27, 2007. There is no indication it was served on the 3rd Party Requester.

COPY

Re- Gdma

OIPE IAP26 FEB 2 7 2007 PATENT & TRADEMARK OFFICE

PTO/SB/83 (01-06)
Approved for use through 12/31/2008. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	90/008,315
Filing Date	November 3, 2006
First Named Inventor	Howard N. Straub
Art Unit	3731
Examiner Name	Vy Q. Bui
Attorney Docket Number	22940/2

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

Please withdraw me as attorney or agent for the above identified patent application, and

- [✓] all the attorneys/agents of record.
- [ ] the attorneys/agents (with registration numbers) listed on the attached paper(s), or
- [ ] the attorneys/agents associated with Customer Number [ ]

NOTE: This box can only be checked when the power of attorney of record in the application is to all the practitioners associated with a customer number.

The reasons for this request are:

CORRESPONDENCE ADDRESS

1. [✓] The correspondence address is NOT affected by this withdrawal.
2. [ ] Change the correspondence address and direct all future correspondence to:

[ ] The address associated with Customer Number: [ ]

OR

[✓] Firm *or* Individual Name	Brown Rudnick Berlack Israels LLP				
Address	One Financial Center, Box IP				
City	Boston	State	MA	Zip	02111
Country	US				
Telephone	617-856-8201	Email	ip@brownrudnick.com		
Signature					
Name	Thomas M. Saunders	Registration No.	29,585		
Date	February 23, 2007	Telephone No.	617-856-8284		

NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

COPY

PATENT
Attorney Docket No.: 56145/4-REEXAM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S):	Howard N. Straub	EXAMINER:	Aaron J. Lewis
REEXAM NO.:	90/008,315	GROUP:	3993
PATENT NO.:	7,008396	CONFIRMATION NO.:	9665
ISSUE DATE:	March 7, 2006		

FOR: OPHTHALMIC DEVICE AND METHOD OF MANUFACTURE AND USE

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being electronically submitted with the United States Patent Office on the date shown below addressed to EFS-Web, Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

By: /Tracey M. Simmons/ Date: November 2, 2007

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CHANGE OF CORRESPONDENCE ADDRESS

Sir:

Please send all future correspondence for this application to:

Mr. Lawrence Jay Deutsch
1 Mountainview Road
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(303) 779-0937

Respectfully submitted,

Date: November 2, 2007

/Thomas M. Saunders/
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,315	11/03/2006	7008396	PRES06-00398	9665

71130 7590 04/15/2008

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EXAMINER

ART UNIT	PAPER NUMBER

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

William A. Munck
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Dallas, TX 75380

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,315*.

PATENT NO. *7008396*.

ART UNIT *3993*.

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

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(for Patent Owner)

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(for Third Party Requester)

In re Straub
Reexamination Proceeding
Control No.: 90/008,202
Filed: August 30, 2006
For: U.S. Patent 7,008,396

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Straud
Reexamination Proceeding
Control No.: 90/008,315
Filed: November 03, 2006
For: U.S. Patent 7,008,396

The above noted reexamination files are before the Director of Technology Center 3900 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 7,008,396, issued March 7, 2006, is the subject of Reexamination Control Nos. 90/008,202 and 90/008,315.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,202 ('8202), was filed August 30, 2006 by William A. Munck of Munck Butrus, P.C. in Dallas, TX on behalf of Refocus Group, Inc. also in Dallas, TX. The request urged that a substantial new question of patentability was raised by the teachings of U.S. Patent No. 6,280,468 to Schachar which was not cited in the prosecution of U.S. Patent No. 7,008,396.

3. Reexamination was ordered for '8202 on November 6, 2006.

4. A second request for reexamination, assigned Reexamination Control No. 90/008,315 ('8315), was filed November 3, 2006 by William A. Munck of Munck Butrus, P.C. in Dallas TX on behalf of Refocus Group, Inc. also in Dallas, TX. The request urder that a substantial new question of patentability was raised by the teachings of U.S.

Patent Publication No. 2005/0283233 to Schachar which was not cited in the prosecution of U.S. Patent No. 7,008,396.

5. Reexamination was ordered for '8315 on January 30, 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 90/008,202 and 90/008,315 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 No. 90/008,315 as:

Reexamination Control Ns. 90/008,202 and 90/008,315

Thomas M. Saunders
Seyfarth Shaw LLP
Two Seaport Lane
Suite 300
Boston, MA 02210-2028

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/008,202 and 90/008,315 as:

William A. Munck
Munck Brutus, P.C.
P.O. Drawer 800889
Dallas, TX 75380

CONCLUSION

Reexamination Control Nos. 90/008,202 and 90/008,315 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

Lissi M. Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,317	12/12/2006	5700460	2903925-002000RE	2471

84331 7590 06/22/2009

Baker Donelson Bearman, Caldwell & Berkowitz, PC
555 Eleventh Street, NW, Sixth Floor
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,317*.

PATENT NO. *5700460*.

ART UNIT *3991*.

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JUN 22 2009

CENTRAL REEXAMINATION UNIT

Jeffery S. Melcher (For Third Party Requester)
Manelli Denison & Selter, PLLC
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In re Reexamination Proceeding	: DECISION ON PETITION
Davidson *et al.*	: TO CONTINUE
Control No.: 90/008,317	: *EX PARTE*
Filed: December 12, 2006	: REEXAMINATION
For: U.S. Patent No.: 5,700,460	: PROCEEDING

This is a decision on the April 9, 2009 patent owner petition under 37 CFR 1.182 requesting continued reexamination of the present proceeding.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to Deposit account No. 50-4254 in accordance with petitioner's April 9, 2009 EFS-WEB Electronic Patent Application Fee Transmittal.

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

REVIEW OF THE FACTS

1. On December 23, 1997, the Office issued U.S. Patent 5,700,460 (the '460 patent) to Davidson et al.

2. On November 7, 2006, a request for *ex parte* reexamination of the '460 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/008,317 (the '8317 proceeding).

3. On December 4, 2006, the Office issued a notice of failure to comply with *ex parte* reexamination request filing requirements and gave the third party requester thirty days to comply. The Office did not assign a filing date for the '8317 proceeding.

4. On December 12, 2006, the third party requester submitted a corrected *ex parte* reexamination request for the '460 patent.

5. On December 24, 2006, the Office issued a notice of the filing of the '8317 *ex parte* reexamination with a filing date of December 12, 2006.

6. On February 9, 2007, the Office issued an order granting the '8317 *ex parte* reexamination request.

7. On August 22, 2007, a first Office action on the merits issued rejecting all claims as unpatentable.

8. On December 21, 2007, patent owner filed a response amending the claims, providing remarks alleging patentability over the prior art of record and providing additional evidence in support of the remarks alleging patentability in the form of a declaration by Dr. Werner.[1] The declaration was also used to support an explication of several claim term definitions, to include the terms "bait", "attractant", and "bait matrix".

9. On October 1, 2008, a final Office action was issued in the '8317 proceeding maintaining the rejections of all remaining claims as unpatentable over the same prior art of record used to support the original grounds of rejection in the first Office action on the merits. The only new grounds of rejection were based on 35 U.S.C. § 112 in response to amendments to the claims made by the patent owner in their December 21, 2007 response.

10. On November 25, 2008, patent owner filed a notice of appeal in the '8317 proceeding.

11. On December 5, 2008, patent owner filed an after-final amendment and a declaration under 37 CFR 1.132 by Dr. Kukorowski in the '8317 proceeding. Patent owner further amended the claims and provided remarks alleging patentability of the pending claims.

12. On December 9, 2008, patent owner submitted a substitute amendment for the amendment filed on December 5, 2008.

13. On December 10, 2008, the Office issued a Notice of Defective Paper in *Ex Parte* Reexamination noting that the December 5, 2008 amendment was not compliant with the rules for submission of amendments in reexamination and that therefore the entire submission was not considered on the merits. The declaration, which was filed after a final action, but before the filing of a notice of appeal, was also not entered. Patent owner alleged the affidavit was necessary and was not earlier presented because it was addressing issues first raised in the final Office action.

14. Also on December 10, 2008, patent owner filed an appeal brief.

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[1] The amendment was timely filed as patent owner had petitioned for and was granted two one month extensions of time, giving patent owner until December 26, 2007 to respond to the outstanding Office action.

15. On April 8, 2009, the Office issued a Notification of Non-Compliant Appeal Brief in *Ex Parte* Reexamination.

16. On April 9, 2009, patent owner filed a petition under 37 CFR 1.182 requesting continued reexamination in the '8317 proceeding. This petition is the subject of the instant decision, which addresses petitioner's request for reopening of prosecution and entry of after final amendment and affidavit evidence.

17. On May 4, 2009, patent owner filed a substitute appeal brief.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '8317 reexamination proceeding requesting entry of the December 5, 2008 after final amendment as corrected by the December 9, 2008 substitute amendment to include consideration of the Kukorowski declaration concurrently filed with the amendment in response to the October 1, 2008 final 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."[2] 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. 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. 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.

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 which mandates that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

Based on the facts and circumstances of the present case, petitioner patent owner's response in the form of a request to enter evidence after final rejection the granting of the present petition is

[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

inconsistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner provides three distinct arguments to justify the granting of the relief of a request for continued reexamination: 1) The examiner has indicated to petitioner for the first time that additional evidence was sought regarding the claim limitation "at the locus which is in or near an area in which other food is present"; 2) The examiner has for the first time on the record indicated an erroneous "conflation" of food based bait components with non-food based bait components; and 3) A determination has not been made as to the propriety of the Kukorowski Declaration submission.

As an introduction to petitioner's arguments for granting the requested extraordinary relief, petitioner appears to imply that a request for the granting of the request for continuing reexamination under these circumstances is in accord with Office policy. However, the granting of extraordinary equitable relief under ordinary circumstances where the petitioner was in control of the prosecution of the proceeding in the normal course of examination, particularly after the first Office action, when the petitioner failed to submit sufficient declaratory evidence to rebut the first Office action on the merits is completely contrary to Office policy as it would undermine the policy intent of the relevant Office rule, *e.g.* 37 CFR 1.116(e).[3] Furthermore, as a preliminary matter it is noted that the examiner neither changed nor added a basis or grounds of rejection in terms of prior art rejections (i.e. neither shifted from the original anticipation or obviousness grounds of rejection nor added new prior art references into the grounds of rejection). All of petitioner's assertions that the examiner has made indications "for the first time" are actually rebuttal comments responsive to assertions made by petitioner in arguments or comments as to the merits of the August 22, 2007 first Office action on the merits.

In regards to petitioner's first argument, the examiner finding that soil and pasture fields are known to contain food sources for insects, was made in the first Office action on the merits.[4] Therefore petitioner was on notice of such BEFORE the final Office action, as evidenced by petitioner's responsive arguments (See page 15, line 17 to page 16 line 25 of the December 21, 2007 patent owner response to the August 22, 2007 First Office Action), and it was reasonably foreseeable that the examiner would not be persuaded by attorney argument and would maintain the rejection; an attorney's argument is not always found persuasive. Patent owner could have submitted declaratory evidence regarding this finding of fact to support the argument made (and further special dispatch by placing everything before the examiner in the response), but patent owner chose not to do so. Furthermore, it is noted that the examiner statement petitioner alleges as being an invitation to submit evidence - "in the absence of evidence showing that soil and pasture fields do not present or contain food sources and the interpretation of the instant claim language regarding the term 'near', this rejection is maintained."[5] - was predicated with the examiner finding of fact that, "Soil and pasture fields are known to contain food sources for insects."[6] Therefore, the quote in context is not an invitation, request or requirement being made

[3] See also MPEP 714.13 (II) Amendments and Other Replies After Final Rejection or Action, Procedure Followed; ENTRY NOT A MATTER OF RIGHT

[4] *See e.g.* the First Office Action, p. 24 rejection of claim 17 (August 22, 2007).

[5] Final Office Action, p. 19 (October 1, 2008).

[6] *Id.*

by the examiner to petitioner to submit additional evidence or information rather it is pointing out that petitioner has NOT presented any evidence contrary to the examiner's finding of fact from the first Office action.[7] Accordingly the actions taken by the examiner were not unforeseeable and patent owner's argument is not persuasive. Also, any argument patent owner wishes to make as to this matter could have gained entry if filed after final rejection without the amendment and evidence, and such argument can be made on appeal. Thus, petitioner's argument is not persuasive.

In regards to petitioner's second argument that for the "first time" petitioner was made aware of an alleged "conflation" of food based bait components with non-food based bait components on the part of the examiner is not persuasive. Viewing the evidence on the record as a whole, it is readily apparent that the examiner is not conflating the concepts of "food based" bait components with "non-food based" bait components. Instead the examiner, when responding to petitioner's arguments presented in the December 21, 2007 patent owner response,[8] was rebutting petitioner's allegation that the fipronil formulation disclosed by the prior art was "prophetic." In the examiner's rebuttal the phrase "current data suggests" from the Colliot reference was emphasized as indicative of a present fact that fipronil baits were outstanding in the control of Orthotera pests, and hence not prophetic. The examiner did not make any determinations in regards to food based bait components and non-food based bait components as an aspect of the rebuttal to petitioner's arguments.[9] The teachings relevant to the issue were presented in the first Office action[10] and petitioner was on notice of such, as evidenced by their responsive arguments and declaration evidence.[11] Patent owner submitted arguments and declaratory evidence in response to this aspect of the first Office action, the examiner considered the submissions and found it not persuasive as to the "prophetic" argument. Accordingly the actions taken by the examiner were foreseeable. Please note that any argument patent owner wishes to make as to this matter could have gained entry if filed after final rejection without the amendment and evidence, and such argument can be made on appeal. Accordingly, petitioner's argument is not persuasive.

Finally, in regards to petitioner's last argument, petitioner states that "because the fate of Dr. Kukorowski's Declaration under 37 CFR § 1.132 has not be resolved . . . Patent Owner requests the Office to grant the Request for Continued Reexamination in this proceeding." 37 CFR 1.116(e) permits the submission of an affidavit or other evidence after a final rejection in an *ex parte* reexamination, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. However, the propriety of the submission of the affidavit under 37 CFR 1.116(e) has not been determined adversely on the merits. In fact, the December 10, 2008 Notice of Defective Paper did not even address the affidavit, and patent owner did nothing in the time period set to cause the affidavit to be considered. The use of a petition under 37 CFR 1.182 in

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[7] Furthermore, requirements for information made by an examiner are only permissible in accordance with 37 CFR 1.105 and as the statement in question was not coupled to 37 CFR 1.105 the statement could not be construed as a requirement being made upon patent owner to present additional evidence.

[8] *See* Page 18, second full paragraph and paragraphs 20 and 21 of the Werner declaration.

[9] Final Office Action, p. 24 (October 1, 2008).

[10] *See* the First Office Action, pgs. 28 and 31 rejection of claims 6 and 19 respectively (August 22, 2007).

[11] *See* Page 18, second full paragraph and paragraphs 20 and 21 of the Werner declaration.

the instant circumstances is not the purpose of a request for continued reexamination. Therefore, the argument is not persuasive.

In addition to the above, in this instance, patent owner has already filed an appeal brief in the present proceeding, and the Office has expended significant resources and efforts in reviewing the appeal brief. There is no evidence on the record that patent owner petitioned for an additional extension of time to file the appeal brief to permit consideration of the petitions filed by patent owner under 37 CFR 1.181 and 1.182 prior to filing the brief and having the Central Reexamination Unit (CRU) initiate a review of the appeal brief. The filing of an extension of time petition prior to filing an appeal brief would have prevented the consumption of resources on behalf of both the patent owner and the Office. Accordingly, this conduct of prosecution is not consistent with the statutory mandate of special dispatch in a reexamination proceeding.

In view of the above and the fact situation presented by the record, the petition is dismissed.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. Jurisdiction for the '8317 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor

Kenneth 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.
90/008,317	12/12/2006	5700460	2903925-002000RE	2471

84331 7590 02/01/2010

Baker Donelson Bearman, Caldwell & Berkowitz, PC
555 Eleventh Street, NW, Sixth Floor
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EXAMINER

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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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JEFFREY S. MELCHER MANELLI DENISON & SELTER, PLLC 2000 M STREET, N.W. 7 TH FLOOR WASHINGTON, D.C. 20036-3307	: : : :	FOR THIRD PARTY REQUESTER
In re Davidson et al. Reexamination Proceeding Control No. : 90/008,317 Filed : December 12, 2006 Patent No. 5,700,460	: : : : : : :	DECISION ON PATENT OWNER'S PETITION UNDER 37 CFR 1.181

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CENTRAL REEXAMINATION UNIT

This is a decision addressing Patent Owner's petition under 37 CFR 1.181 for entry of a declaration submitted under 37 CFR 1.132, filed July 9, 2009. The petition is before the Director of the Central Reexamination Unit for decision.

Patent Owner submitted a declaration under 37 CFR 1.132 by Dr. Kenneth Kukorowski as part of a response after final rejection filed December 5, 2008. The Kukorowski declaration was not considered by the examiner. Review of the file history shows that finality has been withdrawn, and a non-final rejection in which said declaration was considered was mailed December 16, 2009.

Accordingly, Patent Owner's petition is DISMISSED as moot.

Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

90/008,318

2-COMMON OUTGOING (*EX PARTES*)

DRAFT

- ☐ 1449 _____
  Reviewed List of Refs Cited by Appl
- ☐ 892. _____
  List of Refs Cited by Examiner
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,318	12/27/2006	6736126	NED-102J	2450

23409 7590 03/07/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/07/2008

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Waltham, MA 02451

Date:

MAILED

MAR 07 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008318
PATENT NO. : 6736126
ART UNIT : 3900

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

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

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CENTRAL REEXAMINATION UNIT

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ROY J. COLEMAN (For Third Party Requester)
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In re Reexamination Proceeding :
Schroer et al. :
Control No. 90/008,318 : DECISION GRANTING PETITION
Filed: December 27, 2006 :
U.S. Patent No. 6,736,126 :
Attorney Docket No. NED-102J :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 3, 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 (Response To Office Action In Ex Parte Reexamination - item 1), an authorization to charge counsel's deposit account for the $770.00 petition fee under 37 CFR 1.17(m) (item 2) and a Certificate of Service on the Third Party Requester.

Regarding the requisite statement (item3), 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement

appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement in the petition is being construed as the required statement. Petitioners must notify the Office if this is not a correct reading of the statement appearing in the petition.

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

$770.00 has been charged to counsel's deposit account no. 13-3080 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 Response To Office Action In Ex Parte Reexamination filed March 3, 2008, along with the present petition, in due course.

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

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

Fred A. Silverberg

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.
90/008,320	12/12/2006	5614182	B229 1030RE	4856

26158 7590 10/17/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/17/2008

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WASHINGTON, DC 20036-3307

Date:
MAILED
OCT 17 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008320
PATENT NO. : 5614182
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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OCT 17 2008

CENTRAL REEXAMINATION UNIT

Susan Shaw McBee
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Atlanta, GA 30357-0037

For Patent Owner

Jeffrey S. Melcher
Manelli Denison & Selter, PLLC
2000 M Street, N.W.
Suite 700
Washington, D.C. 20036

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,320
Filed: December 12, 2006
For: US Patent No. 5,614,182

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

This is a decision on the petition filed September 29, 2008 to request an extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated August 13, 2008.

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 dated August 13, 2008, 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 PTO is reexamining US Patent No. 5, 614,182 and 5,700,460, which is a continuation-in-part of the '182 patent, in tandem. On December 21, 2007, patentee filed a Response in both reexams. During an interview held November 13, 2007, patentee requested that the Examiner issue further office actions within a short time period of each other to avoid any conflict in preparing two responses. Unfortunately, Examiner Kunz was unable to issue an Office action until September 29, 2008. Patentee has been diligently weighing the options in light of the Final Office action in the present reexamination, however, patentee cannot formulate an overall strategy without reviewing the Office action in the related reexamination proceeding. Patentee

requests that the response to the Office action of August 13, 2008 be due on November 7, 2008.

Analysis and Findings

Patent Owner has filed a response to the Office action of August 13, 2008 on October 14, 2008. Therefore no extension of time is deemed necessary. Accordingly this petition is dismissed.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated August 13, 2008 is **dismissed**.

2. 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 Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,320	12/12/2006	5614182	2903925-001000	4856

84331 7590 06/22/2009

Baker Donelson Bearman, Caldwell & Berkowitz, PC
555 Eleventh Street, NW, Sixth Floor
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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Date:

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JUN 2 2 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008320
PATENT NO. : 5614182
ART UNIT : 3900

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MAILED

JUN 22 2009

Jeffery S. Melcher (For Third Party Requester) CENTRAL REEXAMINATION UNIT
Manelli Denison & Selter, PLLC
2000 M Street, NW, 7th Floor
Washington, DC 20036-3307

In re Reexamination Proceeding	: DECISION ON PETITION
Davidson *et al.*	: TO CONTINUE
Control No.: 90/008,320	: *EX PARTE*
Filed: December 12, 2006	: REEXAMINATION
For: U.S. Patent No.: 5,614,182	: PROCEEDING

This is a decision on the April 9, 2009 patent owner petition under 37 CFR 1.182 requesting continued reexamination of the present proceeding.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to Deposit account No. 50-4254 in accordance with petitioner's April 9, 2009 EFS-WEB Electronic Patent Application Fee Transmittal.

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

REVIEW OF THE FACTS

1. On March 25, 1997, the Office issued U.S. Patent 5,614,182 (the '182 patent) to Davidson et al.

2. On November 7, 2006, a request for *ex parte* reexamination of the '182 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/008,320 (the '8320 proceeding).

3. On December 4, 2006, the Office issued a notice of failure to comply with *ex parte* reexamination request filing requirements and gave the third party requester thirty days to comply. The Office did not assign a filing date for the '8320 proceeding.

4. On December 12, 2006, the third party requester submitted a corrected *ex parte* reexamination request for the '182 patent.

5. On December 20, 2006, the Office issued a notice of the filing of the'8320 *ex parte* reexamination with a filing date of December 12, 2006.

6. On February 9, 2007, the Office issued an order granting the'8320 *ex parte* reexamination request.

7. On September 24, 2007, a first Office action on the merits issued rejecting all claims as unpatentable.

8. On October 22, 2007, the Office *sua sponte* vacated and replaced the September 24, 2007 Office action with a new Office action on the merits rejecting all the claims as unpatentable.

9. On December 21, 2007, patent owner filed a response amending the claims, providing remarks alleging patentability over the prior art of record and providing additional evidence in support of the remarks alleging patentability in the form of a declaration by Dr. Werner. The declaration was also used to support an explication of several claim term definitions, to include the terms "bait", "attractant", and "bait matrix".

10. On August 13, 2008, a final Office action was issued in the '8320 proceeding maintaining the rejections of all remaining claims as unpatentable over the same prior art of record used to support the original grounds of rejection in the first Office action on the merits. The only new grounds of rejection were based on 35 U.S.C. § 112 in response to amendments to the claims made by the patent owner in their December 21, 2007 response.

11. On October 14, 2008, patent owner submitted a response to the August 13, 2008 final Office action.[1] The response consisted of an amendment to the claims and provided remarks alleging patentability of the pending claims.

12. On October 17, 2008, the Office issued an Advisory Action stating that the October 14, 2008 amendment will not be entered due to formal matters with the claims regarding 37 CFR 1.530.

13. On October 23, 2008, patent owner submitted a response to the August 13, 2008 final Office action in light of the Office feedback from the October 17, 2008 Advisory Action. The response consisted of an amendment to the claims and provided remarks alleging patentability of the pending claims.

14. On October 30, 2008, the Office issued an Advisory Action stating that the October 23, 2008 amendment will not be entered as it does not place the claims in condition for allowance or confirmation nor reduces issues for appeal.

---

[1] The amendment was timely filed as patent owner had petitioned for and was granted a one month extension of time, giving patent owner until October 14, 2007 to respond to the October 14, 2008 final Office action.

15. On November 6, 2008, patent owner submitted a response to the August 13, 2008 final Office action in light of the Office feedback from the October 30, 2008 Advisory Action. The response consisted of an amendment to the claims and provided remarks alleging patentability of the pending claims.

16. On November 26, 2008, the Office issued an Advisory Action stating the November 6, 2008 response will be entered as it reduces issues for appeal, but that it does not place the claims in condition for allowance or confirmation.

17. On December 5, 2008, patent owner filed a Notice of Appeal in the '8320 proceeding.

18. On December 5, 2008, patent owner filed a response after-final amendment consisting of a declaration under 37 CFR 1.132 by Dr. Kukorowski in the '8320 proceeding.

19. On December 10, 2008, patent owner filed an Appeal Brief.

20. On December 17, 2008, the Office issued an Advisory Action stating that the declaration fails to overcome the rejections of record and that there is no showing of good and sufficient reasons as to why the declaration is necessary and was not presented earlier.

21. On December 18, 2008, the Office issued a Notice of Non-Compliant Appeal Brief in an *Ex Parte* Reexamination regarding the December 10, 2008 Appeal Brief.

22. On January 9, 2009, patent owner submitted a petition requesting reconsideration of the December 17, 2008 Advisory Action determination to not enter the Kukorowski declaration.

23. On January 15, 2009, patent owner submitted a petition under 37 CFR 1.181 requesting supervisory review of the December 17, 2008 Advisory Action determination to not enter the Kukorowski declaration.

24. On January 16, 2009, patent owner submitted a substitute Appeal Brief.

25. On April 9, 2009, patent owner filed a petition under 37 CFR 1.182 requesting continued reexamination in the '8320 proceeding. Along with the petition patent owner submitted a response under 37 CFR 1.114 consisting of an amendment to the claims, remarks alleging patentability of the pending claims and the Kukorowski declaration.

26. Also on April 9, 2009, patent owner filed a substitute petition under 37 CFR 1.182 requesting continued reexamination in the '8320 proceeding. The basis of the substitute petition being to clarify petitioner's intent <u>to maintain the pendency of the currently pending petition(s) under 37 CFR 1.181 requesting supervisory review of the December 17, 2008 advisory actions determination not to enter the December 5, 2008 Kukorowski declaration</u>. The substitute petition is the subject of the instant decision, which addresses petitioner's request for reopening of prosecution and entry of affidavit evidence after final.

27. On May 1, 2009, the Office issued an Advisory Action after the filing of an appeal brief stating that the Kukorowski declaration submitted on April 9, 2009 would not be entered as it was not timely filed before the filing of an appeal brief.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '8320 reexamination proceeding requesting entry of the April 9, 2009 after final amendment to include consideration of the Kukorowski declaration concurrently filed with the amendment in response to the August 13, 2008 final 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."[2] 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. 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. 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.

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 which mandates that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

Based on the facts and circumstances of the present case, petitioner patent owner's response in the form of a request to enter evidence after final rejection, the granting of the present petition is inconsistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner provides three distinct arguments to justify the granting of the relief of a request for continued reexamination: 1) The examiner has indicated to petitioner for the first time that additional evidence was sought regarding the claim limitation "at the locus which is in or near an area in which other food is present"; 2) The examiner has for the first time on the record

[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

indicated an erroneous "conflation" of food based bait components with non-food based bait components; and 3) A determination has not been made as to the propriety of the Kukorowski Declaration submission.

As an introduction to petitioner's arguments for granting the requested extraordinary relief, petitioner appears to imply that a request for the granting of the request for continuing reexamination under these circumstances is in accord with Office policy. However, the granting of *extraordinary* equitable relief under ordinary circumstances where the petitioner was in control of the prosecution of the proceeding in the normal course of examination, particularly after the first Office action, when the petitioner failed to submit sufficient declaratory evidence to rebut the first Office action on the merits is completely contrary to Office policy as it would undermine the policy intent of the relevant Office rule, *e.g.* 37 CFR 1.116(e).[3] Furthermore, as a preliminary matter it is noted that the examiner neither changed nor added a basis or grounds of rejection in terms of prior art rejections (i.e. neither shifted from the original anticipation or obviousness grounds of rejection nor added new prior art references into the grounds of rejection). All of petitioner's assertions that the examiner has made indications "for the first time" are actually rebuttal comments responsive to assertions made by petitioner in arguments or comments as to the merits of the October 22, 2007 first Office action on the merits.

In regards to petitioner's first argument, the examiner finding that soil and pasture fields are known to contain food sources for insects, was made in the first Office action on the merits.[4] Therefore petitioner was on notice of such BEFORE the final Office action, as evidenced by petitioner's responsive arguments (See page 13 first and second paragraph of the December 21, 2007 patent owner response to the October 22, 2007 First Office Action), and it was reasonably foreseeable that the examiner would not be persuaded by attorney argument and would maintain the rejection; an attorney's argument is not always found persuasive. Patent owner could have submitted declaratory evidence regarding this finding of fact to support the argument made (and further special dispatch by placing everything before the examiner in the response), but patent owner chose not to do so. Furthermore, it is noted that the examiner statement which petitioner alleges as being an invitation to submit evidence - "in the absence of evidence showing that soil and pasture fields do not present or contain food sources and the interpretation of the instant claim language regarding the term 'near', this rejection is maintained."[5]- was predicated with the examiner finding of fact that "Soil and pasture fields are known to contain food sources for insects."[6] Therefore, the quote in context is not an invitation, request or requirement being made by the examiner to petitioner to submit additional evidence or information; rather it is pointing out that petitioner has NOT presented any evidence contrary to the examiner's finding of fact from the first Office action.[7] Accordingly the actions taken by the examiner were not unforeseeable and patent owner's argument is not persuasive. Also, any argument patent owner

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[3] See also MPEP 714.13 (II) Amendments and Other Replies After Final Rejection or Action, Procedure Followed; ENTRY NOT A MATTER OF RIGHT

[4] *See e.g.* the First Office Action, p. 14 rejection of claim 6 (October 22, 2007).

[5] Final Office Action, p. 26 (August 13, 2008).

[6] *Id.*

[7] Furthermore, requirements for information made by an examiner are only permissible in accordance with 37 CFR 1.105 and as the statement in question was not coupled to 37 CFR 1.105 the statement could not be construed as a requirement being made upon patent owner to present additional evidence.

wishes to make as to this matter could have gained entry if filed after final rejection without the amendment and evidence, and such argument can be made on appeal. Thus, petitioner's argument is not persuasive.

In regards to petitioner's second argument that for the "first time" petitioner was made aware of an alleged "conflation" of food based bait components with non-food based bait components on the part of the examiner is not persuasive. Viewing the evidence on the record as a whole, it is readily apparent that the examiner is not conflating the concepts of "food based" bait components with "non-food based" bait components. Instead the examiner, when responding to petitioner's arguments presented in the December 21, 2007 patent owner response,[8] was rebutting petitioner's allegation that the fipronil formulation disclosed by the prior art was "prophetic." In the examiner's rebuttal the phrase "current data suggests" from the Colliot reference was emphasized as indicative of a present fact that fipronil baits were outstanding in the control of Orthotera pests, and hence not prophetic. The examiner did not make any determinations in regards to food based bait components and non-food based bait components as an aspect of the rebuttal to petitioner's arguments.[9] The teachings relevant to the issue were presented in the first Office action[10] and petitioner was on notice of such, as evidenced by their responsive arguments and declaration evidence.[11] Patent owner submitted arguments and declaratory evidence in response to this aspect of the first Office action, the examiner considered the submissions and found it not persuasive as to the "prophetic" argument. Accordingly the actions taken by the examiner were foreseeable. Please note that any argument patent owner wishes to make as to this matter could have gained entry if filed after final rejection without the amendment and evidence, and such argument can be made on appeal. Accordingly, petitioner's argument is not persuasive.

In regards to petitioner's last argument, petitioner asserts that because the examiner refused to enter Dr. Kukorowski's Declaration under 37 CFR § 1.132 patent owner has not been given an opportunity to fully develop the issues of record and therefore requests that the Office continued reexamination in this proceeding." 37 CFR 1.116(e) permits the submission of an affidavit or other evidence after a final rejection in an *ex parte* reexamination, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. In this instance, the patent owner is concurrently pursuing alternative relief via a 37 CFR 1.181 petition to request entry of the declaration December 5, 2008. Since the January 15, 2009 petition under 37 CFR 1.181 to request entry of the declaration and response filed on December 5, 2008 has not yet been decided, the December 5, 2008 submission cannot be considered to have been denied entry after a final rejection, for the purpose of filing a §1.182 petition to request continued reexamination, and it cannot be found that relief is not available under any other rule. Clearly, patent owner believes relief to be available under 37 CFR 1.181 as evidenced by the filing and maintaining of the 37 CFR 1.181 reconsideration petition of January 15, 2009. Therefore, the argument is not persuasive as the present §1.182 petition is also not grantable for this reason.

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[8] *See* p.15, third paragraph to p. 16, the first seven lines of text and paragraphs 20 and 21 of the Werner declaration.
[9] Final Office Action, p. 31 (August 13, 2008).
[10] *See* the First Office Action, p. 18 rejection of claim 8 (October 22, 2007).
[11] *See* p.15; third paragraph to p. 16 the first seven lines of text and paragraphs 20 and 21 of the Werner declaration.

In addition to the above, in this instance, patent owner has already filed an appeal brief in the present proceeding, and the Office has expended significant resources and efforts in reviewing the appeal brief. There is no evidence on the record that patent owner petitioned for an additional extension of time to file the appeal brief to permit consideration of the petitions filed by patent owner under 37 CFR 1.181 and 1.182 prior to filing the brief and having the Central Reexamination Unit (CRU) initiate a review of the appeal brief. The filing of an extension of time petition prior to filing an appeal brief would have prevented the consumption of resources on behalf of both the patent owner and the Office. Accordingly, this conduct of prosecution is not consistent with the statutory mandate of special dispatch in a reexamination proceeding.

In view of the above and the fact situation presented by the record, the petition is dismissed.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. Jurisdiction for the '8320 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor

Kenneth 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.
90/008,320	12/12/2006	5614182	2903925-001000	4856

84331 7590 02/01/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/01/2010

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Date:

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FEB 01 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008320
PATENT NO. : 5614182
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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BAKER DONELSON BEARMAN, CALDWELL & BERKOWITZ, PC 555 ELEVENTH STREET, NW, SIXTH FLOOR WASHINGTON, DC 20004	FOR PATENT OWNER
JEFFREY S. MELCHER MANELLI DENISON & SELTER, PLLC 2000 M STREET, N.W. 7 TH FLOOR WASHINGTON, D.C. 20036-3307	FOR THIRD PARTY REQUESTER
In re Davidson et al. Reexamination Proceeding Control No. : 90/008,320 Filed : December 12, 2006 Patent No. 5,614,182	DECISION ON PATENT OWNER'S PETITIONS UNDER 37 CFR 1.181

This is a decision addressing Patent Owner's petitions under 37 CFR 1.181 for entry of a declaration submitted under 37 CFR 1.132, filed January 15, 2009 and July 9, 2009. The petition is before the Director of the Central Reexamination Unit for decision.

Patent Owner submitted a declaration under 37 CFR 1.132 by Dr. Kenneth Kukorowski as part of a response after final rejection filed December 5, 2008. The Kukorowski declaration was not considered by the examiner. Review of the file history shows that finality has been withdrawn, and a non-final rejection in which said declaration was considered was mailed November 30, 2009.

Accordingly, Patent Owner's petitions are DISMISSED as moot.

Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,322	11/08/2006	6345278		4617

25784 7590 05/21/2008

MICHAEL O. SCHEINBERG
P.O. BOX 164140
AUSTIN, TX 78716-4140

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/21/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GARDERE WYNNE SEWELL LLP
1601 ELM STREET
SUITE 3000
DALLAS, TX 75201

Date:
MAILED
MAY 21 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008322
PATENT NO. : 6345278
ART UNIT : 3900

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

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

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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1601 ELM STREET
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(For Third Party Requester)

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

In re: Hitchcock *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,322
Deposited on: 8 November 2006
For: US Patent No. 6,345,278

This is a decision on the 12 May 2008 , petition for "Petition for Extension of Time Under 37 CFR 1.550," requesting that the time for responding to the Office action mailed 10 April 2008 be extended by one month.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 10 April 2008, 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 12 May 2008, together with the $200.00 petition fee required by 37 CFR 1.515(c) and § 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

Historically extensions of time requested for the purpose of scheduling an interview have not been considered "sufficient cause" for the purpose of granting any extensions of time. However, considering the extensive length and content of the Office action, the request for extension of time is hereby granted in part.

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

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 10 April 2008 is **granted in part**.

2. A two-week extension of time is hereby granted.

3. The Patent Owner's response is due **24 June 2008**.

4. Response may be submitted as follows:

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner at (571) 272-1611 or Eric Keasel, Supervisory Patent Examiner at (571) 272-4929, in the Central Reexamination Unit, Art Unit 3992.

for

MARK J. REINHART
CRU SPE-AU 3992

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999