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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,323	11/07/2006	6945457	602225-002	4616

84310 7590 06/16/2009

ALBERT JACOBS LLP
Suite 502
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New York, NY 10022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/16/2009

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

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WHO-5E
DAYTON, OH 45479

Date:

MAILED

JUN 16 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008323
PATENT NO. : 6945457
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
JUN 16 2009
CENTRAL REEXAMINATION UNIT

DOUGLAS S. FOOTE
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DAYTON, OH 45479

(For Requester)

In re Barcelou
Reexamination Proceeding
Control No. 90/008,323
Request Deposited: November 7, 2006
For: U.S. Patent No. 6,945,457

: DECISION ON
: PETITION

This is a decision on the March 18, 2009 patent owner petition entitled "PETITION TO MAKE SPECIAL" requesting "to make this Appeal special". This decision also addresses the May 18, 2009 paper.

The petition of March 18, 2009 is **dismissed as incomplete** for the reasons set forth below.

The paper of May 18, 2009 is **not considered** because it lacks an indication of service on the third party.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 6,945,457 (hereinafter, the '457 patent), issued to Barcelou on September 20, 2005.

2. On November 7, 2006, a request was deposited requesting reexamination of the '457 patent.

3. On January 4, 2007, the order granting reexamination was mailed.

4. On May 2, 2007, in related litigation, Judge Sue L. Robinson signed an order staying the litigation pending reexamination of the '457 patent.

5. Prosecution included three actions on the merits, each setting a two-month shortened statutory (SSP) period. A Notice of Appeal was filed on January 21, 2009.

6. On March 18, 2009, a petition entitled "PETITION TO MAKE SPECIAL" was filed, in which patent owner informed the office that litigation was stayed because of the reexamination.

7. On March 20, 2009, the petition was served on the third party.

8. On May 18, 2009, a paper entitled "STATUS INQUIRY AND RENEWED PETITION TO MAKE SPECIAL" was filed.

ANALYSIS AND FINDINGS

Initially, it is noted that patent owner took nearly two years to inform the office that related litigation has been stayed pending the reexamination of the '457 patent.

37 CFR 1.565(a) states, in part:
"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."

Patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the '457 patent throughout the course of this reexamination proceeding.

MPEP 2263 states, in part:
"A shortened statutory period of 2 months will be set for response to Office actions in reexaminations, except as follows. Where the reexamination results from a court order or litigation is stayed for purposes of reexamination, the shortened statutory period will be set at 1 month." (emphasis added)

Had the office been timely informed of the stay, the SSP would have been set to one month rather than two months for each of the three actions on the merits.

35 USC 305 states, in part:
"All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office." (emphasis added)

37 CFR 1.181(b) states, in part:
"Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested."

In the petition of March 18, 2009, patent owner "petitions to make this Appeal special". It appears that patent owner does not understand that the appeal to the Board of Patent Appeals and Interferences is covered by the same "special dispatch" provisions of 35 USC 305. Accordingly, there does not appear to be any action requested in the petition. Therefore, the petition of March 18, 2009 is **dismissed as incomplete**.

There is no indication of service of the May 18, 2009 paper on the third party requester. Patent Owner is respectfully directed to 37 CFR 1.530(f), which states:

> 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.

As the paper of May 18, 2009 does not reflect service, the paper is **refused consideration**.

CONCLUSION

1. The petition March 18, 2009 is **dismissed as incomplete**.

2. The paper of May 18, 2009 is **not considered**.

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

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

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,323	11/07/2006	6945457	236263-000004	4616

84310 7590 01/20/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/20/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DOUGLAS S. FOOTE
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1700 S. PATTERSON BLVE., WHO-5E
DAYTON, OH 45479

Date:

MAILED

JAN 2 0 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008323
PATENT NO. : 6945457
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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JAN 2 0 2010

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(For Requester)

CENTRAL REEXAMINATION UNIT

In re Barcelou
Reexamination Proceeding
Control No. 90/008,323
Request Deposited: November 7, 2006
For: U.S. Patent No. 6,945,457

: DECISION ON
: PETITION

This is a decision on the December 18, 2009 patent owner petition entitled "PETITION TO ENTER REPLY BRIEF" requesting "his Reply Brief be entered".

A review of the record indicates that the examiner entered the reply brief filed December 18, 2009 in the paper of January 15, 2010. Accordingly, the petition is **dismissed as moot**.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,324	11/09/2006	6107851	10414-25	6695

7590 05/26/2009

EXAMINER	

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ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2009

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

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MAY 2 6 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008324
PATENT NO. : 6107851
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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Sanjeet K. Dutta
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Menlo Park, CA 94025-1015

(For the Third-Party Requester)

MAILED

MAY 26 2009

CENTRAL REEXAMINATION UNIT

In re Baul Balakrishman et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,324
Filed: November 9, 2006
For: U.S. Patent No. 6,107,851

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

This is a decision on the petition under 37 CFR 1.182 filed by the patent owner on March 24, 2009, requesting continued reexamination in the *ex parte* reexamination proceeding of reexamination proceeding control Nos. 90/008,324.

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration.

The authorization to charge the petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition to Deposit Account No. 02-2666 has been provided with the present petition.

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

REVIEW OF FACTS

1. On August 22, 2000, U.S. Patent No. 6,107,851 (the '851 patent) issued to Baul Balakrishman et al.

2. On November 9, 2006, a request for *ex parte* reexamination of the '851 patent was filed by a third party requester, and was assigned control number 90/008,324 (the '8324 proceeding).

3. On December 19, 2006, the Office granted the reexamination request and ordered reexamination for the '8324 proceeding.

4. On April 7, 2008, a first non-final Office action on the merits was mailed in the '8324 reexamination proceeding.

5. On June 9, 2008, a response to the first non-final Office action was filed, presenting arguments in response to the rejections of record, as well as a declaration under 37 CFR 1.132 of Robert Blauschild. [1]

6. On December 4, 2008, a final Office action was mailed in the '8324 reexamination proceeding.

7. On January 23, 2009, a personal examiner interview was conducted with Baul Balakrishman (a named inventor on the '851 patent) and James Go (the representative of the patent owner).

8. On January 30, 2009, the patent owner filed a submission for the purpose of responding to the final Office action, accompanied by a proposed amendment to the claims, to amend independent claims 1 and 11 and adding claims 19-23.

9. On February 27, 2009, an advisory action was mailed in the '8324 reexamination proceeding notifying the patent owner that the after-final submission fails to overcome all of the rejections in the final Office action mailed on December 4, 2008, and the proposed after-final amendment filed on January 30, 2009 will not be entered.

10. On March 24, 2009, the patent owner filed the instant petition under 37 CFR 1.182 requesting continued reexamination of the '8324 reexamination proceeding.

11. On April 8, 2009, the patent owner filed a notice of appeal accompanied by an authorization to charge required fees to a deposit account and signed by the attorney of record, appealing the '8324 reexamination proceeding to the Board of Patent Appeals and Interferences from the last decision of the examiner.

12. On May 19, 2009, the patent owner filed a second after-final amendment paper, canceling claims 1 and 11, adding new claims 19-20 in lieu of canceled claims 1 and 11, and amending depended claims 2, 7, 9, 10, 16 and 17 to depend on new claims 19-20.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '8324 reexamination proceeding to provide consideration of the after-final response filed on January 30, 2009.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for

[1] The response was considered timely filed on June 9, 2008, which was a Monday, because the time period for response expired on June 7, 2008, which was a Saturday. The response was filed electronically via the Office's electronic filing system (EFS-Web), and the Electronic Acknowledgement Receipt for the response shows a receipt date of June 9, 2008.

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, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action or action closing prosecution) was made available by the Office via a petition under 37 CFR 1.182, in appropriate circumstances. However, this relief is restricted in nature, as the statutory mandate for special dispatch in resolving reexamination proceedings is still paramount. Specifically, 35 U.S.C. 305 mandates that *ex parte* reexamination proceedings must be conducted "with special dispatch within the Office."

Accordingly, relief in the form of a continuation of the reexamination prosecution after a final Office action is now available via a 37 CFR 1.182 petition in appropriate circumstances. Hereinafter, this petition will be referred to as "the § 1.182 petition."

As with a Request for Continued Examination (RCE) in an application, the § 1.182 petition must be filed to further the prosecution of the reexamination proceeding, rather than to delay the proceeding. This is especially critical in the reexamination setting, where 35 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, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

The first amendment and response to the final Office action filed on January 30, 2009, proposed to amend claims 1 and 11, cancel claims 9 and 17, and add new claims 19-23. The patent owner stated that new claims 19-23 are original dependent claims 4, 13, 18, 19 and 17, respectively, rewritten in independent form. However, the amendment presented additional claims without cancelling a corresponding number of finally rejected claims, and introduced changes to claims that are not subject to re-examination (*e.g.*, original dependent claim 18 was not subject to reexamination). Furthermore, claims 3, 5-6, 8, 12, and 14-15 that are not subject to re-examination would depend on the amended claims 1 and 11 rather than the original patented claims 1 and 11. Therefore, the first amendment and response after final filed on January 30, 2009 would not provide a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate, and as such, the granting of the present petition would not be consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

On May 18, 2009, Ms. Joni Chang called the patent owner's representative, Mr. James Go, to

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[2] *Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending*, 1292 *Off. Gaz. Pat. Office* 20 (March 1, 2005).

provide information on how amendments to the claims could be made without introducing changes to claims that are not subject to reexamination and confirmed claims, and canceling the same number of claims as the number of new claims. On May 19, 2009, the patent owner filed a second amendment and response to the final Office action. The second amendment after final proposes to cancel independent claims 1 and 11, add new independent claims 19-20 (in lieu of canceled claims 1 and 11), amend dependent claims 2, 7, 9 and 10 (original depend on claim 1) to depend on new independent claim 19, and amend dependent claims 16 and 17 (original depend on claim 11) to depend on new independent claim 20. The second amendment after final would add two new claims and cancel corresponding number of finally rejected claims and would not introduce any changes to claims that are not subject to reexamination. Based on the above and the facts and circumstances of the present situation, it is found that patent owner's presentation of the second amendment and response after final addressing the final Office action is deemed to provide the requisite *bona fide* effort to advance the prosecution. As such, the granting of the present petition is consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the present record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the patent owner's second amendment paper filed on May 19, 2009. These papers will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the patent owner's second amendment and response after final filed on May 19, 2009, and then issue an Office action treating this paper as a patent owner response received **after** a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '134 *inter partes* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances.

3) The closing of prosecution rendered via the December 4, 2008 Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The first amendment and response to the final Office action filed on January 30, 2009, including the amendment to the claims, will not be entered and will not be considered by the examiner.

5) The second after-final amendment paper filed on May 19, 2009 will be entered[3] and

[3] This decision takes no position on the formal propriety of the amendment, or whether it introduces new matter or impermissibly broadens. Any issues raised by the amendment will be addressed by the examiner in the next Office action.

considered by the examiner. The May 19, 2009 paper will be treated as a response by patent owner received **after** a first Office action.

6) Jurisdiction over this reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further processing not inconsistent with this decision.

7) Telephone inquiries related to this decision should be directed to Joni Y. Chang, Senior Legal Advisor, at (571) 272-7720.

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

May. 26, 2009
C:\Kiva\Kenpet7\RCR\

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CENTRAL REEXAMINATION UNIT

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(For the Third-Party Requester)

In re Baul Balakrishman et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,326
Filed: November 9, 2006
For: U.S. Patent No. 6,249,876

: **DECISION GRANTING**
: **PETITION TO**
: **CONTINUE *EX PARTE***
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the petition under 37 CFR 1.182 filed by the patent owner on March 24, 2009, requesting continued reexamination in the *ex parte* reexamination proceeding of reexamination proceeding control Nos. 90/008,326.

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration.

The authorization to charge the petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition to Deposit Account No. 02-2666 has been provided with the present petition.

The present petition under 37 CFR 1.182 is granted.

REVIEW OF FACTS

1. On June 19, 2001, U.S. Patent No. 6,249,876 (the '876 patent) issued to Baul Balakrishman et al.

2. On November 9, 2006, a request for *ex parte* reexamination of the '876 patent was filed by a third party requester, and was assigned control number 90/008,326 (the '8326 proceeding).

3. On December 21, 2006, the Office granted the reexamination request and ordered reexamination for the '8326 proceeding.

4. On April 7, 2008, a first non-final Office action on the merits was mailed in the '8326 reexamination proceeding.

5. On June 9, 2008, a response to the first non-final Office action was filed, presenting arguments in response to the rejections of record. [1]

6. On December 3, 2008, a final Office action was mailed in the '8326 reexamination proceeding.

7. On January 23, 2009, a personal examiner interview was conducted with Baul Balakrishman (a named inventor on the '851 patent) and James Go (the representative of the patent owner).

8. On January 30, 2009, the patent owner filed a response to the final Office action, accompanied by an amendment to the claims, amending claims 1, 17 and 18.

9. On March 3, 2009, an advisory action was mailed in the '8326 reexamination proceeding notifying the patent owner that the proposed after-final amendment filed on January 30, 2009 will not be entered.

10. On March 24, 2009, the patent owner filed the instant petition under 37 CFR 1.182 requesting continued reexamination of the '8326 reexamination proceeding.

11. On April 3, 2009, the patent owner filed a notice of appeal accompanied by an authorization to charge required fees to a deposit account and signed by the attorney of record, appealing the '8326 reexamination proceeding to the Board of Patent Appeals and Interferences from the last decision of the examiner.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '8326 reexamination proceeding to provide consideration of the after-final response filed on January 30, 2009.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[2] Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly,

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[1] The response was considered timely filed on June 9, 2008, which was a Monday, because the time period for response expired on June 7, 2008, which was a Saturday. The response was filed electronically via the Office's electronic filing system (EFS-Web) and the Electronic Acknowledgement Receipt for the response shows a receipt date of June 9, 2008.

[2] *Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending*, 1292 *Off. Gaz. Pat. Office* 20 (March 1, 2005).

relief in the form of a continuation of the reexamination prosecution (after a final Office action or action closing prosecution) was made available by the Office via a petition under 37 CFR 1.182, in appropriate circumstances. However, this relief is restricted in nature, as the statutory mandate for special dispatch in resolving reexamination proceedings is still paramount. Specifically, 35 U.S.C. 305 mandates that *ex parte* reexamination proceedings must be conducted "with special dispatch within the Office."

Accordingly, relief in the form of a continuation of the reexamination prosecution after a final Office action is now available via a 37 CFR 1.182 petition in appropriate circumstances. Hereinafter, this petition will be referred to as "the § 1.182 petition."

As with a Request for Continued Examination (RCE) in an application, the § 1.182 petition must be filed to further the prosecution of the reexamination proceeding, rather than to delay the proceeding. This is especially critical in the reexamination setting, where 35 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, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

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

In view of the above and the individual facts and circumstances of this proceeding, the petition requesting continued reexamination is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the response filed on January 30, 2009. These papers will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the Amendment After Final filed on January 30, 2009. The Examiner will then issue an Office action treating these papers as responses of patent owner received **after** a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '8326 *ex parte* reexamination proceeding is continued. **No further continuation** of the present reexamination proceeding **will be granted absent** a showing of ***extraordinary*** circumstances.

3) The closing of prosecution rendered via the December 3, 2008 Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The response to the December 3, 2008 final Office action filed on January 30, 2009 will be entered [3] by the Central Reexamination Unit (CRU), and will then be considered by the examiner. The paper will be treated as a response by patent owner received **after** a first Office action.

5) Jurisdiction over this reexamination proceeding is being forwarded to the CRU for further processing not inconsistent with this decision.

6) Telephone inquiries related to this decision should be directed to Joni Y. Chang, Senior Legal Advisor, at (571) 272-7720.

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

[3] This decision takes no position on the propriety of the amendment or whether it introduces new matter. Any issues raised by the amendment will be addressed by the Examiner in the next Office action.

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AUG 03 2007

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Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105

(For Requester)

In re Semple et al.
Reexamination Proceeding
Control No.: 90/008,329
Filed: January 23, 2007
For: U.S. Patent No. 6,415,291 B1

: DECISION GRANTING
: 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.

A petition fee of $400.00 under 37 CFR 1.17(f) is being charged to the patent owner's Deposit Account No. 19-0089 as authorized in the June 13, 2007 patent owner petition.

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,415,291 (the '291 patent) issued on July 2, 2002.

2. The '291 patent claims benefit to US Patent No. 6,408,307 (the '307 patent).

3. U.S. Patent 6, 385,622 (the '622 patent) is a sibling of the '291 patent, which also claims benefit to the '307 patent.[1]

[1] US 6,385,622 issued before the '307 patent even though its filing date is later than the '307 patent's filing date.

4. 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).

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 '662 patent was filed on September 20, 2006. The request was assigned control No. 90/008,192 (the '8192 reexamination proceeding).

7. Reexamination was ordered for the '8329 proceeding on April 3, 2007.

8. Reexamination was ordered for the '8398 proceeding on February 21, 2007.

9. Reexamination was ordered for the '8192 proceeding on October 28, 2006.

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. Concurrently 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, 1.97 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). 37 CFR 1.98(a) requires that copies of certain types of references must be provided in each application for which applicant files an IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's June 13, 2007 submission complies with all other requirements

[2] A total of approximately twenty (20) bankers boxes of references in all.

of the relevant rules. The examiner of record will make such a determination, in light of this decision's waiving the reference copy submission requirement.

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 and 1.98 is granted.

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

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.
90/008,329	01/23/2007	6415291	3242193	1998

30955 7590 04/11/2008

LATHROP & GAGE LC
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BOULDER, CO 80301

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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425 MARKET STREET
SAN FRANCISCO, CA 94105

Date MAILED

APR 11 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008329
PATENT NO. : 6415291
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 11 2008

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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

(For Requester)

In re: Bouve *et alia*
Reexamination Proceeding
Control No. 90/008,329
Corrected Request Deposited: January 23, 2007
For: U.S. Patent No. 6,415,291

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

This is a decision on the April 9, 2008, "PETITION FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R 1.550(C)" requesting that the time to submit a Patent Owner response be extended an additional 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. 6,415,291 (hereinafter, the '291 patent), issued to Bouve *et alia*, on July 2, 2002.

2. On January 23, 2007, a third party deposited a corrected Request for *Ex Parte* Reexamination of the '291 patent. The reexamination proceeding was assigned Control No. 90/008,329 (hereinafter, the '8329 proceeding).

3. The reexamination order was granted in the '8329 proceeding on April 3, 2007.

4. A non-final rejection was mailed on March 3, 2008 setting a two-month shortened statutory period (SSP) for response.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the non-final office action mailed March 3, 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 April 3, 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.

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

The request notes the large number of documents, the necessity to coordinate information between a number of individuals and the preparation being done in connection with a scheduled interview on the present case. Reference is made to the petition for details of these and other issues.

Analysis and Findings

It is noted that Patent Owner has submitted the vast majority of references in this proceeding. The 16 references submitted by requester have been available to Patent Owner since the filing of the reexamination request. The large numbers of references submitted by Patent Owner have been in their possession since well before the non-final office action. The examiner has cited only one additional reference in the action of March 3, 2008. Since Patent Owner has been in possession of all documents (with one exception) since well before the mailing of the non-final office action, petitioner's argument that additional time is needed for review of the documents is not persuasive.

However, other points made in the petition are deemed persuasive to a degree. 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 two weeks is considered sufficient.

Accordingly, the time for filing the response is extended for two weeks and therefor the response is due on or before May 19, 2008 (May 17 being a Saturday).

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 in part. The period during which Patent Owner may file a response has been extended to May 19, 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,329	01/23/2007	6415291	3242193	1998

37086 7590 03/25/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2009

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MAILED
Date:
MAR 25 2009
CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008329
PATENT NO. : 6415291
ART UNIT : 3900

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

Robert A. Saltzberg
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San Francisco, CA 94105

(For Requester)

MAILED

MAR 25 2009

CENTRAL REEXAMINATION UNIT

Tracy W. Druce
Novak Druce & Quigg LLP
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Suite 1000 West Tower
Washington, D.C. 2005

(Courtesy Copy)

In re Bouve et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,329
Filed: January 23, 2007
For: U.S. Patent No. 6,415,291

DECISION
DISMISSING
PETITION

This is a decision on the patent owner petition, filed January 21, 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 July 2, 2002, U.S. Patent No. 6,415,291 (the '291 patent) issued from application serial no. 09/816,829 (the '829 application) to Bouve et al. with 23 claims.

2. The patent lists the assignee as Civix-DDI, LLC, which corresponds to the recorded assignment documents for the parent application of the '829 application.

3. On November 13, 2006, a third party requester, Yahoo!, deposited an incomplete request for *ex parte* reexamination of claims 1-8, 11-14, 16-19, and 21-23 of the '291 patent, which was assigned control no. 90/008,329. A corrected request was filed January 23, 2007, and was 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 '291 patent and other related patents. Third party requestor, Yahoo!, is a defendant in the suit.

5. On April 3, 2007, an order granting the reexamination request was mailed.

6. A non-final Office action was mailed March 3, 2008, in which claims 1-8, 11-14, 16-19, and 21-23 were rejected.

7. On May 28, 2008, patent owner filed a response, after having two requests for extensions of time granted.

8. On September 30, 2008, a final rejection was mailed.

9. On November 17, 2008, a power of attorney revoking the previous power of attorney and appointing new counsel was filed, along with a statement under 37 CFR 3.73(b) establishing that the present assignee has the authority to act in this proceeding. 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 Amendment After Final response was filed on January 21, 2009, after having two requests for extensions of time granted. 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, which is the subject of this decision, 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.

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.

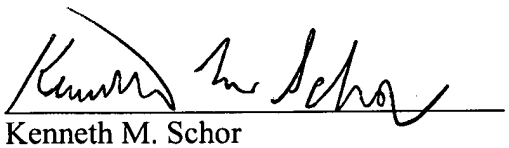
CONCLUSION

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

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.
90/008,329	01/23/2007	6415291	3242193	1998

37086 7590 04/16/2009

NOVAK DRUCE & QUIGG, LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2009

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(For Patent Owner)

MAILED

APR 16 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re W. Lincoln Bouve et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,329
Filed: January 23, 2007
For: U.S. Patent No. 6,415,291

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the April 10, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Notice of Appeal and revive the present terminated reexamination prosecution ("the April 10, 2009 patent owner petition to revive").[1]

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 April 10, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The April 10, 2009 patent owner petition to revive is **granted**.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

[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 September 30, 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 1.113 provides, in pertinent part:

> (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.
> *
> *
> (c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

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

(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 711.03(c)(II)(A)(2)(b) provides, in pertinent part:

A reply under 37 CFR 1.113 to a final action must include ... cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, ... the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee; [or]

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance;

*

*

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*
*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Patent owner submitted a Notice of Appeal and paid the corresponding fee of $540.00 on April 10, 2009, thereby satisfying item (1).[2] A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the April 10, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the April 10, 2009 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

CONCLUSION

1. The April 10, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for further processing in view of the April 10, 2009 Notice of Appeal.

3. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time period is extendable under the provisions of 37 CFR 1.550(c). See 37 CFR 41.37(e).

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Christopher Lee, of CRU Art Unit 3992, at (571) 272-3637.

---

[2] See MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

5. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

Robert A. Clarke
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
95/000,199	12/01/2006	6988138		7245

20277 7590 03/17/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2008

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

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
SOFTWARE FREEDOM LAW CENTER
1995 BROADWAY
17TH FLOOR
NEW YORK, NY 10023-5882

Date:
MAILED
MAR 17 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008330
PATENT NO. : 6988138
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
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FOLEY AND LARDNER LLP
3000 K STREET NW
SUITE 500
WASHINGTON, DC 20007

Date:

MAILED

MAR 17 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95000199
PATENT NO. : 6988138
ART UNIT : 3900

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

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

James Rizzo, Esq.
Michael S. Nadel, Esq.
McDermott Will & Emery LLP
600 13th Street, N.W.
Washington, DC 20005-3096

(For Patent Owner)

MAILED

MAR 17 2008

CENTRAL REEXAMINATION UNIT

Software Freedom Law Center
1995 Broadway
17th Floor
New York, NY 10023-5882

(For *Ex Parte* Requester)

Foley and Lardner LLP
3000 K Street NW
Suite 500
Washington, DC 20007

(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding
Control No. 90/008,330
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138

Inter Partes Reexamination Proceeding
Control No. 95/000,199
Filed: December 1, 2006
For: U.S. Patent No. 6,988,138

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,988,138 (the '138 patent) issued to Robert L. Alcorn *et al.* on January 17, 2006, and was assigned to Blackboard Inc.

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2. A request for *ex parte* reexamination of claims 1-44 of the '138 patent was filed on November 17, 2006, by third party requester Richard E. Fontana, and the request was assigned control number 90/008,330 (the '8330 *ex parte* reexamination proceeding).

3. On January 25, 2007, *ex parte* reexamination was ordered for claims 1-44 of the '138 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability affecting these claims.

4. A request for *inter partes* reexamination of claims 1-44 of the '138 patent was filed on December 1, 2006, by third party requester Desire2Learn, Inc., who is also the real party in interest. The request was assigned control number 95/000,199 (the '0199 *inter partes* reexamination proceeding).

5. On February 26, 2007, *inter partes* reexamination was ordered based on the examiner's determination that the request for *inter partes* reexamination raised a substantial new question of patentability affecting claims 1-44 of the '138 patent.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '8330 *ex parte* reexamination expired after March 25, 2007.[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 '0199 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.

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In accordance with 37 CFR 1.989(a), the 90/008,330 and 95/000,199 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. 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(s), 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(s) 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(s) 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

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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 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. 95/000,199 and *ex parte* Reexamination Control No. 90/008,330 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

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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
Senior Legal Advisor
Office of Patent Legal Administration

Mar. 14, 2008
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,330	11/17/2006	6988138		3192

20277 7590 08/18/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/18/2008

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.
95/000,199	12/01/2006	6988138		7245

20277 7590 08/18/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

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(For Patent Owner)

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New York, NY 10023-5882

(For *Ex Parte* Requester) CENTRAL REEXAMINATION UNIT

Foley and Lardner LLP
3000 K Street NW
Suite 500
Washington, DC 20007

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,199
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138

Ex Parte Reexamination Proceeding
Control No. 90/008,330
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138

DECISION DISMISSING PETITION

This is a decision on the May 29, 2008 patent owner petition entitled "PETITION TO SUSPEND *INTER PARTES* REEXAMINATION UNDER 35 U.S.C. § 314(c)" (hereinafter "petition to suspend") for suspension of *inter partes* reexamination proceeding control number 95/000,199 due to existing concurrent litigation of the patent being reexamined.

In addition, the *inter partes* third party requester filed a paper on June 10, 2008 entitled "REQUEST TO SUBMIT RESPONSE TO PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING" (hereinafter "request to submit opposition paper"), and subsequently filed a paper on June 19, 2008 entitled "THIRD-PARTY REQUESTOR'S RESPONSE TO PATENT OWNER'S PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING" (hereinafter "opposition paper").

The patent owner's petition to suspend, the *inter partes* third party requester's request to submit opposition paper, the requester's opposition paper, and the merged reexamination proceeding are before the Office of Patent Legal Administration for consideration of the petitioned matters.

Because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended, the patent owner's petition to suspend is taken as a petition under 37 C.F.R. § 1.182 for suspension of reexamination proceeding control number 95/000,199.

Inter partes third party requester's request to submit opposition paper is taken as a petition under 37 C.F.R. § 1.183 for waiver of 37 C.F.R. § 1.939 and the opposition paper is taken as a petition under 37 C.F.R. § 1.182 to oppose the patent owner's petition to suspend.

FEES

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. § 1.182 was charged to patent owner's Deposit Account No. 50-2624, as authorized by the patent owner on the transmittal letter that accompanied the instant petition, in which patent owner instructed that a fee of $200.00 be charged to the patent owner's deposit account, as well as any additional fees associated with the instant petition. [1]

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petitions under 37 C.F.R. §§ 1.182 and 1.1823 was charged to the *inter partes* third party requester's Deposit Account No. 19-0741, as authorized by the *inter partes* third party requester in the request to submit the opposition paper, instructing that a fee of $130.00 be charged to the *inter partes* third party requester's deposit account, as well as any deficiency associated with the request, and as further authorized in the opposition paper, instructing that any deficiency associated with the opposition paper be charged to the *inter partes* third party requester's deposit account. [2]

SUMMARY

The patent owner's petition under 37 C.F.R. § 1.182 to suspend the present merged reexamination proceeding is dismissed.

The *inter partes* third party requester's petition under 37 C.F.R. § 1.183 to permit entry and consideration of the requester's opposition paper is granted. Accordingly, the requester's opposition paper has been considered.

---

[1] 37 C.F.R. § 1.182 requires a petition fee as set forth in 37 C.F.R. § 1.17(f). Effective September 30, 2007, the fee pursuant to 37 C.F.R. § 1.17(f) is $400.00.

[2] 37 C.F.R. §§ 1.182 and 1.183 each require a petition fee as set forth in 37 C.F.R. § 1.17(f). Effective September 30, 2007, the fee pursuant to 37 C.F.R. § 1.17(f) is $400.00. *See inter partes* third party requester's request to submit opposition paper at page 2 and opposition paper at page 1.

REVIEW OF FACTS

1. U.S. Patent No. 6,988,138 (the '138 patent) issued to Robert L. Alcorn *et al.* on January 17, 2006, and was assigned to Blackboard Inc. (hereinafter "patent owner").

2. A request for *ex parte* reexamination of claims 1-44 of the '138 patent was filed on November 17, 2006, by third party requester Richard E. Fontana, and the request was assigned control number 90/008,330 (the '8330 *ex parte* reexamination proceeding).

3. On January 25, 2007, *ex parte* reexamination was ordered for claims 1-44 of the '138 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability affecting claims 1-44 of the '138 patent.

4. A request for *inter partes* reexamination of claims 1-44 of the '138 patent was filed on December 1, 2006, by third party requester Desire2Learn, Inc., which is also the real party in interest (hereinafter "*inter partes* third party requester"). The request was assigned control number 95/000,199 (the '0199 *inter partes* reexamination proceeding).

5. On February 26, 2007, *inter partes* reexamination was ordered based on the examiner's determination that the request for *inter partes* reexamination raised a substantial new question of patentability affecting claims 1-44 of the '138 patent.

6. On March 17, 2008, a Decision, *Sua Sponte*, to Merge Reexamination Proceedings was issued, merging the '8330 *ex parte* and '0199 *inter partes* reexamination proceedings into a single proceeding (the merged reexamination proceeding) governed by 37 C.F.R. §§ 1.902 through 1.997.

7. On March 25, 2008, a first Office action rejecting claims 1-44 of the '138 patent was mailed for the merged reexamination proceeding.

8. Patent owner filed a Patent Owner's Response under 37 C.F.R. § 1.945 on May 29, 2008.

9. Also on May 29, 2008, patent owner filed the instant petition to suspend, requesting suspension of the '0199 reexamination proceeding.

10. On June 10, 2008, *inter partes* third party requester filed the instant request to submit an opposition paper, and subsequently filed the opposition paper on June 19, 2008.

11. On June 26, 2008, *inter partes* third party requester filed Third Party Requester's Comments after the Patent Owner Response under 37 C.F.R. § 1.947.

12. The '138 patent is currently the subject of litigation between patent owner and *inter partes* third party requester styled *Blackboard Inc. v. Desire2Learn Inc.*, No. 9:06CV155 (E.D. Tex. filed July 26, 2006), which is currently on appeal before the U.S. Court of Appeals for the Federal Circuit as appeal No. 2008-1368 (filed May 21, 2008).

DECISION

The present patent owner petition for suspension of the '0199 reexamination proceeding, and the *inter partes* third party requester's opposition paper have been fully considered.

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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:

> FINAL DECISION.- 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 C.F.R. § 1.182 states (in part):

> 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. § 1.987 states:

> If a patent in the process of inter partes reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the inter partes reexamination proceeding.

The Manual of Patent Examining Procedure (MPEP) § 2686.01 states (in part):

> It may also be desirable in certain situations to suspend one of the proceedings for a short and specified period of time. For example, a suspension of a first reexamination proceeding may be issued to allow time for the decision on the second request. Further, after the second proceeding has been ordered, it may be desirable to suspend the second proceeding prior to merging, where the first proceeding is presently on appeal before a Federal court to await the court's decision prior to merging. A suspension will only be granted in exceptional (extraordinary) instances because of the statutory requirements that examination proceed with "special dispatch", and the express written approval by the OPLA must be obtained. Suspension will not be granted when there is an outstanding Office action.

With respect to suspension of *inter partes* reexamination, MPEP § 2684.04(III) provides that:

> ... "good cause" might be present, for example, where there is an issue that cannot be decided in the reexamination proceeding but affects the resolution of the proceeding. Another example is where there is an issue common to the litigation and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power (e.g., an issue heavily dependent on presentation of conflicting/contested evidence by the two parties).

II. DISCUSSION

A. "Good Cause"

The merged reexamination proceeding is governed by the *inter partes* reexamination rules set forth in 37 C.F.R. §§ 1.902 through 1.997. 35 U.S.C. § 314(c) expressly allows for the suspension of an *inter partes* reexamination proceeding within the Office "for good cause," notwithstanding that *inter partes* reexamination proceedings are to be conducted with "special dispatch." Pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 1.987, which implements the statutory provision, the USPTO Director has authority to determine circumstances amounting to "good cause" for suspension of an *inter partes* reexamination proceeding, and to do so on a case-by-case basis.

Looking to the precedent, in *inter partes* reexamination proceedings control numbers 95/000,093 and 95/000,094 (collectively referred to hereinafter as "the Immersion-Sony *inter partes* reexamination proceedings"), the Office granted patent owner Immersion's petition to suspend the *inter partes* reexamination proceedings due to existing concurrent litigation of the patents that were the subject of the two reexamination proceedings. [3] The Office decision granting suspension acknowledged that MPEP § 2684.04 sets forth certain criteria as indicia of "good cause" for suspension of an *inter partes* reexamination proceeding, but pointed out that these criteria were

[3] See the '093 and '094 proceedings, "Decision Granting Petitions To Suspend," November 17, 2005.

merely exemplary. [4] The criteria relied upon by the Office in the Immersion-Sony *inter partes* reexamination proceedings to support a finding of "good cause" to suspend were upheld by the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. Using these criteria, the facts and circumstances of record in a given *inter partes* reexamination proceeding can be analyzed to determine whether there is "good cause" to suspend that *inter partes* reexamination proceeding due to existing concurrent litigation of the patent being reexamined.

In *Sony*, the Office denied patent owner Immersion's first petition to suspend the *inter partes* reexamination proceedings, noting that even if the proceedings were suspended in the Office and judgment was rendered adverse to requester Sony in the concurrent litigation, that would not dispose of all claims in the existing *inter partes* reexamination proceedings, thus leading to a piecemeal reexamination, and a delay in reexamination of the non-litigated claims. [5] The patent owner then disclaimed the non-litigated claims of the two patents for which reexamination had been requested in the two proceedings, whereby identical patent claims were the subject of both the *inter partes* reexamination proceedings and the concurrent litigation. The Office then granted patent owner Immersion's second petition to suspend the *inter partes* reexamination proceedings.

At the point in time that the Immersion-Sony *inter partes* reexamination proceedings were suspended, the two reexamination proceedings were at an early stage; the Office's work had been limited only to a finding that the requests for reexamination had raised a substantial new question of patentability. The concurrent litigation, on the other hand, was at an advanced stage: (a) A District Court had issued a decision adverse to requester Sony, holding the litigated patent claims to be valid, (b) an appeal of the District Court had been filed in the Court of Appeals for the Federal Circuit ("the Federal Circuit"), and (c) the matter had already been briefed. Thus, there was a substantial likelihood that suspension of the reexamination proceedings would serve to conserve Office resources, since a final holding of claim validity would statutorily require termination of the Immersion-Sony *inter partes* reexamination prosecutions with respect to all of the claims subject to the litigation, which was all of the claims subject to reexamination in those proceedings. It was not in the Office's and parties' interests to engage resources in administrative proceedings that ultimately could be mooted by the concurrent litigation *which was soon to be finally resolved*. The substantial likelihood that the reexamination prosecutions would terminate and the proceedings be concluded, taken together with the identity of claims in the litigation and the *inter partes* reexamination proceedings and the close proximity to final resolution of the matter, led the Office to conclude that, on balance, there was "good cause" to suspend the Immersion-Sony *inter partes* reexamination proceedings to await the decision by the Federal Circuit.

B. Analysis and Findings

The facts and circumstances in the present merged reexamination proceeding differ significantly from those present in the Immersion-Sony *inter partes* reexamination proceedings. For example, petitioner patent owner has not established that the merged reexamination proceeding is at an

[4] *Id.*, "Decision Granting Petitions To Suspend," November 17, 2005, at footnote 6.
[5] *Id.*, "Decision Denying Petitions," August 23, 2005, at page 6.

early stage. In contrast to the Immersion-Sony *inter partes* reexamination proceedings, which were just at their beginning stages (e.g., the Office's work had been limited only to a finding that the requests for reexamination had raised a substantial new question of patentability), the merged reexamination proceeding has advanced significantly beyond the beginning stage. In this instance, the Office has issued a non-final Office action, in response to which the patent owner has filed a Patent Owner's Response and the *inter partes* third party requester has filed Third Party Requester's Comments on the Patent Owner's Response. Thus, patentability issues have been defined and argued by parties, and the Office's work in the merged reexamination proceeding has not been limited to merely finding that the requests for reexamination raised a substantial new question of patentability (at which point a patentability determination has not yet been made).

Further, petitioner patent owner has not established that concurrent litigation is at an advanced stage, in which a final decision can be expected shortly. Patent owner informs the Office that trial proceedings in federal district court have concluded in concurrent litigation between patent owner and the *inter partes* third party requester ("the '0199 concurrent litigation"). [6] Patent owner further point out that, in the '0199 concurrent litigation, both parties have filed appeals to the U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit"), and that the *inter partes* third party requester's initial brief was due on July 21, 2008. [7] Petitioner patent owner has not established, however, nor does it appear from the Federal Circuit's docket records, that the matter has already been briefed before the Federal Circuit. [8]

Moreover, petitioner patent owner has not established a substantial likelihood that the merged reexamination prosecution would terminate and the proceedings be concluded upon resolution of the '0199 concurrent litigation. The appeal before the Federal Circuit in the '0199 concurrent litigation is at a preliminary stage such that it can not be determined when the appeal will reach a final holding on claim validity and what that decision is likely to be.

Additionally, unlike in the Sony-Immersion *inter partes* reexamination proceedings, where a final holding of claim validity would statutorily require termination of the Immersion-Sony *inter partes* reexamination prosecutions with respect to all of the claims subject to the litigation, which was all of the claims subject to reexamination in those proceedings, a final holding of claim validity upon resolution of the '0199 concurrent litigation would not have the same effect on the present merged reexamination proceeding due to the merger of the '8330 *ex parte* and '0199 *inter partes* reexamination proceedings. Even if all of the claims of the '138 patent are found valid upon resolution of the '0199 concurrent litigation, only the participation rights of the *inter partes* third party requester would be terminated immediately; the merged reexamination proceeding would be severed, and prosecution and examination would continue as the '8330 *ex parte* reexamination proceeding with respect to *all of the issues* present in the previously merged proceeding. It is only if all of the claims of the '138 patent are found invalid upon resolution of the '0199 concurrent litigation would the merged reexamination prosecution be terminated and the proceeding be concluded. In short, unlike in *Sony*, there would be no

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[6] *Blackboard Inc. v. Desire2Learn Inc.*, No. 9:06CV155 (E.D. Tex. filed July 26, 2006).

[7] *See* petition at page 5. The Federal Circuit appeal was docketed as No. 2008-1368 (filed May 21, 2008).

[8] As of August 14, 2008, Appellant's Unopposed Motion for Second Extension of Time to File Principal Brief, filed on August 4, 2008, is pending before the Federal Circuit.

waste of Office resources that might not need to be expended, since the consideration of the issues must continue, even if all claims are found to be valid on appeal.

Further, contrary to the patent owner's assertion regarding the simplifications that might result from suspension, suspension in this situation would not "[leave] only one alleged prior art reference for the Office to consider." [9] Rather, the severed '8330 *ex parte* reexamination proceeding would continue on the merits as to the *full scope* of the art before the Office. [10]

In summary, the absence of a substantial likelihood that the reexamination prosecution of the issues would be concluded upon resolution of the '0199 concurrent litigation, taken together with the preliminary stage of the appeal before the Federal Circuit in the '0199 concurrent litigation and the advancement of the merged reexamination proceeding beyond the beginning stage, on balance, do not establish "good cause" to suspend the '0199 reexamination proceeding to await a decision by the Federal Circuit on claim validity. Accordingly, the patent owner petition to suspend, requesting suspension of the '0199 reexamination proceeding, is **dismissed**.

CONCLUSION

1. The patent owner petition to suspend, filed on May 29, 2008, is dismissed.

2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit for appropriate action.

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

08-15-08
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[9] *See* petition at pages 11-12.
[10] *See*, e.g., MPEP § 2256 regarding prior art patents and printed publications reviewed by examiner in reexamination.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,330	11/17/2006	6988138		3192

20277 7590 11/18/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2008

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.
95/000,199	12/01/2006	6988138		7245

20277 7590 11/18/2008

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(For Patent Owner)

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(For *Ex Parte* Requester)

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Inter Partes Reexamination Proceeding
Control No. 95/000,199
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138

Ex Parte Reexamination Proceeding
Control No. 90/008,330
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138

DECISION DISMISSING PETITION

This is a decision on the September 3, 2008 patent owner petition entitled "PETITION TO PARTIALLY TERMINATE INTER PARTIES REEXAMINATION UNDER 35 C.F.R. § 1.182(b)" (petition for partial termination), requesting termination of *inter partes* reexamination proceeding control number 95/000,199 with respect to claims 36, 37 and 38 of U.S. Patent No. 6,988,138.

In addition, *inter partes* third party requester filed a paper on October 15, 2008 entitled "REQUEST TO SUBMIT RESPONSE TO PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING" (request to submit opposition paper), concurrently with a paper entitled "THIRD-PARTY REQUESTOR'S RESPONSE TO PATENT OWNER'S PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING" (opposition paper).

Patent owner's petition for partial termination, requester's request to submit opposition paper, requester's opposition paper, and the merged reexamination proceeding are before the Office of Patent Legal Administration for consideration of the petitioned matters.

Because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be partially terminated, patent owner's petition for partial termination is taken as a petition under 37 CFR 1.182 for partial termination of reexamination proceeding control number 95/000,199.

Inter partes third party requester's request to submit opposition paper is taken as a petition under 37 CFR 1.183 for waiver of 37 CFR 1.939 and requester's opposition paper is taken as a petition under 37 CFR 1.182 to oppose patent owner's petition for partial termination.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to patent owner's Deposit Account No. 50-2624, as authorized by patent owner in the transmittal letter that accompanied the petition for partial termination.

The fee of $130.00 was charged to *inter partes* third party requester's credit card, as authorized on page two of the request to submit opposition paper, which was accompanied by a credit card authorization form for payment of the fee of $130.00. Because a petition fee of $400.00 pursuant to 37 CFR 1.17(f)[1] is required for *inter partes* third party requester's petitions under 37 CFR 1.182 and 1.183, the $130.00 fee was credited back to *inter partes* third party requester's credit card and the fee of $400.00 was charged to *inter partes* third party requester's Deposit Account No. 19-0741 as authorized on page two of the request to submit opposition paper, and as further authorized on page one of the opposition paper, instructing the Commissioner to charge any deficiency for the request to *inter partes* third party requester's deposit account.

SUMMARY

Patent owner's petition under 37 CFR 1.182 for partial termination of reexamination proceeding control number 95/000,199 is dismissed.

Inter partes third party requester's petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.939 for entry and consideration of requester's opposition paper is granted. Accordingly, third party requester's opposition paper has been considered.

REVIEW OF FACTS

1. U.S. Patent No. 6,988,138 (the '138 patent) issued to Robert L. Alcorn *et al.* on January 17, 2006, and was assigned to Blackboard Inc. (hereinafter "patent owner").

2. A request for *ex parte* reexamination of claims 1-44 of the '138 patent was filed on November 17, 2006, by third party requester Richard E. Fontana, and the request was assigned control number 90/008,330 (the '8330 proceeding).

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[1] 37 CFR 1.182 and 1.183 both require the petition fee set forth in 37 CFR 1.17(f). Effective October 2, 2008, the petition fee set forth in 37 CFR 1.17(f) is $400.00.

3. A request for *inter partes* reexamination of claims 1-44 of the '138 patent was filed on December 1, 2006, by third party requester Desire2Learn, Inc., which is also the real party in interest (hereinafter "*inter partes* third party requester"). The request was assigned control number 95/000,199 (the '0199 proceeding).

4. On January 25, 2007, *ex parte* reexamination was ordered based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability affecting claims 1-44 of the '138 patent.

5. On February 26, 2007, *inter partes* reexamination was ordered based on the examiner's determination that the request for *inter partes* reexamination raised a substantial new question of patentability affecting claims 1-44 of the '138 patent.

6. On March 17, 2008, a Decision, *Sua Sponte*, to Merge Reexamination Proceedings was issued, merging the '8330 *ex parte* and '0199 *inter partes* reexamination proceedings into a single proceeding (the merged reexamination proceeding) governed by 37 CFR 1.902 through 1.997.

7. On March 25, 2008, a first Office action rejecting claims 1-44 of the '138 patent was mailed for the merged reexamination proceeding.

8. Patent owner filed a Patent Owner's Response under 37 CFR 1.945 on May 29, 2008.

9. On September 3, 2008, patent owner filed the instant petition entitled "PETITION TO PARTIALLY TERMINATE INTER PARTIES REEXAMINATION UNDER 35 C.F.R. § 1.182(b)," requesting partial termination of the '0199 proceeding.

10. On October 15, 2008, *inter partes* third party requester filed the instant "REQUEST TO SUBMIT RESPONSE TO PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING," concurrently with the instant opposition paper entitled "THIRD-PARTY REQUESTOR'S RESPONSE TO PATENT OWNER'S PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING."

11. The '138 patent is the subject of litigation between patent owner and *inter partes* third party requester styled *Blackboard Inc. v. Desire2Learn Inc.*, No. 9:06CV155 (E.D. Tex. filed July 26, 2006), which is currently on appeal before the U.S. Court of Appeals for the Federal Circuit as appeal No. 2008-1368 (filed May 21, 2008).

DECISION

Patent owner's petition for partial termination of the '0199 proceeding and *inter partes* third party requester's opposition paper have been fully considered. The instant merged reexamination proceeding is governed by the *inter partes* reexamination rules set forth in 37 CFR 1.902 through 1.997.

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 315(c) states:

> 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.

35 U.S.C. § 317(b) states:

> FINAL DECISION.– 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 1.182 states:

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

37 CFR 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be

> imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 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.

37 CFR 1.939(a) states:

> If an unauthorized paper is filed by any party at any time during the inter partes reexamination proceeding it will not be considered and may be returned.

II. DISCUSSION

A. Background

The '138 patent is the subject of litigation between patent owner and *inter partes* third party requester styled *Blackboard Inc. v. Desire2Learn Inc.*, No. 9:06CV155 (E.D. Tex. filed July 26, 2006). The case was tried to a jury. The jury found for plaintiff patent owner and against defendant *inter partes* third party requester on the issues of infringement of claims 36, 37 and 38 of the '138 patent and did not find any of these claims invalid. On March 11, 2008, in accordance with the jury verdict, the U.S. District Court for the Eastern District of Texas (district court) entered judgment for patent owner and against *inter partes* third party requester on *inter partes* third party requester's counterclaims of invalidity of claims 36, 37 and 38 of the '138 patent. On May 5, 2008, the district court issued an order, denying *inter partes* third party requester's renewed motion for judgment as a matter of law with respect to its counterclaims of invalidity of claims 36, 37 and 38 of the '138 patent. On May 7, 2008, the district court entered a final judgment in accordance with the rulings set out in its May 5, 2008 order. On May 12, 2008, *inter partes* third party requester gave notice of its appeal to the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) from the May 7, 2008 final judgment.

In its September 3, 2008 petition, patent owner asserts that the '0199 proceeding should be terminated with respect to claims 36, 37 and 38 of the '138 patent because the district court entered a final judgment against *inter partes* third party requester's counterclaim that claims 36, 37 and 38 of the '138 patent are invalid. Pet. at 1. Patent owner's position is that 35 U.S.C. § 317(b) does not permit an *inter partes* reexamination of claims as to which final judgment has been entered against the requester by a district court; therefore, patent owner asserts that if the district court's May 7, 2008 final judgment constitutes a "final decision" under 35 U.S.C. § 317(b), no *inter partes* reexamination of claims 36, 37 and 38 requested by *inter partes* third party requester can be maintained. Pet. at 7.

B. The Reciprocal Estoppel Provisions Apply After a "Final Decision," Which Does Not Occur Until After All Appeals are Over

After a "final decision", issues that were raised or could have been raised in a civil action or a prior *inter partes* reexamination cannot be raised in another *inter partes* reexamination as to the same claims nor maintained in an *inter partes* reexamination requested on the basis of such issues. 35 U.S.C. § 317(b). Similarly, after a "final decision" of an ordered *inter partes* reexamination finding a claim valid, issues raised (or that could have been raised) regarding that claim's validity cannot be raised in a civil action. 35 U.S.C. § 315(c).

Patent owner asserts, "[t]he the settled meaning of the term 'final decision' refers to a final appealable decision of a subordinate tribunal, such as a district court judgment." Pet. at 5. In its October 15, 2008 opposition paper, *inter partes* third party requester asserts that "final decision" in 35 U.S.C. § 317(b) "must be interpreted as occurring ***after*** all appeals to the Federal Circuit have occurred." Opp. at 3-4.

Since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as occurring after all appeals are over. That is, after a Federal Circuit decision (or after the time to appeal expires, *e.g.*, after the time to file a petition for certiorari expires following a Federal Circuit decision), and not simply after a district court (or Board of Patent Appeals and Interferences) decision as patent owner argues. *See* MPEP § 2686. The Office's interpretation is based on several factors including the plain language of the statute, the symmetry between the two estoppel provisions, the legislative history, and the policy underlying the whole statutory scheme.

Section 317(b) of Title 35, in pertinent part, 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 the parties 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, . . .

35 U.S.C. § 317(b) (emphasis added). Thus, estoppel does not take effect until a "final decision ... in a civil action" has been entered or alternatively, a "final decision" in an earlier *inter partes* reexamination has occurred. The Office interprets the term "final decision" for either proceeding[2] as "after all appeals." *See* MPEP § 2686. The Office's interpretation is correct for a number of reasons.

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[2] The estoppel provisions are applied reciprocally for *inter partes* reexamination and civil proceedings.

It is well settled that "in determining the meaning of [a] statute, we look not only to the particular statutory language, but to the design of the statute as a whole and to its object and policy." *Crandon v. United States*, 494 U.S. 152, 158 (1990). Further, when interpreting terms in a statute, we "must find that interpretation which can most fairly be said to be imbedded in the statute, in the sense of being most harmonious with its scheme and with the general purposes that Congress manifested." *NLRB v. Lion Oil Co.*, 352 U.S. 282, 297 (1957).

1. "Final decisions" typically only bind the Office after all appeals are exhausted

"Final decisions" typically only bind the Office after all appeals are exhausted. In other words, the Office's interpretation of "final decision" as "after all appeals" is consistent with existing law that holds that all other Office proceedings, whether *inter partes* or *ex parte*, do not terminate until the mandate is issued by the appellate tribunal (if an appeal is filed). For example, a patent application proceeding will not terminate within the Office until the Federal Circuit issues its mandate or the time for appeal has expired. *See* 37 CFR 1.197(b)(2). *See also In re Jones*, 542 F.2d 65 (CCPA 1976) ("that petitioners did not know that receipt of mandate [by PTO] . . . terminated [the] proceedings in case was an inadequate excuse for delay in filing continuation application before mandate issued"). Similarly, an *inter partes* interference proceeding within the Office will not terminate until the Federal Circuit mandate is issued or the time to file an appeal has expired. 37 CFR 41.205(a).

In response to this argument, as set forth by the Office in its August 23, 2005 "DECISION DENYING PETITIONS," issued in reexamination proceeding control numbers 95/000,093 and 95/000,094 (*In re Tremblay*), patent owner contends that Congress used the term "final decision" in 35 U.S.C. § 317(b) which has plain meaning and "[t]he Office is not free to alter that meaning to make it consistent with other policies - certainly not policies that are themselves established by the Office and not Congress." Pet. at 12. Patent owner also contends that 37 CFR 1.197(b)(2) does not contain the term "final decision," but 37 CFR 1.197(b)(1) provides that "[p]roceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action;" therefore, Congress could have included similar language in 35 U.S.C. § 317(b) but chose not to do so. Pet. at 12. Patent owner further contends that under 37 CFR 41.205(a), "a final decision is one that is subject to appeal, rather than the result of the appeal."

While the term "final decision" may, in some instances, refer to a decision that is subject to appeal, in 35 U.S.C. § 317(b) Congress did not use the term "final decision" alone. Rather, Congress used the terms "final decision ... in a civil action" and "final decision in an *inter partes* reexamination proceeding." Thus, it is reasonable to interpret 35 U.S.C. § 317(b) as requiring the *inter partes* reexamination of a claim (requested by a party) be terminated once a final decision upholding the validity of that claim (challenged by the same party) has issued "after any appeals" in the civil action, not simply just after a district court decision which is still pending on appeal. As noted by *inter partes* third party requester, the Office's interpretation of 35 U.S.C. § 317(b) is consistent with how the Office is bound by a prior *inter partes* reexamination or *ex parte* reexamination only after all appeals have been heard pursuant to 37 CFR 1.197(b)(2), and how the Office is bound by a prior interference proceeding only after all appeals have been heard pursuant to 37 CFR 41.205(a). Opp. at 4.

Moreover, the Office's interpretation of 35 U.S.C. § 317(b) was at least implicitly supported by the language of the district court in its opinion in *Sony v. Dudas*, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. 2006). In *Sony*, the district court explained that the "AIPA's reciprocal estoppel provisions make clear that parties challenging patent validity determinations are free to pursue *inter partes* review from the PTO and litigation simultaneously; however, the completion of either process will estop any parallel proceedings. *See* 35 U.S.C. 317(b); 35 U.S.C. 315(c)." *Id.* at *19 (emphasis added). Thus, in interpreting the AIPA's reciprocal estoppel provisions, the district court noted that completion of the litigation process, not merely a final district court decision, would estop any parallel proceedings. [3]

2. Plain language of statute reflects intent to provide estoppel effect in reciprocal fashion

The plain language of the statute reflects Congress' intent to provide estoppel effect in a reciprocal fashion between court and *inter partes* reexamination proceedings. For example, an *inter partes* reexamination will bar a civil action validity challenge on the same claims only after any appeals. *See* 35 U.S.C. § 315(c) (barring invalidity from being raised in a civil action if previously "finally" held valid in a *inter partes* reexamination); *see also* 35 U.S.C. § 316(a) (mandating that an *inter partes* reexamination certificate cannot be issued until the time for appeal has expired or any appeal proceeding has terminated). Similarly, a "final decision" in an *inter partes* reexamination proceeding will bar a subsequent *inter partes* reexamination on the same claims, and a "final decision . . . in a civil action" will bar a subsequent reexamination on the same claims. 35 U.S.C. § 317(b). Looking at the plain language of the statute, it is easy to see that the term "final decision" is symmetrically applied to both civil actions in court and *inter partes* reexamination proceedings within the Office throughout §§ 317(b) and 315(c). Further, there is no reason from the reading of the statute that the same term used twice in the same provision, *i.e.*, "final decision," should have two different meanings. Since an *inter partes* reexamination proceeding does not become a "final decision" holding claims valid until "after all appeals," a similar interpretation should be reciprocally applied to a civil action in court. Thus, just like a Board of Patent Appeals and Interferences decision pending appeal is not a final decision and does not estop a civil action, a district court decision on appeal to the Federal Circuit does not estop an *inter partes* reexamination proceeding from continuing within the Office.

In response to this argument, as set forth by the Office in its August 23, 2005 *In re Tremblay* decision, patent owner contends the Office's position is "precisely wrong." Pet. at 13. Patent owner states that "[u]nder Section 315(b), a 'final decision' favorable to patentability is appealable. First, there is a final decision. Then, it is appealed. The Office's position with respect to Section 317(b) is inconsistent with the statutory scheme. There is no 'plain language' in either statute that supports the Office's position." Pet. at 13.

Patent owner's arguments are not persuasive. Interpreting "final decision" in 35 U.S.C. § 317(b) as occurring after all appeals to the Federal Circuit (or after the time for all appeals has expired) is consistent with the plain language of the statute because, as discussed previously, 35 U.S.C. §

[3] It is evident the district court deemed the "litigation process" as more than just proceedings at the district court and as encompassing any appeals. *See Sony* at *19 (explaining that "While the PTO conceded the possibility that the Federal Circuit would reverse the district court and remand for a new trial—thereby potentially effectively starting *the litigation process* anew—it nonetheless implicitly determined that on balance this possibility did not outweigh the good cause favoring suspension.") (emphasis added).

317(b) does not refer to a "final decision" alone but rather to a "final decision ... in a civil action." Thus, just as a decision in an *inter partes* reexamination proceeding does not become a "final decision in an *inter partes* reexamination proceeding" holding claims valid until "after all appeals," a district court decision may not become a "final decision ... in a civil action" holding claims valid until "after all appeals." [4]

3. Legislative history of 35 U.S.C. § 317 confirms "final decision" must be "after all appeals"

The legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> ... if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity, or if a **final decision** in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised ....

145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added). Consistent with the plain language of the statute, the legislative history confirms that a "final decision" is "after any appeals." A simple reading of the legislative history reveals that Congress contemplated that a "final decision" of either a prior *inter partes* reexamination or a civil action has estoppel effect only "after any appeals." As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term "final decision," is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office's interpretation of "final decision" as "after all appeals."

In response to this argument, as set forth by the Office in its August 23, 2005 *In re Tremblay* decision, patent owner notes that "[t]he petitioner in *Tremblay* pointed out that the phrase 'after any appeals' [in the legislative history of Section 317] modifies only the second clause - 'or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability' - but not the first clause, which deals with a civil action," and that "[t]hat is the grammatically correct reading." Pet. at 13-14.

Patent owner's arguments are not persuasive. An *inter partes* reexamination is only binding on a pending civil action under 35 U.S.C. § 315(c) after the reexamination certificate has issued, which occurs after all appeals have been decided pursuant 35 U.S.C. § 316(a); therefore, a reasonable interpretation of 35 U.S.C. § 317(b) is that a civil action is only binding on a pending *inter partes* reexamination after all appeals have been decided. [5] This interpretation is supported by the legislative history of 35 U.S.C. § 317(b), which identifies final decisions in two types of proceedings (a "final decision ... in a civil action" and a "final decision a prior *inter partes* reexamination"), modified by the phrase "after any appeals." It would not be grammatically incorrect to interpret the phrase "after any appeals" as modifying both final decisions, thereby

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[4] *See also* Opp. at 4.
[5] *See also* Opp. at 4.

clarifying that either a "final decision ... in a civil action" or a "final decision in a prior *inter partes* reexamination" has estoppel effect only "after any appeals."

4. Logic supports construing the term "final decision" as "after all appeals"

Logic supports construing the term "final decision" as "after all appeals," as any other construction would not only be inconsistent with the underlying policy of *inter partes* reexamination, it would make the statutory scheme unworkable. For example, if a district court enters a decision holding all claims in a patent not invalid, and later on appeal is reversed (or modified), then the conclusion of an *inter partes* proceeding prior to exhaustion of appeals would have been premature. If the *inter partes* reexamination proceeding is prematurely terminated, there is no way to "un-terminate" or re-start the reexamination proceeding. A completely new request for reexamination would have to be made in a redundant fashion. Clearly, such redundancy is a result Congress did not intend in light of the fact that it provided the PTO Director with the discretion to suspend parallel proceedings for "good cause." 35 U.S.C. § 314(c); 37 CFR 1.987. Accordingly, a "final decision" as articulated in § 317 cannot occur until "after all appeals" in order for the statutory scheme to work properly.

Patent owner argues that this position, as articulated by the Office in its August 23, 2005 *In re Tremblay* decision, reflects policy that the Office is not entitled to set. Pet. at 14. Patent owner argues that "Congress has enacted a system in which final judgments do have effect prior to the completion of appeals - not just with respect to the patent system but throughout the federal courts," and "[t]he Office's position is that even though a final judgment for money has immediate effect, and even though an injunction has immediate effect, and even [though] a final judgment triggers res judicata regardless of any appeal, with respect to reexamination, an appeal to the Federal Circuit effectively operates as a stay of the final judgment." Pet. at 14.

Patent owner's arguments are not persuasive. The Office does not set forth such a position. Rather, the Office's position is that pursuant to 35 U.S.C. § 317(b), "a final decision ... in a civil action" is reasonably interpreted to mean a "final decision after all appeals" in view of the fact that once terminated, there is no mechanism for "un-terminating" an *inter partes* reexamination proceeding. Thus, it would be illogical to terminate an *inter partes* reexamination on the basis of a district court's validity decision that is on appeal before the Federal Circuit because the Federal Circuit might reverse or modify the district court's decision, thereby rendering premature the termination of the *inter partes* reexamination proceeding which cannot be "un-terminated."

C. The term "final decision" is interpreted with different meanings depending on the context within the statute from which it emanates

Patent owner argues that in the AIPA "the term 'final decision' expressly refers to an appealable decision, rather than a decision with respect to which all appeals have been exhausted." Pet. at 5-6. To support this position, patent owner points to 35 U.S.C. § 315(b)(1), providing that "the request '*may appeal* under the provisions of sections 141 and 144, with respect to any *final decision* favorable to' the patentee" and to 35 U.S.C. § 134(c), providing that "a requester '*may appeal* to the Board of Patent Appeals and Interferences from the *final decision* of the primary examiner favorable to' the patentee." Pet. at 6. Patent owner also argues that "[o]ther provisions of the U.S. Code further demonstrate that the term 'final decision' refers to

appealable decisions, specifically including district court judgments." Pet. at 6. To support this position, patent owner points to 28 U.S.C. § 1291, providing that "the Courts of Appeals 'have jurisdiction of appeals from all *final decisions* of the district courts of the United States'" and to 28 U.S.C. § 1295, providing that "in cases arising in whole or in part under the patent statute, the Federal Circuit has 'exclusive jurisdiction of an appeal from a *final decision* of a district court of the United States ....'" Pet. at 6-7.

Additionally, patent owner cites case law that "confirms this meaning," such as *California Indus. Prods. v. United* States, 436 F.3d 1341, 1343 (Fed. Cir. 2006) (providing that "The United States appeals from the final decision of the United States Court of International Trade ...."); *Apotex, Inc. v. Thompson*, 347 F.3d 1335, 1342 (Fed. Cir. 2003) (stating that the Federal Circuit "has exclusive jurisdiction over an appeal from a final decision of a district court" in a patent case); and *PPG Indus. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (stating that "[T]he district court's order is a *final decision* over which we may exercise appellate review") (emphasis added). Pet. at 7.

The meaning of the term "final decision" is interpreted differently based on the context within the particular statute from which it emanates. In the statutes cited by patent owner, the term "final decision" means different things based on the context within those statutes. For example, as noted by *inter partes* third party requester in its opposition paper, 35 U.S.C. § 134(c) "expressly identifies the decision of the primary examiner as being the final decision" in that statute, 28 U.S.C. § 1291 "expressly identifies the district court decision as being the final decision" in that statute, and 28 U.S.C. § 1295(a) "expressly identifies the district court decision as being the final decision" in that statute. Opp. at 6. Similarly, in the cases cited by patent owner, the term "final decision" means different things based on the context within those cases. For example, *California Indus Pros v. U.S.* refers to a "final decision of the United States Court of International Trade" and *Apotex, Inc. v. Thompson* refers to "a final decision of a district court." *See* Opp. at 7. In these examples, modifiers identify the body (e.g., district court, Court of International Trade) with respect to which the decision is final.

A "final decision" can occur at many stages and is interpreted with different meanings depending on the context within the statute from which it emanates, - at the agency level, the district court level and the appellate court level. *See e.g.*, 5 U.S.C. § 704 (final agency decision required prior to judicial review); 28 U.S.C. § 1295(a) (only "final decisions" of district courts are ripe for appeal); and Fed. R. App. P. 41(b) (1998 advisory committee notes explain "a court of appeals judgment or order is not final until issuance of its mandate; at that time the parties obligations become fixed"). Accordingly, the term "final decision" must be read in the context of the particular statute in which it is embodied. 35 U.S.C. § 317(b) expressly identifies a "final decision ... in a civil action" and a "final decision in an *inter partes* reexamination proceeding" as the final decisions for purposes of that statute. In this context, "final decision" in 35 U.S.C. § 317(b) is reasonably interpreted to mean "after all appeals." [6]

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[6] In its opposition paper, third party *inter partes* requester relies on *Timken Co. v. United States*, 893 F.2d 337 (Fed. Cir. 1990) for the general proposition that "Congress can and does in some statutes use the words 'final decision' to mean after all appeals." Opp. at 7. While *Timken* is factually distinguishable from the present matter because it flows from a different statute and refers to a "final decision" from an agency rather than a civil action in a court, it nevertheless shows that Congress is free to use the term "final decision" and define it to mean "after appeals" if Congress so chooses. Accordingly, *Timken* confirms that when interpreting the term "final decision," the specific statutory scheme from which it is embodied must be consulted. *Timken*, 893 F. 2d at 339. *Timken* shows that the

D. Res Judicata

Patent owner contends that "Section 317 imported the common law doctrine of res judicata into inter partes reexamination" and that the "policy underlying the common law doctrine of res judicata" of preventing parties from getting "two bites at the apple" is mirrored in the legislative history of Section 317(b).[7] Pet. at 9-10. Patent owner further contends that "[w]ell-established res judicata principles confirm that the term 'final decision' in Section 317(b) refers to a district court judgment. It is settled that a district court judgment is binding when entered and that res judicata takes effect as soon as a district court enters judgment."[8] Pet. at 11. Thus, patent owner argues that "regardless of [*inter partes* third party requester's] pending appeal to the Federal Circuit, the district court's judgment is a binding final decision now and bars the Office from maintaining the *inter partes* reexamination of claims 36, 37, and 38." Pet. at 11.

Patent owner's arguments are not persuasive. Common law res judicata doctrine need not be considered in view of the statutory estoppel provisions of 35 U.S.C. 317(b). 35 U.S.C. 317(b) is a statutory estoppel scheme enacted by Congress and its terms are clear on its face. Pursuant to these provisions, a "final decision ... in a civil action" or a "final decision in an *inter partes* reexamination" create an estoppel. As already set forth in this decision, the Office interprets that a "final decision ... in a civil action" or a "final decision in an *inter partes* reexamination" occurs "after all appeals." This interpretation comports with the policy of limiting the parties to "one bite at the apple" because once a final decision (in a civil action or in an *inter partes* reexamination) after all appeals occurs, issues that were raised or could have been raised in the civil action or the *inter partes* reexamination cannot be raised in another *inter partes* reexamination as to the same claims nor maintained in an *inter partes* reexamination requested on the basis of such issues.

E. Summary

For all of the reasons set forth above, pursuant to 35 U.S.C. § 317(b), estoppel does not take effect until a final decision after all appeals is entered in a civil action or until a final decision after all appeals occurs in an *inter partes* reexamination. Accordingly, in view of *inter partes* third party requester's pending appeal before the Federal Circuit from the district court's judgment against its counterclaim that claims 36, 37 and 38 of the '138 patent are invalid, patent owner's September 3, 2008 petition, requesting termination of the '0199 proceeding with respect to claims 36, 37 and 38 of the '138 patent, is **dismissed**.[9]

Federal Circuit has interpreted the language "final decision . . . in an action" as "after all appeals" in the past, and supports the proposition that the Office is reasonable in interpreting similar language in a similar manner in this instance (*i.e.*, "final decision . . . in a civil action"). Finally, applying a similar analysis as in *Timken*, the Office's construction of the term "final decision . . . in a civil action" with respect to 35 U.S.C. § 317 is consistent with language in its respective legislative history (i.e., "after any appeals").

[7] Citing S. Rep. No. 105-42 at 42 (1997) ("To prevent abuse, parties are prohibited from filing the same claim more than once. Whether it be in a reexamination or a civil action [in] Federal Court, they are limited to one bite at the apple.")

[8] Citing *Pharmacia & Upjohn Co. v. Mylan Pharma.*, 170 F.3d 1373, 1381 (Fed. Cir. 1999) ("the Federal Circuit observed that every federal court to have addressed this issue has concluded that 'a final judgment retains all of its res judicata consequences pending decision of the appeal.'")

[9] *See* Appeal No. 2008-1368 (filed May 21, 2008).

III. ADDITIONAL DISCUSSION

A. Conduct of Merged Proceeding

It is noted that patent owner's petition paper and *inter partes* third party requester's request to submit opposition paper and concurrently filed opposition paper do not comply with the requirements set forth in the March 17, 2008 "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS" (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) must 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 **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.

In this instance, patent owner's September 3, 2008 petition paper was not filed in accordance with the March 17, 2008 merger decision because patent owner's petition paper (1) was not filed in duplicate (the petition paper was only filed in the '0199 proceeding) and (2) does not contain identifying data for both files (the petition paper only contain identifying data for the '0199 proceeding).

Inter partes third party requester's October 15, 2008 request to submit opposition paper and concurrently filed opposition paper were also not filed in accordance with the March 17, 2008 merger decision because the request and concurrently filed opposition paper (1) were not filed in duplicate (the request and opposition paper were only filed in the '0199 proceeding), (2) do not contain identifying data for both files (the request and opposition paper only contain identifying data for the '0199 proceeding), and (3) do not reflect that the request and opposition paper were served on all of the other parties (the certificate of service accompanying the request and opposition paper reflects only that the patent owner was served, but not the *ex parte* third party requester).

Any papers filed by the parties subsequent to this decision will not be entered if the papers are not filed in accordance with the March 17, 2008 merger decision.

B. The '0199 and '8330 Proceedings Remain Merged

Patent owner asserts that the granting of its petition for partial termination would necessitate the Office's reversal of its March 17, 2008 decision to merge the '0199 and '8330 proceedings. Pet. at 2. On the other hand, *inter partes* third party requester asserts that should the Office partially terminate the *inter partes* reexamination, there is no reason for the Office to reconsider its decision to merge the '0199 and '8330 proceeding. Opp. at 8.

In view of the instant decision not to partially terminate the '0199 proceeding with respect to claims 36, 37 and 38 of the '168 patent, the '0199 and the '8330 proceedings will continue to be treated as a merged proceeding, as set forth in the March 17, 2008 merger decision.

CONCLUSION

1. Patent owner's petition for partial termination of the '0199 proceeding, filed on September 3, 2008, is dismissed.

2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit for appropriate action.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,330	11/17/2006	6988138		3192

20277 7590 04/08/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/08/2009

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,199	12/01/2006	6988138		7245

20277 7590 04/08/2009

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

EXAMINER	
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FOLEY AND LARDNER LLP
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SUITE 500
WASHINGTON, DC 20007

Date:

MAILED

APR 0 8 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000199
PATENT NO. : 6988138
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SOFTWARE FREEDOM LAW CENTER
1995 BROADWAY
17TH FLOOR
NEW YORK, NY 10023-5882

Date: MAILED

APR 0 8 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008330
PATENT NO. : 6988138
ART UNIT : 3900

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

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

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United States Patent and Trademark Office
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Washington, DC 20005-3096

(For Patent Owner)

MAILED

APR 0 8 2009

CENTRAL REEXAMINATION UNIT

Software Freedom Law Center
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New York, NY 10023-5882

(For *Ex Parte* Requester)

Foley & Lardner LLP
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Washington, DC 20007

(For *Inter Partes* Requester)

Ex Parte Reexamination Proceeding
Control No. 90/008,330
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138 B1

Inter Partes Reexamination Proceeding
Control No. 95/000,199
Filed: December 1, 2006
For: U.S. Patent No. 6,988,138 B1

DECISION
ON
PETITION

This is a decision addressing the *Inter Partes* third party requester's "PETITION UNDER 37 C.F.R. § 1.183," to Waive the Page Limit Requirements of 37 C.F.R. § 1.943(b) submitted on January 22, 2009.

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

SUMMARY

The petition to waive the page limit requirement of 37 CFR 1.943(b) is **dismissed**.

The proceeding is **remanded** to the Central Reexamination Unit, for consideration set forth in this decision.

BACKGROUND FOR PETITION

1. On January 17, 2006, U.S. Patent No. 6,988,138 issued to Alcorn *et al.* (the '138 patent) and was assigned to Blackboard Inc. (hereinafter "patent owner").

2. On November 17, 2006, a request for *ex parte* reexamination was filed by third party requester Richard E. Fontana, which was assigned reexamination control number 90/008,330 (the '8330 proceeding).

3. On December 1, 2006, a request for *inter partes* reexamination was filed by third party requester Desire2Learn, Inc. (hereinafter "*inter partes* requester"), which was assigned reexamination control number 95/000,199 (the '199 proceeding).

4. On January 25, 2007 the Office ordered reexamination in the '8330 proceeding.

5. On February 26, 2007, the Office ordered reexamination in the '199 proceeding.

6. On February 16, 2006, the Office issued a decision *sua sponte* merging the '8330 and '199 reexamination proceedings into a single merged proceeding (the merged proceeding).

7. On March 25, 2008, the Office mailed a first Office action on the merits in the merged proceeding.

8. On May 29, 2008, patent owner filed a response to the first Office action on the merits.

9. On June 26, 2008, inter *partes* requester filed comments to patent owner's response.

10. On December 9, 2008, the Office issued a Notice of Defective Paper finding patent owner's May 29, 2008 improper in accordance with 37 CFR 1.943(b) and setting aside *inter partes* requester's June 26, 2008 comments as they were responding to an improper paper. The examiner advised *inter partes* requester to insure that any resubmitted comments be compliant with 37 CFR 1.943(b). Patent owner was given 15 days to submit a proper response.

11. On December 29, 2008, patent filed a revised response to the first Office action on the merits.

12. On January 22, 2009, *inter partes* requester filed revised comments to patent owner's response.

13. Concurrent with the January 22, 2009 revised comments the *inter partes* requester filed the present petition requesting waiver of the page limit Requirements of 37 CFR 1.943(b).

14. On February 2, 2009, petitioner/patent owner filed a response on the *inter partes* requester's January 22, 2009 petition concurrent with a petition under 37 CFR 1.183 to permit Office consideration of the response. This filing is being addressed in a separate decision.

RELEVANT RULES AND GUIDANCE

37 CFR 1.183 provides:

> In an extraordinary situation, when justice re-quires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the

Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in§ 1.17(f).

37 CFR 1.943(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.

MPEP 2667(I)(A)(2) states in part:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, ***of the patent under reexamination, is considered to be part of the comments*** *submitted by the patent owner,* ***or by the third party requester****, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same.* However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. *Likewise, if a* ***third party requester*** *affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count.* Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

DECISION

Petitioner is seeking relief in the form of waiving the page limit requirements of 37 CFR 1.943(b). Currently, no official notice of non-compliance from the Office is of record. **Facially, the third party comments submission appears compliant,** [1] and the Office has not issued a Notice of Defective Paper finding that the January 22, 2009 revised comments paper is too long. As the need for the grant of waiver relief requested is premature at this time, a decision granting such relief is **dismissed.** The petition to waive 37 CFR 1.943(b) is subject to renewal once a determination is made that such relief is necessary.

The proceeding is **remanded** to the Central Reexamination Unit to review the propriety of the *inter partes* requester's revised January 22, 2009 comments paper, including the length thereof.

---

[1] The remarks section is only 29 pages long, which is in compliance with the rule. The affidavit has never been evaluated in accordance with MPEP 2667(I)(A)(2).

The above noted guidance from the MPEP should be followed, and the computation of the January 22, 2009 *inter partes* requester's revised comments paper length should be articulated on the record for communication to all parties.

If the *inter partes* requester's revised comments submission is found to comply with 37 CFR 1.943(b), then the issue is moot and reexamination can continue in accordance with special dispatch.

If the *inter partes* requester's revised comments submission is not found to comply with 37 CFR 1.943(b), as set forth in an appropriate examiner's notice/action, then the *inter partes* requester may submit a paper renewing the January 22, 2009 petition requesting waiver of the page limit requirements of 37 CFR 1.943(b). Any paper submitted by the *inter partes* requester renewing the January 22, 2009 petition must be clearly captioned as a "renewed petition" in order to facilitate the special dispatch of a decision on the merits regarding any such renewed petition for waiver of 37 CFR 1.943(b).

CONCLUSION

1. The petition to waive the page limit requirement of 37 CFR 1.943(b) is **dismissed**.

2. The proceeding is **remanded** to the Central Reexamination Unit (CRU) for a determination as to whether or not the *inter partes* requester's revised comments to patent owner's response filed on January 22, 2009 comply with 37 CFR 1.943(b) in light of MPEP 2667(I)(A)(2).

3. The *inter partes* requester's January 22, 2009 petition requesting waiver of the page limit requirement is subject to renewal by the *inter partes* requester, if the Office determines the revised comments do not comply with 37 CFR 1.943(b).

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

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

4/7/09
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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.
90/008,330	11/17/2006	6988138		3192

20277 7590 04/08/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/08/2009

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

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,199	12/01/2006	6988138		7245

20277 7590 04/08/2009

MCDERMOTT WILL & EMERY LLP
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WASHINGTON, DC 20005-3096

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/08/2009

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Commissioner for Patents
United States Patent and Trademark Office
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McDermott, Will & Emery LLP (For Patent Owner)
60013th Street, N.W.
Washington, DC 20005-3096

Software Freedom Law Center (For *Ex Parte* Requester)
1995 Broadway, 17th Floor
New York, NY 10023-5882

MAILED
APR 0 8 2009
CENTRAL REEXAMINATION UNIT

Foley & Lardner LLP (For *Inter Partes* Requester)
3000 K Street, N.W. Suite 500
Washington, DC 20007

Ex Parte Reexamination Proceeding :
Control No. 90/008,330 :
Filed: November 17, 2006 :
For: U.S. Patent No. 6,988,138 B1 :
: DECISION
Inter Partes Reexamination Proceeding : ON
Control No. 95/000,199 : PETITION
Filed: December 1, 2006 :
For: U.S. Patent No. 6,988,138 B1 :
:

This is a decision addressing patent owner's papers, filed on February 2, 2009, entitled "REQUEST FOR LEAVE TO SUBMIT A RESPONSE TO DESIRE2LEARN'S PETITION," and "RESPONSE TO PETITION UNDER 37 C.F.R. § 1.183."

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

SUMMARY

The petition requesting leave to respond to *inter partes* requester's petition is **dismissed**.

The petition requesting leave to respond and response to the 37 CFR 1.183 petition are **expunged.**

BACKGROUND FOR PETITION

1. On January 17, 2006, U.S. Patent No. 6,988,138 issued to Alcorn *et al.* (the '138 patent) and was assigned to Blackboard Inc. (Hereinafter "patent owner").

2. On November 17, 2006, a request for *ex parte* reexamination was filed by third party requester Richard E. Fontana, which was assigned reexamination control number 90/008,330 (the '8330 proceeding).

3. On December 1, 2006, a request for *inter partes* reexamination was filed by third party requester Desire2Learn, Inc. (hereinafter "*inter partes* requester"), which was assigned reexamination control number 95/000,199 (the '199 proceeding).

4. On January 25, 2007 the Office ordered reexamination in the '8330 proceeding.

5. On February 26, 2007, the Office ordered reexamination in the '199 proceeding.

6. On February 16, 2006, the Office issued a decision *sua sponte* merging the '8330 and '199 reexamination proceedings into a single merged proceeding (the merged proceeding).

7. On March 25, 2008, the Office mailed a first Office action on the merits in the merged proceeding.

8. On May 29, 2008, patent owner filed a response to the first Office action on the merits.

9. On June 26, 2008, inter *partes* requester filed comments to patent owner's response.

10. On December 9, 2008, the Office issued a Notice of Defective Paper finding patent owner's May 29, 2008 improper in accordance with 37 CFR 1.943(b) and setting aside *inter partes* requester's June 26, 2008 comments as they were responding to an improper paper. The examiner advised *inter partes* requester to insure that any resubmitted comments be compliant with 37 CFR 1.943(b). Patent owner was given 15 days to submit a proper response.

11. On December 29, 2008, patent filed a revised response to the first Office action on the merits.

12. On January 22, 2009, *inter partes* requester filed revised comments to patent owner's response.

13. Concurrent with the January 22, 2009 revised comments the *inter partes* requester filed a petition requesting waiver of the page limit Requirements of 37 C.F.R. § 1.943(b). This filing is being addressed in a separate decision.

14. On February 2, 2009, petitioner/patent owner filed a response to the *inter partes* requester's January 22, 2009 petition concurrent with the presently addressed petition under 37 CFR 1.183 to permit Office consideration of the response.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Patent owner only authorized payment of $130.oo by credit card upon filing of the petition. Therefore, $270.00 has been charged to patent owner's Deposit Account No. 50-2624, as authorized in concluding paragraph of the present petition.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states:

> 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.

37 CFR 1.939(a) states:

> If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

37 CFR 1.945 states:

> (a) The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.
>
> (b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:
>
> (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
>
> (2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
>
> (3) A compelling reason to enter the supplemental response.

37 CFR 1.183 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

For the reasons set forth below, the February 2, 2009 patent owner response to requester's January 22, 2009 petition and petition to enter such response, do not have a right of entry in the merged proceeding.

A. Patent Owner's response to an *inter partes* requester's petition is not permitted for procedural/formal matters in an *inter partes* reexamination

Pursuant to 35 U.S.C. § 314(b)(2), patent owner, in an ordered *inter partes* reexamination proceeding, has a statutory right to file a response to an Office action on the merits. This right is implemented by 37 CFR 1.945, which provides that a patent owner may file written

comments within 30 days from date of an Office action on the merits. Patent owner may supplement their written comments if the patent owner persuasively states: (1) how the supplemental comments satisfy the requirements of 37 CFR 1.111(a)(2)(i); (2) why the supplemental response was not presented together with the original response to the Office action; and (3) a compelling reason to enter the supplemental response.

Inter partes requester's petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b) for an increase of page limit, however, is **not** an Office action on the merits. [1] 35 U.S.C. § 314(b)(2) does not provide any right for the patent owner to file a response to an *inter partes* requester's petition under 37 CFR 1.183 for suspension of the rules governing response page limits.

Patent owner's response to *inter partes* requester's petition to waive the page limit set out in 37 CFR 1.943(b) is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Patent owner's February 2, 2009 response to the *inter partes* requester's petition under 37 CFR 1.183, therefore, is not enterable into the record.

Pursuant to 37 CFR 1.939(a), "[i]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the patent owner's February 2, 2009 response to the *inter partes* requester's January 22, 2009 petition under 37 CFR 1.183 does not have a right of entry into the record of the present proceeding and, as such, is not an authorized paper. Because the patent owner's February 2, 2009 paper was scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the merged proceeding. [2]

B. The Office Lacks Statutory Authority to Consider the Substance of the Petition

Patent owner, notes that the Code of Federal Regulations does not provide for a patent owner response to an *inter partes* requester's petition to waive the page limit under 37 CFR 1.943(b), and, thus, has filed a petition on February 2, 2009 under 37 CFR 1.183 to waive any rules precluding such response. However, the rules cannot be waived to provide patent owner the right to file the requested paper (response to petition).

Pursuant to 35 U.S.C. § 314(b)(2), the patent owner in an ordered *inter partes* reexamination proceeding has a statutory right to file a response to an Office action on the merits.

Whether *inter partes* requester's petition under 37 CFR 1.183 for suspension of the rules is grantable is an issue that goes to procedure and a showing of equities, rather than to the merits of the proceeding. While enactment of the *inter partes* reexamination statute was for the purpose of expanding reexamination participation as to the merits of the proceeding,

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[1] Pursuant to 37 CFR 1.937, an *inter partes* reexamination proceeding is to be conducted in accordance with 37 CFR 1.104 - 1.116. The term "response" is used in reexamination proceedings to avoid confusion with the word "reply," a term used in the context of *ex parte* reexamination proceedings in connection with the right of a third party requester to file a "reply" under 37 CFR 1.535 to a patent owner's statement. Thus, MPEP § 2666, entitled "Patent Owner Response to an Office Action," discusses the requirements for a patent owner's "response" to an Office action on the merits in terms of 37 CFR 1.111, a regulation which governs the filing of "reply" to an Office action.

[2] *See* MPEP 2267.

there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the patent owner was granted any right to challenge the granting of a petition under 1.183 for suspension of the rules in an *inter partes* reexamination proceeding, where the Office's decision whether or not to exercise discretion is made based on the equities of the situation. Such a right was not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such a right was ever contemplated by Congress.

37 CFR 1.183 permits waiver of the regulations in an extraordinary situation when justice requires. Patent owner's February 2, 2009 petition, however, seeks to add to the statutory provision that a patent owner response is permitted only in response to an Office action on the merits, as set forth in 35 U.S.C. § 314(b)(2). Accordingly, the Office is without statutory authority to consider the substance of patent owner's February 2, 2009 petition. In this respect, patent owner's standing is no different from that of any member of the public who wishes to challenge a procedural action taken by the Office in a proceeding. The patent statute does not provide for such intervention.

Patent owner's petition includes comments, extraneous to the merits of the proceeding, relating to the propriety of *inter partes* requester's petition for waiver of 37 CFR 1.943(b). For this reason, the petition paper filed by patent owner will be excluded from the record of the proceeding. Because patent owner's non-statutory February 2, 2009 petition has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the merged proceeding. [3]

CONCLUSION

1. Patent owner's February 2, 2009 response to the requester's January 22, 2009 petition under 37 CFR 1.183 is refused entry as an improper paper.

2. Because the February 2, 2009 response paper was previously incorporated into the IFW, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the merged proceeding. No copy of the February 2, 2009 paper will be maintained of record in the Office.

3. Patent owner's February 2, 2009 petition, filed in response to the requester's January 22, 2009 petition under 37 CFR 1.183, is dismissed.

4. The patent owner petition paper filed on February 2, 2009 is expunged from the record for including material 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 merged proceeding and marking the paper "closed" and "not public.

5. A copy of this decision will be made of record in the IFW record of the merged proceeding.

---

[3] *See* MPEP 2267.

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

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

4-7-09
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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.
90/008,330	11/17/2006	6988138		3192

20277 7590 10/09/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2009

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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
SOFTWARE FREEDOM LAW CENTER
1995 BROADWAY
17TH FLOOR
NEW YORK, NY 10023-5882

Date:
MAILED
OCT 09 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008330
PATENT NO. : 6988138
ART UNIT : 3900

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

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

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UNITED STATES 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.
95/000,199	12/01/2006	6988138		7245

20277 7590 10/09/2009

MCDERMOTT WILL & EMERY LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2009

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Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FOLEY AND LARDNER LLP
3000 K STREET NW
SUITE 500
WASHINGTON, DC 20007

Date:

MAILED

OCT 0 9 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000199
PATENT NO. : 6988138
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

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Foley & Lardner LLP (For *Inter Partes* Requester)
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Washington, DC 20007

Ex Parte Reexamination Proceeding
Control No. 90/008,330
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138 B1

Inter Partes Reexamination Proceeding
Control No. 95/000,199
Filed: December 1, 2006
For: U.S. Patent No. 6,988,138 B1

DECISION
DISMISSED
PETITION

This is a decision addressing the patent owner "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183," to Waive the Page Limit Requirements of 37 C.F.R. § 1.943(b) submitted on January 22, 2009.

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

SUMMARY

The petition to waive the page limit requirement of 37 CFR 1.943(b) is **dismissed as moot**.

FEE

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 was charged to Deposit account No. 50-2624 in accordance with petitioner's April 21, 2009 authorization on page 5 of the petition.

BACKGROUND FOR PETITION

1. On January 17, 2006, U.S. Patent No. 6,988,138 issued to Alcorn *et al.* (the '138 patent) and was assigned to Blackboard Inc. (hereinafter "patent owner").

2. On November 17, 2006, a request for *ex parte* reexamination was filed by third party requester Richard E. Fontana, which was assigned reexamination control number 90/008,330 (the '8330 proceeding).

3. On December 1, 2006, a request for *inter partes* reexamination was filed by third party requester Desire2Learn, Inc. (hereinafter "*inter partes* requester"), which was assigned reexamination control number 95/000,199 (the '199 proceeding).

4. On January 25, 2007, the Office ordered reexamination in the '8330 proceeding.

5. On February 26, 2007, the Office ordered reexamination in the '199 proceeding.

6. On February 16, 2006, the Office issued a decision *sua sponte* merging the '8330 and '199 reexamination proceedings into a single merged proceeding (the merged proceeding).

7. On March 25, 2008, the Office mailed a first Office action on the merits in the merged proceeding.

8. On May 29, 2008, patent owner filed a response to the first Office action on the merits.

9. On June 26, 2008, *inter partes* requester filed comments to patent owner's response.

10. On December 9, 2008, the Office issued a Notice of Defective Paper finding patent owner's May 29, 2008 response improper in accordance with 37 CFR 1.943(b), and setting aside *inter partes* requester's June 26, 2008 comments as they were responding to an improper paper. The examiner advised *inter partes* requester to ensure that any resubmitted comments be compliant with 37 CFR 1.943(b). Patent owner was given 15 days to submit a proper response.

11. On December 29, 2008, patent owner filed a revised response to the first Office action on the merits.

12. On January 22, 2009, *inter partes* requester filed revised comments to patent owner's response.

13. Concurrent with the January 22, 2009 revised comments, the *inter partes* requester filed a petition requesting waiver of the page limit Requirements of 37 CFR 1.943(b).

14. On April 8, 2009, the Office issued a decision dismissing the January 22, 2009 petition, as the *inter partes* requester's January 22, 2009 response was facially compliant with 37 CFR 1.943(b).

15. On April 15, 2009, the Office issued an Action Closing Prosecution (ACP), sixty-four (64) in total length.

16. On April 21, 2009, patent owner submitted the present petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) to the extent of permitting fifty (50) additional pages, or 100 pages in total.

17. On June 15, 2009, patent owner submitted a response to the April 21, 2009 ACP.[1] The submission included, *inter alia*, a forty-seven page patent owner comments document and a three page declaration.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(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.

I. PATENT OWNER'S PETITION OF APRIL 21, 2009

In the instant petition, patent owner requests suspension of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, to increase the page limit for patent owner's response to the April 15, 2009 ACP to 100 pages.[2] In support of waiver of the rule, patent owner asserts that the April 15, 2009 ACP is 64 pages long, includes 18 separate grounds of rejection using 16 different prior art references, and is alleged to incorporate by reference "hundreds" pages of the Request for Reexamination.[3]

II. PATENT OWNER'S JUNE 15, 2009 SUBMISSION

On June 15, 2009, patent owner timely submitted comments in response to the April 15, 2009 ACP. The patent owner comments document was forty-seven pages in total length, consisting of a cover sheet, a signature page, a five page listing of the claims and forty pages of substantive comments. In addition to the comments, patent owner submitted a three page declaration,

---

[1] The response is timely as patent owner was granted a one month extension of time.

[2] Petition at page 4 (patent owner noting that a 100 page limit is reasonable in light of the facts and circumstances of the present proceeding, but without the provision of the specific facts and circumstances to justify the doubling of the page limit.).

[3] Petition at page 2.

consisting of a two page declaration and a certificate of service page for the declaration. The submission facially complies with the requirements of 37 CFR 1.943(b).

Accordingly, the petition is **dismissed as moot**.

CONCLUSION

1. The petition to waive the page limit requirement of 37 CFR 1.943(b) is **dismissed as moot**.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit.

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

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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OCT 2 8 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SOFTWARE FREEDOM LAW CENTER
1995 BROADWAY
17TH FLOOR
NEW YORK, NY 10023-5882

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008330
PATENT NO. : 6988138
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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Alexandria, VA 22313-1450
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Date: OCT 2 8 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FOLEY AND LARDNER LLP
3000 K STREET NW
SUITE 500
WASHINGTON, DC 20007

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000199
PATENT NO. : 6988138
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,330	11/17/2006	6988138		3192

20277 7590 10/28/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2009

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
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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.
95/000,199	12/01/2006	6988138		7245

20277 7590 10/28/2009

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

EXAMINER	
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DATE MAILED: 10/28/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Wayne M. Kennard
Hale and Dorr LLP
60 State Street
Boston MA 02109

(For Patent Owner)

MAILED

OCT 28 2009

CENTRAL REEXAMINATION UNIT

Richard E. Fontana
Software Freedom Law Center
1995 Broadway, 17th Floor
New York, N.Y. 10023-5882

(For *Ex Parte* Third Party Requester)

George C. Beck
Foley & Lardner LLP
3000 K. Street, N.W., Suite 500
Washington, D.C. 2007-5109

(For *Inter Partes* Third Party Requester)

In re Alcorn *et al.*
Ex parte Reexamination Proceeding
Control No. 90/008,330
Filed: November 17, 2006
For: U.S. Patent No. 6,988,138

In re Alcorn *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,199
Filed: December 1, 2006
For: U.S. Patent No. 6,988,138

DECISION GRANTING PETITION

This is a decision on the patent owner's "PETITION TO WAIVE 37 C.F.R. § 1.955 PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183" filed on October 13, 2009, requesting that the provisions of 37 C.F.R. 1.955 be waived to permit a personal interview with the Examiner in order to demonstrate the contents of a CD, the entry of which has been permitted.

The merged 90/008,330 and 95/000,199 proceeding, and the petition, are before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was received.

The petition is granted to waive 37 CFR 1.955 to the extent set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,988,138 ("the '138 patent") issued on Jan. 17, 2006 with 44 claims.

2. On Nov. 17, 2006, a third party requester, Software Freedom Law Center, filed a request for *ex parte* reexamination, which proceeding was assigned Control No. 90/008,330 ("the '8330 proceeding") requesting reexamination of claims 1-44. On Jan. 25, 2007, reexamination was ordered in the '8330 proceeding.

3. On Dec. 1, 2006, a third party requester, Desire2Learn, filed a request for *inter partes* re-examination, which proceeding was assigned Control No. 95/000,199 ("the '199 proceeding") requesting reexamination of claims 1-44. On Feb. 26, 2007, reexamination was ordered in the '199 proceeding.

4. A concurrent civil litigation is being conducted in the U.S. District Court for the Eastern District of Texas, captioned *Blackboard, Inc. v. Desire2Learn, Inc.*, Civil Action No. 9:06-CV-00155.

5. On March 17, 2008, the '8330 proceeding and the '199 proceeding were merged.

6. On March 25, 2008, an Office action in the merged proceeding was mailed. Patent owner responded on May 29, 2008, with an amendment, comments and several declarations. Third party requester filed its comments on June 26, 2008.

7. On April 15, 2009, an action closing prosecution was mailed. Patent owner filed, on June 15, 2009, comments and an additional declaration. Third party requester filed its comments on July 15, 2009.

8. A petition was filed June 15, 2009, with patent owner's response requesting that the provisions of 37 CFR 1.52(e) be suspended regarding the formalities of submission of a computer program on a compact disc. A decision granting the requested suspension (waiver) was mailed Aug. 21, 2009.

9. A petition was filed Oct. 13, 2009, requesting waiver of 37 CFR.1.955 to permit a personal interview to demonstrate the computer program submitted on the compact disc granted entry in the Aug. 21, 2009 decision. This petition is the subject of the present decision.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

A. Relief Requested

37 CFR 1.183 provides:

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

B. Interviews

> § 1.955 Interviews prohibited in inter partes reexamination proceedings. There will be no interviews in an inter partes reexamination proceeding which discuss the merits of the proceeding.

II. FINDINGS AND ANALYSIS

Patent owner requests waiver of 37 CFR 1.955 to permit a personal interview with the Examiner during which the contents of a CD may be demonstrated. The patent owner will provide stand-alone equipment in which the CD contents can be accessed and demonstrated to the Examiner. The CD has already been entered into the record in accordance with the decision mailed Aug. 21, 2009.

The examiner is unable to access the contents of the CD without a demonstration by the patent owner on patent owner's stand alone equipment, and therefore this is deemed an extraordinary situation that warrants granting waiver of the rule to permit an interview. However, keeping in spirit with 37 CFR 1.955, which prohibits interviews in which the merits of the proceedings are discussed, the interview will be strictly limited to a demonstration of the contents of the CD. No discussion of the merits of the proceeding will be permitted. A reexamination supervisor is to be in attendance to ensure compliance with these requirements. Permission to conduct a limited interview under these circumstances is granted.

By this decision, the Office also *sua sponte* grants permission for the third parties to attend the interview and view the demonstration. There is no right of participation by the third parties, and there will be no opportunity provided to the third parties to participate in the proceedings in any manner apart from being in attendance.

The patent owner will provide a summary of the interview and the *inter partes* requester will have the option of responding to the patent owner remarks within fifteen (15) days of the filing. The summary and response will be strictly limited to the demonstration that occurs at the interview. Neither the patent owner's summary not the optional third party response will be permitted to address the merits of the proceeding.

It is patent owner's responsibility to coordinate an amenable date and time for the interview for the examiner, a supervisor, and the third parties if the third parties wish to attend. The interview will take place at the U.S. Patent & Trademark Office at the Carlyle campus in Alexandria, VA during normal business hours.

PATENT OWNER'S ADDRESS

The patent owner is reminded to update the correspondence address in both the patent file and this proceeding based on any change in power of attorney and change of correspondence address. The correspondence address for the patent is the correct address for the patent owner in reexamination proceedings. The Office will not engage in double correspondence with more than one attorney or agent. See 37 CFR 1.33(c). As patent owner has been reminded of this previously, yet no change of address has been received in the patent file, no additional courtesy copies to petitioner will be sent with this decision, or with future correspondence.

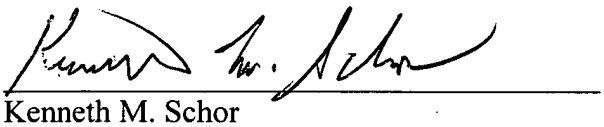
CONCLUSION

1. The petition is granted to waive 37 CFR 1.955 to the extent set forth above.

2. It is patent owner's responsibility to coordinate a mutually agreeable time and date for the interview with the examiner, a supervisor, and the third party requesters.

3. Jurisdiction of the merged proceedings is being returned to the Central Reexamination Unit for further handling consistent with this decision.

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



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

10/25/09
keninterview

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Daniel P. McCarthy
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P.O. Box 45898
Salt Lake City, UT 84145[1]

(For Patent Owner)

MAILED

MAR 13 2008

CENTRAL REEXAMINATION UNIT

A. John Pate
Pate Pierce & Baird
215 South State Street, Suite 550
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(For 3rd Party Requester)

Stoel Rives LLP-SLC
201 South Main Street
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Salt Lake City, UT 84111

(For 3rd Party Requester)

Reexam Control No.: 90/007,656
Filed : August 5, 2005
For U.S. Patent No. : 5,749,111

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,333
Filed : November 20, 2006
For U.S. Patent No. : 5,749,111

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

Reexamination in application control No. 90/007,656 was ordered in a decision mailed October 14, 2005. Prosecution proceeded to the mailing of a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) on January 16, 2007. The NIRC indicated that claims 1-120, all of the claims in the patent, were confirmed. A decision vacating the NIRC was mailed March 12, 2008. There were no amendments made to the claims, specification and/or drawings in this proceeding.

Reexamination in application control No. 90/008,333 was ordered in a decision mailed February 6, 2007 indicating that claims 1-120 will be reexamined. No patent owner's statement has been

[1] [1] Communications from Mr. McCarthy directed to the '7,656 proceeding and received October 15, 2006 and subsequently bear a correspondence address of P.O. Box 71550, Salt Lake City, UT 84171-0550. This address differs from the correspondence address of record. The filing of a formal request to change the correspondence address is suggested to ensure prompt receipt of all Office communications.

filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,656 and reexamination control No. 90/008,333 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-120, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,656 and 90/008,333 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Lissi Mojica Marquis,
Director
Central Reexamination Unit

cc: Daniel P. McCarthy
P.O. Box 71550
Salt Lake City, UT 84171-0550

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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.
90/008,337	11/22/2006	6983542	WNA11-REEX	1020

84822 7590 09/15/2009

Vern Maine & Associates
PO Box 3445
100 Main Street, Suite 2
Nashua, NH 03061-3445

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2009

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

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VERN MAINE & ASSOCIATES
PO BOX 3445
100 MAIN STREET, SUITE 2
NASHUA, NH 03061-3445

(For Patent Owner/Requester)

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SEP 15 2009

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No.: 90/008,337
Filed: November 22, 2006
For: U.S. Patent No.: 6,983,542

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the July 24, 2009 patent owner petition under 37 CFR 1.182 entitled "PETITION TO CORRECT AND SUPPLEMENT INFORMATION DISCLOSURE STATEMENT."

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

The petition fee of $400 pursuant to 37 CFR 1.17(f) accompanied the petition under 37 CFR 1.182.

The petition is dismissed for the reasons set forth below.

Thus, the documents submitted with the petition on July 24, 2009, have not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,983,542 (the '542 patent) issued on January 10, 2006.

2. On November 22, 2006, a request for *ex parte* reexamination of the '542 patent was filed by patent owner, which request was assigned control no. 90/008,337 (the '8337 proceeding).

3. On December 8, 2006, the Office issued an order granting *ex parte* reexamination in the '8337 proceeding.

4. On December 3, 2007, patent owner filed an Information Disclosure Statement (IDS) citing Japanese Patent JP 57-5870 (JP '870), which was accompanied by an English translation of the JP '870 abstract.

5. On November 14, 2008, patent owner filed an IDS, submitting an English translation of a Chinese decision from a related proceeding citing JP '870.

6. Prosecution in the '8337 proceeding progressed to the point where, on June 26, 2009, the Office mailed a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC).

7. On July 2, 2009, the '8337 proceeding was forwarded to the Office of Publications.

8. On July 24, 2009, the Office received the instant patent owner petition entitled "PETITION TO CORRECT AND SUPPLEMENT INFORMATION DISCLOSURE STATEMENT" (petition under 1.182), accompanied by two documents which patent owner has requested the Office enter and consider.

9. The '8337 proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle), which certificate is currently scheduled for September 22, 2009.

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.)

MPEP 2256 provides (in part):

> **AFTER THE NOTICE OF INTENT TO ISSUE *EX PARTE* REEXAMINATION CERTIFICATE (NIRC):**
>
> 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 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

A. Patent Owner's July 24, 2009 Petition under 37 CFR 1.182

In the July 24, 2009 petition under 37 CFR 1.182, patent owner requests entry of the petition and the accompanying materials "to correct an inadvertent error in a prior Information Disclosure Statement and make of record a newly-issued action in a related foreign case."[1] In particular, patent owner requests entry and consideration of (1) an English translation of the entire Japanese

[1] Petition under 37 CFR 1.182 at page 1.

Patent JP 57-5870 (JP '870) and (2) an English translation of a Chinese decision dated May 15, 2009 (referred to by patent owner as "the 2009 Decision").[2]

B. Analysis and Findings

At the time patent owner filed the instant petition under 37 CFR 1.182, the Office had already mailed a NIRC in the '8337 proceeding, and the '8337 proceeding had been forwarded to the Office of Publications and had entered the printing cycle. While the petition under 37 CFR 1.182 did not request entry of an IDS *per se*, patent owner's request for entry and consideration of the English translations of the full JP '870 patent document and of the May 15, 2009 Chinese decision is "a submission of patents and printed publications, or other information described in 37 CFR 1.98(a) ... made while a proceeding is in its printing cycle," pursuant to MPEP 2256.[3] Thus, the petition under 37 CFR 1.182 is treated as a request for withdrawal of the '8337 proceeding from the publication process.

There is no issue fee in reexamination, and, in this instance, the '8337 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 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 '8337 proceeding from the publication process, for consideration of the accompanying documents, 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.

Patent owner's July 24, 2009 submission fails to satisfy the above-quoted criteria. The petition under 37 CFR 1.182 was filed very late in the examination of the '8337 proceeding, and it fails to provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable. With respect to the English translation of the full JP '870 document, patent owner asserts that the document is relevant because it "was cited in an invalidation proceeding involving a corresponding patent in China"; however, there is no statement by patent owner that unequivocally states why the English translation of the full JP '870 document makes at least one

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[2] *See* petition under 37 CFR 1.182 at pages 2-3. It is noted that patent owner incorrectly identifies the date of the Chinese decision as "May 15, 2008" on the bottom of page 2 of the petition under 37 CFR 1.182.

[3] On page 1 of the petition under 37 CFR 1.182, patent owner requests entry of the petition and the accompanying materials "to correct an inadvertent error in a prior Information Disclosure Statement and make of record a newly-issued action in a related foreign case."

claim unpatentable.[4] Likewise, with respect to the English translation of the May 15, 2009 Chinese decision, patent owner asserts that the document is "believed relevant in that it further characterizes references of record, including the JP '870 patent"; however, there is no statement by patent owner that unequivocally states why the English translation of the May 15, 2009 Chinese decision makes at least one claim unpatentable.[5] Thus, patent owner has not submitted these documents out of a belief that the documents would make at least one claim unpatentable and, for this reason, the petition under 37 CFR 1.182 fails to conform to the requirements set forth in MPEP 2256. It is further observed that patent owner has not even provided the requisite "explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding" set forth in MPEP 2256 for the stage before a proceeding enters the printing cycle, since the submitted information is not discussed as to how it is applied to the claim limitations of the claims of the proceeding (there is no discussion as to which limitations are taught, and which are not taught, by the submitted information).

Furthermore, at least with respect to the English translation of the full JP '870 document, 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.[6] Patent owner states that JP '870 was cited in the December 3, 2007 IDS, accompanied by an English translation of the JP '870 abstract.[7] Patent owner further states that the November 14, 2008 IDS included the statement that "[c]ounsel does not have an English translation of the JP 870 patent" but that "unknown to counsel at the time, Patent Owner had an English translation of the entire JP '870 patent."[8] Thus, petitioner patent owner has not asserted that the English translation of the full JP '870 document was unknown or unavailable to *patent owner* at an earlier date (for submission). Therefore, the petition under 37 CFR 1.182 fails to present a sufficient explanation of why information submitted could not have been submitted earlier; and, for this additional reason, 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 in the '8337 proceeding by issuing a NIRC on June 26, 2009, and the '8337 proceeding has now entered the final stages of the publication process, with the reexamination certificate scheduled to be printed

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[4] Petition under 37 CFR 1.182 at page 2 (also stating that such relevance is further described in a Chinese decision that was previously filed in the November 14, 2008 IDS and that "[f]or the same reasons, the English translation is believed relevant.").

[5] Petition under 37 CFR 1.182 at page 3.

[6] With respect to the English translation of the May 15, 2009 Chinese decision, patent owner provides an explanation as to why the information could not have been submitted earlier in that "[t]he 2009 Decision was issued less than three months prior to the filing of the present petition."

[7] Petition under 37 CFR 1.182 at pages 1-2.

[8] Petition under 37 CFR 1.182 at page 2 (identifying the accompanying declarations of Ashish K. Mithal, Marcus J. Millet, and William A. Di Bianca).

on September 22, 2009. The '8337 proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the '8337 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 documents after termination of the prosecution in the '8337 reexamination proceeding and the failure to identify a question of patentability of a claim under reexamination, the '8337 reexamination proceeding will not be reopened at this late date to consider the proffered documents.

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

CONCLUSION

1. Patent owner's July 24, 2009 petition under 37 CFR 1.182 is dismissed as to the request for consideration of the documents that accompanied the petition submission.

2. The documents that accompanied the July 24, 2009 petition submission have not been entered for consideration by the examiner. A copy of the documents will, however, be placed in the electronic file for the proceeding.

3. The '8337 proceeding will continue in the publication process, toward issuance of a reexamination certificate.

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

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,339	01/08/2007	5976645	FIE-061269	1739

50787 7590 08/14/2008

STRADLEY RONON STEVENS & YOUNG, LLP
30 VALLEY STREAM PARKWAY
GREAT VALLEY CORPORATE CENTER
MALVERN, PA 19355-1481

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/14/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Jody L. Factor//FACTOR & LAKE, LTD.

1327 W. Washington Blvd.

Suite 5G/H

Chicago, Ill 60607

MAILED

AUG 14 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,339*.

PATENT NO. *5976645*.

ART UNIT *3991*.

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

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

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Kevin R. Casey
Stradley Ronon Stevens & Young, LLP
30 Valley Stream Parkway
Great Valley Corporate Center
Malvern, PA 19355-1481

(for Patent Owner)

Jody L. Factor
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1327 W. Washington Blvd, Suite 5G/H
Chicago, IL 60607

(for Third Party Requester)

MAILED

AUG 14 2008

CENTRAL REEXAMINATION UNIT

In re Daluise et al
Reexamination Proceeding
Control No.: 90/008,339
Filed: January 8, 2007
For: U.S. Patent 5,976,645

Chris P. Perque
Gardere Wynne Sewell LLP
1000 Louisiana St. Suite 3400
Houston, TX 77002-5011

(for Third Party Requester)

In re Daluise et al
Reexamination Proceeding
Control No.: 90/010,105
Filed: February 27, 2008
For: U.S. Patent 5,976,645

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 5,976,645, issued November 2, 1999, is the subject of Reexamination Control Nos. 90/008,339 and 90/010,105.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,339, was filed January 8, 2007 by Jody L. Factor of Factor & Lake in Chicago, IL. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed synthetic turf and process of forming a synthetic turf on a sub-surface base or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/008,339 on February 16, 2007.

4. A first non-final Office action was issued on April 18, 2007.

6. Patent Owner filed a response on June 21, 2007.

7. A subsequent request for re-examination, assigned Reexamination Control No. 90/010,105, was filed February 27, 2008 by Chris P. Perque of Gardere, Wynne, Sewell LLP in Houston TX. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed synthetic turf and process of forming a synthetic turf on a sub-surface base or are so close as to establish a case of obviousness.

8. Reexamination was ordered for 90/010,105 on April 23, 2008.

9. No Patent Owner statement has been submitted and 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 90/008,339 and 90/010,105 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. 90/008,339 and 90/010,105 as:

Kevin R. Casey
Stradley Ronon Stevens & Young, LLP
30 Valley Stream Parkway
Great Valley Corporate Center
Malvern, PA 19355-1481

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/008,339 as:

Jody L. Factor
Factor & Lake, LTD
1327 W. Washington Blvd, Suite 5G/H
Chicago, IL 60607

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/010,105 as:

Chris P. Perque
Gardere Wynne Sewell LLP
1000 Louisiana St. Suite 3400
Houston, TX 77002-5011

CONCLUSION

Reexamination Control Nos. 90/008,339 and 90/010,105 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, Supervisory Patent Examiner, at (571) 272-1535.

for /Deborah D Jones/
Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,105	02/27/2008	5976645	119168-5001	1922

50787 7590 08/14/2008

STRADLEY RONON STEVENS & YOUNG, LLP
30 VALLEY STREAM PARKWAY
GREAT VALLEY CORPORATE CENTER
MALVERN, PA 19355-1481

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/14/2008

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

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Chris P. Perque

Gardere Wynne Sewell LLP

1000 Louisiana St., Suite 3400

Houston, TX 77002-5011

MAILED

AUG 14 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/010,105*.

PATENT NO. *5976645*.

ART UNIT *3991*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Mailed :

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Kevin R. Casey
Stradley Ronon Stevens & Young, LLP
30 Valley Stream Parkway
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Malvern, PA 19355-1481

(for Patent Owner)

Jody L. Factor
Factor & Lake, LTD
1327 W. Washington Blvd, Suite 5G/H
Chicago, IL 60607

(for Third Party Requester)

MAILED

AUG 14 2008

CENTRAL REEXAMINATION UNIT

In re Daluise et al
Reexamination Proceeding
Control No.: 90/008,339
Filed: January 8, 2007
For: U.S. Patent 5,976,645

Chris P. Perque
Gardere Wynne Sewell LLP
1000 Louisiana St. Suite 3400
Houston, TX 77002-5011

(for Third Party Requester)

In re Daluise et al
Reexamination Proceeding
Control No.: 90/010,105
Filed: February 27, 2008
For: U.S. Patent 5,976,645

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 5,976,645, issued November 2, 1999, is the subject of Reexamination Control Nos. 90/008,339 and 90/010,105.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,339, was filed January 8, 2007 by Jody L. Factor of Factor & Lake in Chicago, IL. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed synthetic turf and process of forming a synthetic turf on a sub-surface base or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/008,339 on February 16, 2007.

4. A first non-final Office action was issued on April 18, 2007.

6. Patent Owner filed a response on June 21, 2007.

7. A subsequent request for re-examination, assigned Reexamination Control No. 90/010,105, was filed February 27, 2008 by Chris P. Perque of Gardere, Wynne, Sewell LLP in Houston TX. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed synthetic turf and process of forming a synthetic turf on a sub-surface base or are so close as to establish a case of obviousness.

8. Reexamination was ordered for 90/010,105 on April 23, 2008.

9. No Patent Owner statement has been submitted and 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 90/008,339 and 90/010,105 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

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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. 90/008,339 and 90/010,105 as:

Kevin R. Casey
Stradley Ronon Stevens & Young, LLP
30 Valley Stream Parkway
Great Valley Corporate Center
Malvern, PA 19355-1481

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/008,339 as:

Jody L. Factor
Factor & Lake, LTD
1327 W. Washington Blvd, Suite 5G/H
Chicago, IL 60607

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/010,105 as:

Chris P. Perque
Gardere Wynne Sewell LLP
1000 Louisiana St. Suite 3400
Houston, TX 77002-5011

CONCLUSION

Reexamination Control Nos. 90/008,339 and 90/010,105 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, Supervisory Patent Examiner, at (571) 272-1535.

/Deborah D Jones/
for Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,340	01/25/2007	6058304	36928.7	2082

7590 09/11/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Brian P. Hopkins
Mintz Levin Cohn Ferris Glovsky and Popeo PC
Chrysler Center
666 Third Avenue
New York, NY 10017

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

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

HAYES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE SUITE 700
DALLAS, TX 75219

Date:

MAILED
SEP 11 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008340
PATENT NO. : 6058304
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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Brian P. Hopkins
Mintz Levin Cohn Ferris Glovsky and Popeo PC
Chrysler Center
666 Third Avenue
New York NY 10017

(For Patent Owner)

MAILED

SEP 11 2009

CENTRAL REEXAMINATION UNIT

David M. O'Dell
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

In re: Callaghan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,340
Deposited: 25 January 2007
For: US Patent No. 6,058,304

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
37 CFR §§ 1.550(c) & 1.181

This is a decision on the 25 August 2009, "Request for Extension of Time Under to 37 CFR §1.550(c)" requesting that the time for responding to the notice of appeal, be extended by one (1) month. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g).

The petition 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 further extended in which to file a response to Final Office action, which set a two (2) months date for filing a response thereto. An after Final amendment was timely submitted 27 July 2009. The petition for extension of time was filed on 25 August 2009. An advisory action extending the period for response by four (4) months was mailed on 31 August 2009.

The extension of time is dismissed

37 CFR § 1.550 (c) states:

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

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

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

MPEP 2265 (in-part)

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> ...
>
> Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. Any request for an extension of time in a reexamination proceeding to file a notice of appeal to the Board of Patent Appeals and Interferences, a brief or reply brief, or a request for reconsideration or rehearing will be considered under the provisions of 37 CFR § 1.550(c). The time for filing the notice and reasons of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action will be considered under the provisions of 37 CFR § 1.304.

ANALYSIS AND FINDINGS

The patent owner's representative petitions to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The patent owner timely submitted an after Final amendment on 27 July 2009. The patent owner sought an extension of time awaiting the response from the examiner. The examiner extended the period for response in the advisory Office action mailed 31 August 2009 by four (4) months. The examiner's action exceeds the time requested by the patent owner. In light of the examiner's extension of time the petition is dismissed as moot.

The petition request to extend the response time is hereby dismissed as moot.

CONCLUSION

1. The patent owner's petition for extension of time is hereby **dismissed.**

2. The time to respond to the Final office action continues to run four (4) months from the date of the Final Office action mailed on 25 June 2009.

3. Response is due on **25 October 2009.**

4. Response and/or submissions to the Office to change the correspondence address or power of attorney in the record of the patent should be addressed as follows:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

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

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MAY 13 2008

CENTRAL REEXAMINATION UNIT

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
1279 OAKMEAD PARKWAY
SUNNYVALE CA 94085-4040

(For Patent Owner)

Otto O. Lee
INTELLECTUAL PROPERTY LAW GROUP LLP
12 SOUTH FIRST STREET
SUITE 1205
SAN JOSE, CA 95113

(For Third Party Requester)

Daniel B Ravicher
PUBLIC PATENT FOUNDATION
1375 BROADWAY
SUITE 600
NEW YORK, NY 10018

(For Third Party Requester)

Thomas A Fairhall
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

(For Third Party Requester)

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

In re: Lowery *et alia*
Ex parte Reexamination Proceeding
Control No. 90/008,342
Deposited: 27 November 2006
For U.S. Patent No. 5,894,554

In re: Lowery *et alia*
Ex parte Reexamination Proceeding
Control No. 90/008,562
Deposited: 29 March 2007

For U.S. Patent No. 5,894,554 :

In re: Lowery *et alia* :
Ex parte Reexamination Proceeding :
Control No. 90/008,574 :
Deposited: 3 April 2007 :
For U.S. Patent No. 5,894,554 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of Reexamination control number 90/008,342; 90/008,562 and 90/008,574 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.

Per **MPEP 2283**

> If a second request for reexamination is filed prior to the issuance of a Notice of Intent to Issue a Reexamination Certificate for the first reexamination proceeding, the proceedings generally will be merged. In this situation, the second request is decided based on the original patent claims, and if reexamination is ordered, the reexamination proceedings generally would be merged.
>
> ...
>
> A decision by the CRU Director to merge the reexamination proceedings should include a requirement that the patent owner maintain identical claims in both files. It will further require that responses by the patent owner, and any other paper filed in the merged proceeding, must consist of a single response, addressed to both files, filed in duplicate, each bearing a signature and containing identifying data for both files, for entry in both files. The decision will point out that both files will be maintained as separate complete files. Where the claims are not the same in both files, the decision of merger will indicate at its conclusion that the patent owner is given 1 month to provide an amendment to make the claims the same in each file. Where the claims are already the same in both files, the decision will indicate at its conclusion that an Office action will be mailed in due

course, and that the patent owner need not take any action at present. The decision of merger will be mailed immediately.

Since all of the requirements of MPEP 2283 and 37 CFR § 1.565(c) are met, accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/008,342; 90/008,562 and 90/008,574 reexamination proceedings are hereby merged. There are no amendments to any of the above noted proceedings at this time. The merged proceeding will be conducted in accordance with the following guidelines and requirements:

I. Requirements for Same Amendments in All Proceedings

There are no amendments at this time in any of the reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,342; 90/008,562 and 90/008,574 are hereby **merged**.

2. The merged proceeding is returned to the examiner assigned these proceedings to issue an Office action in due course.

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents

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

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

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

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

MARK J. REINHART
CRU SPE-AU 3992

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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

MAILED

MAY 13 2008

CENTRAL REEXAMINATION UNIT

Matthew B. Talpis, Esq. BAKER BOTTS LLP 2001 Ross Ave. Dallas TX 75201-2980	(For Patent Owner)
Otto O. Lee INTELLECTUAL PROPERTY LAW GROUP LLP 12 SOUTH FIRST STREET SUITE 1205 SAN JOSE, CA 95113	(For Third Party Requester)
Daniel B Ravicher PUBLIC PATENT FOUNDATION 1375 BROADWAY SUITE 600 NEW YORK, NY 10018	(For Third Party Requester)
Thomas A Fairhall MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606	(For Third Party Requester)
	DECISION, *SUA SPONTE,* MERGING REEXAMINATION PROCEEDINGS PURSUANT TO 37 C.F.R. § 1.565(c)
In re: Lowery *et alia* *Ex parte* Reexamination Proceeding Control No. 90/008,343 Deposited: 27 November 2007 For U.S. Patent No. 6,415,335	
In re: Lowery *et alia* *Ex parte* Reexamination Proceeding Control No. 90/008,568 Deposited: 29 March 2007 For U.S. Patent No. 6,415,335	

In re: Lowery *et alia* :
Ex parte Reexamination Proceeding :
Control No. 90/008,584 :
Deposited: 3 April 2007 :
For U.S. Patent No. 6,415,335 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of Reexamination control number 90/008,343; 90/008,568 and 90/008,584 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.

Per **MPEP 2283**

> If a second request for reexamination is filed prior to the issuance of a Notice of Intent to Issue a Reexamination Certificate for the first reexamination proceeding, the proceedings generally will be merged. In this situation, the second request is decided based on the original patent claims, and if reexamination is ordered, the reexamination proceedings generally would be merged.
>
> ...
>
> After the patent owner and second requester have been given an opportunity to file a statement and reply, respectively, the second reexamination proceeding >generally< will be merged with the first reexamination proceeding, and prosecution will then continue at the most advanced point possible for the first proceeding. It should be noted that if a final rejection has been issued in the first proceeding, prosecution will be ordinarily be reopened where any of the new patents or printed publications presented in the second request are applied to the merged proceeding in a new ground of rejection.
> The patent owner will be provided with an opportunity to respond to a
> A decision by the CRU Director to merge the reexamination proceedings should include a requirement that the patent owner maintain identical claims in both files. It will further require that responses by the patent owner, and any other paper filed in the

merged proceeding, must consist of a single response, addressed to both files, filed in duplicate, each bearing a signature and containing identifying data for both files, for entry in both files. The decision will point out that both files will be maintained as separate complete files. Where the claims are not the same in both files, the decision of merger will indicate at its conclusion that the patent owner is given 1 month to provide an amendment to make the claims the same in each file. Where the claims are already the same in both files, the decision will indicate at its conclusion that an Office action will be mailed in due course, and that the patent owner need not take any action at present. The decision of merger will be mailed immediately.

Since all of the requirements of MPEP 2283 and 37 CFR § 1.565(c) are met, accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/008,343; 90/008,568 and 90/008,584 reexamination proceedings are hereby merged. There are no amendments to any of the above noted proceedings at this time. The merged proceeding will be conducted in accordance with the following guidelines and requirements:

I. Requirements for Same Amendments in All Proceedings

There are no amendments at this time in any of the reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,343; 90/008,568 and 90/008,584 are hereby **merged**.

2. The merged proceeding is returned to the examiner assigned these proceedings to issue an Office action in due course.

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

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

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

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

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 Examiner in the Central Reexamination Unit, Art Unit 3992.

MARK J. REINHART
CRU SPE-AU 3992

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,343	11/27/2006	6415335		3417

7590 08/13/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Matthew B. Talpis, Esq.
BAKER BOTTS LLP
2001 Ross Ave.
Dallas, TX 75201-2980

DATE MAILED: 08/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

Date:
MAILED
AUG 13 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008343
PATENT NO. : 6415335
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.
90/008,568	03/29/2007	6415335	06-455	7319

7590 08/13/2009

EXAMINER	

MATTHEW B. TALPIS, ESQ.
BAKER BOTTS LLP
2001 ROSS AVENUE
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DALLAS, TX 75201

ART UNIT	PAPER NUMBER

DATE MAILED: 08/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

THOMAS A. FAIRHALL
MCDONELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE, 32ND FLOOR
CHICAGO, IL 60606

Date:
MAILED
AUG 13 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008568
PATENT NO. : 6415335
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.
90/008,584	04/03/2007	6415335	FRIENDFINDER.RX2	3276

7590 08/13/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Matthew B. Talpis, Esq.
BAKER BOTTS, L.L.P.
2001 Ross Ave.
Suite 600
Dallas, TX 75201-2980

DATE MAILED: 08/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MR. OTTO O. LEE
INTELLECTUAL PROPERTY LAW GROUP LLP
12 SOUTH FIRST STREET, SUITE 1205
SAN JOSE, CA 95113

Date:

MAILED

AUG 13 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008584
PATENT NO. : 6415335
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

Matthew B. Talpis, Esq.
BAKER BOTTS LLP
2001 Ross Ave.
Dallas TX 75201-2980

(For Patent Owner)

MAILED

AUG 13 2009

CENTRAL REEXAMINATION UNIT

Daniel B. Ravicher
PUBLIC PATENT FOUNDATION
1375 Broadway, Suite 600
New York, New York 10018

(For Third Party Requester)

Thomas A Fairhill
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

(For Third Party Requester)

Otto O Lee
INTELLECTUAL PROPERTY LAW GROUP LLP
12 SOUTH FIRST STREET
SUITE 1205
SAN JOSE, CA 95113

(For Third Party Requester)

In re: Lowery *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,343
Deposited: 27 November 2006
For: US Patent No. 6,415,335

In re: Lowery *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,568
Deposited: 29 March 2007
For: US Patent No. 6,415,335

In re: Lowery *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,584
Deposited: 03 April 2007
For: US Patent No. 6,415,335

DECISION
DISMISSING
PETITION FOR ENTRY
OF AMENDMENTS
37 CFR § 1.181

This is a decision on the 07 August 2009, "Non-Fee Petition Under 37 CFR § 1.181 for Entry of Amendments Submitted After Final Rejection in *Ex Parte* Reexamination Proceedings." The petition was timely filed with the appropriate certificate of service.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner petitions for entry under 37 CFR § 1.181 of after final amendments in an *ex parte* reexamination proceeding. The amendment was submitted on 19 June 2009. The examiner mailed on 01 July 2009 an advisory action telling the patent owner that the amendment would not be entered.

37 CFR § 1.181 Petition to the Director. (in-part)

> (a) Petition may be taken to the Director:
> (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
> (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.

37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal. (in-part)

> (a) An amendment after final action must comply with § 1.114 or this section.
> (b) After a final rejection or other final action (§ 1.113) in an 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....

ANALYSIS AND FINDINGS

Review of the record indicates that the amendment filed on 19 June 2009 introduces a number of limitations in a large number of claims for which additional search and or consideration is warranted.

The amendment does not reduce the issues on appeal. Since the finality of the action mailed 30 March 2009 is deemed appropriate. Further review of 37 CFR 1.116 confirms that the examiner acted appropriately by not entering the amendment to the claims in the advisory action mailed on 01 July 2009. The amendment submitted 19 June 2009 does not reduce or simplify the issues on appeal, the amendment will not be entered.

The petition pursuant to 37 CFR § 1.181 is hereby dismissed.

The amendment submitted on 19 June 2009 will not be entered.

CONCLUSION

1. The patent owner's petition pursuant to 37 CFR 1.181 for entry of amendments is hereby **dismissed**

2. The Patent Owner's response is due two (2) months from the date of the Notice of Appeal.

3. 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.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090415

DATE : April 15, 2009

TO SPE OF : ART UNIT 3991

SUBJECT : Request for Certificate of Correction on Patent No.: 6,265,055 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:

Office Mistake in Ex Parte Reexamination Certificate (6761st) US 6,265,055 C2

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
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.
90/008,351	11/27/2006	6942248	ATI-233 RE	5110

22846 7590 02/20/2008

BRIAN ROFFE, ESQ
11 SUNRISE PLAZA, SUITE 303
VALLEY STREAM, NY 11580-6111

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/20/2008

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.
95/001,012	10/11/2007	6,942,248	ATI-233 IP REEX	5467

22846 7590 02/20/2008

BRIAN ROFFE, ESQ
11 SUNRISE PLAZA, SUITE 303
VALLEY STREAM, NY 11580-6111

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/20/2008

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

Brian Roffe (For Patent Owner)
Law Office of Brian Roffe
11 Sunrise Plaza, Suite 303
Valley Stream, New York 11580-6111

MAILED

FEB 20 2008

Rickard K. DeMille (For Third Party Requester)
Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, Illinois 60610

CENTRAL REEXAMINATION UNIT

Ex parte Reexamination Proceeding	:	
Control No. 90/008,351	:	
Filed: November 27, 2006	:	
For: U.S. Patent No. 6,942,248	:	**DECISION, *SUA SPONTE*,**
	:	**TO MERGE**
	:	**REEXAMINATION**
Inter Partes Reexamination Proceeding	:	**PROCEEDINGS**
Control No. 95/001,012	:	
Filed: October 11, 2007	:	
For: U.S. Patent No. 6,942,248	:	

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF SALIENT FACTS

1. U.S. patent No. 6,942,248 (the '248 patent) issued to David Breed *et al.* on September 13, 2005 and was assigned to Automotive Technologies International Inc.

2. A request for *ex parte* reexamination of claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 of the '248 patent was filed on November 27, 2006, by Rickard DeMille, as the third party requester, and the request was assigned control number 90/008,351 (the '8351 *ex parte* reexamination proceeding).

3. On January 4, 2007, *ex parte* reexamination was ordered for claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 of the '248 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability for these claims.

4. Patent owner notified the Office of two concurrent litigations [1] involving the '248 patent, which have been stayed pending results of the reexamination proceeding.

5. A non-final Office action was mailed June 22, 2007, rejecting claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 of the '248 patent.

6. After an interview with the Examiner on July 17, 2007, the patent owner filed a response on August 24, 2007, proposing an amendment adding claims 48-51 to the '248 patent and changing the drawings.

7. A request for *inter partes* reexamination of claims 1-18 the '248 patent was filed on October 11, 2007, by third party requester Rickard DeMille, in which Elesys North America, Inc. (ENA) was identified as the real party in interest. The request was assigned control number 95/001,012 (the '1012 *inter partes* reexamination proceeding).

8. On January 9, 2008, *inter partes* reexamination was ordered based on the examiner's determination that the October 11, 2007 request raised a substantial new question of patentability for claims 7 and 15 of the '248 patent.

9. There has been no further Office action in the '1012 *inter partes* reexamination proceeding, but, on October 19, 2007, an Office action was mailed in the '8351 *ex parte* reexamination proceeding finally rejecting claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, 46 and 48-51 of the '248 patent.

10. Patent owner filed a response in the '8351 *ex parte* reexamination proceeding to the October 19, 2007 Office action on November 19, 2007. On November 29, 2007, an advisory action was mailed that denied entry of the response.

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 '1012 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

[1] *Automotive Technologies International, Inc. v. American Honda Motor Co., Inc. et al.*, Civil Action No. 06-187-GMS, and *Automotive Technologies International, Inc. v. Hyundai Motor America et al.*, Civil Action No. 06-391-GMS, both in the U.S. District Court for the District of Delaware.

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.

In accordance with 37 CFR 1.989(a), the 95/001,012 and 90/008,351 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 claims 48-51 have been added and changes to the drawings have been proposed in the '8351 proceeding, so that the claims and the specification are not currently the same in both files, a "housekeeping amendment" is needed to place the same amendments in both proceedings.

Patent owner is required to submit an appropriate "housekeeping amendment" within one month of this decision placing the same amendments 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 proceeding would be improper and would result in non-entry of the paper into the record, as it would result in the paper being an improper submission under 37 CFR 1.939.

It should be noted that submission of such an appropriate housekeeping amendment will not create a reply right for the *inter partes* third party requester. Any comments paper filed by the requester in response to any such housekeeping amendment would be improper, since the housekeeping amendment is not to address the merits of the proceeding. Any such comments paper would not be entered into the record, as it would be an improper submission under 37 CFR 1.939. Any amended/new claims of the housekeeping amendment may be addressed by the *inter partes* third party requester at the next opportunity that requester has to file a paper directed to the merits having an entry right. [2]

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

[2] The regulations governing the filing of third party requester written comments, 37 CFR 1.947 and 1.951(b), do not provide for the filing of any third party requester comments unless the written comments are directed to a patent owner paper filed in response to "an Office action." A merger decision is not an Office action on the merits of patentability; thus requester is not authorized to respond to the house-keeping amendment. This is based on 35 U.S.C. 314(b)(2) which only authorizes comments after a patent owner "response to an action on the merits," and goes no further. The third party requester may comment on any new claim after patent owner responds to an Office action, or, if patent owner does not respond to any action, then by way of appeal.

37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. Therefore, the third party requester has the full *inter partes* reexamination participation rights in the merged proceeding that are set forth in 37 CFR 1.902 through 1.997.

It is noted that reexamination was ordered for claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 of the of the '248 patent in the '8351 *ex parte* reexamination proceeding, while reexamination was ordered for claims 7 and 15 of the '248 patent in the '1012 *inter partes* proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-8, 11-16, 19, 24, 32, 37, 44, and 46 of the of the '248 patent and for new claims 48-51 (from the '8351 *ex parte* proceeding), which will be added by amendment in the merged proceeding.

B. Papers mailed/filed:

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

All papers filed by the patent owner and the third party requester should be directed:

by Mail to:

Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

by Hand to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Patent owner and requester are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other party (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on the other party, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as indicated above.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, (which incorporates the provisions of 37 CFR 1.530), and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,012 and *ex parte* Reexamination Control No. 90/008,351 are 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 the mail date of this decision, placing the same amendments in both cases of the present merged proceeding.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner.

4. 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.

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,352	11/27/2006	6712387	ATI-207 RE	5109

22846 7590 06/05/2008

BRIAN ROFFE, ESQ
11 SUNRISE PLAZA, SUITE 303
VALLEY STREAM, NY 11580-6111

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2008

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,035	10/11/2007	6712387	ATI-207 REEX II	5266

22846 7590 06/05/2008

BRIAN ROFFE, ESQ
11 SUNRISE PLAZA, SUITE 303
VALLEY STREAM, NY 11580-6111

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2008

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

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Brian Roffe, Esq.
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Valley Stream, NY 11580-6111

(For Patent Owner)

Richard K. DeMille
Brinks Hofer Gilson & Lione
3600 NBC Tower
455 N. Cityfront Plaza Drive
Chicago, IL 60611-5599

(For 3rd Party Requester)

MAILED

JUN 0 5 2008

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/008,352
Filed : November 27, 2006
For U.S. Patent No. : 6,712,387

Reexam Control No.: 90/010,035
Filed : October 11, 2007
For U.S. Patent No. : 6,712,387

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. 90/008,352 was ordered in a decision mailed January 4, 2007 indicating that claims 1-38, all of the claims would be reexamined. Prosecution has progressed to the point where an Appeal Brief was filed on March 11, 2008. Some of the claims in this proceeding stand amended per an amendment filed August 22, 2007. No further action has taken place since the filing of the Appeal Brief.

Reexamination in application control No. 90/010,035 was ordered in a decision mailed January 7, 2008 indicating that claims 1-38, all of the claims 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. 90/008,352 and reexamination control No. 90/010,035 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, claims have been amended in the '352 reexamination proceeding by virtue of the amendment filed August 22, 2007. No amendments have been filed in the '035 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 1-38, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,352 and 90/010,035 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,352	11/27/2006	6712387	ATI-207 RE	5109

22846 7590 09/24/2008

BRIAN ROFFE, ESQ
11 SUNRISE PLAZA, SUITE 303
VALLEY STREAM, NY 11580-6111

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2008

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

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Brian Roffe, Esq. (For Patent Owner)
11 Sunrise Plaza
Suite 303
Valley Stream, NY 11580-6111

Richard K. Demille (For Requester)
BRINKS HOFER GILSON & LIONE
3600 NBC Tower
455 N. CityFront Plaza Drive
Chicago, IL 60611-5599

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SEP 24 2008

CENTRAL REEXAMINATION UNIT

In re Breed et al. :
Ex Parte Reexamination Proceeding :
Control No. 90/008,352 :
Filed: November 27, 2006 :
For: U.S. Patent No. 6,712,387 : **DECISION**
: **GRANTING**
In re Breed et al. : **PETITION**
Ex Parte Reexamination Proceeding :
Control No. 90/010,035 :
Filed: October 11, 2007 :
For: U.S. Patent No. 6,712,387 :

This is a decision on the September 5, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the September 5, 2008 patent owner petition to revive").

The September 5, 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 $770, for a small entity, set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to the patent owner's deposit account no. 50-0266, as authorized on page 1 of the September 5, 2008 patent owner petition.

SUMMARY

The September 5, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding . . .

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) . . . A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional . . .

*

*

(d) *Terminal Disclaimer.*

*

*

(3) The provisions of paragraph (d)(1) of this section do not apply to . . . reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 711.03(c) II A 2 (a) provides, in pertinent part:

Abandonment for Failure To Reply to a Non-Final Action

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:

(A) an argument or an amendment under 37 CFR 1.111 . . .

> **The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be bona fide. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.** In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period . . . for correction of the error or omission.

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[1] to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted a response on August 21, 2008 in reply to the July 19, 2008 nonfinal Office action, which satisfies item (1).[2] A petition fee and a proper statement under 37 CFR 1.137(b)(3) have also been submitted with the September 5, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the September 5, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[3] is **granted**.

---

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

[2] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (a). Note that **the grant of a petition under 37 CFR 1.137 is not a determination that any response is complete. Where the proposed response is to a non-final Office action, the petition may be granted if the response appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.**

[3] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response to the July 19, 2008 nonfinal Office action.

CONCLUSION

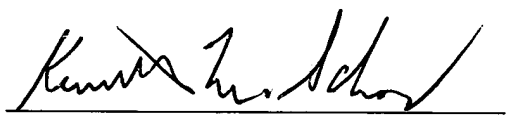
- The September 5, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

- The merger of *ex parte* reexamination control nos. 90/008,352 and 90/010,035 **has been reinstated**.

- Jurisdiction over this merged reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for processing of the August 21, 2008 patent owner response to the July 19, 2008 nonfinal Office action.

- Any inquiry concerning the **examination** of this merged reexamination proceeding should be directed to the primary examiner, Joseph Kaufman, of CRU Art Unit 3993, at (571) 272-4928.

- Any inquiry concerning this **decision** should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



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

cn

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CENTRAL REEXAMINATION UNIT

Oblon, Spivak, Mclelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

FOR PATENT OWNER

Christopher L. McKee
Banner & Witcoff, LTD.
1001 G Street N.W.
Washington, DC 20001-4597

FOR THIRD PARTY REQUESTER

In re Neil Singer et al.
Reexamination Proceeding
Control No. 90/008,354
Filed: December 1, 2006
For: U.S. Patent No. 6,314,473

DECISION DISMISSING PATENT OWNER PETITION FOR ENTRY OF DVD

This is a decision on the July 25, 2007 patent owner petition under 37 CFR 1.182 which is being taken as a petition under 37 CFR 1.183 requesting a waiver of 37 CFR 1.52(e), to accept the DVD submitted by patent owner on July 25, 2007, for entry into the record in the above noted reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

DECISION

37 CFR 1.52(e) states:

> (e)
> * * *
>
> (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:
>
> (i) A computer program listing (see Sec. 1.96);
>
> (ii) A "Sequence Listing" (submitted under Sec. 1.821(c)); or

(iii) Any individual table (see Sec. 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and Sec. 1.58(c).

* * * * *

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

37 CFR 1.182 (Questions not specifically provided for) states:

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

37 CFR 1.183 (Suspension of rules) states:

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

37 CFR 1.52(e) governs the submission of electronic documents that are to become part of the permanent record in a reexamination proceeding. The rule allows for submission of limited material on either CD-R or CD-ROM. Therefore, a submission on DVD would require a waiver of 37 CFR 1.52(e).

Furthermore, at least some of the information contained on the DVD submitted on July 25, 2007 does not fall into any of the categories listed in 37 CFR 1.52(e)(1), and the files are not ASCII data files as required by 37 CFR 1.52(e)(3)(i). Accordingly, these files must not be submitted to the Office on a compact disk, absent a waiver of the rule.

Petitioner has made no showing as to why the present situation may be deemed an "extraordinary"

situation where "justice requires" that the rules be waived [1] to allow entry of the DVD into the record of the reexamination proceeding. Accordingly, no waiver of the rule is appropriate.

Furthermore, even if the petition for entry of the DVD would be considered under 37 CFR 1.182, petitioner has provided no argument or evidence as to the merits of the situation which would warrant entry of the DVD.

The DVD will be retained by the Office in the Central Reexamination Unit for a period of 30 days, after which it will be discarded. Patent Owner may call Legal Advisor Pinchus M. Laufer to make arrangements to retrieve the DVD.

CONCLUSION

1. The petition is dismissed.

2. The DVD submitted July 25, 2007 is not being entered in the record. The examiner will not be directed to consider the contents of the DVD.

3. Patent Owner is provided with a period of 30 days to make arrangements (as set forth above) to retrieve the DVD. If no such arrangements are made, the submitted DVD will be discarded.

4. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit.

4. Inquiries with respect to this decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

c:\Kiva\kenids\decisions\8354_DVD_no_entry.wpd
8-13-07

[1] See 37 CFR 1.183.

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JAN 15 2008

CENTRAL REEXAMINATION UNIT

Charles L. Gholz
Oblon Spivak McClelland Mauer & Neustadt
1940 Duke St.
Alexandria, VA 22314

(For Patent Owner)

Joseph M. Potenza
Banner & Witcoff, LTD.
1100 13th St., NW, Suite 1200
Washington, DC 20005-4051

(For Requester)

In re Singer et al.
Ex parte Reexamination Proceeding
Control No. 90/008,354
Filed: December 1, 2006
For: U.S. Patent No.: 6,314,473

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

This is a decision on the December 18, 2007 petition under 37 CFR 1.182 and 1.183, filed by the third party requester in the above-identified proceeding to (1) permit a representative of the third party requester to attend any examiner interviews; (2) permit any examiner interviews to be recorded by audio and/or videograph; and (3) permit any examiner interviews to be transcribed.

The fee set forth in 37 CR 1.17(f) for a petition under 37 CFR 1.182 and 1.183 is $400. The petition fee for the above proceeding is being charged to the petitioner's deposit account No. 19-0733, as authorized by the petitioner on page 5 of the petition.

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

The petition is dismissed. As the petition paper is not a proper submission, it is being expunged by closing it in the electronic Image File Wrapper (IFW) of the'8354 proceeding and marking it "not public."

REVIEW OF SALIENT FACTS

1. Reexamination of claims 1, 3, 4, and 7-15 of U.S. Patent No. 6,314,473 was ordered on January 26, 2007, as proceeding 90/008,354 (the '8354 proceeding) in response to a third party request for reexamination filed December 1, 2006.

2. No patent owner statement was filed in the '8354 proceeding, and the period for active participation of the third party reexamination requester has ended.

3. A non-final office action was mailed in the '8354 proceeding on November 27, 2007.

4. On December 18, 2007, the third party requester filed the present petition under 37 CFR 1.182 and 1.183.

DISCUSSION

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

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

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

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

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

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

Pursuant to MPEP 713.04:

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

DECISION

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

The present petition of December 18, 2007, was filed after the period for active participation of the reexamination requester had ended. The present petition is not in compliance with the requirements of 37 CFR 1.510 or 1.535, nor does the present petition qualify as a prior art statement under 37 CFR 1.501. Accordingly, it is an improper submission, i.e., an improper paper, under the above-quoted portions of 37 CFR 1.550. See *Syntex (USA) Inc. v. U.S. Patent and Trademark Office,* 11 USPQ 2d 1866, 1868-1869 (Fed. Cir. 1989).

Because the December 18, 2007 petition paper is a improper paper, it does not have an entry right under the rules, it is not being made a part of the record of the present proceeding, and it is returnable without consideration of its substance. The copy of the December 18, 2007 petition paper was, however, scanned into the electronic Image File Wrapper (IFW) of the'8354 proceeding, before the discovery of the impropriety. Thus, that copy cannot be physically returned to the third party requester. Rather, the IFW

copy of the paper is being expunged by closing it in the IFW file of the'8354 proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding. The present decision will, however, be made of record in the reexamination file. See also MPEP 2267.

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

Petitioner has requested that the Office permit the third party to attend any examiner interviews, permit recordation of any examiner interview by audio and/or videograph, and permit transcription of any examiner interviews in the '8354 proceeding. However, only *ex parte* interviews between the examiner and patent owner are permitted. Observation by third parties is not permitted. Pursuant to MPEP 2281, requests by reexamination requesters to participate in or to **attend** interviews will not be granted. The relief requested by petitioner with respect to recording and transcription would permit attendance by a third party in interviews, in addition to the examiner and the patent owner. Such attendance is not permitted.

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

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

---

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

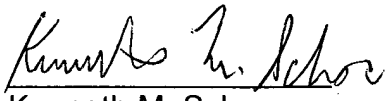
CONCLUSION

1. The petition requesting permission for a representative of the third party requester to observe and/or to transcribe or videotape any examiner interviews in the '8354 proceeding is dismissed.

2. The petition paper is not a proper submission; accordingly, it is being expunged by closing it in the electronic Image File Wrapper (IFW) of the'8354 proceeding and marking it "not public."

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

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

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Charles L. Gholz
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MAILED

FEB 07 2008

CENTRAL REEXAMINATION UNIT

Joseph M. Potenza
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Washington, DC 20005-4051 (For Requester)

In re Singer et al.
Ex parte Reexamination Proceeding
Control No. 90/008,354
Filed: December 1, 2006
For: U.S. Patent No.: 6,314,473

DECISION ON REQUEST TO EXPUNGE THIRD PARTY PETITION

This is a decision on the January 10, 2008 patent owner request to expunge the third party petition filed in the above–captioned proceeding on December 18, 2007, which requested permission for a representative of the third party requester to attend any examiner interviews, that any examiner interviews to be recorded by audio and/or videograph, and that any examiner interviews to be transcribed.

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

The request is dismissed as moot since the petition paper has already been expunged from the proceeding by closing it in the electronic Image File Wrapper (IFW) and marking it "not public" as it was not a proper submission. A decision dismissing the third party petition was mailed January 15, 2008.

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

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

cdd

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Keith R. Jarosik, Esq. (For Requester)
Hanley Flight & Zimmerman, LLC
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Chicago, IL 60606

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MAY 23 2007

CENTRAL REEXAMINATION UNIT

In re Reissue Application of Davies	:	
Application No. 11/361,036	:	
Filed: February 23, 2006	:	
For: U.S. Patent No. 6,694,660	:	**DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS**
In re Davies	:	
Reexamination Proceeding	:	
Control No. 90/008,357	:	
Filed: December 1, 2006	:	
For: U.S. Patent No. 6,694,660	:	

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. 6,694,660 (the '660 patent) issued on February 24, 2004, with 18 claims.

2. An application for reissue, assigned application No. 11/361,036 (the '036 application), was filed by the patent owner on February 23, 2006.

3. The filing of the '036 reissue application was announced in the *Official Gazette* on September 12, 2006.

4. A request for reexamination was filed by a third party requester on December 1, 2006, and was assigned control No. 90/008,357 (the '357 proceeding).

5. Reexamination was ordered for the '357 proceeding on January 8, 2007.

6. On December 6, 2006, a notice of concurrent proceedings was filed by the patent owner in the '357 proceeding, notifying the Office that the '036 application had been previously filed. The third party requestor requested that the '036 application be merged with the '357 proceeding on page 4 of their request for reexamination filed December 1, 2001.

7. A patent owner's statement under 37 CFR 1.530 has not been received in the '357 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. 11/361,036 and reexamination control No. 90/008,357 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. 90/008,357 shows:

(a) Original patent claims 1-18 are present.

(b) No amendments have been made.

A review of reissue application No. 11/361,036 shows:

(a) Original patent claims 1-18 are present, as well as new claims 19, 20.

(b) Original claims 1-3, 7-11, and 15-18 were amended on February 23, 2006.

(c) New claims 19 and 20 were added on February 23, 2006.

At least claims 1-3, 7-11, and 15-20 in the reissue application are not identical to the claims in the reexamination proceeding. **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. 11/361,036 and Control Number 90/008,357. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

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

2. In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings 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. 11/361,036 and reexamination control No. 90/008,357 **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 3600, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '660 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 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.

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
14 May 2007

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OCT 23 2007

TECHNOLOGY CENTER 3600

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(For Patent Owner)

Keith R. Jarosik, Esq.
Hanley Flight & Zimmerman, LLC
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Chicago, IL 60606

(For Requestor)

In re Reissue Application of:
Davies
Serial No.: 11/361,036
Filed: February 23, 2006
For: U.S. Patent No. 6,694,660

In re Davies
Reexamination Proceeding
Control No. 90/008,357
Filed December 1, 2006
For: U.S. Patent No. 6,694,660

DECISION ON PETITION UNDER 37 CFR 1.181 TO ACCEPT PAPERS TIMELY FILED

This is a decision on the petition filed September 24, 2007 under 37 CFR 1.181 to accept papers timely filed.

A review of the record reveals that a decision merging the above reissue application and reexamination proceedings was mailed on May 23, 2007. In that decision, the patent owner was given a time period of one month within which to file a housekeeping amendment in order to place the same amendments in both the reissue and reexamination files.

The file records of the above noted cases do not reveal any amendment as being filed in response to the decision of May 23, 2007.

Petitioner has submitted a copy of the response filed in the Office on June 27, 2007 and a copy of a post card receipt bearing a mail stamp receipt date of June 27, 2007 for the response. Since the response was due on June 25, 2007 (June 23, 2007 was a Saturday), a Certificate of Mailing on the response bearing a June 25, 2007 date of mailing evidenced timely submission of the response. In accordance with the provisions of 37

CFR 1.8(b)(3), petitioner has provided a statement affirming the timely mailing of the response on June 25, 2007.

In view of the above, the response filed June 27, 2007 is accepted as timely filed.

Petitioner is reminded that the time period to respond to the Office action of May 8, 2007 continues to run.

Any inquiry regarding this decision should be directed to Kenneth J. Dorner at (571) 272-6587.

Donald T. Hajec
Director
Technology Center 3600
(571) 272 5150

kjd: 9/26/07

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 07/01/2009

EXAMINER

HANLEY, FLIGHT, & ZIMMERMAN, LLC
150 South Wacker Drive
Suite 2100
Chicago, Illinois 60606

ART UNIT	PAPER NUMBER

DATE MAILED: 07/01/2009

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 07/01/2009

ROBERT A. PARSONS
4000 N. CENTRAL AVENUE, SUITE 1220
PHOENIX, AZ 85012

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/01/2009

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USPTO Customer Number 34431
150 S. Wacker Drive, Suite 2100
Chicago, Illinois 60606

(For Requester)

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JUL 0 1 2009

CENTRAL REEXAMINATION UNIT

In re Reissue Application of: Robert Bruce Davies
Application No. 11/361,036
Filed: February 23, 2006
For: U.S. Patent No. 6,694,660

In re Robert Bruce Davies
Reexamination Proceeding
Control No. 90/008,357
Filed: December 1, 2006
For: U.S. Patent No. 6,694,660

DECISION ON PETITION UNDER 37 CFR 1.182 FOR ENTRY OF PROTEST OF REISSUE APPLICATION

This is a decision on the June 4, 2009 petition under 1.182 for entry of a protest in the above-captioned reissue application and reexamination proceeding.

The petition, reissue application number 11/361,036, and reexamination control number 90/008,357 are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition is dismissed and the papers filed June 4, 2009, are being expunged from the record.

REVIEW OF FACTS

1. U.S. Patent No. 6,694,660 (the '660 patent) issued on February 24, 2004, with 18 claims.

2. An application for reissue of the '660 patent, assigned application No. 11/361,036 (the '036 application), was filed by the patent owner on February 23, 2006.

3. A request for reexamination of the '660 patent was filed by a third party requester on December 1, 2006, and was assigned control No. 90/008,357 (the '8357 proceeding).

4. Reexamination was ordered for the '8357 proceeding on January 8, 2007.

5. A decision merging the '036 reissue application and '8357 reexamination proceeding was mailed on May 23, 2007.

6. Prosecution in the merged proceeding continued to the point that an action closing prosecution as to the merits in accordance with *Ex Parte Quayle* was mailed on April 14, 2009.

7. Requester filed a petition under 37 CFR 1.1.82 for entry of a concurrently filed protest on June 4, 2009. This petition is the subject of this decision.

PERTINENT PROCEDURES

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

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

MPEP 1441.01 ("Protest in Reissue Applications") provides as follows:

> A protest with regard to a reissue application should be filed within the 2-month period following the announcement of the filing of the reissue application in the Official Gazette. If the protest of a reissue application cannot be filed within the 2-month delay period, the protest can be submitted at a later time. Where the protest is submitted after the 2-month period, no petition for entry of the protest under 37 CFR 1.182 is needed with respect to the protest being submitted after the 2 months, unless a final rejection has been issued or prosecution on the merits has been otherwise closed for the reissue application.
>
> ...
>
> Where a final rejection has been issued or the prosecution on the merits has been otherwise closed, a petition under 37 CFR 1.182 along with the required petition fee (37 CFR 1.17(f)) for entry of the protest are required. ***The petition must include an explanation as to why the additional time was necessary*** and the

nature of the protest intended. A copy of the petition must be served upon the applicant in accordance with 37 CFR 1.248. (Emphasis Added)

DISCUSSION

As noted above, an action closing prosecution on the merits in the merged proceeding was mailed on April 19, 2009. Subsequently, requester filed this petition to have a protest entered and considered in the reissue application. According to the procedures set out in MPEP 1441 (and reproduced above), protester must file a petition that includes an explanation as to why the additional time for filing the protest was necessary.

Petitioner states that the reference that forms the basis of the protest was first discovered on May 7, 2009 and the reference was submitted to the USPTO on May 15, 2009 as a submission under 35 U.S.C. 301. Petitioner further states he was first made aware of the necessity of filing a petition under 1.182 on June 3, 2009, and thus, the reference was submitted as a protest pursuant to 37 CFR 1.291.

The statements provided in the petition merely address the events from the discovery of the reference on May 7, until the filing of the petition for consideration of the protest on June 4. There is no sufficient explanation of why the additional time from the expiry of the 2-month protest period, or at the very least from the date of the action closing prosecution (April 19, 2009) until the submission was necessary.

A general statement that the reference was first discovered on May 7, 2009 without an explanation of what efforts were previously made, how the reference was discovered, and why the reference first turned up at this late date does not adequately explain the delay. Protesters are not free to await the close of prosecution to initiate a search for prior art and then retard the orderly conclusion of a proceeding.

The petition is dismissed.

Furthermore, the petition is not limited to "the nature of the protest intended" (e.g., prior art reference relevant to patentability); instead it includes a discussion[1] of the prosecution history and the nature of applying the art to the claim. This amounts to a protest in itself. Accordingly, the petition paper and the accompanying reference filed June 4, 2009 will be expunged from the file by marking them as "closed" in the image file wrapper (IFW)[2] rendering them unavailable for viewing by the public.

---

[1] See the first two paragraphs on page 2 of the petition.

[2] Office practice is not to make a protest part of the IFW until a determination is made that it is a proper protest. However, it appears that the procedure was not followed in this instance.

CONCLUSION

1. The petition is dismissed.

2. The petition and the accompanying protest are being expunged from the record.

3. Jurisdiction over the merged proceeding is being returned to Technology Center 3600 for appropriate action.

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

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

7/1/09
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 07/28/2009

ROBERT A. PARSONS
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/28/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HANLEY, FLIGHT & ZIMMERMAN, LLC
150 SOUTH WACKER DRIVE
SUITE 2100
CHICAGO, IL 60606

Date:
MAILED
JUL 28 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008357
PATENT NO. : 6694660
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)).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/361,036	02/23/2006	Robert Bruce Davies	4151-A7R	3022

29370 7590 07/29/2009

ROBERT A. PARSONS
4000 N. CENTRAL AVENUE, SUITE 1220
PHOENIX, AZ 85012

EXAMINER	
CHAMBERS, TROY	
ART UNIT	PAPER NUMBER
3641	
MAIL DATE	DELIVERY MODE
07/29/2009	PAPER

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

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

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Robert A. Parsons
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(For Patent Owner)

MAILED

JUL 28 2009

CENTRAL REEXAMINATION UNIT

Keith R. Jarosik
Hanley, Flight & Zimmerman, LLC
USPTO Customer Number 34431
150 S. Wacker Drive, Suite 2100
Chicago, Illinois 60606

(For Requester)

In re Reissue Application of: Robert Bruce Davies
Application No. 11/361,036
Filed: February 23, 2006
For: U.S. Patent No. 6,694,660

In re Robert Bruce Davies
Reexamination Proceeding
Control No. 90/008,357
Filed: December 1, 2006
For: U.S. Patent No. 6,694,660

DECISION ON PETITION UNDER 37 CFR 1.182 FOR ENTRY OF PROTEST OF REISSUE APPLICATION

This is a decision on the July 13, 2009 petition under 37 CFR 1.182 for entry of a protest in the above-captioned reissue application and reexamination proceeding.

The petition, reissue application number 11/361,036, and reexamination control number 90/008,357 are before the Office of Patent Legal Administration for consideration.

The petition is granted and the papers filed July 13, 2009, are being entered into the record of the merged proceeding.

REVIEW OF FACTS

1. U.S. Patent No. 6,694,660 (the '660 patent) issued on February 24, 2004, with 18 claims.

2. An application for reissue of the '660 patent, assigned application No. 11/361,036 (the '036 application), was filed by the patent owner on February 23, 2006.

3. A request for reexamination of the '660 patent was filed by a third party requester on December 1, 2006, and was assigned control No. 90/008,357 (the '8357 proceeding).

4. Reexamination was ordered for the '8357 proceeding on January 8, 2007.

5. A decision merging the '036 reissue application and '8357 reexamination proceeding was mailed on May 23, 2007.

6. Prosecution in the merged proceeding continued to the point that an action closing prosecution as to the merits in accordance with *Ex Parte Quayle* was mailed on April 14, 2009.

7. Requester filed a petition under 37 CFR 1.1.82 for entry of a concurrently filed protest on June 4, 2009.

8. A decision was mailed July 1, 2009 dismissing the June 4, 2009 petition for failing to adequately explain the circumstances that engendered the delay in filing of the protest.

9. Requester filed a second petition under 37 CFR 1.1.82 for entry of a concurrently filed protest on July 13, 2009. This petition is the subject of this decision.

PERTINENT PROCEDURES

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

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

MPEP 1441.01 ("Protest in Reissue Applications") provides as follows:

> A protest with regard to a reissue application should be filed within the 2-month period following the announcement of the filing of the reissue application in the Official Gazette. If the protest of a reissue application cannot be filed within the 2-month delay period, the protest can be submitted at a later time. Where the protest is submitted after the 2-month period, no petition for entry of the protest under 37 CFR 1.182 is needed with respect to the protest being submitted after the 2 months, unless a final rejection has been issued or prosecution on the merits has been otherwise closed for the reissue application.

...

> Where a final rejection has been issued or the prosecution on the merits has been otherwise closed, a petition under 37 CFR 1.182 along with the required petition fee (37 CFR 1.17(f)) for entry of the protest are required. ***The petition must include an explanation as to why the additional time was necessary*** and the nature of the protest intended. A copy of the petition must be served upon the applicant in accordance with 37 CFR 1.248. (Emphasis Added)

DISCUSSION

As noted above, an action closing prosecution on the merits in the merged proceeding was mailed on April 19, 2009. Subsequently, on June 4, 2009, requester filed a petition to have a protest entered and considered in the reissue application. That petition was dismissed in a decision mailed July 1, 2009. The decision stated:

> The statements provided in the petition merely address the events from the discovery of the reference on May 7, until the filing of the petition for consideration of the protest on June 4. There is no sufficient explanation of why the additional time from the expiry of the 2-month protest period, or at the very least from the date of the action closing prosecution (April 19, 2009) until the submission was necessary.

Furthermore, the petition paper itself was expunged because it was not limited to "the nature of the protest intended" and was thus deemed to amounts to a protest in itself.

The petition filed July 13, 2009, is found to provide an adequate explanation as to why the additional time for filing the protest was necessary. Accordingly, the petition is granted.

CONCLUSION

1. The petition is granted.

2. The protest is accepted for entry in the record of the merged proceeding.

3. Jurisdiction over the merged proceeding is being returned to Technology Center 3600 for appropriate action.

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

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

7/28/09
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,361	12/08/2006	6243725	1482-0001.03	6873

70653 7590 12/29/2008

LAW OFFICES OF EUGENE M. CUMMINGS, P.C.
ONE NORTH WACKER DRIVE
SUITE 4130
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: DEC 29 2008

Donald J. Quigg, Esq.
NOVAK DRUCE & QUIGG LLP
1000 Louisiana Ave., Wells Fargo Plaza 53rd Fl
Houston, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008361
PATENT NO. : 6243725
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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LAW OFFICES OF EUGENE M. CUMMINGS, P.C. (For Patent Owner)
ONE NORTH WACKER DRIVE
SUITE 4130
CHICAGO, IL 60606

NOVAK DRUCE & QUIGG LLP (For Third-Party Requester)
1000 Louisiana Ave., Wells Fargo Plaza 53rd Floor
Houston, TX 77002

In re Heppleman *et alia*
Reexamination Proceeding
Control No. 90/008,361
Request Deposited: December 8, 2006
For: U.S. Patent No. 6,243,725

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

This is a decision on the October 22, 2008, "PETITION FOR EXTENSION OF TIME FOR FILING APPEAL BRIEF" requesting that the time to submit an Appeal Brief be extended one month.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,243,175 (hereinafter, the '175 patent), issued to Heppleman *et alia*, on June 5, 2001.

2. On December 8, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '175 patent. The reexamination proceeding was assigned Control No. 90/008,361 (hereinafter, the '8361 proceeding).

3. The reexamination order was granted in the '8361 proceeding on February 27, 2007.

4. Later in prosecution, a Notice of Appeal was filed on September 15, 2008.

5. The present petition was filed on October 22, 2008.

6. An appeal brief was timely filed on November 12, 2008.

DECISION

The request for an extension of time is **dismissed as moot** in view of the timely filed appeal brief on November 12, 2008.

CONCLUSION

1. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

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

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

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P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Patent Owner)

MAILED

JUN 28 2007

CENTRAL REEXAMINATION UNIT

JAY MONAHAN
eBAY INC.
2145 HAMILTON AVENUE
SAN JOSE, CA 95125

(For Requester)

In Woolston
Reexamination Proceeding
Control No. 90/008,362
Filing Date: April 3, 2007
For: U.S. Patent No. 6,202,051

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181(a)(1)

The April 26, 2007 patent owner's "Petition Under 37 CFR 1.181(a)(1)" requesting that the filing date of the reexamination request be vacated, and the third party requestor's May 7, 2007 comments in response to the patent owner petition, are before the Office of Patent Legal Administration for consideration of whether to vacate the assigned filing date for failure to comply with the provisions of 37 CFR 1.510.

The PETITION is DISMISSED for the reasons explained below. This decision constitutes notice that the request is signed by a proper party, in compliance with the requirements for an *ex parte* reexamination proceeding set forth in 35 U.S.C. 302 and 37 CFR 1.510.

See MPEP 2210, MPEP 2212, and MPEP 324, Part V.

REVIEW OF FACTS RELEVANT TO THE DECISION

1. U.S. Patent No. 6,202,051 (hereinafter, the '051 patent), issued to Woolston, on March 13, 2001, from an application filed on February 19, 1999.

2. On April 3, 2007, a third party, eBay, Inc., deposited a corrected request for *ex parte* reexamination of claims 13, 33-35, and 52 of the '051 patent, made pursuant to 37 CFR 1.510.[1] Mr. Jay Monahan, who established on the record that he is the Vice President and Assistant Secretary of eBay, Inc, signed the corrected request for reexamination. Mr. Monahan stated that he has the authority to sign for eBay, Inc. and can bind the company. The reexamination proceeding was assigned Control No. 90/008,362 (hereinafter, the '8362 proceeding).

3. On April 12, 2007, a "Notice of *Ex Parte* Reexamination Request Filing Date" was mailed for the '8362 proceeding. The notice assigned the filing date of April 3, 2007 for the request for reexamination.

4. On April 26, 2007, the patent owner filed the present petition under 37 CFR 1.181(a)(1), requesting that the assigned filing date be vacated for failure to comply with 37 CFR 1.510(f) and 1.34.

5. On May 7, 2007, the third party requester filed comments in response to the above-mentioned petition.

DECISION

I. Relevant Statute and Regulations:

Emphasis is provided in bold in the statute and regulations that follow:

> 35 U.S.C. 302 Request for reexamination.
>
> **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. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Director pursuant to the provisions of section 41 of this title. The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. Unless the requesting person is the owner of the patent, the Director promptly will send a copy of the request to the owner of record of the patent.

[1] The original request for reexamination was submitted on December 11, 2006, but was not compliant with the filing date requirements of 37 CFR 1.510, and therefore, did not receive a filing date.

37 CFR 1.510 Request for *ex parte* reexamination.

(a) **Any person** may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).

*****

37 CFR 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

*****

(b)*Amendments and other papers*. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application **must be signed by**:

(1) A patent practitioner of record appointed in compliance with § 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

37 CFR 3.71. Prosecution by assignee.

(a) Patents — conducting of prosecution. One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, **conduct prosecution of a** national patent application or a **reexamination proceeding** to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) Patents — assignee(s) who can prosecute. **The assignee(s) who may conduct** either the **prosecution of a** national application for patent or a **reexamination proceeding** are:

(1) **A single assignee.** An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) Partial assignee(s) together or with inventor(s). All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) Patents — Becoming of record. An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by **a party who is authorized to act on behalf of the assignee**.

§ 3.73 Establishing right of assignee to take action.

****

(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.

II. Analysis and Findings:

A review of the proceeding papers reveals that the request is properly signed in accordance 35 U.S.C. 302 and 37 CFR 1.510 and 1.33. 35 U.S.C. 302 and 37 CFR 1.510(a) both state that "any person" may file a request for reexamination of a patent. Accordingly, there are no persons who are excluded from being able to seek reexamination. MPEP 2212 provides:

> 35 U.S.C. 302 and 37 CFR 1.510(a) both indicate that "any person" may file a request for reexamination of a patent. Accordingly, there are no persons who are excluded from being able to seek reexamination. Corporations and/or governmental entities are included within the scope of the term "any person."

Corporations are included within the scope of the term "any person." Therefore, eBay, Inc. can file a request for reexamination pursuant to 35 U.S.C. 302 and 37 CFR 1.510.

37 CFR 1.33(b) requires that all correspondence with the Office be signed by the appropriate party or parties. An assignee, which can be a corporation, or other business

entity or organization, can sign correspondence submitted to the Office in compliance with 37 CFR 1.33(b)(3). The provisions of 37 CFR 1.33(b) taken with 37 CFR 3.17 and 3.73 provide for a corporation assignee to sign papers via a person "who is authorized to act on behalf of the assignee." The person signing the correspondence in the name of the organization must have either apparent authority, or express authority, to sign on behalf of the organization. See 37 CFR 3.73(b)(2)(ii) and MPEP 324, subsection V. An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority (e.g., has apparent authority) to sign on behalf of the organization. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. Further, any person may sign the correspondence, if the correspondence sets forth express authority to sign by stating that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. See 37 CFR 3.73(b)(2)(i).

The corrected request for reexamination, dated April 3, 2007, establishes both apparent and express authority of the signatory, Mr. Jay Monahan, to sign on behalf of eBay, Inc. Specifically, page 1 of the corrected request for reexamination states that:

> As is set forth in paragraph two of my attached declaration ("Monahan Dec."), I am an Officer of eBay Inc. ("eBay"), and serve as Vice President and Assistant Secretary of eBay. As a corporate Officer, I am authorized to act on behalf of eBay and have the power to bind the company. Monahan Dec. at ¶3. When I sign papers for filing with the U.S. Patent and Trademark Office concerning eBay's requests for reexamination of U.S. Patent No. 6,202,051, I do so solely in my corporate capacity for eBay, and not as eBay's legal representative. Monahan Dec. at ¶4. I am acting in my corporate capacity in submitting this Replacement Request For Ex Parte Reexamination, which is submitted by eBay.

Accordingly, the record is clear that Mr. Jay Monahan is signing the request papers on behalf of eBay in his corporate capacity, and is not a legal representative of eBay. Stated another way, eBay, Inc., is acting without legal representation (e.g., *pro se*), by way of a party authorized to act and sign on behalf of the corporation. In contradiction to the position advanced by the patent owner, the provisions of 37 CFR 1.510(f) and 37 CFR 1.34 are not applicable in this instance, because Mr. Jay Monahan is not acting as a legal representative of eBay, Inc., in this proceeding. Therefore, the request is deemed to be properly signed in accordance with Office rules and procedures.

CONCLUSION

1. The request is properly signed in accordance 35 U.S.C. 302 and 37 CFR 1.510 and 1.33.

2. Accordingly, the PETITION is DISMISSED.

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

4. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714 or Andy Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence, to Legal Advisors Stephen Marcus at (571) 272-7743, or Pinchus M. Laufer at (571) 272-7726.

Kenneth M Schor
Senior Legal Advisor
Office of Patent Legal Administration

June 28, 2007
C:\kiva\kenreex\file-date\ 8362 pet-to-vacate-fd_assignee-signed.doc
C:\kiva\kenassignment\ 8362 pet-to-vacate-fd_assignee-signed.doc

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AUG 08 2008

CENTRAL REEXAMINATION UNIT

Courtesy Copy:
Abraham Hershkovitz
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

In re Woolston.	:
Reexamination Proceeding	:
Control No.: 90/008,362	: **DECISION**
Filed: April 3, 2007	: **ON PETITION**
For: U.S. Patent No.: 6,202,051	: **UNDER 37 CFR 1.182**
	:

This is a decision on the July 14, 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 for decision.

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed July 14, 2008, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,202,051 (the '051 patent) issued on March 13, 2001.

2. A request for reexamination, assigned control No. 90/008,362 (the '8362 proceeding), was filed on April 3, 2007 by third party requester, EBAY.

3. On June 28, 2007 the Office issued an order granting the '8362 reexamination request.

4. The'8362 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on August 31, 2007.

5. On March 5, 2008 the Office received assignments of ownership of the '051 patent from patent owner MERCEXCHANGE LLC to the third party requester EBAY recorded on February 29, 2008 at real/frame numbers 020609/0318 and 020609/0321.

6. On May 9, 2008 the new patent owner (EBAY) submitted a revocation and power of attorney and a change of correspondence address.

7. On May 16, 2008 new patent owner submitted an authorization to act in a representative capacity.

8. On July 14, 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.

9. The '8362 reexamination proceeding is being processed toward publication of the reexamination certificate.

RELEVANT LAW AND PROCEDURE

37 CFR 1.4(c) states:

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

35 U.S.C. 305 states (in part):

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2256 states (in part):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and **(B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. [Emphasis added]

DECISION

I. Pursuant to 37 CFR 1.4(c), 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.

Patent owner has submitted alternative requests for relief, including entry and consideration of a post NIRC IDS, holding in abeyance the issuance of the Reexamination Certificate, suspension of the '6984 reexamination proceeding, and a request to reopen prosecution for future submission of an amendment at some unspecified time in the future. A single submission containing such different matters is improper as it runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for separately distinct and different matters, and also is contrary to the statutory requirement for special dispatch in reexamination, as the individual

issues are commingled. Therefore, the July 14, 2008 submission from the third party requester is improper under 37 CFR 1.4(c) and is dismissed.

II. While no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS exists, the policy for withdrawal from the publication process after the NIRC has been mailed, but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as noted above.

In the present instance, the submission fails to satisfy item (B) because there is no explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. As patent owner has not fully satisfied the requirements of item (B) with regard to the references submitted, at this late stage of reexamination the present petition does not meet the requirements necessary for consideration of an IDS after a NIRC has been mailed.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on August 31, 2007, and the proceeding is in the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite discussion of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is dismissed as to the request for consideration of the IDS papers.

If, however, the patent owner in fact believes that any reference submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s).

III. The IDS submitted by patent owner will be placed in the file, and will remain of record. However, because prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

CONCLUSION

1. The petition is dismissed.

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

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

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor 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

8-6-08
c:\Kiva\kenids\decisions\6984 IDS after NIRC mailed_suspension_1.4(c).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.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 02/06/2009

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/06/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAN MONAHAN
EBAY INC.
2145 HAMILTON AVENUE
SAN JOSE,CA 95125

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008362
PATENT NO. : 6202051
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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Schwegman, Kundberg & Woessner/EBAY (Requester, now Patent Owner)
PO Box 2938
Minneapolis, MN 55402

MAILED

FEB 06 2009

CENTRAL REEXAMINATION UNIT

In re Woolston :
Reexamination Proceeding :
Control No.: 90/008,362 : **DECISION**
Filed: April 3, 2007 : **ON**
For: U.S. Patent No.: 6,202,051 : **PETITION**
:

This is a decision on the February 4, 2009 patent owner petition under 37 CFR 1.182 or 37 CFR 1.183 requesting a seven (7) day emergency stay in this reexamination proceeding.

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

The petition is **granted** to the extent that OPLA will retain jurisdiction over the proceeding for the duration set forth below.

The $400 fee required by 37 CFR 1.182 and 37 CFR 1.17(f) for the February 4, 2008 patent owner petition was charged to patent owner's credit card, as authorized by the patent owner in the February 4, 2009 EFS-web submission.

BACKGROUND

1. Patent number 6,202,051 (the '051 patent) issued on March 13, 2001.

2. A request for reexamination, assigned control No. 90/008,362 (the '8362 proceeding), was filed on April 3, 2007, by third party requester, EBAY.

3. On June 28, 2007, the Office issued an order granting the '8362 reexamination request.

4. The'8362 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on August 31, 2007.

5. On March 5, 2008, the Office received assignments of ownership of the '051 patent from patent owner MERCEXCHANGE LLC to the third party requester EBAY recorded on February 29, 2008 at real/frame numbers 020609/0318 and 020609/0321.

6. On May 9, 2008, the new patent owner (EBAY) concurrently submitted, for the present reexamination proceeding, a revocation and power of attorney, a certificate under 37 CFR 3.73(b) and a change of correspondence address.

7. On May 16, 2008, new patent owner submitted an authorization to act in a representative capacity.

8. On July 14, 2008, new patent owner submitted an IDS containing several references and petitioned under 37 CFR 1.182, requesting, *inter alia*, post NIRC entry and consideration of the IDS.

9. On August 8, 2008, the Office dismissed new patent owner's request for entry and consideration of an IDS submission after NIRC.

10. On November 6, 2008, patent owner submitted a petition requesting withdrawal of the NIRC and a reopening of prosecution in the present proceeding.

11. On January 15, 2009, patent owner's November 6, 2008 petition was expunged from the record as improper.

12. On February 4, 2009, patent owner submitted the instant petition requesting an emergency stay of the '8362 reexamination proceeding.[1]

DECISION

Based upon the specific facts and circumstances in the present proceeding, petitioner patent owner's request for a stay of the '8362 reexamination proceeding due to exigency is granted to the extent that OPLA will retain jurisdiction over the proceeding for seven (7) business days from the February 4, 2009 submission date of the emergency petition, and longer, if the petition submissions, which were the basis for exigency, are timely received. Any submission by patent owner must be received by the Office NO LATER THAN close of official business on Friday, February 13, 2009, at 5:00 P.M. Eastern Standard Time.

CONCLUSION

1. The petition is **granted** to the extent that OPLA will retain jurisdiction over the '8362 reexamination proceeding for the duration set forth above.

2. Any submission on this matter by patent owner must be received by the Office NO LATER THAN close of official business on February 13, 2009, at 5:00 P.M. Eastern Standard time.

3. 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.

Kenneth M. Schor

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

[1] The petition was signed by counsel who is not of record in the '8362 proceeding. The petition was signed by a practitioner who set forth their name and registration number. Therefore the petition was accepted as in accordance with 37 CFR 1.34.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 06/22/2009

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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Schwegman, Lundberg & Woessner
PO Box 2938
Minneapolis, MN 55402

(Third Party Requester EBAY,
Now Patent Owner)

MAILED

JUN 22 2009

CENTRAL REEXAMINATION UNIT

In re Woolston
Reexamination Proceeding
Control No.: 90/008,362
Filed: April 3, 2007
For: U.S. Patent No.: 6,202,051

: **DECISION**
: **ON**
: **PETITION**

This is a decision on the February 13, 2009 patent owner petition under 37 CFR 1.182 requesting reopening of prosecution and entry of an amendment after Notice of Intent to Issue a Reexamination Certificate.

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

The petition is **denied**

Petitioner EBAY has already made a prior non-compliant submission including a request to reopen prosecution, and has, to date, not placed the present proceeding in a condition where reopening would resolve issues consistent with the statutory requirement of special dispatch. To the contrary, EBAY has submitted an informal amendment which includes an attempt to re-prosecute an issue previously addressed in related *ex parte* reexamination proceeding 90/006984 (the '6984 proceeding), and has failed to explain the relevance of the art/information (both of record and newly submitted in EBAY's companion petition submitted on even date) *to the newly proffered set of claim limitations*. On the other hand, a completed extensive prosecution exists as to the claims which were previously presented of record, which is ready to enter the reexamination certificate printing cycle. Accordingly, this decision is made a final agency action.

The $400 fee required by 37 CFR 1.182 and 37 CFR 1.17(f) for the February 13, 2009 patent owner petition was charged to Deposit Account no. 14-1437, as authorized by the February 13, 2009 petition.

BACKGROUND

1. Patent number 6,202,051 (the '051 patent) issued on March 13, 2001.

2. On March 15, 2001 the Office received and processed a recordation of assignment of the '051 patent, assigning the '051 patent to MERCEXCHANGE LLC.

3. A request for reexamination, assigned control No. 90/008,362 (the '8362 proceeding), was filed on April 3, 2007, by third party requester, EBAY.

4. On June 28, 2007, the Office issued an order granting the '8362 reexamination request.

5. The'8362 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on August 31, 2007.

6. On February 29, 2008, the Office received, for recordation in its assignment records, assignments of ownership of the '051 patent from patent owner MERCEXCHANGE LLC to the third party requester EBAY executed on February 25, 2008. The assignments were recorded by the Office at real/frame numbers 020609/0318 and 020609/0321.

7. On May 9, 2008, the new patent owner, EBAY, submitted, for the present reexamination proceeding, a revocation and power of attorney, a certificate under 37 CFR 3.73(b) and a change of correspondence address.

8. On May 16, 2008, patent owner submitted an authorization to act in a representative capacity.

9. On July 14, 2008, patent owner submitted an IDS containing several references and petitioned under 37 CFR 1.182, requesting, *inter alia*, post NIRC entry and consideration of the IDS.

10. On August 8, 2008, the Office dismissed patent owner's request for entry and consideration of an IDS submission after NIRC.

11. On November 6, 2008, patent owner submitted a petition requesting withdrawal of the NIRC and a reopening of prosecution in the present proceeding.

12. On January 15, 2009, patent owner's November 6, 2008 petition was expunged from the record as improper.

13. On February 4, 2009, patent owner submitted a petition requesting an emergency stay of the '8362 reexamination proceeding.[1]

14. On February 6, 2009, the Office issued a decision granting patent owner's request to stay the proceeding to permit patent owner an opportunity to "cure" matters of inequitable conduct.

15. On February 13, 2009, patent owner filed a petition under 37 CFR 1.182 requesting a reopening of prosecution and entry of an amendment after NIRC (the § 1.182 petition).[2] This petition is the subject of the instant decision, which addresses petitioner's request for reopening of prosecution and entry of an amendment after NIRC.

16. Also on February 13, 2009, patent owner submitted a petition under 37 CFR 1.182

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[1] The petition was signed by counsel who is not of record in the '8362 proceeding. The petition was signed by a practitioner who set forth their name and registration number. Therefore the petition was accepted as in accordance with 37 CFR 1.34.

[2] *Id.*

requesting entry and consideration of information submitted concurrent with the petition and previously filed, all of which were filed after issuance of a NIRC.[3]

17. On February 14, 2009, patent owner submitted additional information in support of the petitions.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 states (in part):

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. [Emphasis added.]

MPEP 2256 states (in part):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. [Emphasis added]

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.

DECISION

I. Untimely Submissions

Patent owner was given until NO LATER THAN close of official business on Friday, February 13, 2009, at 5:00 P.M. Eastern Standard Time, to submit a petition to cure issues of inequitable conduct. A petition to reopen prosecution was received, as evidenced by the EFS-web time and date stamp, by the Office on Friday, February 13, 2009 at 9:48 PM EST. Therefore the

[3] *Id.*

submissions are untimely. However, while jurisdiction had technically transferred to the Central Reexamination Unit (CRU), such transfer had not occurred as it was after business hours. As the Office of Patent Legal Administration retained actual jurisdiction and the submissions were received on the last day of the response period, and in the interest of the equities of the situation, the petition to reopen prosecution has been considered.

II. Previous Decisions Regarding Submissions of Information after Issuance of a NIRC

Patent owner has stated on page 4, second half of the first full paragraph of section (I) of their petition,

> "After becoming the patent owner [*sic* EBay], began an analysis of the claims that had been confirmed as being patentable. While that analysis was proceeding, eBay also undertook to submit information disclosure statements on August 2, 2008 [*sic* July 14, 2008] and November 6, 2008, *but the Office refused to consider the submissions.*" [Emphasis added.]

The above statement by patent owner is not a complete and accurate statement of the procedural facts referred to by patent owner. In addition to the submission of information disclosure statements on the noted dates, patent owner also submitted petitions under 37 CFR 1.182 requesting, *inter alia*, the entry and consideration of the information reflected in the information disclosure statements. The dates on which patent owner submitted information disclosure statements, i.e., July 14, 2008 and November 6, 2008, are both after issuance of the NIRC. In decisions mailed August 8, 2008 and January 15, 2009, petitioner was referred to the relevant sections of the MPEP and advised of the necessary actions to meet the standard for papers to qualify for entry and consideration at this point in prosecution. Despite MPEP guidance and the aforementioned decisions, petitioner to date has not complied with the requirements.

The decisions mailed August 8, 2008 and January 15, 2009 do not constitute a "refusal to consider." Instead, they evidence petitioner's failure to comply with clearly outlined procedure. The entry and consideration of information disclosure statements submitted after issuance of a NIRC ***requires*** the submission of a ***grantable*** petition that satisfies ***all*** relevant requirements that are set forth in MPEP 2256 for the purpose of furthering the statutorily mandated requirement of special dispatch in resolving reexamination proceedings. Neither petition that accompanied patent owner's information disclosure statements submitted on July 14, 2008 and November 6, 2008 satisfied all the relevant requirements as set forth in MPEP 2256. Therefore, to the extent that patent owner/petitioner did not submit a grantable petition under MPEP 2256, the Office did not enter and consider the information submitted on July 14, 2008 and November 6, 2008. However, the information submitted on July 14, 2008 was placed in the file. The information submitted on November 6, 2008 was expunged due to the petitioner raising issues beyond the scope of reexamination.

III. Decision on February 13, 2009 Petition to Reopen Prosecution under 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '8362 reexamination proceeding to provide consideration of a two page paper consisting of a set of claims with underlined annotations adding language to a listed set of claims. No attempt is made to style the paper in the form of a response compliant with the rules for submission of a response.[4] Nor does the paper or the petition state to which Office action in the record patent

[4] See 37 CFR §§ 1.550(a), 1.530(e) and 1.104 through 1.116.

owner is attempting to respond, and how these claims would define over the art/information previously of record, and the art/information petitioner is trying to make of record via the petition filed on even date with this petition.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [5] 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. 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, a patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to resolve issues, 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, rather than one which would delay prosecution.

In the present case, petitioner's submission is in the form of an informal amended claim set with a few minimal remarks/comments in support of the "amendment," found in the petition's text bridging pages five and six. It does not include an explanation of the relevance, to the newly proffered set of claim limitations, of the large volume of art/information of record and newly submitted art/information in EBAY's companion petition submitted on even date. Petitioner simply wishes the Office to reopen prosecution and newly analyze the submission in terms of the record, for a re-prosecution of the proceeding. Such is not found to be a *bona fide* effort to advance prosecution, and as such, the granting of the present petition is inconsistent with the requirement of 35 U.S.C. 305 to conduct *ex parte* reexamination proceedings "with special dispatch within the Office."

It is further observed that petitioner's sole argument to justify the granting of the ***extraordinary*** relief of a request for continued reexamination is that the language added regarding "trusted consignment nodes" is believed to more clearly distinguish over the known prior art. Petitioner concedes that this language was previously raised by prior patent owner MERCEXCHANGE LLC in the '6984 proceeding during an interview conducted on November 2, 2005.[6] However, petitioner patent owner fails to disclose that, in the '6984 proceeding, the claim limitations which embrace the "trusted consignment nodes" subject matter were determined to not render the claims patentable.[7,8] Patent owner, in the '6984 proceeding, obviated the rejections of record related to the issues of unpatentability regarding the claims containing limitations to the "trusted consignment node" subject matter by cancelling the claims, *i.e.* acquiescing and conceding to the propriety of the rejections regarding the unpatentability of the "trusted consignment node"

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[5] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

[6] See the text bridging pages five and six of the February 13, 2009 patent owner petition that is the subject of this decision. The '6984 proceeding being an earlier filed, but unmerged, reexamination proceeding of the '051 patent between the same parties as the '8362 proceeding.

[7] '6984 proceeding Office action dated October 2, 2006 finding that patent claims with limitations regarding "trusted consignment node" subject matter were unpatentable under 35 USC § 112 and § 103.

[8] Patent owner is reminded that they have a duty of candor and good faith in prosecution before the Office in a reexamination in accordance with 37 CFR 1.55(a) in regards to omissions as well as positive statements and actions taken before the Office.

subject matter.[9] In other words patent owner, instead of presenting a submission that is a *bona fide* effort to advance the prosecution toward a rapid resolution, is now attempting to re-prosecute an issue that has already been addressed and resolved.[10] The presentation of an issue of record that has already been addressed and resolved during prosecution of a reexamination proceeding regresses the proceeding and thus does not advance prosecution, and is therefore inconsistent with the statutory mandate of special dispatch. Therefore, in view of the above, and the fact situation presented by the record, the petition is denied, and jurisdiction over the '8362 proceeding is returned to the CRU to take immediate action toward publication of the reexamination certificate in accordance with Office's mandate of special dispatch.

CONCLUSION

1. The petition is **denied**.

2. This decision is designated as a final agency action under 5 U.S.C. § 704.

3. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

4. Jurisdiction over the proceeding is transferred to the Central Reexamination Unit (CRU) for immediate forwarding to Publications Branch for reentry into the printing cycle and issuance of a reexamination certificate in accordance with the statutory mandate of special dispatch.

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 in his absence Pinchus M. Laufer, Legal Advisor at (571) 272-7726 or in his absence the undersigned at (571) 272-7710.

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

[9] See patent owner's response to the October 2, 2006 Office action in the '6984 proceeding, dated December 8, 2006 which cancelled all claims containing the "trusted node" subject matter, specifically claims 53-104.
[10] *Id.*

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.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 06/22/2009

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Schwegman, Lundberg & Woessner
PO Box 2938
Minneapolis, MN 55402

(Third Party Requester EBAY,
now Patent Owner)

MAILED

JUN 22 2009

CENTRAL REEXAMINATION UNIT

In re Woolston
Reexamination Proceeding
Control No.: 90/008,362
Filed: April 3, 2007
For: U.S. Patent No.: 6,202,051

: **DECISION**
: **ON**
: **PETITION**

This is a decision on the February 13, 2009 patent owner petition under 37 CFR 1.182 requesting entry and consideration of information submitted both concurrently and previously filed after issuance of a Notice of Intent to Issue a Reexamination Certificate.

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

The $400 fee required by 37 CFR 1.182 and 37 CFR 1.17(f) for the February 13, 2009 patent owner petition will be charged to Deposit Account no. 14-1437, as authorized by the February 13, 2009 petition.

SUMMARY

The petition is **denied**.

Petitioner EBAY purchased U.S. Patent No. 6,202,051 (the '051 patent) on February 25, 2008, six months after the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC). All allegations of inequitable conduct leveled against the previous patent owner, MERCEXCHANGE LLC, were made by EBAY in litigation between EBAY and MERCEXCHANGE LLC regarding the '051 patent. Therefore, patent owner EBAY was fully aware of all patentability issues regarding inequitable conduct on the part of the previous owner of the patent, and their potential impact on the patent, when EBAY purchased the '051 patent from MERCEXCHANGE LLC. Furthermore, EBAY was fully aware that prosecution had been completed in the reexamination proceeding, and was not subject to reopening in the ordinary course of reexamination. EBAY has had over a year since its purchase to properly bring to the Office's attention the need to cure matters of inequitable conduct, and do so pursuant to the only avenue provided for same as outlined in MPEP 2256. Yet, to date, EBAY has failed to submit the matter to the Office in a manner that would permit entry, and minimize the delay running counter to special dispatch. (The failure to comply with Office procedure is set forth below). EBAY has already made a prior non-compliant submission to address the issue. EBAY has been advised on the proper procedure to comply, and has caused significant delay up to this point in time by still not complying in the present petition. Therefore this decision is made a final agency action.

BACKGROUND

1. Patent number 6,202,051 (the '051 patent) issued on March 13, 2001.

2. On March 15, 2001 the Office received and processed a recordation of assignment of the '051 patent, assigning the '051 patent to MERCEXCHANGE LLC.

3. A request for reexamination, assigned control No. 90/008,362 (the '8362 proceeding), was filed on April 3, 2007, by third party requester, EBAY.

4. On June 28, 2007, the Office issued an order granting the '8362 reexamination request.

5. The'8362 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on August 31, 2007.

6. On February 29, 2008, the Office received, for recordation in its assignment records, assignments of ownership of the '051 patent from patent owner MERCEXCHANGE LLC to the third party requester EBAY executed on February 25, 2008. The assignments were recorded by the Office at real/frame numbers 020609/0318 and 020609/0321.

7. On May 9, 2008, the new patent owner, EBAY, submitted, for the present reexamination proceeding, a revocation and power of attorney, a certificate under 37 CFR 3.73(b) and a change of correspondence address.

8. On May 16, 2008, patent owner submitted an authorization to act in a representative capacity.

9. On July 14, 2008, patent owner submitted an IDS containing several references and petitioned under 37 CFR 1.182, requesting, *inter alia*, post NIRC entry and consideration of the IDS.

10. On August 8, 2008, the Office dismissed patent owner's request for entry and consideration of an IDS submission after NIRC.

11. On November 6, 2008, patent owner submitted a petition requesting withdrawal of the NIRC and a reopening of prosecution in the present proceeding.

12. On January 15, 2009, patent owner's November 6, 2008 petition was expunged from the record as improper.

13. On February 4, 2009, patent owner submitted a petition requesting an emergency stay of the '8362 reexamination proceeding.[1]

14. On February 6, 2009, the Office issued a decision granting patent owner's request to stay the proceeding to permit patent owner an opportunity to "cure" matters of inequitable conduct.

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[1] The petition was signed by counsel who is not of record in the '8362 proceeding. The petition was signed by a practitioner who set forth their name and registration number. Therefore the petition was accepted as in accordance with 37 CFR 1.34.

15. On February 13, 2009, patent owner submitted a petition under 37 CFR 1.182 requesting entry and consideration of information submitted concurrent with the petition and previously filed, all of which were filed after issuance of a NIRC.[2] This petition is the subject of the instant decision, which addresses petitioner's request for entry and consider all the information submitted after issuance of the NIRC

16. Also on February 13, 2009, patent owner concurrently submitted another petition under 37 CFR 1.182 requesting a reopening of prosecution and entry of an amendment after NIRC.[3]

17. On February 14, 2009, patent owner untimely submitted additional information in support of the petitions.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 states (in part):

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. [Emphasis added.]

MPEP 2256 states (in part):

AFTER THE NOTICE OF INTENT TO ISSUE *EX PARTE* REEXAMINATION CERTIFICATE (NIRC):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. [Emphasis added]

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

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[2] *Id.*
[3] *Id.*

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.

MPEP 2282 states (in part):

It is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing ex parte reexamination is or was involved, such as interferences, reissues, inter partes reexaminations, other *ex parte* reexaminations or litigations, and any results of such proceedings. In accordance with 37 CFR 1.565(a), the patent owner is required to provide the Office with information regarding the existence of any such proceedings, and the results thereof, if known. **Ordinarily, no submissions of any kind by third parties filed after the date of the order are entered into the reexamination or patent file while the reexamination proceeding is pending. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept *from any parties*, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent.** 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. . . .[Emphasis added]

DECISION

I. Untimely Submissions

Patent owner was given until NO LATER THAN close of official business on Friday, February 13, 2009, at 5:00 P.M. Eastern Standard Time to submit a petition to cure issues of inequitable conduct. A petition was received, as evidenced by the EFS-web time and date stamp, by the Office on Friday, February 13, 2009 at 11:50 PM EST. Additionally, information in support of the petition was also untimely received, as evidenced by the EFS-web time and date stamp, by the Office on Friday, February 13, 2009 at 11:59 PM EST. Therefore the submissions are untimely. However, while jurisdiction had technically transferred to the Central Reexamination Unit, such transfer had not occurred as it was after business hours. As the Office of Patent Legal Administration retained actual jurisdiction and the submissions were received on the last day of the response period, and in the interest of the equities of the situation, the petition purporting to be a filing to cure issues of inequitable conduct has been considered.

II. Applicability of MPEP §§ 2256, 2282 and 2287.01

1. Petitioner has failed to satisfy the requirements for submission of an IDS after NIRC.

Petitioner has alleged that, by virtue of the Office granting patent owner's February 4, 2009 petition requesting an emergency stay of the present proceeding, the additional requirements pertaining to submission of an IDS when a reexamination proceeding is in the print cycle do not apply. To the extent that the stay kept the present proceeding from entering a "452 print cycle status" with special dispatch, patent owner is correct. However, petitioner must still meet the requirements for entry of an IDS after NIRC, which are provided in MPEP 2256 for the purpose of furthering the statutorily mandated requirement of special dispatch in resolving reexamination proceedings: Patent owner still must make: **(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.** As set forth below in sections II.2 and II.3 of this decision petitioner has failed to satisfy the requirements of both criterion (A) and (B) of MPEP 2256 for entry and consideration of all the information submitted after issuance of a NIRC. Accordingly, the information will not be entered for consideration by the examiner.

Petitioner, concurrent with its petition, submitted eight documents contained in an appendix labeled "Appendix A" with a listing and brief discussion contained on a cover sheet to the appendix.[4] Petitioner also submitted patent and non-patent literature references on February 13, 2009. Petitioner requests entry and consideration of all the information submitted on February 13, 2009, and additionally requests entry and consideration of the references submitted on July 14, 2008 (and resubmitted on November 6, 2008).

In a reexamination proceeding, there is no 37 CFR 1.313 withdrawal of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present proceeding from the publication process, for consideration of the accompanying IDS papers, has been appropriately filed under 37 CFR 1.182. While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for the withdrawal from the publication process after the NIRC has been mailed, but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as noted above. Such withdrawals are rare, because a reexamination proceeding is required *by statute* to proceed to publication with special dispatch as pointed out above.

2. Entry criterion (A): Factual Accounting Sufficient to Explain Why the Information could not have been submitted Earlier

(a) The July 14, 2008 IDS– satisfies entry criterion (A)

The explanation filed concurrent with the July 14, 2008 submission satisfied entry criterion A - petitioner EBAY was precluded from filing the information previously as a third party requester, and petitioner did not become the patent owner until February 2008; thus, petitioner was

[4] Appendix A contains several court papers submitted by EBAY from related proceedings regarding the '051 patent. The term "Appendix A" will be used throughout the decision when referring to this information submitted by EBAY with their petition requesting entry of the Appendix A information.

prevented by rule[5] from submitting an IDS that could be entered into the reexamination proceeding record.

(b) The February 13, 2009 Related Proceeding Submission (Appendix A) – does not satisfy entry criterion (A)

No explanation is given as to why this information could not have been submitted earlier. The documents listed in Appendix A are all documents that were submitted in related proceedings. MPEP 2282 permits entry of court documents by a third party requester during a reexamination proceeding. Furthermore, petitioner has not provided a factual accounting as to why these court documents could not have been submitted to the Office earlier, in light of MPEP 2282, as EBAY's prior status as a third party requester did not preclude them from submitting the related proceeding documents. Therefore, petitioner has not made a sufficient factual accounting to satisfy entry criterion (A) for entry and consideration of the related proceeding papers at this late stage in the proceeding.

(c) The February 13, 2009 IDS– does not satisfy entry criterion (A)

No explanation is given as to why the information could not have been submitted earlier. Even though petitioner was precluded from submitting the information when petitioner was a third party requester, petitioner has owned the '051 patent for more than a year; yet petitioner has not explained why the references cited in the February 13, 2009 IDS were not cited earlier during the past year of ownership of the '051 patent. Accordingly, petitioner has not made a sufficient factual accounting to satisfy entry criterion (A) for entry and consideration of the related information submitted in the February 13, 2009 IDS.

3. Entry criterion (B): An Explanation of the Relevance of the Information Submitted with Respect to the *Claimed Invention* in the Reexamination Proceeding

Petitioner has not provided any explanation as to the **relevance of the** July 14, 2008 and February 13, 2009 information submissions with respect to the *claimed invention* in the reexamination proceeding, except that "the third document"[6] listed in Appendix A is asserted to provide a factual basis for curing acts of inequitable conduct set forth in allegations 6, 10-12, 14, 20, 23-33 and 40 of "the third document".[7] Otherwise petitioner only broadly states that the information will be used to ensure that the examiner is apprised of the previous patent owner's and the current patent owner's positions taken in related proceedings, and to discuss the substance of various unidentified declarations. Petitioner also expresses in the petition an intent to bring in additional prior art that patent owner EBAY was aware of as a third party requester, but could not introduce into the proceeding because of EBAY's status as a third party requester.[8]

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[5] 37 CFR 1.530(c) which states:

> (c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the ex parte reexamination requester in accordance with § 1.248.

[6] The third document from the top of the unnumbered listing of eight documents in Appendix A, the term "Appendix A's third document" or "the third document" will be used throughout the decision when referring this document from Appendix A.

[7] A detailed discussion and analysis of patent owner's allegations of inequitable conduct and attempt to cure is discussed in section III of this decision.

[8] As noted in section II(2)(c) patent owner is referring to prior art that patent owner could have submitted over a year ago upon purchase of the '051 patent.

Finally, petitioner states that it will refer to various litigation documents submitted, to ensure that a full and complete record is established.[9]

The requirement, however, is not a future discussion of establishing the relevance of the documents to the claimed invention, but for a contemporaneous explanation of the relevance of **all** the submitted documents ***with respect to the claimed invention*** in the petition submission, to justify entry at the post NIRC stage of reexamination. Entry of an information submission after NIRC does not necessarily result in a reopening for further prosecution; therefore it is not a means for re-prosecution of the proceeding. A statement that the relevancy will be developed at some indeterminate future time on the record in the proceeding does not meet the requirement for a present statement of relevancy. The statement of relevancy contemporaneously with the post NIRC information submission is necessary to determine if the delay caused by the late entry of information is justified, and permit minimizing any further extension of the prosecution process. Thus, the explanation of the relevance of the documents with respect to the claimed invention must be made at the time of their submission in order to justify entry of the documents and to facilitate special dispatch in terms of their consideration by the examiner.

Petitioner did not provide any explanation as to how any of the prior art references or the court documents provided in the submissions are relevant to the ***claimed invention.*** In light of the very late stage at which the present proceeding stands, it is unduly burdensome and contrary to the requirements of special dispatch to call upon the examiner to sift through all the materials and ascertain how petitioner believes this very late submission of documents may be relevant to the claimed invention. Accordingly, petitioner has not made a sufficient contemporaneous explanation of the relevance of **all** the submitted documents ***with respect to the claimed invention*** to satisfy entry criterion (B) for entry and consideration of the all the information submitted post NIRC.

III. Petitioner's Alleged "Cure" of Inequitable Conduct[10]

With respect to the matter of curing acts of inequitable conduct in the present proceeding, petitioner has failed to make an adequate showing that the submission would accomplish the stated purpose to "cure" any issues of inequitable conduct that might exist on the record. Petitioner relies upon *Rohm & Haas*[11] for the proposition that inequitable conduct can be cured by taking adequate corrective measures while the proceeding is still pending. *Rohm & Haas* sets out the following three requirements that **must** be met to effect a cure of an issue of inequitable conduct when a factual misrepresentation is made during examination:

> (1) The applicant must expressly advise the USPTO of the existence of a prior misrepresentation, stating specifically wherein it resides; and
>
> (2) The applicant must advise the USPTO of the actual facts, if the prior misrepresentation was factual, and must indicate that further examination may be required; and
>
> (3) The applicant must establish the patentability of the claimed subject matter.[12]

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[9] As noted in section II (2)(b) patent owner is referring to court documents that patent owner could have submitted, even as a third party requester, during the reexamination proceeding in accordance with MPEP 2282.

[10] Inequitable conduct is not an issue within the scope of reexamination, only the matter of cure is being addressed.

[11] *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

[12] *Id.*

Petitioner correctly articulates that any attempt to cure matters of inequitable conduct must occur in the present proceeding.[13] An attempt to cure, in a subsequent proceeding, acts of inequitable conduct in a prior related proceeding has been held to be ineffective.[14] Providing material information to the examiner in time to act on the information has been held to satisfy the duty of disclosure.[15]

Petitioner has not satisfied the threshold requirements of *Rohm & Haas* as to the information that is to be submitted for the purpose of curing acts of inequitable conduct. Petitioner, while expressly advising the Office about the *possible existence of prior misrepresentations*, has not stated specifically where in the record of the present proceeding the misrepresentations reside. Petitioner's submission attempting to cure includes Appendix A, which lists eight documents and a cursory statement regarding the content of the third document.[16] Appendix A's third document contains a listing of forty-nine (49) allegations of inequitable conduct. Petitioner asserts that allegations 6, 10-12, 14, 20, 23-33 and 40 are pertinent to the current reexamination. As explained below, however, none of the asserted allegations provides the required information that needs to be submitted for the purpose of effecting "cure".

(a). Lack of Specificity (Allegations 6, 10, 11, 14, 23-33, and 40)

With respect to allegations 6, 14 and 29, patent owner has redacted substantially all of the text of allegations 6 and 14, and all of the text of allegation 29; thus, there is a lack of specificity as to where the acts of inequitable conduct reside in the present proceeding. Accordingly, patent owner has not satisfied the first requirement of *Rohm & Haas* by failing to state specifically where the alleged inequitable conduct resides in the record of the present proceeding.

With respect to allegations 10-11, 14, 23-28, 30-33 and 40, petitioner has alleged acts of inequitable conduct on the part of the previous patent owner MERCEXCHANGE LLC in the '051 "reexamination".[17] Petitioner fails to provide sufficient specificity as required by *Rohm & Haas* by not properly citing the specific reexamination proceeding and the specific papers within the specific reexamination proceeding wherein the alleged act(s) of inequitable conduct occurred. The allegations as made in the third document of Appendix A cite to a multitude of documents in order to establish the existence of inequitable conduct, but not all of the documents are in the present proceeding. Furthermore, usage of Appendix A's third document creates confusion and a lack of clarity on the record, because it was drafted for a different purpose and for a different forum and cites to documents that are not of record in the present proceeding. Thus petitioner's asserted allegations of inequitable conduct lack sufficient specificity as to where the acts of inequitable conduct reside in the present proceeding. Accordingly, petitioner has not satisfied the first requirement of *Rohm & Haas* by failing to state specifically where the misrepresentation resides in the record of the present proceeding.

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[13] *Id.*; See also *In re Clark*, 522 F.2d 623 (CCPA 1975)

[14] *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1183 (Fed. Cir. 1995)(Subsequent citation of a reference during the reexamination proceeding does not cure the failure to cite a reference during the original prosecution).

[15] *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1349 (Fed. Cir. 2007).

[16] An "addendum" prepared during litigation involving the '051 patent in support of a motion filed by defendant EBay which was prior to EBay's purchase of the '051 patent.

[17] No such proceeding designation exists in the Office. Currently before the Office two different reexamination proceedings are pending in regards to the '051 patent, the '6984 and the '8362 proceedings. Usage of the phrase '051 reexamination is an inaccurate statement that embraces two separate and distinct reexamination proceedings, thus lacking specificity.

Finally, with respect to allegation 30, petitioner states, "MercExchange similarly argued that . . ." apparently referring to a previously presented allegation, presumably to refrain from being repetitive and to build upon the argument stated in allegation 29 that immediately preceded allegation 30. As was previously noted, allegation 29 is redacted *in toto*. Thus, there is a further lack of specificity as to where the acts of inequitable conduct reside in the present proceeding with respect to allegation 30. Accordingly, petitioner has not satisfied the first requirement of *Rohm & Haas*, because petitioner has failed to specifically identify where the misrepresentation resides in the record of the proceeding.

(b). Failure to Advise the PTO of the Actual Facts (Allegations 6, 14, 20, 23-33 and 40)

Petitioner has implicitly alleged that *Rohm & Haas* is applicable to all the asserted allegations of inequitable conduct, allegations 6, 10-12, 14, 20, 23-33 and 40. *Rohm & Haas* dealt with issues of inequitable conduct when the prior misrepresentation was factual. Petitioner has failed to provide the actual facts for allegations 6, 10-12, 14, 20, 23-33 and 40. Appendix A's third document is a bullet point summary of allegations of inequitable conduct, and despite petitioner's assertion, it is not a listing or compilation of the actual facts which were stated to be previously misrepresented, as required by *Rohm & Haas*. The body of the petition does not supplement Appendix A's documents with the actual facts nor point to where, in Appendix A's documents, the actual facts (alleged to be misrepresented by patent owner during prosecution in the present proceeding) reside. Furthermore, allegations 10-12 are not allegations of misrepresentation of actual facts, but instead are allegations of a withholding of material information in the form of documents from related proceedings and a withholding of prior art references. Accordingly, petitioner has not satisfied the second requirement of *Rohm & Haas*, because petitioner failed to advise the Office of the actual facts that were previously misrepresented during prosecution in the present proceeding.

(c). Failure to Establish Patentability

Petitioner has not established on the record patentability of the claimed subject matter. Petitioner presumes that by alleging the existence of inequitable conduct at this late stage of reexamination that reopening of prosecution will occur, with prosecution starting anew in order to establish patentability of the claims. Such a presumption is in error, and is contrary to the mandate of special dispatch and the relevant case law. Federal Circuit case law provides that "the essence of the duty of disclosure is to get relevant information before an examiner in time for him to act on it, . . ."[18] The ability of a party to establish patentability before the Office is still governed by the stage of prosecution, regardless of the fact that petitioner states that it is attempting to "cure" concerns regarding inequitable conduct. In the present proceeding, prosecution is closed, a NIRC has been issued, and the proceeding is ready for entry into the printing cycle. Petitioner was granted an exigency petition to stay the proceeding based upon a representation of the need to cure issues of inequitable conduct. Instead of effectuating such cure, however, petitioner's efforts appears to be merely directed to reopening prosecution to explore possibilities, e.g. the consideration of belatedly submitted references, without adherence to the relevant statutes, rules, guidance and procedure. A review of the record, engendered by the petitions that followed the exigency based petitions to stay, raises serious doubts as to the judiciousness of the granting of the stay based on petitioner's previously alleged exigency. Petitioner has been intimately involved in the progress of the proceeding by dint of being the third party requester that initiated the proceeding and asserted the various inequitable conduct allegations in the petition, specifically in Appendix A's third document. Petitioner has conceded in the instant petition to

[18] *Young* at 1349.

being aware of the references, currently being submitted, for at least one year, by stating that patent owner could not previously cite them as a third party requester. Petitioner has owned the '051 patent for over a year, is represented by registered practitioners, is on MPEP notice regarding the appropriate procedure to follow, and is on specific notice as outlined in the previous decisions as to the appropriate procedure to follow regarding entry of information after NIRC. Therefore, petitioner at the time of filing the present petition was or should have been fully aware of the necessary actions to properly present the information before the examiner for consideration at such a late stage of a reexamination proceeding and to cure any alleged acts of inequitable conduct while also furthering the statutory mandate of special dispatch. Accordingly, petitioner has not satisfied the third requirement of *Rohm & Haas*.

(d). Not in the Present Proceeding (Allegations 6, 20, and 40)

A predicate for petitioner's request for relief, as set forth by the relevant case law and an aspect of petitioner's exigency petition showing, is that cure must occur in the same proceeding within which the alleged acts of inequitable conduct took place. With respect to allegations 6, 20 and 40, petitioner alleges the existence of acts of inequitable conduct in the original prosecution of the '051 patent. Acts of inequitable conduct that occurred in the original prosecution of the '051 patent cannot be cured in the present reexamination proceeding. The case law precludes attempts to cure acts of inequitable conduct in a subsequent reexamination proceeding that occurred during the original prosecution of a patent.[19] Therefore, petitioner's assertion of acts of inequitable conduct regarding allegations 6, 20 and 40 cannot be cured in the present proceeding. This, by itself, warrants dismissal of the petition and non-entry of the IDS submissions.

(e). Failure to Timely and Properly Provide the Relevant Documents (Allegations 10-12)

With respect to allegation 10, petitioner alleges inequitable conduct because patent owner MERCEXCHANGE LLC failed to disclose material information from a related proceeding by not citing the appeal brief from U.S. Patent Application Serial No. 09/166,779 (The '779 application) in the present reexamination proceeding.[20] The record of the present proceeding indicates that the '779 application's appeal brief[21] is currently not of record in the present proceeding, including all IDS submissions made by new patent owner, EBAY, for which entry is now being requested. The case law provides that failure to submit material information from related proceedings can be cured if the information is supplied to the examiner in time for him or her to act.[22] In this instance, and contrary to petitioner EBAY's assertions, both a patent owner and a third party requester are permitted to submit documents from related proceedings during a reexamination proceeding.[23] Accordingly, petitioner could have cured allegation 10 by

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[19] *Molins* at 1183.

[20] Specifically, EBAY alleges inequitable conduct by patent owner MERCEXCHANGE LLC, because of inconsistent positions regarding the claim term "account verification" patent owner MERCEXCHANGE LLC has taken between the '779 appeal brief filed and the present proceeding. EBAY alleges that a failure to challenge an Official notice position taken by the examiner regarding the claim limitation "account verification" in the '779 application appeal brief has created this inconsistency, which is material to patentability and that the failure to cite the '779 application's brief rises to an act of inequitable conduct.

[21] The '779 application actually has two appeal briefs on record from patent owner to the Board of Patent Appeals and Interferences (BPAI), dated July 22, 2002 and November 19, 2002. Patent owner does not identify in which appeal brief the alleged inequitable conduct occurred. However, both appeal briefs are related to the same appeal before the BPAI and the later brief was a replacement brief for the earlier on a formal matter, so presumably both briefs evidence the alleged inequitable conduct, an inconsistent taking of positions between the '779 application and the present proceeding.

[22] *Young* at 1348-50.

[23] MPEP 2282

submitting the appeal brief in a notification of concurrent proceeding in accordance with MPEP 2282 as the requester or as the patent owner; however to date petitioner has failed to do so.

With respect to allegations 11 & 12, petitioner alleges in the petition, in conjunction with petitioner comments in Appendix A, an omission of material prior art references, "Seat on the Exchange" and "NetBill" respectively, by the previous patent owner MERCEXCHANGE LLC in the present proceeding as acts of inequitable conduct. Neither reference was submitted for the present proceeding via the IDS submissions made by new patent owner, EBAY. Inequitable conduct due to the failure to cite a material reference maybe cured by submitting the reference to the Office in a proceeding, as the examiner can independently assess the veracity of any alleged misstatements by examining the prior art.[24,25] Neither reference "Seat on the Exchange" or "Netbill" is listed as one of the documents being submitted in any of the information submissions by petitioner in support of their attempt to cure. Accordingly, petitioner could have cured allegations 11-12 by submitting the "Seat on the Exchange" or "Netbill" references in an IDS after NIRC with a petition that complies with requirements (A) and (B) of MPEP 2256, and also with 37 CFR 1.313 if the proceeding had entered the print cycle; however to date petitioner has failed to do so.

IV. Summation of Decision

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on August 31, 2007, and the proceeding is ready for entry into the printing cycle. The proceeding is clearly not scheduled to come up for further action on the merits. The requested relief would significantly regress the present proceeding from its current processing stage. This runs 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 information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite discussion of the submitted information, the present reexamination proceeding will not be reopened at this late date to consider the proffered information. Further, the proceeding must be immediately forwarded to the printing cycle to comply with the statutory mandate for special dispatch.

To the extent that petitioner EBAY may be prejudiced by this decision, that prejudice must be balanced by the degree of prejudice the public will suffer by delaying the proceeding any further in contravention of 35 U.S.C. 305. In this instance, patent owner EBAY was fully aware of all issues of inequitable conduct on the part of the previous owner of the patent, and their potential impact on the patent, when EBAY purchased the '051 patent from MERCEXCHANGE LLC. [26] Furthermore, EBAY was fully aware that prosecution had been completed in the reexamination proceedings which were requested in April 3, 2007, and was not subject to reopening in the ordinary course of reexamination. In spite of this, the Office gave EBAY two opportunities to address the matter. EBAY has had over a year since its purchase to properly bring to the Office's attention the need to cure matters of inequitable conduct, and do it pursuant to the only avenue provided for same (MPEP 2256). Yet, to date, EBAY has failed to submit the matter to the

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[24] *Applied Materials Inc. v. Advanced Semiconductor Materials America Inc.*, 30 USPQ2d 1967, 1969 (N.D. Calif. 1994).

[25] *But see, Ethicon Inc., v. United States Surgical Corp.*, 921 F. Supp. 901, 904 (Conn. 1995) (No cure is available when a patentee fails to cite material prior art with an intent to deceive.).

[26] All allegations of inequitable conduct leveled against the previous patent owner, MERCEXCHANGE LLC, were made by EBAY in litigation between EBAY and MERCEXCHANGE LLC regarding the '051 patent.

Office in a manner that would permit entry, and minimize the delay running counter to special dispatch.[27] The Office cannot wait any longer; therefore this decision is made a final agency action.

The information submitted by petitioner will be placed in the file, and will remain of record. However, because prosecution has been terminated for this reexamination proceeding, the information will not be considered by the examiner. If petitioner in fact believes that any reference submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the petitioner can always file a new request for reexamination for consideration of such reference(s).

CONCLUSION

1. The petition is **denied**.

2. This decision is designated as a final agency action under 5 U.S.C. § 704.

3. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

4. Jurisdiction over the proceeding is transferred to the Central Reexamination Unit (CRU) for immediate forwarding to Publications Branch for reentry into the printing cycle and issuance of a reexamination certificate in accordance with the statutory mandate of special dispatch.

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 in his absence Pinchus M. Laufer, Legal Advisor Office of Patent Legal Administration at (571) 272-7726 or in his absence the undersigned at (571) 272-7710.

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

[27] It is observed that petitioner, even at this stage, failed to include a PROPER and complete factual and legal basis for its stated attempt to cure any possible incidences of inequitable conduct in the present proceeding, as part of the rationale or basis for granting the petition. The patent owner failed to draft a document tailored for the present forum and matter to support any effort to cure potential issues of inequitable conduct. Use of Appendix A's third document creates confusion and a lack of clarity on the record, because it was drafted for a different purpose and for a different forum, and it is both over and under inclusive as to information necessary to establish petitioner's position regarding the need to cure acts of inequitable conduct. Despite the fact that petitioner is only attempting to "cure" acts of inequitable conduct in allegations 6, 10-12, 14, 20, 23-33 and 40, it is noted that inequitable conduct allegations 41-49 also implicate the '051 "reexamination" proceedings, and the petitioner failed to address them in attempting to cure acts of inequitable conduct as part of the basis for the entry and consideration of information after NIRC.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 03/23/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Schwegman, Lundberg & Woessner/EBay
P.O. Box 2938
Minneapolis, MN 55402

(Requester, now Patent Owner)

MAILED

MAR 23 2010

CENTRAL REEXAMINATION UNIT

Inventors: Thomas G. Woolston
Reexamination Proceeding: 90/008,362
Filed: April 3, 2007
For: U. S. Patent No. 6,202,051
Title: Facilitating Internet Commerce Through Internetworked Auctions

: **DECISION ON**
: **§ 1.182 PETITION**

This is a decision on a February 5, 2010 petition to revive an unintentionally terminated reexamination proceeding pursuant to 37 CFR 1.137(b).

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

The petition is dismissed as to the § 1.137(b) relief requested; however the submission will be taken as requesting § 1.182 relief, and is granted as a petition under 37 CFR 1.182.

Background

The Office mailed an Order to Show Cause (Order) with a November 18, 2009 date on the cover page as to why the Office should not proceed with issuance of a reexamination certificate. The Order set a one month period for filing a reply thereto without the possibility of an extension of time. A failure to timely reply to the Order was stated to result in immediate issuance of a reexamination certificate.

A reply to the Order, in the form of a § 1.182 petition has been filed on February 5, 2010, beyond the one month period that was set for reply.

Concomitant with the February 5, 2010 reply, the instant petition was also filed, which seeks in effect to have the February 5, 2010 reply considered.

Section 1.137(b) Petition

The instant petition is directed towards revival of a terminated reexamination based on an unintentional failure to timely reply to the Order. The Order did not set a time for reply for which the failure to meed would result in termination of the reexamination. Therefore, the non-filing of the patent owner's response to the Order to Show Cause does not cause the reexamination prosecution to become terminated. The relief provision set forth in 37 CFR 1.137(b) is remedial and is only available to reexaminations that have become terminated for failure to timely respond. As the present reexamination proceeding has not terminated for failure to timely respond, the relief provision set forth in 37 CFR 1.137(b) is unavailable to the patent owner.

The $1,540 § 1.17(m) fee is being charged to Deposit Account No. 14-1439 as authorized in the petition

The petition is accordingly dismissed as to the § 1.137(b) relief requested.

Section 1.182 Petition

The § 1.137 petition will be treated as a (first) petition under § 1.182, requesting that the failure to timely file the required § 1.182 reply to the order not result in immediate issuance of a reexamination certificate based on the NIRC as was stated in the Order. A petition fee for the first § 1.182 petition is not being charged.

The response to the Order in the instant reexamination is a petition under 37 CFR 1.182 as required in the Order, which (second § 1.182) petition contains an admission that "claims 13, and 33-35, as confirmed to be patentable in the NIRC of August 31, 2007, are in fact unpatentable."

Reference is made to a similar Order in a parallel reexamination, 90/006,984, of the same patent, in which a timely reply was made to the Order, and an admission was made there also that "claims 13, and 33-35, as confirmed to be patentable in the NIRC of August 31, 2007, are in fact unpatentable."

In view of the: (1) clear intent to file a response to the Order in the instant reexamination, based on the filing of a timely reply in the parallel reexamination, and (2) the admission of unpatentability, the Office will grant the instant petition, an extraordinary situation is present justifying relief; the Office will not issue a reexamination certificate confirming claims admitted to be unpatentable.

Accordingly, the Office (1) will not issue a reexamination certificate at this time, and (2) will review the § 1.182 response (second § 1.182 petition) to the Order for its compliance with the constraints imposed in the Order.

Conclusion

1. The petition is dismissed as to the § 1.137(b) relief requested.

2. The petition is granted as a petition under 37 CFR 1.182.

3. Jurisdiction over the proceeding is being retained by the Office of Patent Legal Administration for consideration of the response to the Order.

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

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

3-22-10

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.
90/008,363	12/06/2006	6538908		7394

7590 08/09/2007

EXAMINER	

JAMES Y GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
7TH FLOOR
LOS ANGELES, CA 90025

ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2007

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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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CENTRAL REEXAMINATION UNIT

James Y. Go
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles CA 90025

For Patent Owner

Richard V. Burgujian, Esq.
FINNEGAN HENDERSON FARABOW GARRET & DUNNER LLP
901 New York Avenue NW
Washington, DC 20001-4413

For Third Party Requester

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,790
Filed: October 25, 2005
For: US Patent No. 6,538,908

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,363
Filed: December 6, 2006
For: US Patent No. 6,538,908

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

BACKGROUND

1. Patent No. 6,538,908 issued on March 25, 2003.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,790 was requested by a third party requester on October 25, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,790 on December 27, 2005.

4. There are currently no amendments proceeding control number 90/007,790.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,363 was requested by a third party requester filed on December 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,363 on January 25, 2007.

7. There are currently no amendments proceeding control number 90/008,363.

8. Proceedings control numbers 90/007,790 and 90/008,363 awaits the first Office action on the merits from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/007,790 and 90/008,363 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,790 and 90/008,363 are **MERGED**.

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

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

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,363	12/06/2006	6538908		7394

7590 03/05/2009

EXAMINER	
ART UNIT	PAPER NUMBER

JAMES Y GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

DATE MAILED: 03/05/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Finnegan, Henderson, Farabow, Garrett & Dunner LL
901 New York Avenue N.W.
Washington, DC 20001-4413

Date:
MAILED

MAR 05 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008363
PATENT NO. : 6538908
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,790	10/25/2005	6538908	09578-0006	9396

7590 03/05/2009

EXAMINER

JAMES Y. GO
Blakely Sokoloff Taylor & Zafman LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RICHARD V. BURGUJIAN, ESQ.
C/O FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Date:
MAILED
MAR 05 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007790
PATENT NO. : 6538908
ART UNIT : 3900

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

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

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MAR 05 2009

CENTRAL REEXAMINATION UNIT

JAMES Y. GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE CA 94085-4040

(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Requester)

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/007,790
Request Deposited: October 25, 2005
For: U.S. Patent No. 6,538,908

DECISION ON PETITION UNDER 37 CFR 1.59

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/008,363
Request Deposited: December 6, 2006
For: U.S. Patent No. 6,538,908

DECISION

This is a decision on the petition under 37 CFR 1.59(b), filed August 31, 2006, to expunge information from the above identified proceedings.

The petition is **granted**.

Petitioner requests that documents entitled

COMPLAINANT POWER INTEGRATIONS, INC.'S POSTHEARING STATEMENT, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006;

RESPONDENT SYSTEM. GENERAL CORPORATION'S POST-HEARING BRIEF. In the Matter Of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME. United State, International Trade Commission, Washington. DC 20436. Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006; and

POST-HEARING BRIEF OF THE COMMISSION INVESTIGATIVE STAFF, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 14, 2006

, filed August 28, 2006, be expunged from the record. It is noted that the documents and petition were submitted in 90/007,790 only. 90/007,790 was subsequently merged with 90/008,363. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been removed from the official file. Since this proceeding is not a paper file, the return of the expunged material may not be possible in an Image File Wrapper (IFW) proceeding where a paper is entered into the record. Instead, such papers are marked "closed" and "not public".

CONCLUSION

1. Petitioner's request is **granted**.

2. Patent Owner is **required** to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

3. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel For
Gregory Morse
Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 13, 2009

TO SPE OF : ART UNIT 3992 - Lynne H. Browne

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/007,790 and 90/008,363 Patent No.: 6,538,908 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Antonio Johnson

_____

Certificates of Correction Branch

(571)272-0483

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- ☒ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

_____

_____

_____

_____

Eric Frahm SPE, AU 3992

Copied from 90007790 on 10/29/2009

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.
90/008,364	12/06/2006	6351398		7395

7590 08/09/2007

EXAMINER	

ART UNIT	PAPER NUMBER

JAMES Y GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
7TH FLOOR
LOS ANGELES, CA 90025

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
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James Y. Go
BLAKELY SOKOLOFF TAYLOR
& ZAFMAN LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles CA 90025

For Patent Owner

MAILED

AUG 09 2007

CENTRAL REEXAMINATION UNIT

Richard V. Burgujian, Esq.
FINNEGAN HENDERSON FARABOW
GARRET & DUNNER LLP
901 New York Avenue NW
Washington, DC 20001-4413

For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,781
Filed: October 26, 2005
For: US Patent No. 6,351,398

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,364
Filed: December 16, 2006
For: US Patent No. 6,351,398

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

BACKGROUND

1. Patent No. 6,351,398 issued on February 26, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,781 was requested by a third party requester on October 26, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,781 on December 27, 2005.

4. There are currently no amendments proceeding control number 90/007,781.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,364 was requested by a third party requester filed on December 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,364 on February 2, 2007.

7. There are currently no amendments proceeding control number 90/008,364.

8. Proceedings control numbers 90/007,781 and 90/008,364 awaits the first Office action on the merits from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/007,781 and 90/008,364 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,781 and 90/008,364 are **MERGED**.

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

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

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

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

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

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

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.
90/008,364	12/06/2006	6351398		7395

7590 03/06/2009

EXAMINER	
ART UNIT	PAPER NUMBER

JAMES Y GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

DATE MAILED: 03/06/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Finnegan, Henderson, Farabow, Garrett & Dun
901 New York Ave., N.W.
Washington, DC 20001-4413

Date: MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008364
PATENT NO. : 6351398
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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JAMES Y. GO (For Patent Owner)
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE CA 94085-4040

MAILED
MAR 06 2009
CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW, (For Requester)
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/007,781
Request Deposited: October 26, 2005
For: U.S. Patent No. 6,351,398

DECISION ON PETITION UNDER 37 CFR 1.59

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/008,364
Request Deposited: December 6, 2006
For: U.S. Patent No. 6,351,398

DECISION

This is a decision on the petition under 37 CFR 1.59(b), filed August 31, 2006, to expunge information from the above identified proceedings.

The petition is **granted**.

Petitioner requests that documents entitled

COMPLAINANT POWER INTEGRATIONS, INC.'S POSTHEARING STATEMENT, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006;

RESPONDENT SYSTEM. GENERAL CORPORATION'S POST-HEARING BRIEF. In the Matter Of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME. United State, International Trade Commission, Washington. DC 20436. Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006; and

POST-HEARING BRIEF OF THE COMMISSION INVESTIGATIVE STAFF, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 14, 2006

, filed August 28, 2006, be expunged from the record. It is noted that the documents and petition were submitted in 90/007,781 only. 90/007,781 was subsequently merged with 90/008,364. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been removed from the official file. Since this proceeding is not a paper file, the return of the expunged material may not be possible in an Image File Wrapper (IFW) proceeding where a paper is entered into the record. Instead, such papers are marked "closed" and "not public".

CONCLUSION

1. Petitioner's request is **granted**.

2. Patent Owner is **required** to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

3. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel for
Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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MAR 12 2009

CENTRAL REEXAMINATION UNIT

Bayer Material Science LLC
100 Bayer Road
Pittsburgh, PA 15205

(For Patent Owner)

In re Reexamination Proceedings :
Dietrich et al. : DECISION GRANTING PETITION
Control No. 90/008,365 :
Filed: January 18, 2007 :
Attorney Docket No. MO4805 RE-EXAM :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on February 27, 2009, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

A review of the present petition reveals that it includes, *inter alia*, a copy of a Notice of Appeal, filed February 24, 2009, which includes the requisite $540.00 fee under 37 CFR 41.20(b)(1). As such, Petitioner has provided the response required by 37 CFR 1.137(b) (item 1). Payment of the requisite unintentional delay fee of $1,620.00 was made (item 2). The petition contains the proper statement for unintentional delay in filing the required response (item 3). The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer (item 4). 37 CFR 1.137(d)(3).

Accordingly, the present petition under 37 CFR 1.137(b) includes the requisite response (item 1), the $1620.00 petition fee under 37 CFR 1.17(m) (item 2), and the requisite statement (item 3).

CONCLUSION

1. The petition for entry of late papers is **granted.**

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).

3. The time period for filing an appeal brief and the appeal brief fee is set to run one (1) month from the date of this decision.

4. Any further communication as to the merits of the reexamination proceeding should be directed to examiner Jerry Johnson in the CRU, who can be reached at (571) 272-1448.

5. Telephone inquiries with regard to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

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.
90/008,368	02/05/2007	6002103	70465.00008.RE05	1044

7590 09/23/2008

EXAMINER	

George Corrigan
5 Briarcliff Court
Appleton, WI 54915

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Bhaskar Kakarla
Paul Hasting Janofsky & Walker LLP
875 15th Street N.W.
Washington, DC 20005

MAILED

SEP 23 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,368*.

PATENT NO. *6002103*.

ART UNIT *3991*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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George R. Corrigan
Corrigan Law Offices
5 Briarcliff Court
Appleton, WI 54915

(For Patent Owner)

Bhaskkar Kakarla
Paul, Hastings, Janofsky & Walker, LLP
P.O. Box 919092
San Diego, CA 92191-9092

(For Requester)

MAILED

SEP 23 2008

CENTRAL REEXAMINATION UNIT

In re Thommes :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,368 : **GRANTING**
Filed: February 5, 2007 : **PETITION**
For: U.S. Patent No. 6,002,103 :

This is a decision on the May 9, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the May 9, 2008 patent owner petition to revive").

The May 9, 2008 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1540 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to the patent owner's deposit account no. 50-0599, as authorized on page 1 of the May 9, 2008 paper entitled "Transmittal for After Final Response, Terminal Disclaimer, Petition to Revive, and Notice of Appeal and Fee Payment," which accompanied the May 9, 2008 patent owner petition to revive.

SUMMARY

The May 9, 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 September 10, 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 May 9, 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 May 9, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[2] is **granted**.

CONCLUSION

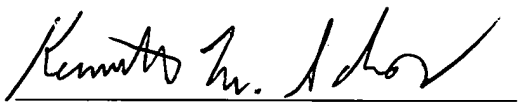
- The May 9, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

- The time period for filing an appeal brief and the appeal brief fee is set to run **two (2) months** from the date of this decision.

- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3991 for processing of the May 9, 2008 terminal disclaimer and patent owner amendment/response to the March 6, 2008 final Office action, both of which accompanied the May 9, 2008 patent owner petition to revive.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Krisanne Jastrzab, of CRU Art Unit 3991, at (571) 272-1279.

- 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.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,369	01/24/2007	5,601,741	70465.00008.RE04	9971

7590 11/26/2008

EXAMINER	
ART UNIT	PAPER NUMBER

GEORGE R. CORRIGAN
CORRIGAN LAW OFFICE
5 BRIERCLIFF CT.
APPLETON, WI 54915

DATE MAILED: 11/26/2008

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,877	04/21/2008	5601741	37792-61565	9219

7590 11/26/2008

EXAMINER	
ART UNIT	PAPER NUMBER

GEORGE R. CORRIGAN
CORRIGAN LAW OFFICE
5 BRIERCLIFF CT.
APPLETON, WI 54915

DATE MAILED: 11/26/2008

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GEORGE R. CORRIGAN
CORRIGAN LAW OFFICE
5 BRIERCLIFF CT.
APPLETON WI 54915

(For Patent Owner

Bhaskar Kakarla
PAUL, HASTINGS, JANOFSKY
& WALKER LLP
875 15TH STREET, NW
WASHINGTON, DC 20005

(For Third Party Requester)

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NOV 26 2008

CENTRAL REEXAMINATION UNIT

Kevin M. Kercher
Thompson Coburn LLP
One US Bank Plaza
St. Louis, MO 63101

(For Third Party Requester)

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

In re: Thommes
Ex Parte Reexamination Proceeding
Control No. 90/008,369
Deposited: 24 January 2007
For U.S. Patent No. 5,601,741

In re: Thommes
Ex Parte Reexamination Proceeding
Control No. 90/008,877
Deposited: 21 April 2007
For U.S. Patent No. 5,601,741

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/008,369 and the reexamination control number 90/008,877 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 90/008,369 and 90/008,877 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. 90/007,369 and 90/008,8776 are hereby **merged**. There are amendments to the claims in proceeding 90/008,369 dated 3 April 2008 and 23 June 2008. There are no amendments to the claims in proceeding 90/008,877. The examiner in charge of the now merged proceedings has agreed to address the amendments in the next office action, thereby avoiding the need for a housekeeping amendment. The proceedings are thus returned to the examiner in charge of the proceedings for an first Office action.

CONCLUSION

1. Reexamination Control Nos. 90/008,369 and 90/008,877 are hereby **merged**.

2. The proceedings are thus returned to the examiner in charge of the proceedings for an Office action on the merits.

3. The amendments of claims dated 3 April 2008 and 23 June 2008 in proceeding 90/008,369 will be addressed by the examiner in charge of the proceeding, no housekeeping amendment is required at this time.

43. 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
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By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the

reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

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.
90/008,371	02/05/2007	6239407		3327

7590 06/05/2008

GEORGE R. CORRIGAN
CORRIGAN LAW OFFICES
5 BRIARCLIFF CT
APPLETON, WI 54915

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PAUL, HASTINGS, JANOFSKY & WALKER LLP
P.O. BOX 919092
SAN DIEGO, CA 92191-9092

Date:
MAILED
JUN 05 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008371
PATENT NO. : 6239407
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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GEORGE R. CORRIGAN
CORRIGAN LAW OFFICES
5 BRIARCLIFF CT
APPLETON, WI 54915

(For Patent Owner)

MAILED

JUN 05 2008

CENTRAL REEXAMINATION UNIT

PAUL, HASTINGS, JANOFSKY & WALKER LL
P.O. BOX 919092
SAN DIEGO, CA 92191-9092

(For Third Party Requester)

In re Reexamination Proceeding :
J. Thommes :
Control No. 90/008,371 : DECISION GRANTING PETITION
Filed: February 5, 2007 :
U.S. Patent No. 6,239,407 :
Attorney Docket No. ITW 7188.61R :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 9, 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 (Notice of Appeal and Appeal Fee - item 1); an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2): the requisite statement (item 3); an Amendment And Response and Terminal Disclaimer (re: nonstatutory obviousness-type double patenting rejection) and disclaimer fee; and a Certificate of Service on the Third Party Requester.

The petition for entry of the late papers is granted.

No terminal disclaimer and disclaimer fee are required for a period of termination in a reexamination proceeding. The Terminal Disclaimer submitted May 9, 2008, was filed in response to the nonstatutory obviousness-type double patenting rejection set forth in the Office action mailed March 6, 2008.

$2,050.00 ($1,540.00 for the petition fee and $510.00 for a Notice of Appeal fee) has been charged to counsel's deposit account no. 50-0599 in accordance with the present petition.

The time period for filing an appeal brief and the appeal brief fee in response to the Notice of Appeal filed as a response to the outstanding Office action is **two (2) months from the date of this decision**, MPEP 711.03(c).

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the Notice of Appeal, the Amendment And Response and Terminal Disclaimer (re: nonstatutory obviousness-type double patenting rejection) filed May 9, 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, Krisanne Jastrzab, in CRU Art Unit 3991, who can be reached at 571-272-1279.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ROBERT M. MASTERS
PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15TH STREET, NW
WASHINGTON, DC 20005

MAILED

NOV 13 2009

CENTRAL REEXAMINATION UNIT

In re Application of :
THOMMES :
Control No. 90/008,371 (US PAT 6,239,407) : DECISION ON PETITION
Filed: December 13, 2006 : TO WITHDRAW
Attorney Docket No. ITW 7188.61R : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed November 05, 2009.

The request is **NOT APPROVED**.

A review of the file record indicates that Robert M. Masters, customer number 36183 does not have power of attorney in this patent application nor is there any statement or evidence of record of employment in or otherwise being engaged in the proceedings in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

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

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

Patricia Volpe for

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: GEORGE R. CORRIGAN
CORRIGAN LAW OFFICES
5 BRIARCLIFF CT
APPLETON, WI 54915

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.
90/008,372	03/09/2007	6746773	ETH1597USREX/ETHI-0029	3326

45511 7590 10/02/2009

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2009

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

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CENTRAL REEXAMINATION UNIT

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

In re Gerard Llanos *et al* :
Reexamination Serial No. : 90/008,372 : DECISION ON PETITION
Patent No: 6,746,773 :
Attorney Docket No.: ETHI-0029 :

This is in response to Patent Owner's petition, filed July 16, 2009 under 37 CFR 1.324, to correct inventorship in U.S. Patent 6,746,773.

Specifically, the petition requests **addition** of **Robert Falotico** and **deletion** of **Pallassana Narayanan** as inventors in the above named patent. Patent Owner has fulfilled all the requirements of 37 CFR 1.324.

Applicant's petition is GRANTED.

Deborah Jones
Supervisory Patent Examiner
Central Reexamination Unit
Art Unit 3991

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,373	12/13/2006	6,102,802	6620-76454-02	2872

50086 7590 04/16/2008

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Microsoft Corporation
One Microsoft Way
Building 8
Redmond, WA 98052

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008373
PATENT NO. : 6102802
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

Law Office of David H. Judson
15950 DALLAS PARKWAY
Suite 225
Dallas, TX 75248

(For Patent Owner)

Microsoft Corporation
One Microsoft Way
Building 8
Redmond, WA 98052

(For Third Party Requester)

In re Brad Armstrong
Reexamination Proceeding
Control No.: 90/008,373
Filed: December 13, 2006
For: U.S. Patent No.: 6,102,802

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

This is a decision on the December 11, 2007 patent owner petition under 37 CFR 1.182 to enter and have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed December 11, 2007, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,102,802 issued August 15, 2000.
2. On December 13, 2006, a request for reexamination, assigned control No. 90/008,373 (the '8373 proceeding), was filed by a third party requester, Microsoft Corporation.
3. On March 9, 2007 the Office issued an order granting the '8373 reexamination request.
4. The'8373 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on December 10, 2007.
5. On December 11, 2007, the instant petition was submitted with an IDS, which the patent owner requests the Office to consider.
6. The reexamination proceeding is being processed toward publication of the reexamination certificate.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings states (in part):

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

37 CFR 1.4(c) states:

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

MPEP 2256 states (in part):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present proceeding from the publication process, for consideration of the accompanying IDS papers, has been appropriately filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

> ...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a

> submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

In the present instance, the submission fails to satisfy both items (A) and (B), because there is neither a ***factual accounting*** to explain why the information submitted could not be submitted earlier or an ***explanation of the relevance*** of the information submitted with respect to the **claimed invention** in the reexamination proceeding. The instant petition was filed very late in the reexamination proceeding, and no substantive attempt is made to satisfy the guidance of MPEP 2256. The patent owner has not provided a discussion of the substance of the information, and has neither made a factual accounting to explain why the information is being submitted so late or explained the relevance of the same with respect to the claim limitations in the present reexamination proceeding. The only statements made by patent owner in the petition are that on the date of filing the petition they were aware of the NIRC by virtue of the public PAIR system and that patent owner had not yet received or seen the NIRC. Such statements satisfy neither items (A) nor (B).

In summary, there is no factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; nor is there an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with ***special dispatch*** within the Office." A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on December 10, 2007, and the proceeding is being prepared to enter the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite discussion (factual accounting and explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is dismissed as to the request for consideration of the IDS papers.

If, however, the patent owner in fact believes that any reference submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s).

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on December 11, 2007.

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

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

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

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

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.
90/008,376	12/14/2006	6212079	9578.0006-07	3367

7590 08/09/2007

EXAMINER	

JAMES Y GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
7TH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES, CA 90025

ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2007

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

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CENTRAL REEXAMINATION UNIT

James Y. Go
BLAKELY SOKOLOFF TAYLOR
& ZAFMAN LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles CA 90025

For Patent Owner

Richard V. Burgujian, Esq.
FINNEGAN HENDERSON FARABOW
GARRET & DUNNER LLP
901 New York Avenue NW
Washington, DC 20001-4413

For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,771
Filed: October 21, 2005
For: US Patent No. 6,212,079

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,376
Filed: December 14, 2006
For: US Patent No. 6,212,079

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

BACKGROUND

1. Patent No. 6,212,079 issued on April 3, 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,771 was requested by a third party requester on October 21, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,771 on December 27, 2005.

4. There are currently no amendments proceeding control number 90/007,771.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,376 was requested by a third party requester filed on December 14, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,376 on February 9, 2007.

7. There are currently no amendments proceeding control number 90/008,376.

8. Proceedings control numbers 90/007,771 and 90/008,376 awaits the first Office action on the merits from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/007,771 and 90/008,376 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,771 and 90/008,376 are **MERGED**.

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

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

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

James Y Go (For Patent Owner)
Blakely Sokoloff Taylor & Zafman LLP
7th Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

Richard V. Burgujian, Esq. (For Requester)
Finnegan Henderson Farabow
Garret & Dunner LLP
901 New York Avenue NW
Washington, DC 20001-4413

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/007,771
Request Deposited: October 21, 2005
For: U.S. Patent No. 6,121,079

: DECISION ON PETITION
: FILED UNDER 37 CFR 1.181

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/008,376
Request Deposited: December 14, 2006
For: U.S. Patent No. 6,121,079

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of the petition filed October 12, 2007 requesting resetting the shortened statutory period (SSP) for response and requesting remailing of the office action of October 1, 2007. The petition is considered pursuant to 37 CFR 1.181 and no fee is required.

The petition is **DISMISSED AS MOOT**.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,212,079 (hereinafter, the '079 patent), issued to Balakrishnan *et alia*, on April 3, 2001.

2. On October 21, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '457 patent. The reexamination proceeding was assigned Control No. 90/007,771 (hereinafter, the '7771 proceeding).

3. The reexamination order was granted in the '7771 proceeding on December 27, 2005.

4. On December 14, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '457 patent. The reexamination proceeding was assigned Control No. 90/008,376 (hereinafter, the '8376 proceeding).

5. The reexamination order was granted in the '8376 proceeding on February 9, 2007.

6. The '7771 and '8376 proceedings were merged on August 9, 2007.

7. A non-final office action was mailed on October 1, 2007 setting a shortened period for response of 1 month.

DECISION

Petitioner points out that one of the conditions set forth in MPEP 2263 that would permit a shortened statutory period of one month has not been met. Specifically, the action was not signed by the Director or Deputy Director of OPLA, the Director of the CRU, or the Director of the Technology Center in which the reexamination is being conducted. Petitioner is correct. Although the petition is silent as to the other conditions under which a SSP can be set to one month, the present proceedings are not court-ordered reexaminations and litigation is not stayed for purposes of the reexamination. It is noted that litigation is stayed pending final determination of an appeal from the International Trade Commission (ITC). However, litigation is not stayed for purposes of the present merged reexaminations. Therefore, there is no basis to set the SSP to one month. The SSP in the office action mailed October 1, 2007 should have been set to expire 2 months from the mailing date.

Petitioner also requests that the office action of October 1, 2007 be remailed. There appears to be no basis for the requested relief. A review of the record indicates that a second non-final office action was mailed on October 19, 2007. That action withdrew the office action mailed October 1, 2007 and set the SSP to 2 months. Accordingly, petitioner's requests are dismissed as moot.

CONCLUSION

1. Petitioner's requests are dismissed as moot. The non-final office action mailed October 19, 2007 is before Patent Owner for response.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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

Eric Keasel For
Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,376	12/14/2006	6212079	9578.0006-07	3367

7590 03/06/2009

EXAMINER	

JAMES Y GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

RICHARD V. BURGUJIAN
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 2001-4413

Date:

MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008376
PATENT NO. : 6212079
ART UNIT : 3900

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

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

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MAR 06 2009
CENTRAL REEXAMINATION UNIT

JAMES Y. GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE CA 94085-4040

(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Requester)

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/007,771
Request Deposited: October 21, 2005
For: U.S. Patent No. 6,121,079

DECISION ON PETITION UNDER 37 CFR 1.59

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/008,376
Request Deposited: December 14, 2006
For: U.S. Patent No. 6,121,079

DECISION

This is a decision on the petition under 37 CFR 1.59(b), filed August 31, 2006, to expunge information from the above identified proceedings.

The petition is **granted**.

Petitioner requests that documents entitled

COMPLAINANT POWER INTEGRATIONS, INC.'S POSTHEARING STATEMENT, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006;

RESPONDENT SYSTEM. GENERAL CORPORATION'S POST-HEARING BRIEF. In the Matter Of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME. United State, International Trade Commission, Washington. DC 20436. Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006; and

POST-HEARING BRIEF OF THE COMMISSION INVESTIGATIVE STAFF, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 14, 2006

, filed August 28, 2006, be expunged from the record. It is noted that the documents and petition were submitted in 90/007,771 only. 90/007,771 was subsequently merged with 90/008,376. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been removed from the official file. Since this proceeding is not a paper file, the return of the expunged material may not be possible in an Image File Wrapper (IFW) proceeding where a paper is entered into the record. Instead, such papers are marked "closed" and "not public".

CONCLUSION

1. Petitioner's request is **granted**.

2. Patent Owner is **required** to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

3. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel for
Gregory Morse
Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 13, 2009

TO SPE OF : ART UNIT 3992 - Lynne H. Browne

SUBJECT : Request for Certificate of Correction for Appl. No. 90/007,771 and 90/008,376 Patent No.: 6,212,079 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Antonio Johnson

Should FIG. 2 be substituted?

Certificates of Correction Branch

(571)272-0483

Thank You For Your Assistance

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

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

approved

MARK J. REINHART
CRU SPE AU 3992

28Oct2009

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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.
90/008,377	12/15/2006	6847729	8133.003.RXUS00	3422

55694 7590 05/20/2008

DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/20/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
VINCENT M. DELUCA
NOVAK DRUCE DELUCA & QUIGG LLP
1300 EYE ST. NW
WASHINGTON, DC 20005

Date:
MAILED

MAY 20 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008377
PATENT NO. : 6847729
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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MAY 20 2008

CENTRAL REEXAMINATION UNIT

DRINKER BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, D.C. 20005

(For Patent Owner)

Vincent M. DeLuca
NOVAK, DRUCE, DELUCA + QUIGG LLP
1300 I Street, N.W., Suite 400 East Tower
Washington, D.C. 20005

(For Third Party Requester)

In re Reissue Application of
Noah Clinch, *et al.*
Application No.: 11/657,635
Filed: January 25, 2007
For: U.S. Patent No. 6,847,729

In re Noah Clinch, *et al.*
Reexamination Proceeding
Control No.: 90/008,377
Filed: December 15, 2006
For: U.S. Patent No.: 6,847,729

: DECISION, *SUA SPONTE*,
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. Patent No. 6,847,729 (the '729 patent) issued on January 25, 2005.

2. A request for reexamination, assigned control No. 90/008,377 (the '8377 reexamination proceeding), was filed by a third party requester on December 15, 2006.

3. An application for reissue, assigned application No. 11/657,635 (the '635 reissue application), was filed by the patent owner on January 25, 2007.

4. On January 25, 2007, a Notification of Concurrent Proceedings Pursuant to

37 CFR 1.565(a) was filed by the patent owner in the '8377 reexamination proceeding, notifying the Office of the filing of the '635 reissue application.

5. Also on January 25, 2007, a Notification of Concurrent Proceedings Pursuant to 37 CFR 1.178(b) was filed by the patent owner in the '635 reissue application, notifying the Office of the '8377 reexamination proceeding.

6. Reexamination was ordered for the '8377 reexamination proceeding on March 14, 2007.

7. The filing of the '635 reissue application was announced in the *Official Gazette* on June 26, 2007.

8. A patent owner's statement under 37 CFR 1.530 was not received in the '8377 reexamination proceeding, and the time for filing same expired.

9. In the '635 reissue application, the Office issued a non-final Office action on February 20, 2008. The February 20, 2008 Office action was defective in that it does not treat the '635 application as a reissue application. As indicated in the Interview Summary of April 17, 2008, the examiner agreed to generate another Office action to correct the February 20, 2008 action. The Office has not issued such an action superseding the February 20, 2008 action.

10. An Office action on the merits has not been issued in the '8837 reexamination proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

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

As evidenced by the above review of facts, the '635 reissue application and the '8837 reexamination proceeding are currently pending. Because the order to reexamine has been mailed in the '8837 reexamination proceeding and notice of the '635 application has been published in the *Official Gazette*, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a

particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the '635 reissue application shows:

   (a) Original patent claims 1-22 are present.

   (b) Original claims 1, 16, and 21 are amended by the Preliminary Amendment filed on January 25, 2007.

(c) New claims 23-52 are added by the Preliminary Amendment filed on January 25, 2007.

3. A review of the reexamination file for the '8377 reexamination proceeding shows that original patent claims 1-22 are present, and no amendments have been made.

4. At least claims 1, 16, 21, and 23-52 in the '635 reissue application are not identical to the claims in the '8377 reexamination proceeding. Accordingly, the claims are not identical in both proceedings.

5. It is noted, further, that the specification is amended in the '635 reissue application, while not so for the '8377 reexamination proceeding. In particular, the paragraph beginning at column 6, line 11, of the '729 patent is amended by the Preliminary Amendment filed on January 25, 2007, in the '635 reissue application.

6. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, the above-captioned reissue and reexamination proceedings. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must not address any issue of patentability in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

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

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

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

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

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

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

6. Pursuant to MPEP 2285:

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

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

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

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

8. Upon return of the present merged proceeding to the examiner, the examiner will review the files to ascertain that each file contains identical citations of prior

patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

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

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

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

CONCLUSION

1. Reissue application No. 11/657,635 and reexamination control No. 90/008,377 are hereby merged into a single proceeding.

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

3. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 2600, 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 '729 patent (e.g., by preparing/signing an action). See MPEP 2236. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the

housekeeping amendment to place the same amendments in both cases, or (b) the expiration of the ONE MONTH period (from the mailing of this decision) set in part 2 of the "Conclusion."

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

5. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

RT
05/19/08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,378	12/15/2006	6804129	072395.0109	3897

41066 7590 08/09/2007

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2007

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

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CENTRAL REEXAMINATION UNIT

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE CA 95113

For Patent Owner

Kenneth H. Ohriner
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P. O. Box 1208
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For Third Party Requester

Fulghum, Roger
BAKER BOTTS LLP
910 Louisiana St.
One Shell Plaza
Houston, TX 77002

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/007,929
Filed: February 12, 2006
For: US Patent No. 6,804,129

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/008,378
Filed: December 15, 2006
For: US Patent No. 6,804,129

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

BACKGROUND

1. Patent No. 6,804,129 issued on October 12, 2004.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,929 was requested by a third party requester on February 12, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/007,929 on April 11, 2006.

4. There are currently no amendments proceeding control number 90/007,929.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,378 was requested by a third party requester filed on December 15, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,378 on January 26, 2007.

7. There are currently no amendments proceeding control number 90/008,378.

8. Proceedings control numbers 90/007,929 and 90/008,378 awaits the first Office action on the merits from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/007,929 and 90/008,378 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,929 and 90/008,378 are **MERGED**.

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

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

By Mail to: Mail Stop *Ex Parte* Reexam
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By Fax to: (571) 273-9900
Central Reexamination Unit

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

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

for

Lissi M. Marquis,
Director,
Central Reexamination Unit

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MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET,
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For Patent Owner

MAILED
JAN 03 2008
CENTRAL REEXAMINATION UNIT

Kenneth H. Ohriner
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For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
EX PARTE & INTER PARTES
REEXAMINATION
PROCEEDINGS

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/007,929
Deposited on: 12 February 2006
For: US Patent No. 6,804,129

In re: Lin :
Ex Parte Reexamination Proceeding :
Control No. 90/008,378 :
Deposited on: 15 December 2006 :
For: US Patent No. 6,804,129 :

In re: Lin :
Inter Partes Reexamination Proceeding :
Control No. 95/000,291 :
Deposited on: 16 August 2007 :
For: US Patent No. 6,804,129 :

The above-identified reexamination files are before the Director of the Central Reexam Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.989

DISCUSSION

As noted under 37 CFR 1.989. Merger of concurrent reexamination proceedings.

37 CFR 1.989

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an ex parte reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by § 1.902 through 1.997, except that the rights of any third party requester of the ex parte reexamination shall be governed by § § 1.510 through 1.560.

As noted in the above noted facts, the *inter partes* reexamination proceeding and the *ex parte* reexamination proceedings are currently pending Since reexamination has been ordered in all the proceedings and the time period for filing the appropriate subsequent patent owner's response has expired, a decision under 37 CFR § 1.989 (a) is timely.

The general policy of the Office is that the examination of the *inter partes* reexamination proceeding and the *ex parte* reexamination proceedings will not be conducted separately but will be conducted at the same for a single patent resulting in a single reexamination certificate. The reason for this policy is to prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding.

In review of the prosecution history of the inter partes reexamination control number 95/000,291 there have been no amendments to the claims since the order has only just been granted. There is no first Office action on the merits at this time.

In review of the prosecution history of the ex parte proceedings 90/007,929 and 90/008,378 there are no amendments at this time to the claims or specification in these previously merged proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.989(a), the 90/95/000,291; 90/007,929 and 90/008,378 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files throughout the prosecution of the merged proceedings.

III. Conduct of Merged Proceeding.

A. Governing regulations for the merged proceedings:

The present decision merges the ex parte proceedings and the inter partes proceeding. Pursuant to 37 CFR 1.989 (b), the merges proceeding is to be governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed.

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

CONCLUSION

1. Reexamination Control Nos. 95/000,291; 90/007,979 and 90/008,378 are **MERGED**.

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

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

By Mail to: Mail Stop *Ex Parte* Reexam
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Alexandria, VA 22314

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

MARK J. REINHART
CRU SPE-AU 3992

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,378	12/15/2006	6804129	072395.0109	3897

41066 7590 06/27/2008

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2008

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

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FULGHUM,ROGER

Baker Botts, LLP

910 Louisiana St.

One Shell Plaza

Houston, TX 77002

MAILED

JUN 27 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,378*. + 90/007989 + 95/000291

PATENT NO. *6804129*.

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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JUN 27 2008

CENTRAL REEXAMINATION UNIT

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910 Louisiana Street
One Shell Plaza
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Kenneth H. Ohriner (For 90/007,929 Requester)
Perkins Coie LLP
P.O. Box 1208
Seattle, WA 98111

In re Lin :
Inter partes Reexamination Proceeding :
Control No.: 95/000,291 :
Filed: October 1, 2007 :
For: U.S. Patent No. 6,804,129 : DECISION GRANTING
: PETITION UNDER
In re Lin : 37 CFR § 1.183
Ex parte Reexamination Proceeding :
Control No.: 90/008,378 :
Filed: December 15, 2006 :
For: U.S. Patent No. 6,804,129 :
:
In re Lin :
Ex parte Reexamination Proceeding :
Control No.: 90/007,929 :
Filed: February 12, 2006 :
For: U.S. Patent No. 6,804,129 :

This is a decision on the June 13, 2008 patent owner petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length.

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

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,804,129 (the '129 patent) issued on October 12, 2004.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/007,929 ('929), was filed on February 12, 2006, by the '929 third party requester. An order granting reexamination of the '129 patent was mailed for the '929 reexamination proceeding on April 11, 2006.

3. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/008,378 ('378), was filed on December 15, 2006, by the '378 third party requester. An order granting reexamination of the '129 patent was mailed for the '378 reexamination proceeding on January 26, 2007.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,291 ('291), was filed on October 1, 2007, by the '291 third party requester. An order granting reexamination of the '129 patent was mailed for the '291 reexamination proceeding on November 9, 2007.

5. A decision merging the '929, '378, and '291 reexamination proceedings was mailed on January 3, 2008.

6. A non-final Office action regarding the merged proceeding was mailed on March 26, 2008.

7. On April 28, 2006, patent owner filed a response that was 168 pages in length to the March 26, 2008 Office Action.

8. On June 13, 2008, the patent owner filed the instant petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed 50 pages in length.

DECISION

37 CFR 1.943(b) prohibits a patent owner in an *inter partes* reexamination proceeding from filing a response which exceeds 50 pages in length. In the instant petition, the patent owner requests relief from such limitation on filing its response to the Office action of March 26, 2008. The April 28, 2006 response to the March 26th Office action is 168 pages in length. Based upon the need to address the patentability issues raised in the three merged reexamination proceedings, the requested page limit of 168 pages is deemed equitable in addressing the Office action. Accordingly, the petition is granted:

(A) For only the April 28, 2006 response supplied by the patent owner in response to the March 26, 2008 Office action, and thus

(B) To permit patent owner to provide one-hundred and sixty-eight (168) pages for patent owner's response to the March 26, 2008 Office action, as patent owner has done.

CONCLUSION

1. The renewed petition under 37 CFR 1.183 for waiver of the length requirement of 37 CFR 1.943(b) is granted to permit patent owner's April 28, 2006 response to the March 26, 2008 first Office action, which response is one-hundred and sixty-eight (168) pages in length.

2. The date for filing of any third party requester comments under 37 CFR 1.947 runs thirty (30) days from the date of this decision waiving the length requirement of 37 CFR 1.943(b), to now complete the response *as to the length requirement*.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

4. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Office of Patent Legal Administration, at (571) 272-7710.

for

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

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Lionel M. Lavenue (For *Inter Partes* Requester)
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CENTRAL REEXAMINATION UNIT

Kenneth H. Ohriner (For First *Ex Parte* Requester)
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Roger Fulghum (For Second *Ex Parte* Requester)
BAKER BOTTS LLP
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Inter Partes Reexamination Proceeding :
Control No. 95/000,291 :
Filed: October 1, 2007 :
For: U.S. Patent No. 6,804,129 :
:
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/007,929 : **GRANTING**
Filed: February 12, 2006 : **PETITION**
For: US Patent No. 6,804,129 :
:
Ex Parte Reexamination Proceeding :
Control No. 90/008,378 :
Filed: December 15, 2006 :
For: US Patent No. 6,804,129 :

This is a decision on the patent owner paper entitled "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)," filed on March 3, 2009.

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

The patent owner petition under 37 CFR 1.183 is granted for the concurrently submitted (March 3, 2009) patent owner 37 CFR 1.951(a) submission. The page limit of 37 CFR 1.943(b) submission is waived as to the 8 pages of the arguments portion of the patent owner's March 3, 2009 response that are found to exceed the 50-page limit.

Because the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 did not accompany the March 3, 2009 petition, the petition fee of $400.00 will charged to patent owner's Deposit Account (50-4160), as authorized on page 2 of the petition.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,804,129 (the '129 patent) issued on October 12, 2004.

2. On February 12, 2006, a first request for *ex parte* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 90/007,929 (the '7929 proceeding).

3. On April 11, 2006, the Office issued an order granting *ex parte* reexamination in the '7929 proceeding.

4. On December 15, 2006, a second request for *ex parte* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 90/008,378 (the '8378 proceeding).

5. On January 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8378 proceeding.

6. On August 9, 2007, the Office issued a "DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS," merging the '7929 and '8378 *ex parte* proceedings.

7. On October 1, 2007, a request for *inter partes* reexamination of the '129 patent was filed by a third party requester, and assigned Reexamination Control No. 95/000,291 (the '291 proceeding).

8. On November 9, 2007, the Office issued an order granting *inter partes* reexamination in the '291 proceeding.

9. On January 3, 2008, the Office issued a "DECISION, *SUA SPONTE* MERGING *EX PARTE* & *INTER PARTES* REEXAMINATION PROCEEDINGS," merging the '7929, '8378, and '291 proceedings into a single, merged proceeding ("the merged proceeding").

10. On February 2, 2009, the Office mailed an Action Closing Prosecution in the merged proceeding.

11. On March 3, 2009, patent owner filed the instant petition paper entitled, "PETITION UNDER 37 CFR §1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR RESPONSE TO OFFICE ACTION UNDER 37 CFR § 1.943(b)."

12. Concurrently on March 3, 2009, patent owner filed a 37 CFR 1.951(a) submission, after the February 2, 2009 Action Closing Prosecution.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

On March 3, 2009, patent owner concurrently filed with the instant petition a 37 CFR 1.951(a) submission, titled as a response to the February 2, 2009 Action Closing Prosecution. The response exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 8 pages (the response is a total of 66 pages - 1 page of identification information and introductory remarks, 7 pages of claim amendments, and 58 pages of arguments).[1] In the instant petition, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) with respect to the March 3, 2009 response.

In support of waiver of the rule, patent owner indicates that the February 2, 2009 Action Closing Prosecution "numbered 137 pages in length and recites eighteen issues."[2] Patent owner asserts that "[i]n order effectively address the patentability of the three merged proceedings, and rebut the eighteen issues raised in the Office Action, the Patent Owner feels it will be necessary to exceed the 50 page limit set forth in 37 C.F.R. § 1.943."[3]

In this instance, petitioner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a patent owner's response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the March 3, 2009 petition for waiver of 37 CFR 1.943(b) with respect to the submitted response. Upon review of the submitted response for economizing, extraneous

[1] Only those pages of patent owner's response upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2).
[2] Petition at page 1.
[3] Petition at pages 1-2.

material, and arrangement, without repetition of information already of record, it is found that the 8 pages of arguments in excess of 50 required to complete the patent owner's response are not unreasonable in this instance, in view of the present facts and circumstances.

Based on the February 2, 2009 Action Closing Prosecution, which sets forth 50 grounds of rejection of the claims in approximately 120 pages, and the review of the submitted response thereto, as well as on the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the arguments portion of patent owner's March 3, 2009 response exceeds the 50-page limit by 8 pages.

Accordingly, the patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **8 pages** of the arguments portion of the patent owner's March 3, 2009 response that exceed the 50-page limit.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) submission is waived as to the 8 pages of the arguments portion of the patent owner's March 3, 2009 response that exceed the 50-page limit.

2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at 571-272-7717.

/Kenneth M. Schor/

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

04-28-09
C:\kiva\kenpet7\IP\UV\length\95_291+90_7929+90_8378 Grant Pg Length Waiver

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,380	12/15/2006	6259615	072395.0107	4318

41066 7590 08/09/2007

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2007

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CENTRAL REEXAMINATION UNIT

MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE CA 95113

For Patent Owner

Kenneth H. Ohriner
PERKINS COLE LLP
P. O. Box 1208
Seattle, WA 98111

For Third Party Requester

Fulghum, Roger
BAKER BOTTS LLP
910 Louisiana St.
One Shell Plaza
Houston, TX 77002

For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/008,009
Filed: April 13, 2006
For: US Patent No. 6,259,615

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/008,380
Filed: December 15, 2006
For: US Patent No. 6,259,615

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

BACKGROUND

1. Patent No. 6,259,615 issued on July 10, 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,009 was requested by a third party requester on April 13, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,009 on May 15, 2006

4. There are currently no amendments proceeding control number 90/008,009.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,380 was requested by a third party requester filed on December 15, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,380 on January 26, 2007.

7. There are currently no amendments proceeding control number 90/008,380.

8. Proceedings control numbers 90/008,009 and 90/008,380 awaits the first Office action on the merits from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,009 and 90/008,380 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,009 and 90/008,380 are **MERGED**.

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

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
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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, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

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SAN JOSE CA 95113

For Patent Owner

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For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/008,014
Filed: April 19, 2006
For: US Patent No. 6,396,722

In re: Lin
Ex Parte Reexamination Proceeding
Control No. 90/008,381
Filed: December 15, 2006
For: US Patent No. 6,396,722

In re: Lin

Ex Parte Reexamination Proceeding :
Control No. 90/008,586 :
Filed: April 11, 2007 :
For: US Patent No. 6,396,722 :

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

BACKGROUND

1. Patent No. 6,396,722 issued on May 28, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,014 was requested by a third party requester on April 19, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,014 on June 1, 2006.

4. There are currently no amendments proceeding control number 90/008,014.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,381 was requested by a third party requester filed on December 15, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,381 on January 26, 2007.

7. There are currently no amendments proceeding control number 90/008,381.

8. *Ex Parte* Reexamination Proceeding, control no. 90/008,586 was requested by a third party requester filed on April 11, 2007.

9. The Reexamination Order was granted in proceeding, control no. 90/008,586 on May 8, 2007.

10. There are currently no amendments proceeding control number 90/008,586.

11. Proceedings control numbers 90/008,014; 90/008,381 and 90/008,586 awaits the first Office action on the merits from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,014; 90/008,381 and 90/008,586 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,014; 90/008,381 and 90/008,586 are **MERGED**.

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

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
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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, 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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SUITE 200
AUSTIN TX 78730

Kevin W. Jakel (For Requester)
Kaye Scholer LLP
901 Fifteenth Street, NW, Suite 1000
Washington, DC 20005

In re: Meyer *et alia* :
Reexamination Proceeding : **DECISION**
Control No. 90/008,386 : **DISMISSING**
Request Deposited: December 21, 2006 : **PETITIONS**
For: U.S. Patent No. 6,504,103 :

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of the petition filed April 8, 2009 entitled "PETITION TO ENTER AND CONSIDER SUPPLEMENTAL REPLY" and the petition filed June 2, 2009 entitled "PETITION TO REOPEN PROSECUTION".

The petitions are **DISMISSED** for the reasons set forth below.

DECISION

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.

The petitions raise multiple issues which are addressed by different branches of the office. The April 8, 2009 petition request states, in part:

"Applicants [sic, presumably Patent Owner] request the Director to invoke his supervisory authority under 37 C.F.R. § 1.181 to enter the March Supplemental Reply...

In the alternative, should the Director not invoke his supervisory authority Applicants [sic, presumably Patent Owner] hereby petition the Director to suspend the rules under 37 C.F.R. § 1.183 and enter the March Supplemental Reply because Applicants were diligent in filing the March Supplemental Reply... "

The June 2, 2009 states, in part:

"Patent Owner petitions the Director to invoke his supervisory authority under 37 C.F.R. § 1.181 to reopen prosecution in the present examination...

In the alternative, should the Director not invoke his supervisory authority, the Patent Owner hereby petitions the Director to address a question not specifically provided for under 37 C.F.R. § 1.182 or suspend the rules under 37 C.F.R. § 1.183 to reopen prosecution in the present examination..."

In view of the fact that the petitions improperly combine multiple, distinct matters considered by different branches of the USPTO in a single paper, the petitions are **dismissed** under 37 CFR 1.4(c).

CONCLUSION

1. Petitioner's requests are **dismissed**.

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.

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,386	12/21/2006	6504103	RTC-2007-0245	1550

34456 7590 08/04/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Date:

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008386
PATENT NO. : 6504103
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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SUITE 200
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(For Patent Owner)

KEVIN W. JAKEL
KAYE SCHOLER LLP
901 FIFTEENTH STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005

(For Requester)

MAILED
AUG 04 2009
CENTRAL REEXAMINATION UNIT

In re Meyer et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,386
Filed: December 21, 2006
For: U.S. Patent No. 6,504,103 B1

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the June 29, 2009 patent owner petition entitled "PETITION TO ENTER AND CONSIDER SUPPLEMENTAL REPLY"

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

The petition is **dismissed**.

BACKGROUND

- On December 21, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,386 ("the '386 proceeding").

- Prosecution progressed until, on March 25, 2009, a final Office action was issued by the Office.

- On June 16, 2009, the Office issued a decision dismissing petitions filed April 8, 2009, and June 2, 2009, as violating the proscription under 37 C.F.R. § 1.4 against submission of a single paper containing multiple issues addressed by different branches of the Office; in particular, relief was requested under both 37 C.F.R. § 1.181 and 37 C.F.R. § 1.182.

- On June 29, 2009, patent owner filed four petitions:

1. "PETITION UNDER 37 CFR 1.181 TO REOPEN PROSECUTION," requesting reopening of prosecution.

2. "PETITION TO REOPEN PROSECUTION," requesting reopening of prosecution under 37 CFR 1.182, or alternately, 37 CFR 1.183.

3. "PETITION UNDER 37 CFR 1.181 TO ENTER AND CONSIDER SUPPLEMENTAL REPLY," requesting entry and consideration of the supplemental reply filed on March 4, 2009.

4. "PETITION TO ENTER AND CONSIDER SUPPLEMENTAL REPLY," requesting entry and consideration, under 37 CFR 1.182, or alternately, 37 CFR 1.183, of the supplemental reply filed on March 4, 2009, the petition which is the subject of this decision.

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 1.183 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 1.181 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.

37 CFR 1.111 provides, in pertinent part:

(a)(2) Supplemental replies. (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);
(B) Adoption of the examiner suggestion(s);
(C) Placement of the application in condition for allowance;
(D) Reply to an Office requirement made after the first reply was filed;
(E) Correction of informalities (e.g., typographical errors); or
(F) Simplification of issues for appeal.

DECISION

In this instance, the patent owner has concurrently (with the petition addressed by this decision) pursued alternative relief via a 37 CFR 1.181 petition to request entry and consideration of a supplemental reply filed on May 4, 2009, denied consideration as indicated in a final Office action issued March 25, 2009. In the instant petition, patent owner requests the identical relief via a petition filed under 37 CFR 1.182, or in the alternative, 37 CFR 1.183. The concurrently filed June 29, 2009 petition under 37 CFR 1.181 to request entry and consideration of a supplemental reply filed on May 4, 2009 has not yet been decided. The relief requested in the petition under 37 CFR 1.182 would be moot, should relief be granted under 37 CFR 1.181. Since entry and consideration of the supplemental reply filed on May 4, 2009 is currently in the process of being addressed through a concurrently filed petition under 37 CFR 1.181, consideration of this situation under 37 CFR 1.182 would be premature. Note that further supervisory review of an adverse decision under 37 CFR 1.181 is available by further petition under 37 CFR 1.181.

Should patent owner, at some future date, concede the propriety of the nonentry of the May 4, 2009 supplemental reply, (making a request for further supervisory review under 1.181 inapplicable), patent owner retains the option of filing a renewed petition under 37 CFR 1.182 or 37 CFR 1.183 as appropriate. Until such time, the issue is not ripe for consideration by the Office under either 37 CFR 1.182 or 1.183. Note that § 1.183 applies where there is a rule that applies for which petitioner is requesting waiver, while § 1.182 applies where there is no rule that applies.

Should patent owner, at some future date, file a renewed petition for rule waiver, patent owner

should identify which rule or rules are desired to be waived under 37 CFR 1.183 and provide the proper facts and rationale for such a determination. Note that 37 CFR 1.111(a)(2) addresses a situation in which a supplemental response is currently pending before the Office, not a situation in which a previously submitted supplemental response was previously denied entry. Further note MPEP 714.03, which states: "If applicant wishes to have a not-entered supplemental reply considered, applicant should include the changes in a reply filed in response to the next Office action. Applicant cannot simply request its entry in the subsequent reply." If rule waiver is not needed, but no rules apply, patent owner should so state, and file only under 37 CFR 1.182 giving an appropriate, and clearly indicated, rationale. It is noted that a separate request for consideration under 37 CFR 1.182, or alternately, 37 CFR 1.183, to reopen prosecution and continue reexamination has been concurrently filed, and a decision is being mailed on an even date herewith. This decision does not address that separate request.

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

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 June 29, 2009 petitions 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
Senior Legal Advisor
Office of Patent Legal Administration

Aug, 3, 2009
kenpet7/

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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.
90/008,387	12/21/2006	6346983	71226.0027	1565

7590 10/30/2009

ALEKSANDR L. YUFA
698 CYPRESS AVENUE
COLTON, CA 92324-1952

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

KENNETH CAGE

MCDERMOTT WILL & EMERY LLP

600 13TH STREET, N.W.

WASHINGTON, DC 20005-3096

MAILED

OCT 30 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,387*.

PATENT NO. *6346983*.

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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ALEKSANDR L. YUFA
698 CYPRESS AVENUE
COLTON CA 92324-1952

(For Patent Owner)

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

(For Third Party Requester)

MAILED

OCT 3 0 2009

CENTRAL REEXAMINATION UNIT

In re: Aleksandr L Yufa
Ex Parte Reexamination Proceeding
Control No. 90/008,387
Deposited: 21 December 2006
For: US Patent No. 6,346,983

DECISION
DENYING
PETITION FOR EXTENSION
OF TIME
37 CFR § 1.136(b)

This is a decision on the 19 October 2009, "Petition for Extension of Time Under 37 CFR §1.136(b)" requesting that the time for responding be extended by one (1) month. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g).

The petition 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 further extended in which to file a response, which sets a one (1) months date for filing a response thereto. The petition for extension of time was timely submitted 19 October 2009. The petition seeks a one (1) month extension of time

The extension of time is denied

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.

MPEP 2265 (in-part)

> The provisions of 37 CFR § 1.136 (a) and (b) are NOT applicable to *ex parte* reexamination proceedings under any circumstances. Public Law 97-247 amended 35 U.S.C. § 41 to authorize the Director to provide for extensions of time to take action which do not require a reason for the extension in an "application." An ex parte reexamination proceeding does not involve an "application." 37 CFR § 1.136 authorizes extensions of the time period only in an application in which an applicant must respond or take action. There is neither an "application," nor an "applicant" involved in a reexamination proceeding. (emphasis added)

ANALYSIS AND FINDINGS

The patent owner's representative petitions under 37 CFR 1.136(b) which is not applicable to ex parte reexamination. The Patent Owner is directed to 37 CFR 1.550(c) for future reference as to how extensions of time are submitted for consideration in *ex parte* reexamination..

The petition request to extend the response time is hereby denied.

CONCLUSION

1. The patent owner's petition for extension of time is hereby **denied.**

2. The time to respond to the notice of appeal continues to run.

3. Response is due on **28 October 2009**.

4. Response and/or submissions to the Office should be addressed as follows:

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

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

By Hand: Customer Service Window
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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,391	02/26/2007	4918645	QNTA.006XX0	6097

33694 7590 02/12/2008

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2008

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SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON DC 20005

(For Patent Owner)

MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

HSUE, JAMES
Davis Wright Tremaine, LLP
505 Montgomery Street
Suite 800
San Francisco, CA 94111

(For Third Party Requestor)

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

In re: Lagoy, Jr.
Reexamination Proceeding
Control No. 90/006,789
Deposited: 14 October 2003
For U.S. Patent No. 4,918,645

In re: Lagoy, Jr.
Reexamination Proceeding
Control No. 90/007,420
Deposited: 14 February 2005
For U.S. Patent No. 4,918,645

In re: Lagoy, Jr.
Reexamination Proceeding
Control No. 90/008,391
Deposited: 26 February 2007
For U.S. Patent No. 4,918,645

The above-identified reexamination files are before the Director of the Central Reexam Unit, for consideration of merger of reexamination control number 90/008,391 and the reexamination control number 90/007,420 previously merged with 90/006,789 pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,918,645 issued on 17 April 1990.

2. The 90/006,789 reexamination proceeding was deposited on 14 October 2003 by a third party requester.

3. The 90/007,420 proceeding Order was deposited on 14 February 2005 by a third party requester.

4. The 90/006,678 and the 90/007,420 proceedings were merged on 5 April 2005.

5. Claim 2, 6, 13 and 17 were amended on 27 May 2005 in the merged proceedings, control number 90/006,789 and 90/007,420.

6. On 28 September 2006 the Board of Appeals and Interferences rendered a decision on the claims. Claims 1, 6, 12, and 17 were revered under the examiner's rejection and new grounds for rejection provided by the Board. The Merged proceedings were remanded to the examiner for further action on the new grounds for rejection.

7. The 90/008,391 reexamination proceeding was deposited on 26 February 2007 by a third party requester.

8. The 90/008,391 proceeding Order granting reexamination was mailed on 27 April 2007.

9. There are no amendments to the 90/008,319 proceeding at this time.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte*

reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

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

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/006,789; 90/007,420 and 90/008,391 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/006,789; 90/007,420 and 90/008,391 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in Both Proceedings

As noted above, the claims have been amended in the 90/006,789 and 90/007,420 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/006,789; 90/007,420 and 90/008,391 are **merged**.

2. Patent owner has **one-month** from the date of this decision to submit an appropriate "housekeeping" amendment.

3. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

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

By Mail to: Mail Stop *Ex Parte* Reexam
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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

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

MARK J. REINHART
SPE ~~SPRE-AU 3992~~
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,391	02/26/2007	4918645	24286-40162	6097

33694 7590 02/13/2009

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1501 K STREET, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2009

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,789	10/14/2003	4918645	24286-40160	8644

33694 7590 02/13/2009

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ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,420	02/14/2005	4918645	24286-40161	2031

33694 7590 02/13/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2009

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SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON DC 20005

(Patent Owner)

JAMES S. HSUE
PARSONS HSUE & DE RUNTZ LLP
595 MARKET STREET
SUITE 1900
SAN FRANCISCO, CA 94105

(Third Party Requester)

MAILED

FEB 13 2009

CENTRAL REEXAMINATION UNIT

In re Lagoy, Jr. et al.
Reexamination Proceeding
Control No.: 90/006,789
Filed: October 14, 2003
For: U.S. Patent No.: 4,918,645

In re Lagoy, Jr. et al.
Reexamination Proceeding
Control No.: 90/007,420
Filed: February 14, 2005
For: U.S. Patent No.: 4,918,645

In re Lagoy, Jr. et al.
Reexamination Proceeding
Control No.: 90/008,391
Filed: December 26, 2006
For: U.S. Patent No.: 4,918,645

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the December 12, 2008 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this merged reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

The patent owner IDS submission filed on December 12, 2008 is improper and is being EXPUNGED from the record.

BACKGROUND

1. Patent number 4,918,645 (the '645 patent) issued on April 17, 1990.
2. Reexamination Control Numbers 90/006,789, 90/007,420, and 90/008,391, addressed to the '645 patent, were merged on February 12, 2008.
3. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the merged '6789/'7420/'8931 proceeding on May 27, 2008.
4. On June 6, 2008, the '6789/'7420/8931 proceeding was forwarded to the Office of Publications.
5. The instant petition was filed on December 12, 2008, accompanied by an IDS that the patent owner requests the Office to consider.
6. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

. . . All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

37 CFR 1.4(c) states:

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

37 CFR 1.535 states:

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

37 CFR 1.550(g) provides:

The active participation of the ex parte reexamination requester ends with the reply pursuant to §1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
(1) in accordance with §1.510 or §1.535; or
(2) entered in the patent file prior to the date of the order for ex parte reexamination pursuant to § 1.525.

37 CFR 1.565(a) provides:

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

inter partes reexamination proceeding.

MPEP 2254 provides, (in part):

Once *ex parte* reexamination is ordered pursuant to 35 U.S.C. 304 and the times for submitting any responses to the order have expired, no further active participation by a third party reexamination requester is allowed, and no third party submissions will be acknowledged or considered unless they are in accordance with 37 CFR 1.510. The reexamination proceedings will be ex parte, even if ordered based on a request filed by a third party, because this was the intention of the legislation. *Ex parte* proceedings preclude the introduction of arguments and issues by the third party requester which are not within the intent of 35 U.S.C. 305 ("reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title").

The patent owner may not file papers on behalf of the requester and thereby circumvent the intent of the ex parte reexamination legislation and the rules. The Court of Appeals for the Federal Circuit held in *Emerson Elec. Co. v. Davoil*, Inc., 88 F.3d 1051, 39 USPQ2d 1474 (Fed. Cir. 1996) that a federal district court does not have the authority to order a patent owner to file papers prepared by a third party in addition to the patent owner's own submission in a patent reexamination proceeding. Such papers prepared by the third party and filed by the patent owner will not be entered, and the entire submission will be returned to the patent owner as an inappropriate response. See MPEP §§ 2266 and 2267. (Emphasis added)

MPEP 2256 provides, (in part):

. . . Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination

proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

MPEP § 2282 provides:

It is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing *ex parte* reexamination is or was involved, such as interferences, reissues, *inter partes* reexaminations, other *ex parte* reexaminations or litigations, and any results of such proceedings. In accordance with 37 CFR 1.565(a), the patent owner is required to provide the Office with information regarding the existence of any such proceedings, and the results thereof, if known. Ordinarily, no submissions of any kind by third parties filed after the date of the order are entered into the reexamination or patent file while the reexamination proceeding is pending. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. **Further, papers filed in the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments**, such as a memorandum in support of summary judgment. If the argument has an entry right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right. It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. **Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office.** It is to he noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers. **Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information. Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office.** It is to be understood that highlighting of certain text by underlining, fluorescent marker, etc., goes beyond bare notice of the prior or concurrent proceedings. (Emphasis added.)

DECISION

I. MPEP 2254 & 2282 SUBMISSION OF THIRD PARTY ARGUMENTS

The December 12, 2008 submission styled as an IDS submission is improper, because a review of the submissions reveals that the patent owner is submitting court documents, containing third party arguments, with patent owner commentary on the documents, which constitutes impermissible "notification" of concurrent proceedings. The submissions are improper under 37 CFR 1.565(a) and MPEP 2282 because (1) the patent owner has gone beyond the bare notice requirement for notification of concurrent proceedings in accordance with MPEP 2282 and (2) the third party documents contain impermissible third party arguments in support of the third party's legal defense to patent owner's legal claim they infringed the patent. Therefore, the submission is an improper submission of notification of concurrent proceedings and its inclusion on the record would violate the statutory preclusion of third party participation in an *ex parte*

reexamination proceeding. A submission can only be permitted on the record if there is a vehicle by which the documents have a right of entry.

To safeguard the statutory preclusion of third party participation in accordance with 35 U.S.C. 305, MPEP 2254 provides materials that are prepared by a third party cannot obtain entry by way of the patent owner submitting them. Accordingly, the December 12, 2008 IDS submission lacks an entry right in the present reexamination proceeding, because patent owner is submitting arguments made by a third party that do not have any right of entry. While the December 12, 2008 IDS submission was filed by the patent owner, patent owner's petitions merely points to the fact that the papers were from third party in related proceedings regarding the relevancy of the materials/documents, which do not have an entry right as an IDS submission, nor as a notification of concurrent proceedings as outlined above.[1] These materials contain third party arguments that go to the merits of the proceeding and provide unauthorized third party participation in the proceeding. See patent owner's petitions under 37 CFR 1.182 requesting entry of IDS after NIRC, documents cited in the December 12, 2008 submission in Attachments A, B, and C. The assertions made in these cited papers are, as noted above, not prior art patents or printed publications, they are directed to the merits of the reexamination proceeding, as they are commenting on the patentability of claims subject to the instant reexamination in light of prior art patents and printed publications. The assertions are clearly sourced from a third party or parties who do not have a right to comment on the merits in the present *ex parte* proceeding; having their opinions, arguments and assertions considered on the record by the examiner would be contrary the reexamination rules and the statute.

Even if patent owner's submissions are treated as a petition to waive 37 CFR 1.565(a), the provisions of this rule cannot be waived, because there is no authority in the statute providing for submission of a third party paper directed to the issues of the reexamination proceeding during the examination-prosecution stage of an *ex parte* reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). To the contrary, the *ex parte* reexamination legislation made the examination-prosecution stage of a reexamination proceeding under 35 U.S.C. 302 - 307 an *ex parte* proceeding. 35 U.S.C. 305 provides (in part):

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination **will be conducted** according to the procedures established for initial examination under the provisions of **sections 132 and 133** of this title. . . . (Emphasis added.)

The examination under the provisions of 35 U.S.C. 132 and 133 is ex parte examination. 35 U.S.C. 305 unequivocally requires such *ex parte* examination, and third party input (by a requester **or any other party**) is thus prohibited after the times for filing the statement and reply provided for by section 304. See also *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the court said (paragraph bridging pages 1868 & 1869):

---

[1] Furthermore, the December 12, 2008, submission, containing third party authored/prepared materials, is not a patent owner's statement pursuant to 37 CFR 1.530, nor a reply pursuant to 37 CFR 1.535 in accordance with 35 U.S.C. 305. The December 12, 2008, submission is not a request for reexamination in compliance with the requirements of 37 CFR 1.510 (it not in the proper format for a request for reexamination, and the reexamination filing fee has not been paid). Nor do the third party prepared court papers in the December 12, 2008, submission qualify as a prior art citation under 37 CFR 1.501. Therefore, based on 37 CFR 1.550(e), the December 12, 2008, submission does not have an entry right.

> "If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination. See 35 U.S.C. § 305 ("**[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination**"). Thus, a reexamination is conducted ex parte after it is instituted. See *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1, 5-6 n.6 (Fed. Cir.), cert. denied, 474 U.S. 828 (1985)." (Emphasis added in bold)

Accordingly, materials authored/prepared by a third party are precluded during the examination/prosecution stage of a reexamination proceeding, because a reexamination proceeding requested under 35 U.S.C. 302 is an *ex parte* proceeding after the expiration of the statement/reply period under 37 CFR 53 1.530 and 1.535. Furthermore, patent owner's petition and IDS cover letters go beyond the bare notice requirement of MPEP 2282, for notification and submission of papers in related proceedings.

In view of the above, the December 12, 2008 submission has been reviewed only to the extent needed to find that they contain impermissible third party materials, and discussions of same, which touch upon the merits of the merged proceeding. Because the December 12, 2008 submission contains improper papers, the IDS submissions are not being made a part of the record of the present proceeding. The copy of the December 12, 2008 submission papers filed for the merged reexamination proceeding is being expunged from the electronic Image File Wrapper (IFW) record of the proceedings. The expungment is effected by closing the submission documents in the IFW file of the merged proceeding and marking the documents "not public." They will not constitute part of the record of the present reexamination proceeding. In accordance with MPEP 2266, all papers in the IDS submissions will be expunged, as the Office will not determine which portion of the submission is the third party paper. A copy of this decision will be made of record in the merged proceeding.

As the IDS submission is expunged, because the information submitted therein lacks a right of entry, the petition requesting entry of an IDS after NIRC is dismissed.

II. ADDITIONAL DICUSSION REGARDING THE POST NIRC IDS PETITION

The following discussion is provided as general guidance for submissions after NIRC.

There is no issue fee in reexamination, and, in this instance, the reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present merged proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 has provided such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been

applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2656 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy the above-quoted criteria. The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. To the contrary, patent owner merely provides contentions from a third party, along with references and a rejection of claims from a "counterpart" Japanese patent application. These are not statements by the patent owner that unequivocally state why the art submitted makes at least one claim unpatentable.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Since it has been required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory provision for special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2656, quoted from above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on May 27, 2008, and the proceeding has now entered the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding and the failure to identify a question of patentability of the claims, the present merged reexamination proceeding would not be reopened at this late date to consider the proffered IDS papers. Accordingly, even if the IDS submission was a proper reexamination paper, the proceeding would not be withdrawn from the publication process.

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.

III. DIFFERENT MATTERS SUBMITTED IN A SINGLE PAPER

The December 12, 2008 submission styled as an IDS submission is improper, because while it contains prior art patents and printed publications, it also contains court documents from a related legal proceeding that are not prior art patents and printed publications. IDS submissions of patents and printed publication are governed by 37 CFR 1.97-98 and MPEP § 609; the submission of a notice of prior or concurrent proceedings and providing papers from such proceedings is governed by 37 CFR 1.565 and MPEP 2282. By melding the two separate and distinct sets of information into a single paper that purports to be an IDS, the submission runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for each separately distinct and different matter, in this instance prior art submissions versus related proceeding notification. Therefore, the filing of IDS submissions to serve as both prior art submissions and to serve as concurrent proceeding notifications is improper.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on December 12, 2008.

2. The December 12, 2008 IDS submission is an improper paper, and therefore it will NOT be made a part of the record of the merged proceeding.

3. The December 12, 2008 IDS submission, which was scanned into the electronic Image File Wrapper (IFW) of the merged proceeding, is being expunged by closing the documents in the IFW file of the present proceeding and marked them as "not public." They will not constitute part of the record of the present reexamination proceeding.

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

5. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

2-12-09

Docket No.: 204552028400
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:
Godo SAKAMOTO et al.

Patent No.: 6,899,950

Issued: May 31, 2005

For: HIGH STRENGTH POLYETHYLENE FIBER

REQUEST FOR CERTIFICATE OF CORRECTION
PURSUANT TO 37 CFR 1.322

Attention: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Upon reviewing the above-identified patent, Patentee noted a typographical error which should be corrected.

In the Claims:

In Claim 1, column 16, line 4, delete "along" and replace with -- a long --.

This error was made by the applicant in the application. Accordingly, the fee set forth in 37 CFR 1.20(a) of $100.00 is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission.

Transmitted herewith is a proposed Certificate of Correction effecting such amendment. Patentee respectfully solicits the granting of the requested Certificate of Correction.

Dated: December 29, 2006

Respectfully submitted,

By _____

Barry E. Bretschneider
Registration No.: 28,055
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7743

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
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.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO.	:	6,899,950
APPLICATION NO.	:	10/450,159
ISSUE DATE	:	May 31, 2005
INVENTOR(S)	:	Godo SAKAMOTO et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In Claim 1, column 16, line 4, delete "along" and replace with --a long--

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Barry E. Bretschneider
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102

va-187593

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

AUG 3 1 2007

CENTRAL REEXAMINATION UNIT

SYNOPSYS, INC.
C/O HAYNES BEFFEL & WOLFELD LLP
P.O. BOX 366
HALF MOON BAY CA 94019

(for Patent Owner)

Gerald P. Parsons
PARSONS HSUE & DE RUNTZ LLP
655 Montgomery St., Suite 1800
San Francisco, CA 94111

(for Third Party Requester)

James S. Hsue
PARSONS HSUE & DE RUNTZ LLP
595 Market Street, Suite 1900
San Francisco, CA 94105

(for Third Party Requester)

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Sheony *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,660
Filed: August 9, 2005
For: US Patent No. 6,378,114

In re: Sheony *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,396
Filed: December 26, 2006
For: US Patent No. 6,378,114

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

BACKGROUND

1. Patent No. 6,378,114 issued on April 23, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,660 was requested by a third party requester on August 9, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,660 on September 21, 2005.

4. An amendment was filed October 3, 2006 proceeding control number 90/007,660.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,396 was requested by a third party requester filed on December 26, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,396 on March 13, 2006.

7. An amendment was filed March 14, 2007 in proceeding control number 90/008,396.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/007,660 and 90/008,396 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,660 and 90/008,396 are **MERGED**.

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

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

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

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

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

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

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.
90/008,397	12/29/2006	7039679	6082.007.RXUS	9136

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.

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

TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date:

MAILED

AUG 29 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008397
PATENT NO. : 7039679
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

MAILED

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 et al.
Reexamination Proceeding
Control No. 90/008,397
For: U.S. Patent No. 7,039,679

: DECISION GRANTING
: IN PART PETITION
: FOR EXTENSTION OF TIME
: [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. 7,039,679 (hereinafter, the '679 patent), issued to Mendez et al., on May 2, 2006.

2. On December 29, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '679 patent. The reexamination proceeding was assigned Control No. 90/008,397 (hereinafter, the '8397 proceeding).

3. The reexamination order was granted in the '8397 proceeding on February 9, 2007.

4. Later in prosecution, a final rejection was mailed on March 14, 2008 setting a two-month period for response.

5. 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". 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. On June 20, 2008, an advisory action was mailed.

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

9. A petition for extension of time was filed on August 13, 2008.

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.
90/008,397	12/29/2006	7039679	6082.007.RXUS	9136

7590 10/02/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2008

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OCT 02 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,397*.

PATENT NO. *7039679*.

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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90/008,397	12/29/2006	7039679	6082.007.RXUS	9136

EXAMINER	
ART UNIT	PAPER NUMBER

SCOTT MCKEOWN
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DATE MAILED: 10/02/2008

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OCT 02 2008

CENTRAL REEXAMINATION UNIT

In re Mendez et al :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,397 : **GRANTING**
Filed: December 29, 2006 : **PETITION UNDER**
For: U.S. Patent No. 7,039,679 : **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 April 20, 2007 power of attorney and change of correspondence address for the patent owner, and the April 20, 2007 statement under 37 CFR 3.73(b).

The September 29, 2008 patent owner petition to revive, the April 20, 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 April 20, 2007 power of attorney and change of correspondence address for the patent owner, and the April 20, 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:

(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 306 provides:

> 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.

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 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).[1] 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, 2007 Notice of Intent to Issue a Reexamination Certificate (NIRC) is **vacated** based on the termination of prosecution for failure to timely respond.

The April 20, 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 April 20, 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,**[2] and is shown on the first page of this decision. See 37 CFR 1.33(c) and MPEP 2222.[3]

The change of correspondence address for the patent owner, filed on April 20, 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 April 20, 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 April 20, 2007, is **ineffective** for the following reasons:

1. The April 20, 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.

---

[1] The substance of the June 24, 2008 interview was summarized by the examiner in the examiner's amendment which accompanied the August 21, 2008 NIRC.

[2] The change of power of attorney and correspondence address, filed on April 2, 2007 in patent file 10/741113, 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 26, 2007 in the patent file.

[3] See also *Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*, 72 FR 18892 (April 16, 2007) (final rule).

2. The April 20, 2007 statement fails to satisfy 37 CFR 3.73(b)(1)(ii). Office records fail to reveal that any assignment of the patent under reexamination, U.S. Patent 7,039,679, has been recorded with the Office.[4] The April 20, 2007 statement also fails to satisfy 37 CFR 3.73(b)(1)(i), because the statement fails to include documentary evidence of a chain of title from the original owner to the assignee, and 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**.

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 10/741113, 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**.

- The power of attorney, change of correspondence address, and statement under 37 CFR 3.73(b), filed by the patent owner on April 20, 2007, 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.

- 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.

---

[4] An assignment of parent application 09/666877 (which issued as U.S. Patent 6,708,221), has been recorded on reel 012862, frame 0600. The corporate name and address change for parent application 09/6666877 U.S. Patent 6,708,221 is recorded on reel 014275, frame 0652. The patent file 10/741113, of the patent under reexamination in this proceeding, is a continuation of parent application 09/666877. However, a request for recordation of the patent file 10/741113, which issued as U.S. patent 7,039,679, the patent under reexamination, has not been received by the Office. See MPEP 306. Furthermore, a statement pursuant to 37 CFR 3.73(b) has not been filed in the patent file 10/741113.

- 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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PATENT NO. *7039679*.

ART UNIT *3992*.

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OCT 03 2008

CENTRAL REEXAMINATION UNIT

In re Mendez et al :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,397 : **DISMISSING AND EXPUNGING**
Filed: December 29, 2006 : **PETITION**
For: U.S. Patent No. 7,039,679 :

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 May 2, 2006, U.S. Patent 7,039,679 ("the '679 patent) issued to Mendez et al.

- On December 29, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,397 ("the '8397 proceeding").

[1] See MPEP 2267.

- On February 9, 2007, 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 '8397 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 '8397 proceeding. The statutory statement and reply period ended in the '8397 proceeding when the paten owner did not file a statement in response to the February 9, 2007 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 10/741113, 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

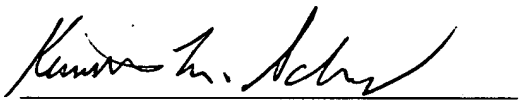
- The September 2, 2008 third party requester petition and the September 5, 2008 third party requester petition are **dismissed**.

- 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 '8397 *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.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,397	12/29/2006	7039679	6082.007.RXUS	9136

7590 10/03/2008

MANATT PHELPS AND PHILLIPS
1001 PAGE MILL ROAD
BUILDING 2
PALO ALTO, CA 94304

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/03/2008

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OCT 03 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,397*.

PATENT NO. *7039679*.

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,397	12/29/2006	7039679	6082.007.RXUS	9136

7590 10/03/2008

EXAMINER	
ART UNIT	PAPER NUMBER

SCOTT MCKEOWN
OBLON, SPIVAK, MCCLELLAND
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DATE MAILED: 10/03/2008

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(For Requester)

MAILED

OCT 03 2008

CENTRAL REEXAMINATION UNIT

Scott McKeown
Oblon, Spivak, McClelland Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

(Courtesy Copy)

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,397
Filed: December 29, 2006
For: U.S. Patent No. 7,039,679

: **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 May 2, 2006, U.S. Patent 7,039,679 ("the '679 patent) issued to Mendez et al.
- On December 29, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,397 ("the '8397 proceeding").
- On February 9, 2007, 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 '8397 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 is filed after the statutory statement and reply period ended in the '8397 proceeding. The statutory statement and reply period ended in the '8397 proceeding when the patent owner did not file a statement in response to the February 9, 2007 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 10/741113, 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 '8397 *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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,397	12/29/2006	7039679	6082.007.RXUS	9136

7590 10/06/2008

EXAMINER	

MANATT PHELPS AND PHILLIPS
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ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2008

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,397*.

PATENT NO. *7039679*.

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,397	12/29/2006	7039679	6082.007.RXUS	9136

22850 7590

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EXAMINER	
ART UNIT	PAPER NUMBER

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

In re Mendez *et alia* :
Reexamination Proceeding : DECISION DISMSSING
Control No. 90/008,397 : PETITION UNDER
For: U.S. Patent No. 7,039,679 : 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. 7,039,679 (hereinafter, the '679 patent), issued to Mendez et al., on May 2, 2006.

2. On December 29, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '679 patent. The reexamination proceeding was assigned Control No. 90/008,397 (hereinafter, the '8397 proceeding).

3. The reexamination order was granted in the '8397 proceeding on February 9, 2007.

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".

6. On August 1, 2008, a paper entitled "REVOCATION OF 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 dismissed as moot, 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,397	12/29/2006	7039679	6082.007.RXUS	9136

7590 12/19/2008

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ART UNIT	PAPER NUMBER

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CENTRAL REEXAMINATION UNIT

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REEXAMINATION CONTROL NO. : 90008397
PATENT NO. : 7039679
ART UNIT : 3900

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

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CENTRAL REEXAMINATION UNIT

Novak, Druce, DeLuca & Quigg, LLP
1000 Louisiana Street, 53rd Floor
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(For Requester)

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,397
Filed: December 29, 2006
For: U.S. Patent No. 7,039,679

: **DECISION**
: **DISMISSING AND EXPUNGING**
: **PETITION**

This is a decision on the October 20, 2008 third party requester petition entitled "PETITION UNDER 37 CFR § 1.182 AND/OR 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 May 2, 2006, U.S. Patent 7,039,679 ("the '679 patent) issued to Mendez et al.
- On December 29, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,397 ("the '8397 proceeding").
- On February 9, 2007, 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 mailed.

[1] See MPEP 2267.

- Prosecution continued until, on August 21, 2008, a Notice of Intent to Issue a Reexamination Certificate ("NIRC") was issued in view of an advisory action mailed on June 20, 2008, and a telephone conversation held on June 24, 2008.

- 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 filings on September 5, 2008 and October 1, 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, decisions dismissing and expunging the September 2, 2008, the September 5, 2008, and October 1, 2008 third party requester petitions, was mailed. Additionally, the Office issued a NIRC.

- On October 20, 2008, the third party requester filed the instant petition entitled "Petition Under 37 CFR § 1.182 and/or § 1.183" to vacate the October 3, 2008 NIRC ("the October 20, 2008 requester petition to vacate the October 3, 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 20, 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 '8397 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 20, 2008 petition paper was filed after the statutory statement and reply period ended in the '8397 proceeding. The statutory statement and reply period ended in the '8397 proceeding when the patent owner did not file a statement in response to the February 9, 2007 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 20, 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 3rd NIRC

To *sua sponte* clarify the record on the issuance of the October 3, 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 April 22, 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 3, 2008 NIRC.

CONCLUSION

- The petition is **dismissed**.

- The petition paper filed by the third party requester on October 20, 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 '8397 *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
Senior Legal Advisor
Office of Patent Legal Administration

December 18, 2008
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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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FEB 24 2009

CENTRAL REEXAMINATION UNIT

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,397
Filed: December 29, 2006
For: U.S. Patent No. 7,039,679

: **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 May 2, 2006, U.S. Patent 7,039,679 ("the '679 patent) issued to Mendez et al.

[1] See MPEP 2267.

2. On December 29, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,397 ("the '8397 proceeding").

3. On February 9, 2007, 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 April 22, 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 20, 2008, an advisory action, which addressed the April 22, 2008 patent owner response after final rejection, was mailed by the Office.

8. On June 24, 2008, the examiner conducted an interview with Mr. McKeown, attorney of record for patent owner ("the June 24, 2008 interview") during which the examiner obtained the patent owner's authorization for an examiner's amendment. The examiner summarized the interview on page 2 of the examiner's amendment which accompanied each of the August 21, 2008 and October 3, 2008 Notices of Intent to Issue a Reexamination Certificate (NIRC), itemized below (as items 10 and 19).

9. On August 13, 2008, the patent owner filed a petition for extension of time under 37 CFR 1.550(c).

10. On August 21, 2008, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed ("the August 21, 2008 NIRC") by the Office. The August 21, 2008 NIRC was accompanied by an examiner's amendment containing an interview summary of the June 24, 2008 interview.

11. On August 30, 2008, a decision granting-in-part the August 13, 2008 patent owner petition for extension of time was mailed by the Office.

12. 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").

13. 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").

14. 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.

15. 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").

16. 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.

17. 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.

18. Also on October 3, 2008, a decision dismissing and expunging the October 1, 2008 requester petition was mailed by the Office.

19. Also on October 3, 2008, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed by the Office ("the October 3, 2008 NIRC").

20. 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").

21. 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").

22. 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 '8397 proceeding, the statutory statement and reply period ended when the patent owner did not file a statement in response to the February 9, 2007 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 '8397 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]

(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 '8397 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

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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] 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 must 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).

standing.[7] 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

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[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.

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 April 22, 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 3, 2008, the Office

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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 3rd NIRC".

[10] *Id.*

issued a NIRC in this reexamination proceeding. The Office possessed jurisdiction to act upon the proceeding by issuing the October 3, 2008 NIRC after revival of the proceeding, in view of the complete response by the patent owner. The October 3, 2008 NIRC issued by the Office was therefore proper.

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 3, 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 3, 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

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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.

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 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 has been reconsidered, but is **denied** as to the underlying relief requested.

---

[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

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 '8397 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."

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

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.: 7,039,679 C1

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 March 24, 2009

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

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

AUG 03 2007

CENTRAL REEXAMINATION UNIT

Lathrop & Gage LC
4845 Pearl East Circle
Suite 300
Boulder, CO 80301

(For Patent Owner)

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

(For Requester)

In re Semple et al.
Reexamination Proceeding
Control No.: 90/008,398
Filed: December 22, 2006
For: U.S. Patent No. 6,408,307 B1

: DECISION GRANTING
: 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.

A petition fee of $400.00 under 37 CFR 1.17(f) is being charged to the patent owner's Deposit Account No. 19-0089 as authorized in the June 13, 2007 patent owner petition.

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,408,307 (the '307 patent) issued on June 18, 2002.

2. U.S. Patent Nos. 6,385,622 (the '662 patent) and 6,415,291 (the '291 patent) both claim benefit to the '307 patent.[1]

3. A request for reexamination of the '307 patent was filed on December 22, 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. 90/008,398 (the '8398 reexamination proceeding).

4. A request for reexamination of the '662 patent was filed on September 20, 2006. The request was assigned control No. 90/008,192 (the '8192 reexamination proceeding).

5. 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).

6. Reexamination was ordered for the '8398 proceeding on February 21, 2007.

7. Reexamination was ordered for the '8192 proceeding on October 28, 2006.

8. Reexamination was ordered for the '8329 proceeding on April 3, 2007.

9. 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]

10. 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, 1.97 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). 37 CFR 1.98(a) requires that copies of certain types of references must be provided in each application for which applicant files an IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's June 13, 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's waiving the reference copy submission requirement.

---

[2] a total of approximately twenty (20) bankers boxes of references in all.

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 and 1.98 is granted.

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

7-31-07
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UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,398	12/22/2006	6408307		9219

30955 7590 04/11/2008

LATHROP & GAGE LC
4845 PEARL EAST CIRCLE
SUITE 300
BOULDER, CO 80301

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
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

MAILED
Date:
APR 11 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008398
PATENT NO. : 6408307
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

MAILED

APR 11 2008

CENTRAL REEXAMINATION UNIT

Lathrop & Gage LC
4845 Pearl East Circle
Suite 300
Boulder, CO 80301

(For Patent Owner)

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

(For Requester)

In re: Semple *et alia*
Reexamination Proceeding
Control No. 90/008,398
Request Deposited: December 22, 2006
For: U.S. Patent No. 6,408,307

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

This is a decision on the April 9, 2008, "PETITION FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R 1.550(C)" requesting that the time to submit a Patent Owner response be extended an additional 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. 6,408,307 (hereinafter, the '307 patent), issued to Semple *et alia*, on June 18, 2002.

2. On December 22, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '307 patent. The reexamination proceeding was assigned Control No. 90/008,398 (hereinafter, the '8398 proceeding).

3. The reexamination order was granted in the '8398 proceeding on February 21, 2007.

4. A non-final rejection was mailed on March 3, 2008 setting a two-month shortened statutory period (SSP) for response.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the non-final office action mailed March 3, 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 April 3, 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.

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

The request notes the large number of documents, the necessity to coordinate information between a number of individuals and the preparation being done in connection with a scheduled interview on the present case. Reference is made to the petition for details of these and other issues.

Analysis and Findings

It is noted that Patent Owner has submitted the vast majority of references in this proceeding. The 15 references submitted by requester have been available to Patent Owner since the filing of the reexamination request. The large numbers of references submitted by Patent Owner have been in their possession since well before the non-final office action. Since Patent Owner has been in possession of all documents since well before the mailing of the non-final office action, petitioner's argument that additional time is needed for review of the documents is not persuasive.

However, other points made in the petition are deemed persuasive to a degree. 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 two weeks is considered sufficient.

Accordingly, the time for filing the response is extended for two weeks and therefor the response is due on or before May 19, 2008 (May 17 being a Saturday).

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 in part. The period during which Patent Owner may file a response has been extended to May 19, 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.
90/008,398	12/22/2006	6408307		9219

30955 7590 05/19/2008

LATHROP & GAGE LC
4845 PEARL EAST CIRCLE
SUITE 300
BOULDER, CO 80301

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Lathrop & Gage LC
4845 Pearl East Circle
Suite 300
Boulder, CO 80301

(For Patent Owner)

MAILED
MAY 19 2008
CENTRAL REEXAMINATION UNIT

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

(For Requester)

In re: Semple *et alia*
Reexamination Proceeding
Control No. 90/008,398
Request Deposited: December 22, 2006
For: U.S. Patent No. 6,408,307

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

This is a decision on the May 14, 2008, "SECOND REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R 1.550(C)" requesting that the time to submit a Patent Owner response be extended an additional ten days.

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

The petition is granted and a ten-day extension of time is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,408,307 (hereinafter, the '307 patent), issued to Semple *et alia*, on June 18, 2002.

2. On December 22, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '307 patent. The reexamination proceeding was assigned Control No. 90/008,398 (hereinafter, the '8398 proceeding).

3. The reexamination order was granted in the '8398 proceeding on February 21, 2007.

4. A non-final rejection was mailed on March 3, 2008 setting a two-month shortened statutory period (SSP) for response.

5. A first request for extension of time was timely filed on April 9, 2008. Said petition was granted in part and the period for response was extended to May 19, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the non-final office action mailed March 3, 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 May 14, 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.

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

The request notes the large number of documents, the necessity to coordinate information between a number of individuals and the interview on the present case. 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 ten days is considered sufficient.

Accordingly, the time for filing the response is extended for two weeks and therefor the response is due on or before May 28, 2008.

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. The period during which Patent Owner may file a response has been extended to May 28, 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.
90/008,398	12/22/2006	6408307	460661	9219

37086 7590 03/25/2009

EXAMINER	

LATHROP & GAGE LC
4845 PEARL EAST CIRCLE
SUITE 300
BOULDER, CO 80301

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2009

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,398	12/22/2006	6408307	460661	9219

37086 7590 03/25/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2009

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

MAILED

MAR 2 5 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008398

PATENT NO. 6,408,307

ART UNI 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Lathrop & Gage LC
4845 Pearl East Circle
Suite 300
Boulder, CO 80301

(For Patent Owner)

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

(For Requester)

Tracy W. Druce
Novak Druce & Quigg LLP
1300 Eye Street, N.W.
Suite 1000 West Tower
Washington, D.C. 2005

(Courtesy Copy)

MAILED

MAR 25 2009

CENTRAL REEXAMINATION UNIT

In re Semple et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,398
Filed: December 22, 2006
For: U.S. Patent No. 6,408,307

DECISION DISMISSING PETITION

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 June 18, 2002, U.S. Patent No. 6,408,307 (the '307 patent) issued from application serial no. 08/920,044 (the '044 application) to Semple et al. with 30 claims.

2. The patent lists the assignee as Civix-DDI, LLC, which corresponds to the recorded assignment documents for the parent application of the '044 application.

3. On December 22, 2006, a third party requester, Yahoo!, filed a request for *ex parte* reexamination of claims 1-3, 5-15, 17-25, and 30 of the '307 patent and was assigned control no. 90/008,398 (the '8398 proceeding).

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 '307 patent and other related patents. Third party requestor, Yahoo!, is a defendant in the suit.

5. On February 21, 2007, an order granting the reexamination request was mailed.

6. A non-final Office action was mailed March 3, 2008, in which claims 1-3, 5-15, 17-25, and 30 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, after several extensions of time were granted.

8. On October 24, 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, after an extension of time was granted. 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.

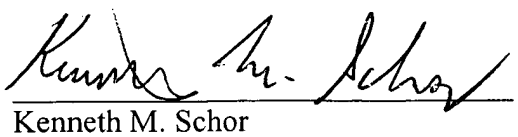
CONCLUSION

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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CENTRAL REEXAMINATION UNIT

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(For *Ex Parte* Requester)

In re Howes *et al.*	:	**DECISION DISMISSING**
Ex Parte Reexamination Proceeding	:	**PETITION FOR**
Control No.: 90/008,406	:	**MERGER OF *EX PARTE***
Filed: February 8, 2007	:	**REEXAMINATION AND**
For: U.S. Patent No. 6,045,834	:	**REISSUE APPLICATION**

This is a decision on patent owner's "PETITION UNDER 37 C.F.R. §1.182 FOR MERGER OF COPENDING REEXAMINATION AND REISSUE PROCEEDINGS," filed March 10, 2010.

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

The petition is dismissed, for the reasons set forth herein.

FEES

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was processed on March 11, 2010.

BACKGROUND

1. On April 4, 2000, United States Patent No. 6,045,834 ("the '834 patent") issued to Howes *et al.* with claims 1-21.

2. On February 8, 2007, a corrected request for *ex parte* reexamination of the '834 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 90/008,406 ("the '8406 proceeding").

3. On April 17, 2007, the Office mailed an order granting *ex parte* reexamination in the '8406 proceeding.

4. On March 6, 2008, the Office mailed a non-final Office action in the '8406 proceeding, rejecting all of the claims (i.e., claims 1-21) of the '834 patent.

5. On May 6, 2008, patent owner filed a response to the March 6, 2008 Office action, including an amendment to the claims in which the text of the independent claims (1, 15 and 17) was amended and new claims 22-26 were added.

6. On May 29, 2009, the Office mailed a final Office action in the '8406 proceeding, rejecting claims 1-26.

7. On July 28, 2009, patent owner filed, in the '8406 proceeding, a first response to the May 29, 2009 final Office action, including an after-final amendment to the claims.

8. On August 14, 2009, the Office mailed an advisory action in the '8406 proceeding, denying entry of the July 28, 2009 after-final claim amendments and maintaining the rejection of claims 1-26.

9. On September 24, 2009, patent owner filed, in the '8406 proceeding, a second response to the May 29, 2009 final Office action, including an after-final amendment to the claims.

10. On September 29, 2009, patent owner filed a notice of appeal in the '8406 proceeding.

11. On September 30, 2009, the Office mailed a second advisory action in the '8406 proceeding, denying entry of the September 24, 2009 after-final claim amendments and maintaining the rejection of claims 1-26.

12. On October 16, 2009, patent owner filed, in the '8406 proceeding, a third response to the May 29, 2009 final Office action, including an after-final amendment to the claims.

13. On November 19, 2009, the Office mailed a third advisory action in the '8406 proceeding, denying entry of the October 16, 2009 after-final claim amendments and maintaining the rejection of claims 1-26.

14. On November 30, 2009, patent owner filed an appeal brief in the '8406 proceeding.

15. On January 4, 2010, patent owner filed a reissue application for the '834 patent, which application was assigned application number 12/651,887 ("the '887 reissue application"). The reissue application included a preliminary amendment in which the text of original patent claims 1, 10, 11, 15 and 17 was amended and new claims 22 and 23 were added. No Office action has been mailed in the '887 reissue application.

16. On February 16, 2010, a notice of the filing of the '887 reissue application was published in the *Official Gazette*.

17. On March 10, 2010, patent owner filed in the '8406 proceeding the instant "PETITION UNDER 37 C.F.R. §1.182 FOR MERGER OF COPENDING REEXAMINATION AND REISSUE PROCEEDINGS" ("the petition under 37 CFR 1.182").

CLAIMS OF RECORD

A review of the prosecution history for the '8406 reexamination proceeding reveals that all original patent claims (1-21) have been amended by virtue of amendment to the text of independent claims 1, 15 and 17, and new claims 22-26 have been added. All pending claims (claims 1-26) are under appeal.

A review of the '887 reissue application file reveals that the text of original patent claims 1, 10, 11, 15 and 17 has been amended and new claims 22 and 23 have been added. Thus, claims 1-23 are pending in the '887 reissue application.

The claims of the '887 reissue application and the claims of the '8406 reexamination proceeding are not identical.

RELEVANT AUTHORITY

35 U.S.C. § 305 provides, in part:

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

37 CFR 1.103(e) states:

> *Notice of suspension on initiative of the Office.* The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

37 CFR 1.565(d) provides, in part:

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

MPEP § 2285 provides, in part:

> The general policy of the Office is that a reissue application examination and an *ex parte* reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both proceedings to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Accordingly, if both a reissue application and an *ex parte* reexamination proceeding are pending concurrently on a patent, a decision will normally be made (A) to merge the two proceedings or

(B) to stay one of the two proceedings. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

MPEP § 2285(II)(C) provides, in part:

> In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination. In addition, consideration will also be given to the status of the reexamination proceeding. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them.

MPEP § 2285(V) provides, in part:

> The patent owner may file a petition under 37 CFR 1.182 to merge the reissue application and the reexamination proceeding, or stay one of them because of the other, at the time the patent owner's statement under 37 CFR 1.530 is filed or subsequent thereto in the event the Office has not acted prior to that date to merge or stay.

PATENT OWNER'S REQUEST UNDER 37 CFR 1.182 FOR MERGER

In support of its request for merger of the '8406 reexamination proceeding and the '887 reissue application, patent owner asserts, in the petition under 37 CFR 1.182, "that merger of the two proceedings in the instant case will conserve the resources of the Office and the Patent Owner by obviating the need for the continuation of the Appeal process in the present reexamination proceeding."[1] In particular, patent owner asserts "***the reissue application presents only a single independent claim that is narrower in scope than the claims currently on appeal in the reexamination***."[2] Patent owner further asserts that "[m]erger of the two proceedings will allow the continued examination of only the reissue application's simplified and narrowed claim set" and "[t]hus, the reissue raises issues that would not be proper for consideration in the reexamination."[3]

As additional support for merger of the '8406 reexamination proceeding and the '887 reissue

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[1] Petition under 37 CFR 1.182 at page 1.

[2] Petition under 37 CFR 1.182 at pages 1-2.

[3] Petition under 37 CFR 1.182 at page 2 (noting that "the Examiner in the reexamination has thrice declined the entry of the narrowing claim amendments.") See also, page 2, paragraph 9, of the petition under 37 CFR 1.182 (asserting that "[t]he Reissue Application presented only a single independent Claim (Claim 1). Claim 1 of the Reissue Application corresponds to the Claim 1 of the third Amendment After Final and reflects the results of the personal interview with the Examiners. Thus, the claims pending in the Reissue Application are narrower than the claims pending in the Reexamination.")

application, patent owner asserts that it is seeking claims via the reissue application which "include additional limitations not found in the claims on appeal" in the re-examination proceeding and "[a]ccordingly, any decision on the reexamination appeal would be rendered moot in view of the Patent Owner's strategy in the reissue."[4] Patent owner also asserts "that the current status of the reexamination proceeding - the Examiner has not yet filed an Answer to the Patent Owner's Appeal Brief - provides an additional reason to merge the two proceedings."[5]

DECISION

The '887 reissue application (proceeding) and the '8406 reexamination proceeding are currently pending for the same patent. The order has been mailed pursuant to 37 CFR 1.525 for the '8406 reexamination proceeding, and the '887 reissue application has been announced in the *Official Gazette* more than two months ago. Accordingly, consideration of patent owner's March 10, 2010 request under 37 CFR 1.182 for merger of the '887 reissue application and the '8406 reexamination proceeding is appropriate at this time.

In considering patent owner's instant request for merger, the following options have been evaluated: (1) merging the '887 reissue application and '8406 reexamination proceedings, (2) conducting the '887 reissue application and '8406 reexamination proceedings separately and at the same time, and (3) suspending one of the '887 reissue application and '8406 reexamination proceedings. After consideration of the records of the '887 reissue application and the '8406 reexamination proceeding, the Office has decided that merger of the two proceedings is not the appropriate option in this case, and that prosecution in the '887 reissue application will be suspended. This decision is based on the following considerations.

1. The Merger Option

With respect to the option of merging the '887 reissue application and the '8406 reexamination proceeding, MPEP § 2285(II)(C) clearly points out that when a reexamination proceeding is on appeal to the Board of Patent Appeals and Interferences ("the BPAI"), that circumstance would itself weigh against merger of the reexamination proceeding with a copending reissue application for the same patent. In this instance, a merger of the '887 reissue application and the '8406 reexamination proceeding would impede treatment of the '8406 reexamination proceeding with the statutorily mandated special dispatch (pursuant to 35 U.S.C § 305) in reexamination. That no examiner's answer has been issued in the '8406 proceeding does not support merger of the proceedings in this instance. Rather, a merger would pull the '8406 reexamination proceeding back from its on-appeal stage, and return the prosecution to a point in which no examination on the merits of the claims of record in the merged proceeding has taken place. Also, the merged proceeding would be conducted under the broader reissue regulations, as required by 37 CFR 1.565(d). It simply does not appear that prosecution on the '887 reissue application will be concluded so quickly as to provide the statutorily mandated special dispatch for the '8406 reexamination proceeding if the two proceedings are merged. There is a public interest in the outcome of the '8406 reexamination proceeding, and the public has a right to have that

[4] Petition under 37 CFR 1.182 at page 3.
[5] Petition under 37 CFR 1.182 at page 3.

proceeding conducted with special dispatch, rather than have prosecution in this instance delayed indefinitely in favor of prosecution of a reissue application that has not yet had a first examination on the merits, and which may be subject to prosecution that might subsequently be extended by multiple follow-on filings. As patent owner asserts, the reissue claims are different from the claims that are currently on-appeal in the reexamination and correspond to after-final claim amendments that were denied entry into the reexamination. Thus, such claims would require complete examination on the merits with respect to all statutory requirements for patentability in the merged proceeding, as explained below. Further, while merger would obviate the present appeal in the '8406 proceeding, it would not with certainty obviate the possibility of appeal in the merged proceeding.

In this instance, the '887 reissue application was filed more than two years after the issue date of the '834 patent; thus, applicant/patent owner will not have the opportunity to provide broadening claims in the reissue application. However, the reissue application is subject to an entirely new examination not only on new art but also on previously applied art, whereas examination in a reexamination proceeding is limited to art that raises a substantial new question of patentability. Thus, even if the claims are not broadened in the reissue application, the examiner of a merged proceeding, as proposed, would need to (a) consider any grounds of rejection of the patent claims other than those based solely on prior patents and printed publications, (b) consider any grounds of rejection of the patent claims other than those based solely on art that raises a substantial new question of patentability, and (c) evaluate the adequacy and propriety of the reissue declaration. These additional issues would retard the prompt resolution of the reexamination proceeding in contradiction to the statutory mandate of 35 U.S.C. § 305 for special dispatch.

In view of the foregoing considerations, it is not deemed beneficial to consolidate the '887 reissue application and '8406 reexamination proceedings within the Office. Accordingly, patent owner's instant request under 37 CFR 1.182 for merger of the '887 reissue application and the '8406 reexamination proceeding is **dismissed**.

2. The Option to Conduct the Proceedings Separately

It is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the '834 patent. The reason for this Office policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner, and not providing complex requirements for separate concurrent prosecution of proceedings. In this instance, separate and concurrent prosecution would involve undue complexities in coordinating the proceedings which would run contrary to the special dispatch requirement of 35 U.S.C. § 305, and would require re-work in each proceeding based on resulting outcomes of the other proceeding. As pointed out above, the claims of the reissue application and the claims of the reexamination proceeding are not identical.

3. The Suspension Option

Given that the examination of the '887 reissue application and the '8406 reexamination proceedings will not be conducted separately and at the same time, and will not be merged for

the reasons stated above, the only remaining option is to suspend one of the proceedings. The question remains as to which of the two proceedings should proceed, and which should be suspended.

To answer this question, it is observed that there is a statutory requirement for "special dispatch" in *ex parte* reexamination proceeding (pursuant to 35 U.S.C. § 305). In making a decision on whether to merge a reissue application and a reexamination proceeding, consideration is given to the status of each proceeding. See MPEP 2285(II)(C). In this instance, a significant amount of prosecution has taken place in the '8406 reexamination proceeding. The proceeding has advanced to appeal, and an appeal brief has been filed by the patent owner. In contrast, the '887 reissue application has not had an action on the merits.

Thus, a suspension of the reissue proceeding would not result in a delay of a proceeding that has progressed substantially toward its resolution. Because 35 U.S.C. § 305 provides the statutory requirement that *ex parte* reexamination proceedings (including appeals to the BPAI) must be conducted with special dispatch, the examination of the reexamination proceeding must take precedence in this instance.

Based on the above, a decision is being issued concurrently herewith, ***sua sponte* suspending action in the '887 reissue application** pursuant to 37 CFR 1.103(e) in favor of the '8406 reexamination proceeding.

CONCLUSION

1. Patent owner's March 10, 2010 "PETITION UNDER 37 C.F.R. §1.182 FOR MERGER OF COPENDING REEXAMINATION AND REISSUE PROCEEDINGS" is **dismissed**.

2. On an even date herewith, a decision is being mailed in the '887 reissue application *sua sponte* suspending action in the '887 reissue application.

3. Jurisdiction over the '8406 reexamination proceeding is bring returned to the Central Reexamination Unit.

4. Telephone inquiries relating to this decision should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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CENTRAL REEXAMINATION UNIT

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1950 Roland Clark Place
Reston, VA 20191

(For Third Party Requester)

In re Reexamination of 5404505
Reexamination Control No.: 90/008,408
Filed: January 12, 2007
For: **SYSTEM FOR SCHEDULING TRANSMISSION OF INDEXED AND REQUESTED DATABASE TIERS 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 proceeding.

The decision on the petition will be held in abeyance until mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate, at which time the petition will be decided.

Petitioner requests that documents entitled 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.

Eric Keasel For

Lissi M. Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,408	01/12/2007	5404505	060900-5020US	4280

24341 7590 02/12/2008

MORGAN, LEWIS & BOCKIUS, LLP.
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA 94306

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

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.
90/008,282	10/05/2006	5404505	060900-5021US	5471

24341 7590 02/12/2008

MORGAN, LEWIS & BOCKIUS, LLP.
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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

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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
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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)).

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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
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)).

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United States Patents and Trademark Office
P.O.Box 1450
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www.uspto.gov

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)).

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United States Patent and Trademark Office
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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
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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

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

: 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. 5,404,505 (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

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,408	01/12/2007	5404505	060900-5020US	4280

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
P.O. Box 1450
Alexandria, VA 22313-1450
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Serial Number	Filing Date	First Named Applicant
11/186,013	07/21/05	ANTHONY BROWN
Attorney Docket Number	Patent Number	Date of This Notice
	6,597,990	10/29/07

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control Nos. 90/008410 Filing Date: 01/05/07

Requester: DANIEL E. VALENCIA
BERENATO, WHITE & STAVISH, LLC
6550 ROCK SPRING DRIVE
SUITE 240
BETHESDA, MD 20817

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

REEXAMINATION RESULTS

The questions raised in reexamination request 90/008,410, filed 01/05/07 have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U. S. C. 307 as provided in 37 CFR 1.570(e), for *ex parte* reexaminations, or the reexamination certificate required by 35 U. S. C. 316 as provided in 37 CFR 1.997(e) for *inter partes* reexaminations.

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

ANTHONY BROWN
5218 Carswell Avenue #205
Suitland, MD 20746-3937

(For Patent Owner)

MAILED

OCT 29 2007

CENTRAL REEXAMINATION UNIT

Susan A. Wolffe
BANNER & WITCOFF, LTD.
1100 13th Street, NW
Suite 1200
Washington, DC 20005

(For Patent Owner)

Daniel E. Valencia
BERENATO, WHITE & STAVISH, LLC
6550 Rock Spring Drive
Suite 240
Bethesda, MD 20817

(For Third Party Requester)

In re Reissue Application of
Anthony Brown
Application No.: 11/186,013
Filed: July 21, 2005
For: U.S. Patent No. 6,597,990

In re Anthony Brown
Reexamination Proceeding
Control No.: 90/008,410
Filed: January 5, 2007
For: U.S. Patent No.: 6,597,990

: DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. Patent No. 6,597,990 (the '990 patent) issued on July 22, 2003.

2. An application for reissue, assigned application No. 11/186,013 (the '013 reissue application), was filed by the patent owner on July 21, 2005.

3. Notice of the filing of the reissue application was published in the *Official Gazette* on September 20, 2005.

4. A request for reexamination, assigned control No. 90/008,410 (the '8410 reexamination proceeding), was filed by a third party requester on January 5, 2007.

5. Reexamination was ordered for the '8410 reexamination proceeding on March 16, 2007.

6. A patent owner's statement under 37 CFR 1.530 has not been received in the '8410 reexamination proceeding, and the time for filing same expired.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

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

As evidenced by the above review of facts, the '013 reissue application and the '8410 reexamination proceeding are currently pending. Because the order to reexamine has been mailed in the '8410 reexamination proceeding, and a notice of the reissue application has been published in the *Official Gazette*, a decision under 37 CFR 1.565(d) is timely.

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the reexamination file for the '8410 reexamination proceeding shows that original patent claims 1-30 are present, and no amendments have been made.

3. A review of the '013 reissue application shows that original patent claims 1-30 are present, as well as new claims 31-129. Original claims 18 and 20 were amended, and new claims 31-129 were added, by the Preliminary Amendment and Statement of Status Pursuant to 37 CFR 1.173(b) filed on July 21, 2005.

4. At least claims 18, 20, and 31-129 in the '013 reissue application are not identical to the claims in the '8410 reexamination proceeding. Accordingly, the claims are not identical in both proceedings.

5. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, the above-captioned reissue and reexamination proceedings. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must not address any issue of patentability in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

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

2. In the event that a housekeeping amendment is not timely submitted, 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 of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305).**

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

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

6. Pursuant to MPEP 2285:

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

Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are *always* underlined, and only words being deleted from the patent appear in brackets.

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

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

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

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

following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the patent, (2) the reissue application and (3) the reexamination proceeding. The current proper correspondence address for the patent file pursuant to 37 CFR 1.33(c) is that of Anthony Brown of Suitland, MD. Thus, for the '8410 reexamination proceeding, Anthony Brown of Suitland, MD is the current proper address. This is the address to which the order granting reexamination was mailed. On the other hand, the current proper correspondence address for the '013 reissue application pursuant to 37 CFR 1.33(a) is that of Banner & Witcoff, Ltd. of Washington, DC..

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 one of the two correspondence addresses and parties prosecuting these proceedings as the correspondence address and party of record in both proceedings (to provide one address and party for the merged proceeding) and the patent file, and

(b) If there is a designated attorney, supply the designated attorney with the requisite power of attorney in the appropriate proceedings.

As a courtesy, this decision is being mailed to both addresses. Pending clarification, the address of Banner & Witcoff, Ltd. of Washington, DC, will be used in future correspondence.

CONCLUSION

1. Reissue application No. 11/186,013 and reexamination control No. 90/008,410 are hereby merged into a single proceeding.

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

3. The patent owner is further required to, within **ONE MONTH** of this decision, unify the correspondence addresses and parties prosecuting these proceedings as set forth in the last section of this decision.

4. 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 '990 patent (e.g., by preparing/signing an action). See MPEP 2236.

5. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of:

   (a) the expiration of the ONE MONTH period (from the mailing of this decision) for the filing of (i) the required housekeeping amendment and (ii) the papers unifying the correspondence address and attorney of record in both proceedings, or

   (b) the receipt of both the required housekeeping amendment (i) and papers (ii).

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

7. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

October 25, 2007

Oct. 26, 2007
C:\kiva\kenpetmerger\8410_claims-diff_2-addresses_3PR.doc

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CENTRAL REEXAMINATION UNIT

Denton, L. Anderson
Sheldon & Mark
225 South Lake Avenue, 9th Floor
Pasadena, CA 91101

(For Patent Owner)

William A. Munck
P.O. Drawer 800889
Dallas, TX 75380

(For 3rd Party Requester)

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.

Andres Kashnikow

Lissi Mojica Marquis,
Director
Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/8/09

TO SPE OF : ART UNIT 3991 Deborah Jones (Spe)

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/008427 Patent No.: 5527628

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

[signature]
Certificates of Correction Branch
703-756-1571 _____

Thank You For Your Assistance

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

- [x] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

Comments: _____

DEBORAH D. JONES
CRU SPE-AU 3991

[signature]
SPE

3991
Art Unit

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OFFICE OF PETITIONS

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS MN 55440-1022

In re Patent No. 5,527,628 C1 :
Ex Parte Reexam Issue Date: March 10, 2009 :
Issue Date June 18, 1996 : DECISION ON PETITION
Application No. 08/394,228 :
Filed: February 24, 1995 :
Attorney Docket No. 08411-0057RX1 :

This is a decision on the Corrected Transmittal Of Request For Certificate Of Correction, filed March 17, 2010, requesting, in effect, that the First Page of the Ex Parte Reexamination Certificate issued in the subject patent be corrected, via issuance of a Certificate of Correction under 37 CFR 1.322, to identify the correct assignees names at the time the Ex Parte Reexamination Certificate was issued. The Request has been treated as a petition under 37 CFR 1.322(a) for which no fee is required.

The petition under 37 CFR 1.322(a) is **GRANTED**.

Petitioner urges that the present Petition was submitted to correct the names of the assignees on the First Page of the Ex Parte Reexamination Certificate issued in the above-identified patent and that such error was made by the USPTO.

Telephone inquiries related this communication should be directed to the undersigned at (571)272-3213. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571)272-4200.

The Certificate of Correction Branch will be notified of this decision granting the petition under 1.322(a) and directing issuance of the requested Certificate of Correction.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,428	01/16/2007	6054270		7156

513 7590 04/29/2008

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2008

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,830	09/04/2007	6054270	3006US0	3702

513 7590 04/29/2008

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,020	10/09/2007	6054270	100788.0029	5022

513 7590 04/29/2008

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2008

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CENTRAL REEXAMINATION UNIT

Warren M. Cheek, Jr.
Wenderoth Lind & Ponack, LLP
2033 K Street, NW, Suite 800
Washington, DC 20006

(for Patent Owner)

Anthony G. Craig
Fliesler Meyer LLP
650 California street, 14th Floor
San Francisco, CA 94108

(for Third Party Requester)

In re Southern et al
Reexamination Proceeding
Control No.: 90/008,428
Filed: January 16, 2007
For: U.S. Patent 6,054,270

Anthony G. Craig
Fliesler Meyer LLP
650 California street, 14th Floor
San Francisco, CA 94108

(for Third Party Requester)

In re Southern et al
Reexamination Proceeding
Control No.: 90/008,830
Filed: September 4, 2007
For: U.S. Patent 6,054,270

Robert D. Fish
Fish & Associates, PC
2603 Main Street, suite 1050
Irvine, CA 92614-6232

(for Third Party Requester)

In re Southern et al
Reexamination Proceeding
Control No.: 90/010,020
Filed: October 9, 2007
For: U.S. Patent 6,054,270

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 6,054,270 which issued April 25, 2000, is the subject of Reexamination Control Nos. 90/008,428, 90/008,830 and 90/010,020.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,428, was filed January 16, 2007 by Anthony Craig of Fliesler Meyer LLP in San Francisco. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed method or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/008,428 on February 21, 2007.

4. A first non-final Office action was issued on August 24, 2007.

5. Patent Owner filed a response on October 24, 2007.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,830, was filed September 4, 2007 by Anthony Craig of Fliesler Meyer LLP in San Francisco. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed method or are so close as to establish a case of obviousness.

7. Reexamination was ordered for 90/008,830 on October 18, 2007.

8. A subsequent request for re-examination, assigned Reexamination Control No. 90/010,020, was filed on October 9, 2007 by Robert D. Fish of Fish & Associates in Irvine CA. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed method or are so close as to establish a case of obviousness.

9. Reexamination was ordered for 90,010,020 on December 10, 2007.

8. No Office action has been issued in either of the later re-examination proceedings.

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 90/008,428, 90/008,830, and 90/010,020 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 or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in triplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/008,428, 90/008,830 and 90/010,020 as:

Warren M. Cheek
Wenderoth Lind & Ponack LLP
2033 K Street, NW, Suite 800
Washington, DC 20006

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/008,428 and 90/008,830 as:

Anthony G. Craig
Fliesler Meyer LLP
650 California Street, 14th Floor
San Francisco, CA 94108

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/010,020 as:

Robert D. fish
Fish & Associates, PC
2603 Main Street, Suite 1050
Irvine, CA 92614-6232

CONCLUSION

Reexamination Control Nos. 90/008,428, 90/008,830 and 90/010,020 are merged. **Since there has been no amendment in any of the files, the requirement to file a "housekeeping amendment" is waived.** An office action will issue in due course.

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

for Lissi M. Marquis, Director
Central Reexamination Unit

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Mailed :

DDJ

Warren M. Cheek, Jr.
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2033 K Street, NW, Suite 800
Washington, DC 20006

(for Patent Owner)

Anthony G. Craig
Fliesler Meyer LLP
650 California street, 14th Floor
San Francisco, CA 94108

(for Third Party Requester)

In re Southern et al
Reexamination Proceeding
Control No.: 90/008,429
Filed: January 29, 2007
For: U.S. Patent 5,700,637

Anthony G. Craig
Fliesler Meyer LLP
650 California street, 14th Floor
San Francisco, CA 94108

(for Third Party Requester)

In re Southern et al
Reexamination Proceeding
Control No.: 90/008,844
Filed: September 4, 2007
For: U.S. Patent 5,700,637

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 5,700,637 which issued December 23, 1997, is the subject of Reexamination Control Nos. 90/008,429 and 90/008,844.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,429, was filed January 29, 2007 by Anthony Craig of Fliesler Meyer LLP in San Francisco. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose a method of generating an array of oligo-nucleotides of chosen lengths within discrete cells of a support material or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/008,429 on March 22, 2007.

4. A first non-final Office action was issued on October 24, 2007.

5. Patent Owner filed a response on December 26, 2007.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,844, was filed September 4, 2007 by Anthony Craig of Fliesler Meyer LLP in San Francisco. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed method or are so close as to establish a case of obviousness.

7. Reexamination was ordered for 90/008,844 on October 24, 2007.

8. No Office action has been issued in the later re-examination proceeding.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,429 and 90/008,844 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. 90/008,429 and 90/008,844 as:

Warren M. Cheek
Wenderoth Lind & Ponack LLP
2033 K Street, NW, Suite 800
Washington, DC 20006

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/008,429 and 90/008,844 as:

Anthony G. Craig
Fliesler Meyer LLP
650 California Street, 14th Floor
San Francisco, CA 94108

CONCLUSION

Reexamination Control Nos. 90/008,429 and 90/008,844 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, Supervisory Patent Examiner, at telephone No. (571) 272-1535.

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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,438	01/23/2007	5752954	TRAUMA 3.5-090 FWC	6119

530 7590 09/04/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/04/2008

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Robert M. Rauker, Esq.

Synthes (USA)

1302 Wrights Lane East

West Chester, PA 19380

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SEP 04 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,438*.

PATENT NO. *5752954*.

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
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Lerner, David, Littenberg, Krumholz
& Mentlik
600 South Avenue West
Westfield, New Jersey 07090

(For Patent Owner)

MAILED

SEP 04 2008

CENTRAL REEXAMINATION UNIT

Robert M. Rauker, Esq.
Synthes (USA)
1302 Wrights Lane East
West Chester, PA 19380

(For Third Party Requester)

In re Stryker Trauma S.A :
Ex Parte Reexamination Proceeding : **DECISION**
Control No.: 90/008,438 : **DISMISSING**
Filed: January 23, 2007 : **PETITION**
For: U.S. Patent No.: 5;752,954 :

This is a decision on the July 30, 2008 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 TO CONSIDER ADDITIONAL MATERIALS."

The petition and the 90/008,438 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration of the above petition.

The petition is dismissed for the reasons set forth below.

Thus, the information submission filed July 30, 2008, has not been entered for consideration by the examiner.

FEES

The petition fee of $ 400.00 (37 CFR 1.17(f)) has been charged to Deposit Account No. 12-1095 as authorized in the patent owner's petition.

BACKRGROUND

1. Patent number 5,752,954 ("the '954 patent") issued on May 19, 1998.

2. A request for *ex parte* reexamination of the '954 patent was filed on January 23, 2007, by a third party requester, and was assigned control No. 90/008,438 (the '438 reexamination proceeding).

3. *An Order Granting Ex parte Reexamination* in the '438 reexamination proceeding was mailed on March 5, 2007, which granted reexamination for claims 1-3, 5, 7, 9-12 and 14 of the '954 patent.

4. The patent owner and the third party requester are involved in litigation with respect to the '954 patent, styled *Stryker Trauma S.A. and Howmedica Osteonics Corp. v. Synthes (USA)*, Civil Action No. 01-3879(JLL), United States District Court, District of New Jersey.

5. Although it appears that in October, 2006, claims 1 and 2 of the '954 patent were held valid and infringed by Synthes (USA) ("Synthes") in the above-captioned litigation, it also appears that on March 28, 2008 the court ordered that the litigation be stayed pending reexamination of the '954 patent.

6. A non-final Office action was mailed on May 6, 2008, in which all claims of the '954 patent subject to reexamination were rejected.

7. Patent owner conducted an interview with the examiner on May 20, 2008, and filed an amendment to the certain of the claims on June 2, 2008.

8. On September 5, 2007, third party requester timely filed written comments to the August 6, 2007 patent owner response. Such requester comments are provided for by 37 CFR 1.947.

9. On June 27, 2008, the Office mailed a *Notice of Intent to Issue Ex Parte Reexamination Certificate* (NIRC) in which the patentability of claims 1-3, 5, 7, 9 and 10 was confirmed and claims 11, 12 and 14 were held to be patentable as amended.

10. On July 30, 2008, patent owner filed the present petition, and also filed a letter addressed to the Office of Patent Publication informing that Office that the petition had been filed.

11. On July 30, 2008, third party requester filed a paper notifying the Office that a new request for *ex parte* reexamination of the '954 patent had been filed (see reexamination control number 90/009,229).

12. The Office's PALM/PAIR system shows that an *Ex Parte* Reexamination Certificate was published on August 27, 2008; however, the Office's other records do not yet confirm that publication occurred on that date.

DECISION

I. Relevant Authority

35 U.S.C. § 305 provides, in part:

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

35 U.S.C. § 307(a) provides:

> (a) In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to

be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

37 CFR 1.182 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).

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 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." [Emphasis added.]

II. Background and Relief Requested

A review of the record shows that, after reexamination was ordered for some of the '954 patent claims, prosecution was ultimately terminated by the mailing of a NIRC. It now appears from the present patent owner petition that third party requester Synthes asserted to patent owner

that certain information adduced during the litigation referred to in Fact # 5, *supra*, should have been cited to the Office by patent owner, but had not been so cited. Patent owner has submitted this information concurrently with the filing of the present petition, and requests consideration of that information, notwithstanding that prosecution in the '438 reexamination proceeding has long since been terminated by the issue and mailing of the NIRC.

III. Analysis and Findings

MPEP § 2256 points out that once an NIRC is issued and mailed by the Office, the statutory requirement that reexamination be conducted with special dispatch within the Office requires that the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Further, MPEP § 2256 specifically discusses the practice with respect the submission of information in a reexamination proceeding once the proceeding has entered the publication cycle for publishing the Reexamination Certificate, and establishes the necessary showing that must accompany a petition under 37 CFR 1.182 to have the reexamination proceeding withdrawn from the printing cycle for the purpose of having the submitted information considered by the Office. Patent owner has not satisfied the requirements for an adequate showing in the present petition.

Although patent owner has made a showing that as to why the information now being cited to the Office was not earlier furnished to the Office, the showing does not adequately explain why that information could not have been earlier cited to the Office. Any information in possession of the patent owner was either (a) material to patentability of the claims at issue in the '438 reexamination proceeding, (*i.e.*, the information was relevant to the claims and information that a reasonable examiner would have considered important in determining patentability of one or more of the claims being reexamined), or (b) not material to patentability of the claims at issue in the '438 reexamination proceeding. Patent owner has not discussed, in the present petition, any steps taken by patent owner to analyze this information in order to determine whether some or all of this information was relevant, and would have been important to a reasonable examiner in determining patentability of the '954 patent claims that were subject to reexamination in the '438 reexamination proceeding. Rather, patent owner merely states that requester had not earlier advised patent owner that requester regarded this information as being material to patentability.

Further, even assuming, *arguendo*, that patent owner could not have cited this to the Office prior to issuing and mailing the NIRC and prior to the '483 reexamination proceeding entering the printing cycle, the citation of this information to the Office concurrently with the present petition has not been accompanied by unequivocal statement as to why the submitted information renders one or more of the claim subject to reexamination unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. MPEP § 2256 establishes this requirement as a necessary part of any petition under 37 CFR 1.182 to have a reexamination proceeding withdrawn from the printing cycle for purposes of having information not previously before the Office considered by the Office.

It is also noted that third party requester has filed a new request for *ex parte* reexamination of the '954 patent, assigned reexamination control number 90/009,229. Patent owner may file the information filed with the present petition in the '229 proceeding. Further, patent owner is entitled to also file a new request for *ex parte* reexamination for the purpose of having any information not before the Office in the present proceeding considered with respect to the

claims of the '954 patent, as amended by the Reexamination Certificate that will conclude the 'present '438 reexamination proceeding upon its publication. Provided that any newly filed request for reexamination of the '954 patent establishes a "new" substantial new question of patentability (*i.e.*, adduces a new technical teaching not previously discussed and considered on the record of a prior proceeding for the '954 patent, and not cumulative to teachings that had been previously discussed and considered on the record of such a prior proceeding), the Office will order reexamination of the claims for which the substantial new question of patentability has been demonstrated. [1] Patent owner would then have the opportunity to obtain consideration of information that has not discussed and considered on the record in the present '438 reexamination proceeding.

For all of the foregoing reasons, patent owner is not considered to have established entitlement to the relief requested in the present petition.

CONCLUSION

1. The present patent owner is dismissed.

2. The information submission furnished by patent owner will be made of record in the file of the '438 reexamination proceeding, but will not be considered by the examiner. [2]

3. Jurisdiction of the '438 *ex parte* reexamination proceeding will be returned to the Office of Patent Publication to ensure that if the reexamination certificate has not published on August 27, 2008, that the reexamination certificate be promptly published.

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

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

sm
September 3, 2008

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9-3-08

[1] In general, see MPEP § 2216 as to the meaning of "substantial new question of patentability" and MPEP § 2240(II) as to the filing of a second or subsequent request for ex parte reexamination of a patent for which reexamination has previously been ordered.

[2] With respect to the treatment of information cited by patent owner subsequent to an order granting reexamination, see MPEP § 2206.

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.
90/008,440	03/23/2007	7098853	004578.1600	9893

45507 7590 09/11/2009

BAKER BOTTS LLP
2001 ROSS AVENUE
6TH FLOOR
DALLAS, TX 75201-2980

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

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

Jenni R Moen
BAKER BOTTS LLP
2001 ROSS AVENUE
6TH FLOOR
DALLAS TX 75201-2980

(For Patent Owner)

MAILED

SEP 11 2009

CENTRAL REEXAMINATION UNIT

In re: McGrath *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,440
Deposited: 23 March 2007
For: US Patent No. 7,098,853

DECISION
DENYING
PETITION FOR ENTRY
OF AMENDMENTS
37 CFR § 1.181

This is a decision on the 13August 2009, "Non-Fee Petition Under 37 CFR § 1.181 for Entry of Amendments Submitted After Final Rejection in an *Ex Parte* Reexamination Proceeding." The petition was timely filed with the appropriate certificate of service. No fee is required for this petiotion.

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 petitions for entry under 37 CFR § 1.181 of after final amendments in an *ex parte* reexamination proceeding submitted 17 July 2009. The examiner mailed on 04 September 2009 a communication telling the patent owner that the amendment would not be entered.

37 CFR § 1.181 Petition to the Director. (in-part)

(a) Petition may be taken to the Director:
(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(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.

37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal. (in-part)

(a) An amendment after final action must comply with § 1.114 or this section.
(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented....

MPEP § 2272 After Final Practice (in-part)

It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution. Consideration of amendments submitted after final rejection and prior to, or with, the appeal will be governed by the strict standards of 37 CFR § 1.116. 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.

In the event that the patent owner is of the opinion that (A) a final rejection is improper or premature, or (B) that an amendment submitted after final rejection complies with 37 CFR § 1.116 but the examiner improperly refused entry of such an amendment, the patent owner may file a petition under 37 CFR § 1.181 requesting that the final rejection be withdrawn and that prosecution be reopened, or file a petition under 37 CFR § 1.181 requesting entry of the amendment, where appropriate. The petition under 37 CFR §1.181 must be filed within the time period for filing a notice of appeal. Note that the filing of a petition under 37 CFR § 1.181 does not toll the time period for filing a notice of appeal.
...

II. ACTION BY EXAMINER

It should be kept in mind that a patent owner cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection, or reinstate previously canceled claims. For an amendment filed after final rejection and prior to the appeal brief, a showing under 37 CFR § 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after final rejection except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner. An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided:
(A) the total effect of the amendment is to cancel claims or comply with any requirement of form expressly set forth in a previous Office action, or present rejected claims in better form for consideration on appeal;
(B) for an amendment touching the merits of the patent under reexamination, the patent owner provides a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.
The first proposed amendment after final action in a reexamination proceeding will be given sufficient consideration to determine whether it places all the claims in condition where they are patentable and/or whether the issues on appeal are reduced or simplified. Unless the proposed amendment is entered in its entirety, the examiner will briefly explain the reasons for not entering a proposed amendment. For example, if the claims as amended present a new issue requiring further consideration or search, the new issue should be identified and a brief explanation provided as to why a new search or consideration is necessary. The patent owner should be notified if certain portions of the amendment would be entered if a separate paper was filed containing only such amendment.

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. (emphasis added)

ANALYSIS AND FINDINGS

The petitioner notes that there have been two after final amendments submitted on 10 April 2009 and 18 June 2009.

The petitioner relies upon continued prosecution as the standard by which there is in "[a]n 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" for their showing of "good and sufficient" reasons for entry under 37 CFR § 1.116(b)(3). The petitioner has failed to show any reasons which are beyond ordinary prosecution of the instant proceeding to support a showing of "good and sufficient" reasons for entry of the amendment.

It is axiomatic that an examiner must reply to all arguments advanced by a patent owner in response to a rejection. The addition of the Nokkonen reference at Final was appropriate because of the patent owner's amendments to the claims. See 37 CFR §§ 1.104 & 1.112. Further, it would appear axiomatic that an examiner cannot anticipate an argument that will be advanced by a patent owner,

but has not been so advanced, when in fact the claims have been rejected on a given grounds of rejection. In the instant proceeding the patent owner submitted an amendment and remarks on 07 October 2008 and the Final office action contained rejections to those claims as necessitated by amendment. The reasons set forth in the petition do not address raise any points beyond normal examination practice to which the examiner responded.

Additionally pursuant to MPEP § 2272 "[a]ny 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." The second and third amendments do not reduce the issues on appeal and are appropriately not entered.

The petition pursuant to 37 CFR § 1.181 1.116(b)(3) is hereby denied.

The amendments submitted on 18 June 2009 will not be entered.

CONCLUSION

1. The patent owner's petition pursuant to 37 CFR 1.181 for entry of amendments is hereby **DENIED.**

2. 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.

3. 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Van Dyke, Gardner, Linn & Burkhart LLP
2851 Charlevoix Drive, S.E.
Suite 207
Grand Rapids, MI 49546

(For Patent Owner)

MAILED

AUG 08 2007

Sughrue, Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

(For Requester) CENTRAL REEXAMINATION UNIT

In re Repp et al.
Reexamination Proceeding
Control No.: 90/008,442
Filed: January 26, 2007
For: U.S. Patent No. 5,966,874

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the July 2, 2007 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 AND 1.183." The petition requests waiver of the formal reference–copy submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of filing 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 granted.

REVIEW OF FACTS

1. U.S. Patent No. 5,966,874 (the '874 patent) issued on October 19, 1999.

2. U.S. Patent Nos. 5,704,173 (the '173 patent) issued on January 6, 1998.

3. The '874 patent claims benefit via continuation thru the '173 patent.

4. A request for reexamination of the '874 patent was filed on January 26, 2007. The request was assigned control No. 90/008,442 (the '8442 reexamination proceeding).

5. A request for reexamination of the '173 patent was filed on January 26, 2007. The request was assigned control No. 90/008,441 (the '8441 reexamination proceeding).

6. Reexamination was ordered for the '8442 proceeding on March 2, 2007.

7. Reexamination was ordered for the '8441 proceeding on March 2, 2007.

8. On May 24, 2007, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

9. On June 5, 2007, patent owner filed an second IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

10. On June 15, 2007, patent owner filed an third IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

11. On July 2, 2007, patent owner filed, in the '8442 proceeding, IDS submissions under 37 CFR 1.555, 1.97 and 1.98 identical to those of May 24, 2007, June 5, 2007 and June 15, 2007, submitted in the '8441 proceeding.

12. Concurrent with the IDS submissions of July 2, 2007, in the '8442 proceeding, patent owner filed a petition under 37 CFR 1.182 and 1.183 requesting waiver of the formal submission requirements for the IDS submissions under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in the '8441.

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 copies of certain types of references must be provided in each application for which applicant files an

IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's July 2, 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's waiving the reference copy submission requirement.

A fee of $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's July 2, 2007 petition submission.

ADDITIONAL DISCUSSION

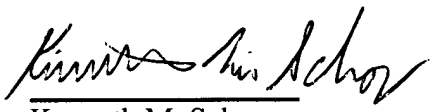
EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future, as references could be scanned in and electronically submitted directly into each case.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the reference–copy submission requirements of 37 CFR 1.555 and 1.98 is granted.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Van Dyke, Gardner, Linn & Burkhart LLP
2851 Charlevoix Drive, S.E.
Suite 207
Grand Rapids, MI 49546

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AUG 3 1 2007

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Sughrue, Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

(For Requester)

In re Lewno	:
Reexamination Proceeding	: DECISION GRANTING
Control No.: 90/008,443	: PETITION UNDER
Filed: January 26, 2007	: 37 CFR § 1.183
For: U.S. Patent No. 6,319,344	:

This is a decision on the July 23, 2007 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 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 granted.

REVIEW OF FACTS

1. U.S. Patent No. 5,853,895 (the '895 patent) issued on December 29, 1998.

2. U.S. Patent Nos. 6,319,344 (the '344 patent) issued on November 20, 2001.

3. The '344 patent claims benefit via continuation to the '895 patent.

4. A request for reexamination of the '895 patent was filed on January 26, 2007. The request was assigned control No. 90/008,473 (the '8473 reexamination proceeding).

5. A request for reexamination of the '344 patent was also filed on January 26, 2007. The request was assigned control No. 90/008,443 (the '8443 reexamination proceeding).

6. Reexamination was ordered for the '8473 proceeding on March 21, 2007.

7. Reexamination was ordered for the '8443 proceeding on March 22, 2007.

8. On July 19, 2007, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8473 proceeding.

9. On July 23, 2007, patent owner filed under 37 CFR 1.555, 1.97 and 1.98 an IDS identical to the IDS of July 19, 2007 in the '8473 proceeding in the '8444 proceeding.

10. Concurrent with the IDS submission of July 23, 2007, in the '8443 proceeding, patent owner filed a petition under 37 CFR 1.182 and 1.183 requesting waiver of the formal submission requirements for the IDS under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in the '8473.

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 copies of certain types of references must be provided in each application (or in this case, reexamination proceeding) for which applicant (patent owner) files an IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's July 23, 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's waiving the reference copy submission requirement.

A fee o f $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's July 23, 2007 petition submission.

ADDITIONAL DISCUSSION

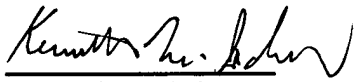
EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future, as references can be scanned in and electronically submitted directly into each case.

CONCLUSION

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

2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AUG 3 1 2007

CENTRAL REEXAMINATION UNIT

Van Dyke, Gardner, Linn & Burkhart LLP
2851 Charlevoix Drive, S.E.
Suite 207
Grand Rapids, MI 49546

(For Patent Owner)

Sughrue, Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

(For Requester)

In re Lewno	:
Reexamination Proceeding	: DECISION GRANTING
Control No.: 90/008,444	: PETITION UNDER
Filed: January 26, 2007	: 37 CFR § 1.183
For: U.S. Patent No. 6,068,719	:

This is a decision on the July 23, 2007 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 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 granted.

REVIEW OF FACTS

1. U.S. Patent No. 5,853,895 (the '895 patent) issued on December 29, 1998.

2. U.S. Patent Nos. 6,068,719 (the '719 patent) issued on May 30, 2000.

3. The '719 patent claims benefit via continuation to the '895 patent.

4. A request for reexamination of the '895 patent was filed on January 26, 2007. The request was assigned control No. 90/008,473 (the '8473 reexamination proceeding).

5. A request for reexamination of the '719 patent was also filed on January 26, 2007. The request was assigned control No. 90/008,444 (the '8444 reexamination proceeding).

6. Reexamination was ordered for the '8473 proceeding on March 21, 2007.

7. Reexamination was ordered for the '8444 proceeding on March 22, 2007.

8. On July 19, 2007, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8473 proceeding.

9. On July 23, 2007, patent owner filed under 37 CFR 1.555, 1.97 and 1.98 an IDS identical to the IDS of July 19, 2007 in the '8473 proceeding in the '8444 proceeding.

10. Concurrent with the IDS submission of July 23, 2007, in the '8444 proceeding, patent owner filed a petition under 37 CFR 1.182 and 1.183 requesting waiver of the formal submission requirements for the IDS under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in the '8473.

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 copies of certain types of references must be provided in each application (or in this case, reexamination proceeding) for which applicant (patent owner) files an IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's July 23, 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's waiving the reference copy submission requirement.

A fee o f $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's July 23, 2007 petition submission.

ADDITIONAL DISCUSSION

EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future, as references can be scanned in and electronically submitted directly into each case.

CONCLUSION

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

2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit.

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

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2851 Charlevoix Drive, S.E.
Suite 207
Grand Rapids, MI 49546

(For Patent Owner)

MAILED

AUG 08 2007

CENTRAL REEXAMINATION UNIT

Sughrue, Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

(For Requester)

In re Repp et al.
Reexamination Proceeding
Control No.: 90/008,445
Filed: January 26, 2007
For: U.S. Patent No. 6,871,450 B2

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the July 2, 2007 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 AND 1.183." The petition requests waiver of the formal reference–copy submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of filing 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 granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,871,450 (the '450 patent) issued on March 29, 2005.

2. U.S. Patent Nos. 5,704,173 (the '173 patent) issued on January 6, 1998.

3. The '450 patent claims benefit via continuation thru the '173 patent.

4. A request for reexamination of the '450 patent was filed on January 26, 2007. The request was assigned control No. 90/008,445 (the '8445 reexamination proceeding).

5. A request for reexamination of the '173 patent was filed on January 26, 2007. The request was assigned control No. 90/008,441 (the '8441 reexamination proceeding).

6. Reexamination was ordered for the '8445 proceeding on March 30, 2007.

7. Reexamination was ordered for the '8441 proceeding on March 2, 2007.

8. On May 24, 2007, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

9. On June 5, 2007, patent owner filed an second IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

10. On June 15, 2007, patent owner filed an third IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

11. On July 2, 2007, patent owner filed, in the '8445 proceeding, IDS submissions under 37 CFR 1.555, 1.97 and 1.98 identical to those of May 24, 2007, June 5, 2007 and June 15, 2007, submitted in the '8441 proceeding.

12. Concurrent with the IDS submissions of July 2, 2007, in the '8445 proceeding, patent owner filed a petition under 37 CFR 1.182 and 1.183 requesting waiver of the formal submission requirements for the IDS submissions under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in the '8441.

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 copies of certain types of references must be provided in each application for which applicant files an

IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's July 2, 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's waiving the reference copy submission requirement.

A fee of $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's July 2, 2007 petition submission.

ADDITIONAL DISCUSSION

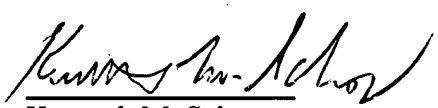
EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future, as references could be scanned in and electronically submitted directly into each case.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the reference–copy submission requirements of 37 CFR 1.555 and 1.98 is granted.

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

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Van Dyke, Gardner, Linn & Burkhart LLP
2851 Charlevoix Drive, S.E.
Suite 207
Grand Rapids, MI 49546

(For Patent Owner)

MAILED

AUG 08 2007

Sughrue, Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

(For Requester) CENTRAL REEXAMINATION UNIT

In re Repp et al.
Reexamination Proceeding
Control No.: 90/008,449
Filed: January 26, 2007
For: U.S. Patent No. 6,128,860

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the July 2, 2007 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 AND 1.183." The petition requests waiver of the formal reference–copy submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of filing 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 granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,128,860 (the '860 patent) issued on October 10, 2000.

2. U.S. Patent Nos. 5,704,173 (the '173 patent) issued on January 6, 1998.

3. The '450 patent claims benefit as a continuation thru the '173 patent.

4. A request for reexamination of the '860 patent was filed on January 26, 2007. The request was assigned control No. 90/008,449 (the '8449 reexamination proceeding).

5. A request for reexamination of the '173 patent was filed on January 26, 2007. The request was assigned control No. 90/008,441 (the '8441 reexamination proceeding).

6. Reexamination was ordered for the '8449 proceeding on March 16, 2007.

7. Reexamination was ordered for the '8441 proceeding on March 2, 2007.

8. On May 24, 2007, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

9. On June 5, 2007, patent owner filed an second IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

10. On June 15, 2007, patent owner filed an third IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

11. On July 2, 2007, patent owner filed, in the '8449 proceeding, IDS submissions under 37 CFR 1.555, 1.97 and 1.98 identical to those of May 24, 2007, June 5, 2007 and June 15, 2007, submitted in the '8441 proceeding.

12. Concurrent with the IDS submissions of July 2, 2007, in the '8449 proceeding, patent owner filed a petition under 37 CFR 1.182 and 1.183 requesting waiver of the formal submission requirements for the IDS submissions under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in the '8441.

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 copies of certain types of references must be provided in each application for which applicant files an IDS, to constitute a proper IDS. The scanning in of a single submission of references

and subsequent electronic transfer of the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's July 2, 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's waiving the reference copy submission requirement.

A fee o f $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's July 2, 2007 petition submission.

ADDITIONAL DISCUSSION

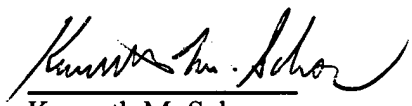
EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future, as references could be scanned in and electronically submitted directly into each case.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the reference–copy submission requirements of 37 CFR 1.555 and 1.98 is granted.

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

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.: 6,101,502 C1

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 November 10, 2009

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

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: 01/11/10

Patent No. : 6101502 C1
Ser. No. : 90/008,452
Inventor(s) : HUEBNER, ROBERT A.
Issued : 11/10/09
Title : **OBJECT MODEL MAPPING AND RUNTIME ENGINE FOR EMPLOYING RELATIONAL DATABASE WITH OBJECT ORIENTED SOFTWARE**
Docket No. : **R96409**

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-0025
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(703) 756-1574 or (703) 305-8309

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

LMN

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Commissioner for Patents
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Van Dyke, Gardner, Linn & Burkhart LLP
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Grand Rapids, MI 49546

(For Patent Owner)

MAILED

AUG 08 2007

CENTRAL REEXAMINATION UNIT

Sughrue, Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

(For Requester)

In re Repp et al.
Reexamination Proceeding
Control No.: 90/008,458
Filed: January 26, 2007
For: U.S. Patent No. 5,551,197

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the July 2, 2007 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 AND 1.183." The petition requests waiver of the formal reference–copy submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of filing 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 granted.

REVIEW OF FACTS

1. U.S. Patent No. 5,551,197 (the '197 patent) issued on September 3, 1996.

2. U.S. Patent Nos. 5,704,173 (the '173 patent) claims benefit to the '197 patent.

3. A request for reexamination of the '197 patent was filed on January 26, 2007. The request was assigned control No. 90/008,458 (the '8458 reexamination proceeding).

4. A request for reexamination of the '173 patent was filed on January 26, 2007. The request was assigned control No. 90/008,441 (the '8441 reexamination proceeding).

5. Reexamination was ordered for the '8458 proceeding on April 6, 2007.

6. Reexamination was ordered for the '8441 proceeding on March 2, 2007.

7. On May 24, 2007, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

8. On June 5, 2007, patent owner filed an second IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

9. On June 15, 2007, patent owner filed an third IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

10. On July 2, 2007, patent owner filed, in the '8458 proceeding, IDS submissions under 37 CFR 1.555, 1.97 and 1.98 identical to those of May 24, 2007, June 5, 2007 and June 15, 2007, submitted in the '8441 proceeding.

11. Concurrent with the IDS submissions of July 2, 2007, in the '8458 proceeding, patent owner filed a petition under 37 CFR 1.182 and 1.183 requesting waiver of the formal submission requirements for the submissions under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in the '8441.

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 copies of certain types of references must be provided in each application for which applicant files an IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of the same scanned references in an identical IDS

between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's July 2, 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's waiving the reference copy submission requirement.

A fee of $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's July 2, 2007 petition submission.

ADDITIONAL DISCUSSION

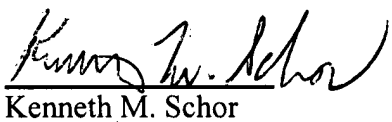
EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future, as references could be scanned in and electronically submitted directly into each case.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the reference–copy submission requirements of 37 CFR 1.555 and 1.98 is granted.

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

8-2-07
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Alexandria, VA 22313-1450
www.uspto.gov

Van Dyke, Gardner, Linn & Burkhart LLP
2851 Charlevoix Drive, S.E.
Suite 207
Grand Rapids, MI 49546

(For Patent Owner)

MAILED

AUG 08 2007

CENTRAL REEXAMINATION UNIT

Sughrue, Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

(For Requester)

In re Repp et al.
Reexamination Proceeding
Control No.: 90/008,462
Filed: January 26, 2007
For: U.S. Patent No. 6,298,606 B1

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the July 2, 2007 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 AND 1.183." The petition requests waiver of the formal reference–copy submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of filing 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 granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,298,606 (the '606 patent) issued on October 9, 2001.

2. U.S. Patent Nos. 5,704,173 (the '173 patent) issued on January 6, 1998.

3. The '606 patent claims benefit via continuation thru the '173 patent.

4. A request for reexamination of the '606 patent was filed on January 26, 2007. The request was assigned control No. 90/008,462 (the '8462 reexamination proceeding).

5. A request for reexamination of the '173 patent was filed on January 26, 2007. The request was assigned control No. 90/008,441 (the '8441 reexamination proceeding).

6. Reexamination was ordered for the '8462 proceeding on March 16, 2007.

7. Reexamination was ordered for the '8441 proceeding on March 2, 2007.

8. On May 24, 2007, patent owner filed an IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

9. On June 5, 2007, patent owner filed an second IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

10. On June 15, 2007, patent owner filed an third IDS under 37 CFR 1.555, 1.97 and 1.98 in the '8441 proceeding.

11. On July 2, 2007, patent owner filed, in the '8462 proceeding, IDS submissions under 37 CFR 1.555, 1.97 and 1.98 identical to those of May 24, 2007, June 5, 2007 and June 15, 2007, submitted in the '8441 proceeding.

12. Concurrent with the IDS submissions of July 2, 2007, in the '8462 proceeding, patent owner filed a petition under 37 CFR 1.182 and 1.183 requesting waiver of the formal submission requirements for the IDS submissions under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in the '8441.

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 copies of certain types of references must be provided in each application for which applicant files an

IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requester. Accordingly, the petition is granted.

The grant of this petition is based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's July 2, 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's waiving the reference copy submission requirement.

A fee of $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's July 2, 2007 petition submission.

ADDITIONAL DISCUSSION

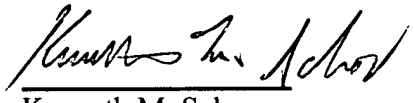
EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future, as references could be scanned in and electronically submitted directly into each case.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the formal reference–copy submission requirements of 37 CFR 1.555 and 1.98 is granted.

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
8-2-07
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,463	02/02/2007	6947254	4389.77166	4685

24978 7590 03/03/2008

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2008

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,534	03/19/2007	6947254	10760/346	2377

24978 7590 03/03/2008

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CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

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Commissioner for Patents
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Thomas R. Fitzsimons
Greer, Burns & Crain, Ltd.
300 S. Wacker Drive, Suite 2500
Chicago, IL 60606

(For Patent Owner)

MAILED

MAR 03 2008

CENTRAL REEXAMINATION UNIT

Michelle Camaiux
Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

(For Third Party Requester)

In re Edwards *et alia*
Reexamination Proceeding
Control No. 90/008,463
Request Deposited: February 2, 2007
For: U.S. Patent No. 6,947,254

In re Edwards *et alia*
Reexamination Proceeding
Control No. 90/008,534
Corrected Request Deposited: March 19, 2007
For: U.S. Patent No. 6,947,254

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. 6,947,254 (hereinafter, the '254 patent), issued to Edwards *et alia*, on September 20, 2005.

2. On February 2, 2007, Patent Owner deposited a Request for *Ex Parte* Reexamination of the '254 patent. The reexamination proceeding was assigned Control No. 90/008,463 (hereinafter, the '8463 proceeding).

3. The Reexamination Order was granted in the '8463 proceeding on April 25, 2007.

4. There are currently no amendments in the '8463 proceeding.

5. On March 19, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '254 patent. The reexamination proceeding was assigned Control No. 90/008,534 (hereinafter, the '8534 proceeding).

6. The Reexamination Order was granted in the '8534 proceeding on April 25, 2007.

7. There are currently no amendments in the '8534 proceeding.

8. The '8463 and '8534 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 '8463 and the '8534 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. 90/008,463 and 90/008,534 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,463	02/02/2007	6947254	4389.77166	4685

24978 7590 09/10/2009

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/10/2009

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(For Patent Owner)

Kenyon & Kenyon LLP
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New York, NY 10004

(For Requester)

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SEP 10 2009

CENTRAL REEXAMINATION UNIT

In re Edwards et al
Ex Parte Reexamination Proceeding
Control No. 90/008,463
Filed: February 2, 2007
For: U.S. Patent 6,947,254

In re Edwards et al
Ex Parte Reexamination Proceeding
Control No. 90/008,534
Filed: March 19, 2007
For: U.S. Patent No. 6,947,254

DECISION DISMISSING PETITION

This is a decision on the June 15, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the June 15, 2009 patent owner petition to revive").

The June 15, 2009 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been received.

SUMMARY

The June 15, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding . . .

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed

by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon . . . for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.116 provides, in pertinent part:

(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).

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 § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

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

37 CFR 41.37 provides, in pertinent part:

(a)

(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

MPEP 711.03(c) II A 2 (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 . . .

An application subject to a final action in which a proposed amendment under 37 CFR 1.116 is filed as the required reply will normally be routed by the Office of Petitions to the Technology Center (TC) to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The examiner is instructed that if the reply places the application in condition for allowance, the examiner should write in the margin of the reply "OK to enter upon revival." For Image File Wrapper (IFW) processing, see IFW Manual. If the petition is otherwise grantable and the examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If, on the other hand, the reply would not place the application in condition for allowance, the examiner is instructed to complete form PTOL-303 and return the form to the Office of Petitions with the application. Form PTOL-303 should not be mailed to the applicant by the examiner. In this situation, the Office of Petitions will not grant the petition. A copy of the form PTOL-303 is marked with the notation "Courtesy Copy" by the Office of Petitions. The courtesy copy is sent as an attachment with the decision on the petition. The advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the amendment after final rejection.

MPEP 711.03(c) II A 2 (c) provides, in pertinent part:

Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995. . . ; or

(C) the filing of a continuing application under 37 CFR 1.53(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 II, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response[1] to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

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 June 15, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively. The patent owner has not, however, satisfied item (1), because the patent owner has not provided a proper response to the outstanding Office action.

Regarding item (1), the required response must be an appeal brief in compliance with 37 CFR 41.37(c) and (b) an appeal brief fee.[2] The filing of an amendment, however, that places the proceeding in condition for issuance of a reexamination certificate, i.e., in a condition in which all of the claims under reexamination are cancelled, or in a condition in which all of the claims under reexamination are patentable or confirmed, may also satisfy the reply requirement in a reexamination proceeding.[3] The patent owner, however, has not satisfied item (1), because the patent owner has not filed an appeal brief and appropriate fee, and because the amendment filed by the patent owner on June 15, 2009 does not place the proceeding in condition for issuance of a reexamination certificate, i.e., a condition in which all of the claims under reexamination are cancelled, or in a condition in which all of the claims under reexamination are patentable or confirmed. See the advisory action, which is attached to this decision. For the reasons given in the attached advisory action, the amendment filed on June 15, 2009 fails to comply with the reply requirement of 37 CFR 1.137(b)(1).

Accordingly, the June 15, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[4] is **dismissed**.

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[2] See MPEP 2268 IV and, in addition, MPEP 711.03(c) II A 2 (c), which also states that the reply may be the filing of an RCE accompanied by a submission and the requisite fee, or the filing of a continuing application under 37 CFR 1.53(b). The Request for Continued Reexamination (RCE) practice established by 37 CFR 1.114, however, does not apply to a patent under reexamination. See 37 CFR 1.114(e)(5). A continuing application under 37 CFR 1.53(b) also does not apply to a patent under reexamination. RCE practice, and continuation practice, does not apply in reexamination because a reexamination proceeding is not an "application" under 37 CFR 1.53.

[3] An amendment pursuant to 37 CFR 1.116, however, does apply to a patent under reexamination. See 37 CFR 1.113 and 37 CFR 1.116. See also 37 CFR 41.33(a), which provides:

> Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

To satisfy the reply requirement for a petition to revive under 37 CFR 1.137(b), however, an amendment pursuant to 37 CFR 1.116 must "[cancel] all rejected claims or otherwise *prima facie* [place] the [proceeding] in condition for allowance." See MPEP 711.03(c) II A 2 (b), which provides, in pertinent part:

> A reply under 37 CFR 1.113 to a final action must include . . . cancellation of . . . each claim so rejected. Accordingly, . . . the reply required for consideration of a petition to revive must be:
>
> *
>
> (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 . . .

[4] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file an appeal brief pursuant to 37 CFR 41.37(a).

CONCLUSION

- The June 15, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

- Any grantable renewed petition under 37 CFR 1.137(b), that is filed in response to this decision, must be accompanied by either an appeal brief and appropriate fee, or by an amendment that places the proceeding in a condition in which all of the claims under reexamination are cancelled, or in a condition in which all of the claims under reexamination are patentable or confirmed. If the patent owner desires to submit such an amendment, the amendment should be included in a cover letter entitled **"Renewed Petition under 37 CFR 1.137(b)."**

- Jurisdiction over this merged reexamination proceeding is being retained by the Office of Patent Legal Administration pending a response to this decision, or the expiration of time to respond to this decision.

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

- All correspondence relating to this petition in this merged *ex parte* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Ex Parte* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

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

Attachment: Advisory Action

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,463	02/02/2007	6947254	4389.77166	4685

24978 7590 11/12/2009

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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.
90/008,534	03/19/2007	6947254	10760/346	2377

24978 7590 11/12/2009

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Michelle Carniaux
Kenyon & Kenyon
One Broadway
New York, NY 10004

Date:

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008534
PATENT NO. : 6947254
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

Greer, Burns, & Crain
300 S.Wacker Drive
25th Floor
Chicago, IL 60606

(For Patent Owner)

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

(For Requester)

In re Edwards et al
Ex Parte Reexamination Proceeding
Control No. 90/008,463
Filed: February 2, 2007
For: U.S. Patent 6,947,254

DECISION GRANTING PETITION

In re Edwards et al
Ex Parte Reexamination Proceeding
Control No. 90/008,534
Filed: March 19, 2007
For: U.S. Patent No. 6,947,254

This is a decision on the October 5, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the October 5, 2009 patent owner petition to revive").

The October 5, 2009 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to deposit account no. 07-2069 as authorized in the paper entitled "Reexamination Transmittal" filed on October 5, 2009.

SUMMARY

The October 5, 2009 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 1.116 provides, 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).

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 § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

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

37 CFR 41.37 provides, in pertinent part:

(a)

(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

MPEP 711.03(c) II A 2 (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 . . .

An application subject to a final action in which a proposed amendment under 37 CFR 1.116 is filed as the required reply will normally be routed by the Office of Petitions to the Technology Center (TC) to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The examiner is instructed that if the reply places the application in condition for allowance, the examiner should write in the margin of the reply "OK to enter upon revival." For Image File Wrapper (IFW) processing, see IFW Manual. If the petition is otherwise grantable and the examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If, on the other hand, the reply would not place the application in condition for allowance, the examiner is instructed to complete form PTOL-303 and return the form to the Office of Petitions with the application. Form PTOL-303 should not be mailed to the applicant by the examiner. In this situation, the Office of Petitions will not grant the petition. A copy of the form PTOL-303 is marked with the notation "Courtesy Copy" by the Office of Petitions. The courtesy copy is sent as an attachment with the decision on the petition. The advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the amendment after final rejection.

MPEP 711.03(c) II A 2 (c) provides, in pertinent part:

Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995. . . ; or

(C) the filing of a continuing application under 37 CFR 1.53(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 II, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response[1] to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the October 5, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), the required response must be an appeal brief in compliance with 37 CFR 41.37(c) and (b) an appeal brief fee.[2] The filing of an amendment, however, that places the proceeding in condition for issuance of a reexamination certificate, i.e., in a condition in which all of the claims under reexamination are cancelled, or in a condition in which all of the claims under reexamination are patentable or confirmed, may also satisfy the reply requirement in a reexamination proceeding.[3] The amendment filed on October 5, 2009 has satisfied item (1), because the amendment places the proceeding in a condition that permits the processing by the Office of a notice of intent to issue a reexamination certificate (NIRC), and has been entered by the examiner as indicated on the attached copy of the amendment. For this reason, the amendment is deemed to comply with the reply requirement of 37 CFR 1.137(b)(1).

Accordingly, the October 5, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[4] is **granted**.

---

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

[2] See MPEP 2268 IV and, in addition, MPEP 711.03(c) II A 2 (c), which also states that the reply may be the filing of an RCE accompanied by a submission and the requisite fee, or the filing of a continuing application under 37 CFR 1.53(b). The Request for Continued Reexamination (RCE) practice established by 37 CFR 1.114, however, does not apply to a patent under reexamination. See 37 CFR 1.114(e)(5). A continuing application under 37 CFR 1.53(b) also does not apply to a patent under reexamination. RCE practice, and continuation practice, does not apply in reexamination because a reexamination proceeding is not an "application" under 37 CFR 1.53.

[3] An amendment pursuant to 37 CFR 1.116, however, does apply to a patent under reexamination. See 37 CFR 1.113 and 37 CFR 1.116. See also 37 CFR 41.33(a), which provides:

> Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

To satisfy the reply requirement for a petition to revive under 37 CFR 1.137(b), however, an amendment pursuant to 37 CFR 1.116 must "[cancel] all rejected claims or otherwise *prima facie* [place] the [proceeding] in condition for allowance." See MPEP 711.03(c) II A 2 (b), which provides, in pertinent part:

> A reply under 37 CFR 1.113 to a final action must include . . . cancellation of . . . each claim so rejected. Accordingly, . . . the reply required for consideration of a petition to revive must be:
>
> *
>
> (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 . . .

[4] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file an appeal brief pursuant to 37 CFR 41.37(a).

CONCLUSION

- The October 5, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

- Jurisdiction over this merged reexamination proceeding is being returned to the Central Reexamination Art Unit 3992 for processing of the October 5, 2009 patent owner amendment.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Matthew Heneghan, of CRU Art Unit 3992, at (571) 272-3834.

- Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7724.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

Attachment: Copy of October 5, 2009 Amendment Initialed by Examiner

4389.77166
71338 U.S. PTO

PATENT

10/05/09

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Edwards et al.
Reexamination No.	90/008,463; 90/008,534 (merged)
U.S. Patent No.	6,947,254
Issue Date:	September 20, 2005
For:	INTERCHANGEABLE CARTRIDGE DATA STORAGE SYSTEM FOR DEVICES PERFORMING DIVERSE FUNCTIONS

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

October 1, 2009
Date

Registration No. 40,607
Attorney for Applicant(s)

OK TO ENTER: /MH/
11/09/2009

REEXAMINATION AMENDMENT B
AFTER FINAL (FOURTH RESUBMISSION)

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

Sir:

This Amendment B is being Resubmitted a fourth time in response to the Decision Dismissing Petition mailed on September 10, 2009. That Decision indicated that errors remained in the Amendment B, Third Resubmission, since claims 11-20 were not labeled "New" and since rejected claims were not cancelled. Corresponding changes have been made in this Amendment B, FOURTH Resubmission. No other changes are made.

Further, it is noted that no appeal brief has been filed, and that this Reexamination proceeding has been closed, leaving the reexamination application abandoned. A Petition to Revive was filed with the Amendment B, Third Resubmission.

The present Fourth Resubmission is being filed together with a Renewed Petition under 37 CFR §1.137(b) as suggested so that the attached Amendment can be entered, which will result in the claims being placed into allowable form. The amendments only place claims that were previously objected to in a condition suitable to be allowed, and change the dependency of some other claims to depend from newly allowable claim 2. All other rejected claims are cancelled.

AMENDMENTS TO THE CLAIMS

Pursuant to 1.530(d)-(j), please cancel claims 1, 6-10, 14-17, and 19-20.

The status of the claims is:

1. (Cancelled)

2. (Twice Amended) [The data storage system recited in claim 1 further comprising:] An interchangeable data storage system comprising:

a drive in one of a plurality of devices for generating signals, wherein a first of the plurality of devices is a host computer, a second device is a portable game, and a third of the plurality of devices is selected from the group consisting of: electronic books, global positioning systems, personal digital systems, cellular phones and digital cameras;

a miniature storage device having a rotatable medium capable of storing signals from each of the plurality of devices; wherein said drive writes said signals to and reads said signals from said storage device so that said storage device can be interchangeably operated upon by said first, second, and third of the plurality of devices, said miniature storage device dimensioned smaller than a standard full size cartridge; and [.]

a caddy for accommodating said storage device, said caddy having an interface for transferring signals between said caddy and said host computer, each of the plurality of devices having a motor for driving rotation of said rotatable medium at a first speed, said caddy having a plurality of gears that translate said first speed from said motor to a higher rotational speed, one or more of said plurality of gears linked to said rotatable medium wherein said rotatable medium rotates at a speed in said caddy that is higher than said first speed.

3. (Currently Amended) The data storage system recited in claim [1]2, wherein said storage device comprises flexible magnetic media.

4. (Currently Amended) The data storage system recited in claim [1]2, wherein said storage device comprises rigid magnetic media.

5. (Currently Amended) The data storage system recited in claim [1]2, wherein said storage device comprises optical media.

6.-10. (Cancelled)

11. (New) An interchangeable data storage system as defined by claim 2 wherein said miniature storage device further comprises a mini-cartridge including a shell enclosing said medium, said shell providing access to said rotating medium wherein the device may write to and read from said rotating medium, said shell being generally square shaped with a top wall, a bottom wall, and having opposing sidewalls and endwalls connecting said top wall to said bottom wall, a wedge shaped cut-out in at least one of said sidewalls configured to receive a cooperating wedge lock from each of said plurality of devices, wherein engagement of said wedge lock with said wedge shaped cut-out locks said shell in place in said device.

12. (New) An interchangeable data storage system as defined by claim 2 wherein said rotatable medium is contained in a shell that includes a shutter moveable into an open position wherein said rotatable medium may have data written thereto and read therefrom by one or more moveable arms in each of said host computer, portable game, and a third device, movement of said shutter allowing said arms from each of said host computer, portable game, and a third device to operatively access said rotatable medium.

13. (New) An interchangeable data storage system as defined by claim 12 wherein said shell is configured to engage a spring in each of said host computer,

second, and third devices, said spring providing a spring force useful to eject said miniature storage device from said at least one of said plurality of devices.

14.-17. (Cancelled)

18. (Previously Presented) An interchangeable data storage system as defined by claim 2, wherein said plurality of gears include at least three gears and are configured to cause said medium to rotate at the same angular velocity but a greater speed than a full size drive magnetic medium.

19.-20. (Cancelled)

STATUS OF THE CLAIMS

Pursuant to §1.530(e), the status of the claims as of the date of the above amendments is:

Claim:	Status:	Support for Amendment:
1	Cancelled	
2	Twice Amended	(See Remarks below)
3	Amended	(See Remarks below)
4	Amended	(See Remarks below)
5	Amended	(See Remarks below)
6	Cancelled	
7	Cancelled	
8	Cancelled	
9	Cancelled	
10	Cancelled	
11	Amended	(See Remarks below)
12	Amended	(See Remarks below)
13	Previously Presented	
14	Cancelled	
15	Cancelled	
16	Cancelled	
17	Cancelled	
18	Previously Presented	
19	Cancelled	
20	Cancelled	

REMARKS

This Amendment B is being resubmitted a Fourth time in response to the Decision Dismissing Petition mailed on September 10, 2009. That Decision indicated that errors remained in the proposed amendment to claims since claims were not cancelled and claims 11-20 were not labeled as "new." That Decision indicated that if all claims were put in a condition for reissuance (by canceling rejected claims and correcting label errors to claims 11-20) and a Renewed Petition under 37 CFR §1.137(b) were submitted, the amendment could be entered. Corresponding changes have been made in this Amendment B, Fourth Resubmission. In particular, claims 1, 6-10, 14-17, 19 and 20 have been cancelled and claims 11-13 and 18 relabeled as "New."

It is noted that no appeal brief has been filed, and that this Reexamination proceeding has been closed leaving the reexamination application abandoned. A Renewed Petition to Revive has been filed herewith so that the attached Amendment can be entered, which will result in the claims being placed into allowable form. The amendments only place claims that were previously objected to in a condition suitable to be allowed, and change the dependency of some other claims to depend from newly allowable claim 2. Other rejected claims have been cancelled.

In the Reexamination Final Office Action mailed on December 17, 2008, claims 2 and 18 were patented or confirmed, and indicated to be allowable if rewritten in independent form. Claims 2 and 18 were also rejected under §112 based on a typographical error. Claim 2 has been amended to include the limitations of claim 1 from which it formerly depended, and to address the typographical errors pointed out in the Final Action. Claim 2 as amended is therefore allowable. Other claims (3, 4, 5, 11 and 12) have been amended to depend from allowable claim 2, and these other claims are therefore allowable. All other claims have been cancelled.

Pursuant to §1.550(f), this submission is being served on third party requestor at the correspondence address indicated on the Office Action on today's date by first class mail.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By
Thomas R. Fitzsimons
Registration No. 40,607

October 1, 2009

Suite 2500
300 South Wacker Drive
Chicago, Illinois 60606
(312) 360-0080
Customer No. 24978
P:\DOCS\4389\77166\F76059.DOC

Reexam

4389.77166

PATENT

71338 U.S. PTO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

10/05/09

OIPE IAP10 OCT 05 2009 PATENT & TRADEMARK OFFICE

Applicant:	Edwards et al.
Reexamination No.	90/008,463; 90/008,534 (merged)
U.S. Patent No.	6,947,254
Issue Date:	September 20, 2005
For:	INTERCHANGEABLE CARTRIDGE DATA STORAGE SYSTEM FOR DEVICES PERFORMING DIVERSE FUNCTIONS

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

October 1, 2009
Date

Registration No. 40,607
Attorney for Applicant(s)

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

REEXAMINATION TRANSMITTAL

Sir:

Transmitted herewith is a communication regarding the above-identified reexamination proceeding. This proceeding is a Merged Reexamination of two Reexaminations. The below referenced submissions are being provided in duplicate with original signatures in a single filing in accordance with the March 3, 2008 Decision Sua Sponte Merging Reexamination Proceedings.

Fee Calculation For Claims As Amended

	As Amended		Previously Paid For		Present Extra		Rate		Additional Fee
Total Claims	8	-	20	=	0	x	$52.00	=	$ 00.00
Independent Claims	1	-	3	=	0	x	$220.00	=	$ 00.00
Fee for Multiple Dependent Claims							$390.00	=	$ 00.00
					Total Additional Fee				$ 00.00
					Small Entity Fee (reduced by half)				$ 00.00

(X) Renewed Petition Under 37 CFR 1.137(b) with Reexamination Amendment B After Final (FOURTH RESUBMISSION) with Certificate of Service.

(X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By: _____
Thomas R. Fitzsimons
Registration No. 40,607

300 South Wacker Drive -Suite 2500
Chicago, Illinois 60606
Telephone: (312) 360-0080
Facsimile: (312) 360-9315
Customer Number 24978

P:\DOCS\4389\77166\F86861.DOC

4389.77166 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Edwards et al.
Reexamination No.	90/008,463; 90/008,534 (merged)
U.S. Patent No.	6,947,254
Issue Date:	September 20, 2005
For:	INTERCHANGEABLE CARTRIDGE DATA STORAGE SYSTEM FOR DEVICES PERFORMING DIVERSE FUNCTIONS

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

October 1, 2009
Date

Registration No. 40,607
Attorney for Applicant(s)

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

REEXAMINATION TRANSMITTAL

Sir:

Transmitted herewith is a communication regarding the above-identified reexamination proceeding. This proceeding is a Merged Reexamination of two Reexaminations. The below referenced submissions are being provided in duplicate with original signatures in a single filing in accordance with the March 3, 2008 Decision Sua Sponte Merging Reexamination Proceedings.

Fee Calculation For Claims As Amended

	As Amended		Previously Paid For		Present Extra		Rate		Additional Fee
Total Claims	8	-	20	=	0	x	$52.00	=	$ 00.00
Independent Claims	1	-	3	=	0	x	$220.00	=	$ 00.00
Fee for Multiple Dependent Claims							$390.00	=	$ 00.00
					Total Additional Fee				$ 00.00
					Small Entity Fee (reduced by half)				$ 00.00

(X) Renewed Petition Under 37 CFR 1.137(b) with Reexamination Amendment B After Final (FOURTH RESUBMISSION) with Certificate of Service.

(X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By: _____
Thomas R. Fitzsimons
Registration No. 40,607

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Covington & Burling LLP (For Patent Owner)
1201 Pennslyvania Avenue, NW
Washington, DC 2004-2401

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JUN 01 2007

CENTRAL REEXAMINATION UNIT

Womble,Carlyle,Sandrige & Rice, PLLC (For Patent Owner)
P.O. Box 7037
Atlanta, Georgia 30357-00037

Knobbe, Martens, Olson & Bear, LLP (For Requester)
2040 Main Street, 14th Floor
Irvine, CA 92614

In re Reissue Application :
of Hungerpiller et al :
Application No. 11/605,488 :
Filed: November 29, 2006 :
For: U.S. Patent No. 6,826,548 : **DECISION ON PETITION**
: **UNDER 37 CFR 1.182 TO**
In re Hungerpiller et al : **MERGE REISSUE AND**
Reexamination Proceeding : **REEXAMINATION**
Control No. 90/008,470 : **PROCEEDINGS**
Filed: January 31, 2007 :
For: U.S. Patent No. 6,826,548 :

This is a decision on the May 16,2007 patent owner petition under 1.182 to merge above-captioned reissue and reexamination proceedings.

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

The petition is granted.

REVIEW OF FACTS

1. U.S. patent No. 6,826,548 (the '548 patent) issued on November 30, 2004, with 38 claims.

2. An application for reissue of the '548 patent, assigned application No. 11/605,488 (the '488 application), was filed by the patent owner on November 29, 2006.

3. The filing of the '488 reissue application was announced in the *Official Gazette* on January 16, 2007.

4. A request for reexamination was filed by a third party requester on January 31, 2007, and was assigned control No. 90/008,470 (the '470 proceeding).

5. Reexamination was ordered for the '470 proceeding on April 17, 2007.

6. On May 16, 2007, the present petition under 37 CFR 1.182 to merge the reissue application and reexamination proceeding was filed by the patent owner in the '488 application.

7. On May 16, 2007 the patent owner filed, in the '470 proceeding, a notice of concurrent proceeding under 37 CFR 1.565 - informing the Office of the '488 reissue application.

8. A patent owner's statement under 37 CFR 1.530 has not been received in the '470 proceeding, and the time for filing same has expired. Furthermore, on May 16, 2007 the patent owner filed a waiver of its right to file such a statement in the '470 proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

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

As evidenced by the above review of facts, reissue application No. 11/605,488 and reexamination control No. 90/008,470 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. 90/008,470 shows:

(a) Original patent claims 1-38 are present.

(b) No amendments have been made.

A review of reissue application No. 11/605,488 shows:

(a) Original patent claims 1-38 are present, as well as new claims 39 - 114.

(b) New claims 39 - 114 were added on November 29, 2006.

At least claims 39 - 114 in the reissue application are not identical to the claims in the reexamination proceeding. **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. 11/605,488 and Control Number 90/008,470. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

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

2. In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings 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.

PATENT OWNER'S ADDRESS

The patent owner is called upon to clarify and coordinate the patent owner's addresses in (1) the patent, (2) the reissue application and (3) the reexamination proceeding. Various papers have been filed by the law firm of Covington and Burling, LLP of Washington, DC in both cases. However the current proper correspondence address for the patented file pursuant to 37 CFR 1.33(c) is that of Womble, Carlyle, Sandrige & Rice, PLLC, of Atlanta, GA. Thus, for the '470 reexamination proceeding Womble, Carlyle, Sandrige & Rice, PLLC, of Atlanta, GA is the current proper address. This is the address to which the order granting reexamination was mailed. The reissue application has "none" listed under attorneys in the Office's database.

Clarification is needed so that all future correspondence can be directed to a single address for the patent owner. Accordingly, **patent owner is required to, within ONE (1) MONTH of this decision:**

(a) Designate one of the two correspondence addresses and attorneys prosecuting these proceedings as the correspondence address and attorney of record in both proceedings (to provide one address and attorney for the merged proceeding) and the patent file, and

(b) Supply the designated attorney with the power of attorney in the appropriate proceedings.

As a courtesy, this decision is being mailed to both addresses.

CONCLUSION

1. The petition requesting merger is granted.

2. Reissue application No. 11/605,488 and reexamination control No. 90/008,470 **are merged** into a single proceeding.

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

4. The patent owner is further required to, within **ONE MONTH** of this decision **unify the correspondence addresses and attorneys prosecuting these proceedings** as set forth in the last section of this decision.

5. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 3600, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '548 patent (e.g., by preparing/signing an action). See MPEP 2236.

6. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period from the mailing of this decision for the filing of (i) the required housekeeping amendment and (ii) the papers unifying the correspondence address and attorney of record in both proceedings or the receipt of such papers, or

   (B) The receipt of both the required amendment and papers.

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

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

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

kmh
30 May 2007

May 31, 2007
C:\kiva\kenpetmerger\8470_PO-Pet-to-merge_cls-diff_3PR_2-addresses.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.
90/008,470	01/31/2007	6826548		2122

26853 7590 03/10/2010

COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2010

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 Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

MAILED

MAR 10 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,470*.

PATENT NO. *6826548*.

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

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Covington & Burling LLP
Attn: Patent Docketing
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401

(For Patent Owner)

MAILED

MAR 10 2010

CENTRAL REEXAMINATION UNIT

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

(For Requester)

In re Reissue Application of Hungerpiller et al.
Application No. 11/605,488
Filed: November 29, 2006

In re Hungerpiller et al.
Reexamination Proceeding
Control No. 90/008,470
Filed: January 31, 2007
For: U.S. Patent No. 6,826,548

DECISION,
***SUA SPONTE*,**
SEVERING MERGER OF REISSUE AND REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. patent No. 6,826,548 (the '548 patent) issued on November 30, 2004, with 38 claims.

2. An application for reissue of the '548 patent, assigned application No. 11/605,488 (the '488 application) was filed by the patent owner on November 29, 2006.

3. A request for reexamination was filed by a third party requester on January 31, 2007, and was assigned control No. 90/008,470 (the '470 proceeding).

4. Reexamination was ordered for the '470 proceeding on April 17, 2007.

5. On May 16, 2007, a petition under 37 CFR 1.182 to merge the reissue application and reexamination proceeding was filed by the patent owner in the '488 application.

6. On June 1, 2007, a decision was granted to merge the reissue application and reexamination proceedings.

7. The merged proceeding progressed to the point where, on November 9, 2009, a Request for Continued Examination (RCE) was filed by patent owner.

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."

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.

Under 35 USC 305:

> 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.

DECISION SEVERING THE MERGED REISSUE AND REEXMINATION PROCEEDINGS

Pursuant to 35 U.S.C. 305, reexamination proceedings must be conducted with "special dispatch". The filing of an RCE delays the reexamination proceeding, and the resolution of the substantial new question of patentability raised by the reexamination request, contrary to statutory mandate. Further, the filing of the RCE is effective for the reissue proceeding, but not for the reexamination proceeding; and it is tantamount to a filing of a reissue application after a

reexamination proceeding is well advanced, in which case the proceedings would generally not be merged and a decision supending the reissue application would be issued. Accordingly, the merged proceedings must be severed to permit the reexamination proceeding to proceed to conclusion with special dispatch.

In order to prevent inconsistent, and possibly conflicting, responses and amendments from being introduced into the multiple proceedings on behalf of the patent owner, it is not appropriate to conduct the now-severed examination of the reissue and reexamination proceedings separately, and at the same time as to the same patent. Rather, prosecution of the reissue application is hereby suspended until the conclusion of the reexamination proceeding.

The reissue application suspension shall remain in effect until the conclusion of the '8470 proceeding by the issuance and publication of the reexamination certificate. To the extent that 37 CFR 1.570(d) would preclude prosecution of the '488 reissue application in the event that the prosecution in the '8470 proceeding results in cancellation of all claims of the '548 patent, patent owner has filed the '488 reissue application prior to publication of a reexamination certificate for the '548 patent. Therefore, patent owner would be entitled to file a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d) to request that prosecution of the reissue patent could continue, even if a reexamination certificate should issue canceling all patent claims (and not adding any new claims to the patent).

The patent owner is given ONE (1) MONTH from this decision, to revise the claims as patent owner deems appropriate in view of the differences in reexamination and reissue, after which, a new Office action will be issued for the reexamination proceeding. If broadened claims are not deleted, they will be rejected under 35 U.S.C. 305, which prohibits broadened claims in reexamination. Any rejection directed to the reissue application that does not apply in reexamination will be withdrawn in the new Office action. As pointed out above, the reissue application prosecution is being suspended, because the filing of the RCE of the reissue application is well after substantial prosecution has been conducted in the original reexamination proceeding.

CONCLUSION

1. The merged proceeding of reissue application number 11/605,488 and reexamination control No. 90/008,470 **are hereby severed**.

2. Prosecution of the reissue application is hereby suspended until the conclusion of the '470 reexamination proceeding by the issuance and publication of a reexamination certificate.

3. After the issuance and publication of a reexamination certificate, patent owner may call up the reissue application for action, by notifying the Office of such completion. The patent owner may include an amendment of the reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding. In the event that the prosecution in the '8470 proceeding results in cancellation of all claims of the '548 patent, the patent owner would need to file a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d) to request that prosecution of the reissue patent continue (see discussion above).

4. Jurisdiction over the reexamination and reissue is returned to Technology Center 3600.

5. Telephone inquires related to this decision should be directed to the undersigned at 571-272-7710.

6. Telephone inquires related to this matter should be directed to Teri Luu, Special Programs Examiner, at 571-272-7045.

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

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(For Patent Owner)

Kenneth L. Cage
McDermott Will & Emery LLP
600 13th Street N.W.
Washington, D.C. 20005

(For Third Party Requester)

MAILED
MAY 21 2009
CENTRAL REEXAMINATION UNI

In re Reissue Application of
Joey F. Boatman et al.
Application No.: 12/020,987
Filed: January 28, 2008
For: U.S. Patent No. RE38,985

In re Joey F. Boatman et al.
Reexamination Proceeding
Control No.: 90/008,471
Filed: January 26, 2007
For: U.S. Patent No.: RE38,985

: DECISION, *SUA SPONTE*,
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. Patent No. 5,892,690 ("the '690 patent") issued on April 6, 1999.

2. Application No. 09/833,269 ("the '269 reissue application") was filed on April 5, 2001, for reissue of the '690 patent; the '269 reissue application issued as reissue patent RE38,985 ("the '985 reissue patent") on February 14, 2006.

3. A request for reexamination of the '985 reissue patent, assigned control No. 90/008,471 ("the '8471 reexamination proceeding"), was filed by a third party requester on January 26, 2007.

4. Reexamination was ordered for the '8471 reexamination proceeding on March 15, 2007.

5. An application for reissue of the '985 reissue patent, assigned application No.

12/020,987 ("the '987 reissue application"), was filed by the patent owner on January 28, 2008.

6. The filing of the '987 reissue application was announced in the *Official Gazette* on February 10, 2009.

7. A patent owner's statement under 37 CFR 1.530 was not received in the '8471 reexamination proceeding, and the time for filing same expired.

8. An Office action on the merits has not been issued in either the '8471 reexamination proceeding or the '987 reissue application.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

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

As evidenced by the above review of facts, the '987 reissue application and the '8471 reexamination proceeding are currently pending. The order to reexamine has been mailed in the '8471 reexamination proceeding, and notice of the '987 reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

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

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

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.* In addition, **if a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed**, and the reissue application may then be suspended. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination under 37 CFR 1.114 (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the '987 reissue application file shows:

   (a) Original claims 1-75 of the '985 reissue patent are present.

   (b) Original claims 4, 5, 20, and 65 are amended by the November 26, 2008 Preliminary Amendment.

   (c) New claims 76-83 are added by the November 26, 2008 Preliminary Amendment.

3. A review of the file of the '8471 reexamination proceeding shows:

   (a) Original claims 1-75 of the '985 reissue patent are present.

(b) Original claims 4, 5, and 20 are amended by the January 16, 2009 Preliminary Amendment.

(c) New claims 76-83 are added by the January 16, 2009 Preliminary Amendment.

4. At least claim 65 is not identical in the '987 reissue application and the '8471 reexamination proceeding. Accordingly, the claims are not identical in both proceedings.

5. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, the above-captioned reissue and reexamination proceedings. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must not address any issue of patentability in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time period for filing the amendment expires (see item 5 of Part II above), the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that a housekeeping amendment is not timely submitted to place the same changes in both the '987 reissue application and the '8471 reexamination proceeding, 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 are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

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

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

6. Pursuant to MPEP 2285:

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

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

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

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

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

9. If the reissue application ultimately matures into a reissue patent, the

reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. *See*: MPEP 2285.

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

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

CONCLUSION

1. Reissue application No. 12/020,987 and reexamination control No. 90/008,471 are merged into a single proceeding.

2. Periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination. In addition, **if a final rejection Office action should be issued in this merged proceeding**, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.

3. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed.** Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination under 37 CFR 1.114 (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution as per 37 CFR 1.550(d).

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

5. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 2442, 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 '985 reissue patent or '690 patent (e.g., by preparing/signing an action). *See*: MPEP 2236. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases, or (b) the expiration of the ONE MONTH period (from the mailing of this decision) set in part 4 of this "Conclusion."

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

7. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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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 05/30/2008

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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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Matthew A. Smith
FOLEY & LARDNER LLP
3000 K Street NW, Suite 500
Washington, DC 20007

Date:

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)).

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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BAKER BOTTS L.L.P.
910 LOUISANA
HOUSTON, TX 77002

Date:

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)).

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DANIEL B. RAVICHER
PUBLIC PATENT FOUNDATION, INC.
1375 BROADWAY, SUITE 600
NEW YORK, NY 10018

Date:

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)).

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Daniel B. Ravicher
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

(For Third Party Requester)

In re Moore *et alia*
Reexamination Proceeding
Control No. 90/008,237
Corrected Request Deposited: November 17, 2006
For: U.S. Patent No. 5,809,336

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: 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 05/30/2008

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.

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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:

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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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,477	05/10/2007	6,208,271	6620-76454-05	2625

50086 7590 03/03/2010

LAW OFFICE OF DAVID H. JUDSON
15950 DALLAS PARKWAY
SUITE 225
DALLAS, TX 75248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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PORTLAND, OR 97204

MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,477*.

PATENT NO. *6,208,271*.

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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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Brad A. Armstrong
P.O. Box 2048
Carson City, NV 89702

(For Patent Owner)

Richard D. McLeod
Klarquist Sparkman LLP
121 S.W. Salmon Street
Suite 1600
Portland, OR 97204

(For Third Party Requester)

MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

Law Office of David H. Judson
15950 Dallas Parkway
Suite 225
Dallas, TX 75248

(Courtesy Copy)

In re Brad A. Armstrong
Ex Parte Reexamination Proceeding
Control No. 90/008,477
Filed: May 10, 2007
For: U.S. Patent No. 6,208,271

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **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 to final Office action and revive the present terminated reexamination ("the December 14, 2009 patent owner petition to revive").

The December 14, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The December 14, 2009 patent owner petition to revive is **granted**.

The December 11, 2009 Notice of Intent to Issue a Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 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.

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 June 30, 2009 final Office action. As stated in the September 25, 2009 Advisory Action, patent owner's August 28, 2009 Response After Final was not such a response. However, patent owner's December 14, 2009 paper titled Amendment After Final Canceling Non-Allowed Claims cancels rejected claims 1-18 and 22-31. Therefore, item (1) is deemed to have been satisfied.[1]

A petition fee of $1,620.00 was submitted as part of the December 14, 2009 patent owner petition to revive, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted on December 14, 2009. 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 December 14, 2009 patent owner petition to revive is **granted**.

The December 11, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

---

[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 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 6,208,271 patent file is that of Brad A. Armstrong, P.O. Box 2048, Carson City, NV 89702.

As a courtesy, this decision is being mailed to the address Law Office of David H. Judson, 15950 Dallas Parkway, Suite 225, Dallas, TX 75248, in view of the March 11, 2008 Power of Attorney in the file of the '8477 reexamination proceeding.

The address of Brad A. Armstrong, P.O. Box 2048, Carson City, NV 89702, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '271 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The December 14, 2009 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

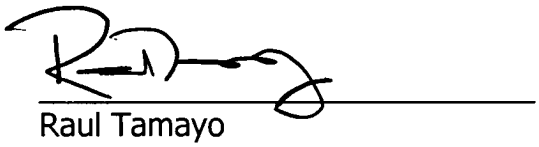
2. The December 11, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992 for treatment in due course of the December 14, 2009 Amendment After Final Canceling Non-Allowed Claims.

4. The address of Brad A. Armstrong, P.O. Box 2048, Carson City, NV 89702, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '271 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, Scott Weaver, of CRU Art Unit 3992, at (571) 272-7548.

6. 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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MAR 17 2008

CENTRAL REEXAMINATION UNIT

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP (For Patent Owner)
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

KIRK M. YOUNG (For Third Party Requester)
MCKEE VORHEES & SEASE P.L.C.
801 GRAND AVENUE, SUITE 3200
DES MOINES, IA 50309-2721

In re Reexamination Proceeding	:	
Jones et al.	:	
Control No. 90/008,482	:	DECISION GRANTING PETITION
Filed: February 8, 2007	:	
U.S. Patent No. 5,236,503	:	
Attorney Docket No. GLATT3.5-001	:	

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on February 25, 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 (Applicant summary of interview with examiner filed February 19, 2008 supplemented by a certificate of service filed February 25, 2008 - item 1), an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester.

The petition for entry of the late papers is granted.

$1,540.00 has been charged to counsel's deposit account no. 12-1095 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 Applicant summary of interview with examiner filed February 19, 2008 supplemented by the certificate of service filed February 25, 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
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.
90/008,483	02/09/2007	5852326	8189.002.RXUS00	6311

7590 07/10/2009

EXAMINER	
ART UNIT	PAPER NUMBER

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVE. WEST
WESTFIELD, NJ 07090

DATE MAILED: 07/10/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TRACY DRUCE
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date: MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008483
PATENT NO. : 5852326
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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Marcus J. Millet.
LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVE. WEST
WESTFIELD NJ 07090

(For Patent Owner)

MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

DECISION
DISMISSING
PETITION
PURSUANT TO
37 CFR §§ 1.181; 1.182; 1.183

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,483
Deposited: 09 February 2007
For: US Patent No. 5,852,326

This is a decision on the 01 July 2009, "Petition to Withdraw Finality of Official Action" requesting that the Final Office action dated 06 March 2009 be made non-Final.

The patent owner has petitioned under 37 CFR §§ 1.181, 1.182, 1.183.

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

The petition is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 22 December 1998 US Patent No. 5,852,326 was granted to Khandros *et alia*.

2. On 09 February 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,483.

3. On 19 April 2007 the Order was granted for *ex parte* reexamination in control number 90/008,483.

4. On 22 February 2008 a non-final Office action was mailed.

5. On 23 April 2008 a response from the patent owner was received.

6. On 01 August 2008 a non-final Office action was mailed.

7. On 06 October 2008 a response from the patent owner was received.

8. On 06 March 2009 a Final Office action was mailed.

9. On 09 April 2009 an after final response from the patent owner was received.

10. On 22 June 2009 an Advisory action was mailed responding to the patent owners remarks from the after final dated 09 April 2009.

11. On 01 July 2009 the instant petition submitted under 37 CFR §§ 1.181, 1.182, & 1.183 to withdraw finality was received.

DISCUSSION

The Patent Owner requests that the finality of the Office action dated 06 March 2009 be withdrawn. The patent owner has provided the petition fee and certificate of service..

The request for express consideration is dismissed.

STATEMENT OF RELEVANT AUTHORITY

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. If any required fee does not accompany the petition, the petition will be dismissed.

37 CFR § 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 CFR § 1.183 Suspension of rules.
In an extraordinary situation, when justice re-quires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 1.4(c) Nature of correspondence
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.

MPEP § 2271 Final Action (in-part)
Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR § 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims.

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.

In the event that the patent owner is of the opinion that (A) a final rejection is improper or premature, or (B) that an amendment submitted after final rejection complies with 37 CFR § 1.116 but the examiner improperly refused entry of such an amendment, the patent owner may file a petition under 37 CFR § 1.181 requesting that the final rejection be withdrawn and that prosecution be reopened, or file a petition under 37 CFR § 1.181 requesting entry of the amendment, where appropriate. The petition under 37 CFR § 1.181 must be filed within the time period for filing a notice of appeal. Note that the filing of a petition under 37 CFR § 1.181 does not toll the time period for filing a notice of appeal.

MPEP § 1207.03 New Ground of Rejection in Examiner's Answer (in-part)
III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION
There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re* Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. § 103 does not constitute a new ground of rejection).
In addition, former 37 CFR § 1.193(a)(2) also provided that if:
(A) an amendment under 37 CFR § 1.116 [or 41.33] proposes to add or amend one or more claims;
(B) appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal; and
(C) the advisory action indicates which individual rejection(s) set forth in the action from which appeal has been taken would be used to reject the added or amended claims, then
(1) the appeal brief must address the rejection(s) of the added or amended claim(s) and
(2) the examiner's answer may include the rejection(s) of the added or amended claims. Such rejection(s) made in the examiner's answer would not be considered as a new ground of rejection.
...
A new prior art reference applied or cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re* Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). Where a newly cited reference is added

merely as evidence of the prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not ordinarily constitute a new ground of rejection within the meaning of 37 CFR § 41.39(a)(2). See also MPEP § 2144.03.

...

ANALYSIS AND FINDINGS

The petition before the Office is considered pursuant to 37 CFR § 1.181 which is the proper section for which the petitioner may seek withdrawal pursuant to MPEP § 2272. The petitions under 37 CFR §§ 1.182 and 1.183 are hereby dismissed pursuant to 37 CFR §1.4(c) which states that different matters may be considered by different branches or sections of the Office, each distinct subject or inquiry must be contained in separate papers. The instant petition is considered pursuant to 37 CFR § 1.181.

Considering the instant petition under 37 CFR § 1.181 the relevant authority is found in MPEP §§ 2271 & 2272 which articulates the after final practice. "the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final." The finality of the action dated 06 March 2009 appears fully to meet the requirements of MPEP § 2271.

The petitioner's statement that the advisory action dated 22 June 2009 "relies upon Otsuka and Stout as "evidence contradicting the Patentee's allegation that al least glass epoxy will not bend"" is factually correct. The references were cited in response to newly presented samples and patent owner's remarks. Since the references are not a part of the rejection and merely cited to support evidence in contradiction to that provided by the patent owner in the after final remarks, the finality of the rejection is proper and will be maintained. Further, pursuant to MPEP 1207.03 it is clear that evidentiary support is provided for at this late stage of prosecution. On balance, the references cited by the examiner are considered appropriate in the context in which they were cited. The references cited do not impact the rejection of the claims as the references are applied. As such, the finality will be maintained.

The petition to withdraw finality of official action filed on 01 July 2009 under 37 CFR §§ 1.181, 1.182, 1.183 is hereby dismissed.

CONCLUSION

1. The patent owner's petition for withdrawal of finality of official action under 37 CFR §§ 1.181, 1.182, 1.183 proceeding is hereby **dismissed.**

2. The proceeding is hereby forwarded to the examiner in charge of the proceeding for further handling.

3. Response should be addressed as follows:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

Deborah Jones SPE3991

for Gregory Morse
Director,
Central Reexamination Unit 3999

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P.O. Box 1450
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Marcus J. Millet.
LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVE. WEST
WESTFIELD NJ 07090

(For Patent Owner)

MAILED

SEP 3 02009

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

DECISION
GRANTING
ENTRY OF MODEL
PETITION
37 CFR § 1.91(A)(3)

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,483
Deposited: 09 February 2007
For: US Patent No. 5,852,326

This is a decision on the 09 April 2009, "Petition Under 37 CFR § 1.91(a)(3)" requesting entry of models into the official record of the instant proceeding. The petition includes the required certificate of service. The petition included the required petition fee pursuant to 37 CFR § 1.17(h).

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

The petition is granted for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 22 December 1998 US Patent No. 5,852,326 was granted to Khandros *et alia*.

2. On 09 February 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,483.

3. On 19 April 2007 the Order was granted for *ex parte* reexamination in control number 90/008,483.

4. On 22 February 2008 a non-final Office action was mailed.

5. On 23 April 2008 a response from the patent owner was received.

6. On 01 August 2008 a non-final Office action was mailed.

7. On 06 October 2008 a response from the patent owner was received.

8. On 06 March 2009 a Final Office action was mailed.

9. On 09 April 2009 an after final response from the patent owner was received.

10. On 09 April 2009 the instant petition and models were received.

DISCUSSION

The Patent Owner requests entry of models into the *ex parte* reexamination proceeding by filing a petition pursuant to 37 CFR 1.91(a)(3). The petitioner seeks entry to rebut statements made by the examiner. The petitioner has submitted a certificate of service and appropriate fees under 37 CFR § 1.17(h).

The entry of the models is granted.

STATEMENT OF RELEVANT AUTHORITY

MPEP § 1002.02(c) Petitions and Requests Decided by the Technology Center Directors (in-part)

> 20. Petitions under 37 CFR § 1.91 to admit a model or exhibit as part of the record of an application.

37 CFR § 1.91 Models or exhibits not generally admitted as part of application or patent.

(a) A model or exhibit will not be admitted as part of the record of an application unless it:
(1) Substantially conforms to the requirements of § 1.52 or § 1.84;
(2) Is specifically required by the Office; or
(3) Is filed with a petition under this section including:
(i) The fee set forth in § 1.17(h); and
(ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.
(b) Notwithstanding the provisions of paragraph (a) of this section, a model,

working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.
(c) Unless the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84 under paragraph (a)(1) of this section, it must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84.

ANALYSIS AND FINDINGS

The petitioner has submitted four (4) models for the purpose of rebutting statements made by the examiner, in the Final Office action mailed on 06 March 2009. The explanation by the petitioner meets the requirements of 37 CFR 1.91(a)(3)(ii) as to why the models are necessary to demonstrate the patent owner's position and rebut statements made by the examiner. In addition the petitioner has provided the required fee pursuant to 37 CFR 1.17(h). Further pursuant to 37 CFR 1.91(c), photographs of the four (4) models are provided with the petition.

The petitioner has met the requirements for submission of models into the *ex parte* reexamination proceeding 90/008,483 and thus the petition is hereby granted.

CONCLUSION

1. The patent owner's petition for entry of models into the ex parte reexamination proceeding is hereby **granted.**

2. The proceeding is hereby forwarded to the examiner in charge of the proceeding for further handling.

3. Response should be addressed as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
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Alexandria, VA 22313-1450

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Central Reexamination Unit

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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 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992, may also be contacted..

Gregory Morse
Director,
Central Reexamination Unit 3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,484	02/09/2007	5679977	8188.002.RXUS00	6502

7590 02/12/2008

EXAMINER	
ART UNIT	PAPER NUMBER

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

DATE MAILED: 02/12/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,528	03/14/2007	5679977		7588

7590 02/12/2008

EXAMINER	
ART UNIT	PAPER NUMBER

LERNER, DAVID, LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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

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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.
90/008,695	06/11/2007	5679977		5843

7590 02/12/2008

EXAMINER	

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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
TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date: MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008484
PATENT NO. : 5679977
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
NOVAK DRUCE & QUIGG LLP
NDQ REEXAMINATION GROUP
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX

Date:

MAILED
FEB 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008528
PATENT NO. : 5679977
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008695
PATENT NO. : 5679977
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

Lerner David Littenberg Krumholz & Mentlik (For Patent Owner)
600 South Avenue West
Westfield, NJ 07090-1497

Tracy Druce (For Third Party Requester)
Novak Druce & Quigg LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

In re Khandros *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/008,484	: MERGING
Request Deposited: February 9, 2007	: REEXAMINATION
For: U.S. Patent No. 5,679,977	: PROCEEDINGS
In re Khandros *et alia*	:
Reexamination Proceeding	:
Control No. 90/008,528	:
Request Deposited: March 15, 2007	:
For: U.S. Patent No. 5,679,977	
In re Khandros *et alia*	:
Reexamination Proceeding	:
Control No. 90/008,695	:
Corrected Request Deposited: June 11, 2007	:
For: U.S. Patent No. 5,679,977	:

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. 5,679,977 (hereinafter, the '977 patent), issued to Khandros *et alia*, on October 21, 1997.

2. On February 9, 2007, a third party requester deposited a Request for *Ex Parte* Reexamination of the '977 patent. The reexamination proceeding was assigned Control No. 90/008,484 (hereinafter, the '8484 proceeding).

3. The Reexamination Order was granted in the '8484 proceeding on April 19, 2007.

4. There are currently no amendments in the '8484 proceeding.

5. On March 15, 2007, a third party requester deposited a Request for *Ex Parte* Reexamination of the '977 patent. The reexamination proceeding was assigned Control No. 90/008,528 (hereinafter, the '8528 proceeding).

6. The Reexamination Order was granted in the '8528 proceeding on June 12, 2007.

7. There are currently no amendments in the '8528 proceeding.

8. On June 11, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '977 patent. The reexamination proceeding was assigned Control No. 90/008,695 (hereinafter, the '8695 proceeding).

9. The Reexamination Order was granted in the '8695 proceeding on August 15, 2007.

10. There are currently no amendments in the '8695 proceeding.

11. The '8484, 8528, and '8695 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 '8484, '8528, and the '8695 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;484, 90/008,528, and 90/008,695 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
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,484	02/09/2007	5679977	8188.002.RXUS00	6502

7590 03/03/2010

EXAMINER	

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date:

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MAR 03 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008484
PATENT NO. : 5679977
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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,528	03/14/2007	5679977		7588

7590 03/03/2010

EXAMINER	

LERNER, DAVID, LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
NDQ REEXAMINATION GROUP
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX

Date:
MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008528
PATENT NO. : 5679977
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.
90/008,695	06/11/2007	5679977		5843

7590 03/03/2010

EXAMINER	

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
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ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1000 LOUISANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
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MAR 03 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008695
PATENT NO. : 5679977
ART UNIT : 3900

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

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MAR 03 2010

CENTRAL REEXAMINATION UNIT

Marcus J. Millet.
LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVE. WEST
WESTFIELD NJ 07090

(For Patent Owner)

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

(For Third Party Requester)

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,484
Deposited: 09 February 2007
For: US Patent No. 5,679,977

DECISION
GRANTING
ENTRY OF MODEL
PETITION
37 CFR § 1.91(A)(3)

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,528
Deposited: 14 March 2007
For: US Patent No. 5,679,977

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,695
Deposited: 11 June 2007
For: US Patent No. 5,679,977

This is a decision on the 01 December 2009, "Petition Under 37 CFR § 1.91(a)(3)" requesting entry of models into the official record of the instant proceeding. The petition includes the required certificate of service. The petition included the required petition fee pursuant to 37 CFR § 1.17(h).

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

The petition is granted for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 21 October 1997 US Patent No. 5,679,977 was granted to Khandros *et alia.*

2. On 09 February 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,484.

3. On 19 April 2007 the Order was granted for *ex parte* reexamination in control number 90/008,483.

4. On 14 March 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,528.

5. On 12 June 2007 the Order was granted for *ex parte* reexamination in control number 90/008,528.

6. On 11 June 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008, 695.

7. On 15 August 2007 the Order was granted for *ex parte* reexamination in control number 90/008,695.

8. On 01 October 2009 the Final Office action was mailed.

9. On 01 December 2009 the instant petition and models were received.

DISCUSSION

The Patent Owner requests entry of models into the *ex parte* reexamination proceeding by filing a petition pursuant to 37 CFR 1.91(a)(3). The petitioner seeks entry to rebut statements made by the examiner. The petitioner has submitted a certificate of service and appropriate fees under 37 CFR § 1.17(h).

The extension of the model is granted.

STATEMENT OF RELEVANT AUTHORITY

MPEP § 1002.02(c) Petitions and Requests Decided by the Technology Center Directors (in-part)

> 20. Petitions under 37 CFR § 1.91 to admit a model or exhibit as part of the record of an application.

37 CFR § 1.91 Models or exhibits not generally admitted as part of application or patent.

> (a) A model or exhibit will not be admitted as part of the record of an application unless it:
> (1) Substantially conforms to the requirements of § 1.52 or § 1.84;
> (2) Is specifically required by the Office; or
> (3) Is filed with a petition under this section including:
> (i) The fee set forth in § 1.17(h); and
> (ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.
> (b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.
> (c) Unless the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84 under paragraph (a)(1) of this section, it must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84.

ANALYSIS AND FINDINGS

The petitioner has submitted four (4) models for the purpose of rebutting statements made by the examiner. The explanation by the petitioner meets the requirement of 37 CFR 1.91(a)(3)(ii) as to why the models are necessary to demonstrate the patent owner's position and rebut statement made by the examiner. In addition the petitioner has provided the requires fee pursuant to 37 CFR 1.17(h).

Further pursuant to 37 CFR 1.91(c), photographs of the four (4) models are provided with the petition.

It is noted that the fourth model is physically located in the artifact folder associated with proceeding control number 90/008,483 since a second model of this type was unavailable to the petitioner for submission in the above identified merged proceedings.

The petitioner has met the requirements for submission of models into the *ex parte* reexamination proceedings and thus the petition is hereby granted.

CONCLUSION

1. The patent owner's petition for entry of models into the *ex parte* reexamination proceedings is hereby **granted.**

2. The proceedings are hereby forwarded to the examiner in charge of the proceeding for further handling.

3. Response 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..

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,484	02/09/2007	5679977	8188.002.RXUS00	6502

7590 03/11/2010

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/11/2010

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MAR 11 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008484
PATENT NO. 5,679,977
ART UNI 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Marcus J. Millet.
LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVE. WEST
WESTFIELD NJ 07090

(For Patent Owner)

MAILED

MAR 11 2010

CENTRAL REEXAMINATION UNIT

Tracy W Druce
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(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,484
Deposited: 09 February 2007
For: US Patent No. 5,679,977

DECISION
DISMISSING
PETITION

37 CFR §§ 1.550(c) & 1.181

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,528
Deposited: 14 March 2007
For: US Patent No. 5,679,977

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,695
Deposited: 11 June 2007
For: US Patent No. 5,679,977

This is a decision on the 04 March 2010, "Petition for Extension of Time" requesting one (1) month extension of time. The petition includes the required certificate of service. The petition included the required petition fee pursuant to 37 CFR § 1.17(h).

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

The petition is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 21 October 1997 US Patent No. 5,679,977 was granted to Khandros *et alia*.

2. On 09 February 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,484.

3. On 19 April 2007 the Order was granted for *ex parte* reexamination in control number 90/008,483.

4. On 14 March 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,528.

5. On 12 June 2007 the Order was granted for *ex parte* reexamination in control number 90/008,528.

6. On 11 June 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008, 695.

7. On 15 August 2007 the Order was granted for *ex parte* reexamination in control number 90/008,695.

8. On 01 October 2009 the Final Office action was mailed.

9. On 01 December 2009 a petition for entry of models were received.

10. On 03 March 2010 the petition for entry of models was granted.

11. On 04 March 2010 a petition was submitted under 37 CFR § 1.181.

11. On 04 March the instant petition for extension of time was received.

DISCUSSION

The Patent Owner requests an extension of time while awaiting a decision of a petition filed pursuant to 37 CFR § 1.181. Since MPEP § 2272 is explicit about extensions of time filed for the purpose of

awaiting a decision on a petition filed after notice of appeal noting that the filing of a petition under 37 CFR § 1.181 does not toll the time period for filing a notice of appeal.

The petition for extension of time is dismissed.

STATEMENT OF RELEVANT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

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

MPEP 2265 (in-part)

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

ANALYSIS AND FINDINGS

The petitioner seeks extension of time awaiting a decision on co-filed petition under 37 CFR § 1.181. Pursuant to MPEP § 2272 the filing of a petition under 37 CFR § 1.181 does not toll the time period for filing a notice of appeal. Absent a showing of sufficient cause the petition for extension of time is dismissed.

The petition for extension of time is hereby dismissed.

CONCLUSION

1. The patent owner's petition for one (1) month extension of time is hereby dismissed.

2. The proceedings are hereby forwarded to the examiner in charge of the proceeding for further handling.

3. Response should be addressed as follows:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft

scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

_____

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,484	02/09/2007	5679977	8188.002.RXUS00	6502

7590 04/13/2010

LERNER DAVID LITTENBERG
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600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TRACY DRUCE
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1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date:
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APR 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008484
PATENT NO. : 5679977
ART UNIT : 3900

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,528	03/14/2007	5679977		7588

7590 04/13/2010

EXAMINER	

LERNER, DAVID, LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

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APR 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008528
PATENT NO. : 5679977
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.
90/008,695	06/11/2007	5679977		5843

7590 04/13/2010

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

APR 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008695
PATENT NO. : 5679977
ART UNIT : 3900

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

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APR 13 2010

CENTRAL REEXAMINATION UNIT

Marcus J. Millet : (For Patent Owner)
LERNER DAVID LITTENBERG :
KRUMHOLZ & MENTLIK :
600 SOUTH AVE. WEST :
WESTFIELD, NJ 07090 :

Tracy W. Druce : (For Third Party Requester)
NOVAK DRUCE & QUIGG, LLP :
(NDQ REEXAMINATION GROUP) :
1000 LOUSIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

In re: Khandros *et al.* :
Ex Parte Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/008,484 : UNDER 37 CFR § 1.181
Deposited: 09 February 2007 :
For: U.S. Patent No.: 5,679,977 :

In re: Khandros *et al.* :
Ex Parte Reexamination Proceeding :
Control No.: 90/008,528 :
Deposited: 14 March 2007 :
For: U.S. Patent No.: 5,679,977 :

In re: Khandros *et al.* :
Ex Parte Reexamination Proceeding :
Control No.: 90/008,695 :
Deposited: 11 June 2007 :
For: U.S. Patent No.: 5,679,977 :

This is a decision on a petition filed by the patent owner on 04 March 2010. The petition is entitled "PETITION UNDER 37 CFR §§ [sic] 1.181 FOR ENTRY OF EXHIBITS AND PHYSICAL SAMPLES ACCOMPANYING PATENT OWNER'S RESPONSE TO FINAL

OFFICE ACTION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to enter the evidence submitted 01 December 2009 in response to the final rejection.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated 04 March 2010 is granted with respect to entry of the evidence submitted on 01 December 2009.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 5,679,977 issued on 21 October 1997.
- Three requests for *ex parte* reexamination were filed and assigned control nos. 90/008,484, 90/008,528, and 90/008,695.
- *Ex parte* reexamination was ordered in each proceeding and they were merged in a decision mailed 12 February 2008.
- Prosecution progressed in the merged proceeding until a Final Rejection was mailed on 01 October 2009.
- On 01 December 2009, the Patent owner filed an after-final amendment. The submission included various evidence, including exhibits 1-4, 7-9, and 11 and Samples A-D [collectively, "Rebuttal Evidence"] that are the subject of the instant petition.
- On 14 January 2010, an Advisory Action was mailed, entering the after-final amendment but refusing entry of the Rebuttal Evidence, stating that Patent owner failed to provide a showing of good and sufficient reasons why the evidence was necessary and not earlier presented as required by 37 CFR § 1.116(e).
- On 20 January 2010, another Advisory Action was mailed because the previous action did not set a time period for response. The time was set at 4 months from the date of the Final Rejection. The reasoning for not entering the Rebuttal Evidence was repeated from the prior Advisory Action.

- On 04 February 2010, the Patent owner filed a Notice of Appeal to the Board of Patent Appeals and Interferences.

- On 04 March 2010 the instant petition was received.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal (in part):

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

37 CFR § 1.181 Petition to the Director (in part):

> (a) Petition may be taken to the Director:
>
> > (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court . . . .

DECISION

The Patent owner [hereinafter "petitioner"] states that the examiner erred in deciding not to enter the Rebuttal Evidence filed on 01 December 2009 after the Final Rejection. Petitioner explains that the examiner provided new arguments and evidence for the first time in the Final Rejection, and the Rebuttal Evidence is necessary to rebut the examiner's position. It is noted that petitioner does not seek withdrawal of the finality of the action or continued prosecution, but simply seeks that the evidence be entered for the purpose of appeal.

Rule 1.116(e) requires that there be "a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." The Director agrees with the petitioner that the required showing has been made here. The Rebuttal Evidence is necessary in that it directly rebuts the positions set forth by the examiner. For example, dictionary definitions

are provided to rebut the examiner's definition of a word, web pages citing the Young's modulus of various materials are provided to rebut the examiner's assertion that such materials are inherently flexible, and declarations are provided asserting the examiner's statements as to some references are incorrect. The Rebuttal Evidence will provide a more complete record on which the Board can base its decision.

Additionally, the Rebuttal Evidence could not have been earlier presented because the rebuttal is of points first made by the examiner in the Final Rejection. For example, the examiner argued for the first time in the Final Rejection that the dimensions of certain substrates render them inherently flexible. Further, the examiner first relied on the Stout and Otsuka references in the Final Rejection to support her arguments. Without knowing that the examiner would take such positions, there was no reason for petitioner to provide at an earlier time evidence of, for example, the flexibility of certain materials or evidence rebutting the Stout and Otsuka references.

This is not a case where the petitioner withheld useful evidence hoping it would not be needed, and provided it only when other avenues were unsuccessful. This is a situation where the petitioner provided the evidence in the next submission after the examiner first made these particular statements. The Director finds that there is a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented. Rule 1.116(e) is therefore satisfied.

Accordingly, the Rebuttal Evidence is entered into the record and patent owner's petition is granted.

CONCLUSION

1. The petition under 37 CFR § 1.181 for reconsideration of the entry of the Rebuttal Evidence filed 01 December is granted. Exhibits 1-4, 7-9, and 11 and Samples A-D of that submission are entered into the record.

2. The time period for response is not changed by this decision. See the Decision mailed 11 March 2010.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his 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.
90/008,485	02/09/2007	6133627	8189.003.RXUS00	6503

7590 02/12/2008

EXAMINER	

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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.
90/008,696	06/11/2007	6133627		5844

7590 02/12/2008

EXAMINER	

LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090-1497

ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

TRACY DRUCE
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date:

MAILED
FEB 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008485
PATENT NO. : 6133627
ART UNIT : 3900

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

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

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United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1000 LOUISANA STREET, FIFTY-THIRD FLOOR
HOUSTON,TX 77002

Date: MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008696
PATENT NO. : 6133627
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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FEB 12 2008

CENTRAL REEXAMINATION UNIT

Lerner David Littenberg Krumholz & Mentlik (For Patent Owner)
600 South Avenue West
Westfield, NJ 07090-1497

Tracy Druce (For Third Party Requester)
Novak Druce & Quigg LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

In re Khandros *et alia* :
Reexamination Proceeding : DECISION *SUA SPONTE*
Control No. 90/008,485 : MERGING
Request Deposited: February 9, 2007 : REEXAMINATION
For: U.S. Patent No. 6,133,627 : PROCEEDINGS

In re Khandros *et alia* :
Reexamination Proceeding :
Control No. 90/008,696 :
Corrected Request Deposited: June 11, 2007 :
For: U.S. Patent No. 6,133,627 :

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. 6,133,627 (hereinafter, the '627 patent), issued to Khandros *et alia*, on October 17, 2000.

2. On February 9, 2007, a third party requester deposited a Request for *Ex Parte* Reexamination of the '627 patent. The reexamination proceeding was assigned Control No. 90/008,485 (hereinafter, the '8485 proceeding).

3. The Reexamination Order was granted in the '8485 proceeding on April 19, 2007.

4. There are currently no amendments in the '8485 proceeding.

5. On June 11, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '627 patent. The reexamination proceeding was assigned Control No. 90/008,696 (hereinafter, the '8696 proceeding).

6. The Reexamination Order was granted in the '8696 proceeding on August 13, 2007.

7. There are currently no amendments in the '8696 proceeding.

8. The '8485 and '8696 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 '8485 and the '8696 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. 90/008,485 and 90/008,696 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

Commissioner for Patents
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CENTRAL REEXAMINATION UNIT

Marcus J. Millet
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WESTFIELD NJ 07090

(For Patent Owner)

Tracy Druce
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1000 LOUISIANA STREET
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(For Third Party Requester)

Sanjeet K. Dutta
ORRICK HERRINGTON &
SUTCLIFFE, LLP
1000 MARSH ROAD
MENLO PARK, CA 94025

(For Third Party Requester)

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS
[37 CFR § 1.565(c)]

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,485
Deposited: 9 February 2007
For: US Patent No. 6,133,627

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,696
Deposited: 11 June 2007
For: US Patent No. 6,133,627

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,096
Deposited: 7 April 2008
For: US Patent No. 6,133,627

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. 6,133,627 issued on 17 October 2000.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,485 was requested by a third party requester deposited on 9 February 2007.

3. The Reexamination Order was granted in proceeding, control no. 90/008,485 on 19 April 2007.

4. *Ex Parte* Reexamination Proceeding, control no. 90/008,696 was requested by a third party requester deposited on 11 June 2007.

5. The Reexamination Order was granted in proceeding, control no. 90/008696 on 13 August 2007.

6. *Ex Parte* Reexamination Proceeding, control no. 90/009,096 was requested by a third party requester deposited on 7 April 2008.

7. The Reexamination Order was granted in proceeding, control no. 90/008696 on 2 May 2008.

8. *Ex Parte* proceedings 90/008,485 and 90/008,696 contain amendments.

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 control nos. 90/008,485; 90/008,696 and 90/009,096 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/008,485; 90008,696 and 90/009,096 are hereby merged.

2. The patent owner's representative is required to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable, Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted.

/Mark Reinhart/
for

Gregory A. Morse,
Director,
Central Reexamination Unit

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.
90/008,486	02/09/2007	4,852,362	105986-54202	6087

7590 08/27/2008

EXAMINER	
ART UNIT	PAPER NUMBER

BALOGH,OSANN,KRAMER,DVORAK, GENOVA & TRAUB
53 WEST JACKSON BLVD.
CHICAGO, IL 60604

DATE MAILED: 08/27/2008

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

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CENTRAL REEXAMINATION UNIT

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53 West Jackson Boulevard
Chicago, IL 60604

(For Patent Owner)

David R. Padnes
Gibbons, PC
One Gateway Center
Neward, NJ 07102-5310

(For Third Party Requester)

In re Conry
Ex Parte Reexamination Proceeding
Control No. 90/008,486
Filed: February 12, 2007
For: U.S. Patent No. 4,852,362

DECISION ON
PETITION UNDER
37 CFR 1.181

The paper filed by requester on April 13, 2007, entitled "Petition To The Director Under Rule 1.181," is being treated as a petition Under 37 CFR 1.181 and 1.515(c) (hereinafter the Petition). The Petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination mailed March 16, 2007.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 4,852,362 (hereinafter, the '362 patent) issued on August 1, 1989.

2. A request for *ex parte* reexamination was filed by Andrew M. Grodin of Newark, NJ on behalf of Freeze Company Systems Limited of Ontario, Canada, a third party requestor, on February 12, 2007. The resulting reexamination proceeding was assigned Control No. 90/008,486 (hereinafter, the '8486 proceeding).

3. Reexamination was requested for claims 1-8 of the '362 patent.

4. A Notice of Reexamination Request Filing Date was issued on February 22, 2007.

5. An order denying the request for reexamination for claims 1-8 was mailed on March 16, 2007.

6. On April 13, 2007, the third party requester filed the present Petition under 37 CFR §§ 1.515(c) and 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges several grounds for which petitioner feels the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the following three main arguments:

1. The examiner overlooked aspects of Fordsmand that were not taught in Reid, Markwell or any of the other references that were considered during the prosecution of the application resulting in the '362 patent.

2. The examiner incorrectly concluded that the claims in the '362 patent were allowed because of the inclusion of the limitations "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of housing means" and "releasable connecting means interconnecting adjacent ends of said header pipes of adjacent modular units" in the independent claims.

DECISION

I. Standard of Review

37 CFR 1.515(c) provides for the filing of a petition under 37 CFR 1.181 to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-6 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-8 of the '362 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 303 reveals that, by statute, *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. 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. If a substantial new question of patentability is found to be raised, an order granting *ex parte* reexamination of the patent is issued.

III. Summary of the Prior Prosecution with Respect to the Patent

The '362 patent contains claims 1-8.

In the April 7, 1989 Notice of Allowability issued in the application resulting in the '362 patent, the examiner did not provide reasons for allowance.

In the Interview Summary Record of April 3, 1989, the examiner stated that independent claims 41 and 42 were allowed. He stated that applicant agreed to the cancellation of claims 38-40, 43 and 44. He further stated that applicant agreed to an examiner's amendment changing the dependency of claims 45, 46, 48, 49 and 50.

In the amendment filed March 21, 1989, claims 38 and 41 were very similar. The only difference between these claims is that claim 41 included the limitations:

> 1) "a first fluid return means in fluid communication with said first fluid flow passage means to remove said heat exchange fluid therefrom," and
> 2) "said first fluid supply means and said first fluid returns means comprising header pipes extending laterally of said housing means."

In the amendment filed March 21, 1989, claims 39 and 42 were very similar. The only difference between these claims is that claim 42 included the limitations:

> 1) "a first fluid return means in fluid communication with said first fluid flow passage means to remove said heat exchange fluid therefrom," and
> 2) "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of said housing means."

In the amendment filed March 21, 1989, claims 40 and 42 were nearly identical. The only difference between these claims was that claim 42 included the limitation:

> "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of said housing means."

Review of the differences between the allowed and non-allowed claims reveals that claims 41 and 42 were allowed because of their inclusion of the specific limitation "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of said housing means."

Claim 35 was canceled by the amendment filed March 21, 1989, and, thus cannot be employed in the determination as to why claims 41 and 42 were allowed.

IV. Analysis of the Request for Reexamination

The Request sets forth the following substantial new question (SNQ) of patentability:

(1) Claims 1-8 are unpatentable under 35 U.S.C. §103 over Fordsmand in view of Reid and Markwell.

The Request was denied in the March 16, 2007 Order Denying Request for *Ex Parte* Reexamination, wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. With regard to the French Application Publication No. 2,258,596 to Fordsmand, the examiner determined that this publication does not teach

anything that was not taught in the prior art of record. Thus, Fordsmand is stated, in the denial, to be cumulative and not to raise a substantial new question of patentability.

As pointed out above, 37 CFR 1.515(c) provides for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

Turning to the request, it states that Fordsmand teaches fluid supply means and fluid return means extending laterally of the housing means. The Director has reviewed the entire record, and has determined that there is at least one substantial new question of patentability presented by the teachings of Fordsmand for reasons set forth below. Accordingly, the petition is granted, and reexamination is hereby ordered.

The French Application Publication to Fordsmand: According to the request and the Petition, Fordsmand raises a substantial new question of patentability regarding claims 1-8 of the '362 patent (see pages 29-35 of the request and pages 1-6 of the Petition).

Fordsmand was not cited in the earlier examination of the patent. As explained on pages 29-35 of the request, and after a review of the record, Fordsmand teaches the feature of claims 1-8 of the '362 patent, based on which the patent claims were allowed.

Review of the specification and prosecution history of the '362 patent clearly indicates that the invention of the '362 patent is directed to an expandable refrigeration system having fluid supply means and fluid return means extending laterally from the housing. Although it appears that Reid (U.S. Patent No. 4,402,190) may also teach this claim limitation, the record does not show that the examiner in the previous examination fully appreciated this teaching of Reid. Reid was applied in a rejection against the claims in the previous examination, but there is no statement by the examiner that Reid teaches this feature in that record. It is also noted that Reid does not teach the releasable connecting means in claims 1 and 2 of the '362 patent. In the previous examination, a secondary reference Markwell was cited to for this teaching. Fordsmand appears to also have teachings pertaining this to claim limitation (see pages 4-6 of the Petition).

As pointed out above, the differences between the allowed and non-allowed application claims reveals that claims 41 and 42 were allowed because of their inclusion of the specific limitation "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of said housing means." The Fordsmand teaching of the fluid supply means and fluid return means extending laterally of the housing means is directly related to subject matter considered as the basis for allowability of the claims in the application that issued as the '362 patent, a reasonable examiner would consider evaluation of Fordsmand as important in determining the patentability of claims 1-8. As such, it is agreed with petitioner that Fordsmand raises a substantial new question of patentability with respect to claims 1-8 of the '362 patent.

Because it is agreed that Fordsmand raises a SNQ with respect to claims 1-8 of the '362 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claims 1-8 of the '362 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.

4. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

5. Telephone inquiries related to this decision should be directed to Andres Kashnikov Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-8383.

Andres Kashnikov

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
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.
90/008,486	02/09/2007	4,852,362	105986-54202	6087

7590 08/29/2008

EXAMINER	

BALOGH,OSANN,KRAMER,DVORAK, GENOVA & TRAUB
53 WEST JACKSON BLVD.
CHICAGO, IL 60604

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
Gibbons P.C.
One Gateway Center
Newark, NJ 07102

Date: MAILED

AUG 29 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008486
PATENT NO. : 4852362
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

AUG 29 2008

CENTRAL REEXAMINATION UNIT

Balogh, Osann, Kramer, Dvorak
Genova & Traub
53 West Jackson Boulevard
Chicago, IL 60604

(For Patent Owner)

David R. Padnes
Gibbons, PC
One Gateway Center
Neward, NJ 07102-5310

(For Third Party Requester)

In re Conry
Ex Parte Reexamination Proceeding
Control No. 90/008,486
Filed: February 12, 2007
For: U.S. Patent No. 4,852,362

DECISION ON
PETITION UNDER
37 CFR 1.181

The paper filed by requester on April 13, 2007, entitled "Petition To The Director Under Rule 1.181," is being treated as a petition Under 37 CFR 1.181 and 1.515(c) (hereinafter the Petition). The Petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination mailed March 16, 2007.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 4,852,362 (hereinafter, the '362 patent) issued on August 1, 1989.

2. A request for *ex parte* reexamination was filed by Andrew M. Grodin of Newark, NJ on behalf of Freeze Company Systems Limited of Ontario, Canada, a third party requestor, on February 12, 2007. The resulting reexamination proceeding was assigned Control No. 90/008,486 (hereinafter, the '8486 proceeding).

3. Reexamination was requested for claims 1-8 of the '362 patent.

4. A Notice of Reexamination Request Filing Date was issued on February 22, 2007.

5. An order denying the request for reexamination for claims 1-8 was mailed on March 16, 2007.

6. On April 13, 2007, the third party requester filed the present Petition under 37 CFR §§ 1.515(c) and 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges several grounds for which petitioner feels the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the following three main arguments:

1. The examiner overlooked aspects of Fordsmand that were not taught in Reid, Markwell or any of the other references that were considered during the prosecution of the application resulting in the '362 patent.

2. The examiner incorrectly concluded that the claims in the '362 patent were allowed because of the inclusion of the limitations "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of housing means" and "releasable connecting means interconnecting adjacent ends of said header pipes of adjacent modular units" in the independent claims.

DECISION

I. Standard of Review

37 CFR 1.515(c) provides for the filing of a petition under 37 CFR 1.181 to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-6 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-8 of the '362 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 303 reveals that, by statute, *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. 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. If a substantial new question of patentability is found to be raised, an order granting *ex parte* reexamination of the patent is issued.

III. Summary of the Prior Prosecution with Respect to the Patent

The '362 patent contains claims 1-8.

In the April 7, 1989 Notice of Allowability issued in the application resulting in the '362 patent, the examiner did not provide reasons for allowance.

In the Interview Summary Record of April 3, 1989, the examiner stated that independent claims 41 and 42 were allowed. He stated that applicant agreed to the cancellation of claims 38-20, 43 and 44. He further stated that applicant agreed to an examiner's amendment changing the dependency of claims 45, 46, 48, 49 and 50.

In the amendment filed March 21, 1989, claims 38 and 41 were very similar. The only difference between these claims is that claim 41 included the limitations:

> 1) "a first fluid return means in fluid communication with said first fluid flow passage means to remove said heat exchange fluid therefrom," and
> 2) "said first fluid supply means and said first fluid returns means comprising header pipes extending laterally of said housing means."

In the amendment filed March 21, 1989, claims 39 and 42 were very similar. The only difference between these claims is that claim 42 included the limitations:

> 1) "a first fluid return means in fluid communication with said first fluid flow passage means to remove said heat exchange fluid therefrom," and
> 2) "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of said housing means."

In the amendment filed March 21, 1989, claims 40 and 42 were nearly identical. The only difference between these claims was that claim 42 included the limitation:

> "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of said housing means."

Review of the differences between the allowed and non-allowed claims reveals that claims 41 and 42 were allowed because of their inclusion of the specific limitation "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of said housing means."

Claim 35 was canceled by the amendment filed March 21, 1989, and, thus cannot be employed in the determination as to why claims 41 and 42 were allowed.

IV. Analysis of the Request for Reexamination

The Request sets forth the following substantial new question (SNQ) of patentability:

(1) Claims 1-8 are unpatentable under 35 U.S.C. §103 over Fordsmand in view of Reid and Markwell.

The Request was denied in the March 16, 2007 Order Denying Request for *Ex Parte* Reexamination, wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. With regard to the French Application Publication No. 2,258,596 to Fordsmand, the examiner determined that this publication does not teach

anything that was not taught in the prior art of record. Thus, Fordsmand is stated, in the denial, to be cumulative and not to raise a substantial new question of patentability.

As pointed out above, 37 CFR 1.515(c) provides for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

Turning to the request, it states that Fordsmand teaches fluid supply means and fluid return means extending laterally of the housing means. The Director has reviewed the entire record, and has determined that there is at least one substantial new question of patentability presented by the teachings of Fordsmand for reasons set forth below. Accordingly, the petition is granted, and reexamination is hereby ordered.

The French Application Publication to Fordsmand: According to the request and the Petition, Fordsmand raises a substantial new question of patentability regarding claims 1-8 of the '362 patent (see pages 29-35 of the request and pages 1-6 of the Petition).

Fordsmand was not cited in the earlier examination of the patent. As explained on pages 29-35 of the request, and after a review of the record, Fordsmand teaches the feature of claims 1-8 of the '362 patent, based on which the patent claims were allowed.

Review of the specification and prosecution history of the '362 patent clearly indicates that the invention of the '362 patent is directed to an expandable refrigeration system having fluid supply means and fluid return means extending laterally from the housing. Although it appears that Reid (U.S. Patent No. 4,402,190) may also teach this claim limitation, the record does not show that the examiner in the previous examination fully appreciated this teaching of Reid. Reid was applied in a rejection against the claims in the previous examination, but there is no statement by the examiner that Reid teaches this feature in that record. It is also noted that Reid does not teach the releasable connecting means in claims 1 and 2 of the '362 patent. In the previous examination, a secondary reference Markwell was cited to for this teaching. Fordsmand appears to also have teachings pertaining this to claim limitation (see pages 4-6 of the Petition).

As pointed out above, the differences between the allowed and non-allowed application claims reveals that claims 41 and 42 were allowed because of their inclusion of the specific limitation "said first fluid supply means and said first fluid return means comprising header pipes extending laterally of said housing means." The Fordsmand teaching of the fluid supply means and fluid return means extending laterally of the housing means is directly related to subject matter considered as the basis for allowability of the claims in the application that issued as the '362 patent, a reasonable examiner would consider evaluation of Fordsmand as important in determining the patentability of claims 1-8. As such, it is agreed with petitioner that Fordsmand raises a substantial new question of patentability with respect to claims 1-8 of the '362 patent.

Because it is agreed that Fordsmand raises a SNQ with respect to claims 1-8 of the '362 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claims 1-8 of the '362 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.

4. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

5. Telephone inquiries related to this decision should be directed to Andres Kashnikov Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-8383.

Andres Kashnikov

/gr/ 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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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,491	03/22/2007	7034083	KUZ-0019	6986

26259 7590 05/28/2008

LICATA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/28/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Kathleen A. Tyrrell
LICATA & TYRELL P.C.
66 E. Main Street
Marlton, NJ 08053

For Patent Owner

MAILED

MAY 28 2008

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/008,491
Filed: March 22, 2007
For: US Patent No. 7,034,083

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

This is a decision on the petition filed May 14, 2008 to request a two-month extension of time pursuant to 37 CFR 1.550(c) to respond to the Final rejection mailed January 14, 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 Final rejection mailed January 14, 2008. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

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

The petition for extension of time states that the extension is necessary to provide adequate time for the USPTO to render a decision in the Petition filed May 14, 2008 to Merge Concurrent Proceedings to Allow Prosecution of Broadened Claims, or if Broadened Claims are not Possible in a Merged Proceeding, to Suspend Reexamination during the Reissue Proceeding under 37 CFR 1.182, said Petition filed in Reissue Application 12/108,934 filed April 24, 3008.

Analysis and Findings

On January 14, 2008, a Final rejection was sent to Patent Owner with a shortened statutory period for response set to expire two months therefrom.
On March 12, 2008, Patent Owner submitted a first response to the Final rejection.
On March 17, 2008, an Advisory Action was mailed to Patent Owner denying entry of the amendment which was seen to raise issues concerning broadening with regards to newly added claims 11-12. The rejection of claims 1 and 3-10 were maintained.
On April 24, 2008, Patent Owner filed a reissue application, Serial Number 12/108,934. This application has not been forwarded to the Technology Center or assigned to an examiner.

On May 14, 2008, Patent Owner filed the present petition for an extension of time.

On balance, it does not appear that the petition explains the "sufficient cause" for an extension of time. The issues regarding the claims in this proceeding have been fully developed. The petitions in the Reissue application are not before the examiner in this proceeding. In the view of the requirement of 35 USC 305 that these proceedings be conducted with special dispatch, an extension of time is deemed not to be appropriate in this instance. The Notice of Appeal is due on May 17, 2008 while the reissue application is still listed in the Office's records as "APPLICATION UNDERGOING PREEXAM PROCESSING." Even if a petition for merger is of record, the granting of this extension request would result in an unwarranted delay of the present proceeding, running contrary to the statutory mandate for special dispatch in reexamination.

Conclusion

1. The Patent Owner's petition for extension of time of one month in which to file a response to the Final office action of January 14, 20008 is **dismissed**.

2. The Patent Owner's Notice of Appeal is due May 14, 2008.

3. Response may be submitted as follows:

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

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

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

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

/Deborah Jones/

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,491	03/22/2007	7034083	KUZ-0019	6986

26259 7590 08/04/2008

LICATA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2008

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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AUG 04 2009

CENTRAL REEXAMINATION UNIT

LICATA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

(For Patent Owner)

In re Reexamination Proceeding :
T. Yasukochi et al. :
Control No. 90/008,491 : DECISION GRANTING PETITION
Filed: February 9, 2007 : UNDER 37 CFR 1.137(b)
U.S. Patent No. 7,034,083 :
Attorney Docket No. KUZ-0019 :

This is a decision on the PETITION TO WAIVE RULE 37 C.F.R. § 1.570(d) UNDER 37 C.F.R. § 1.183, OR ALTERNATIVELY, TO REVIVE UNINTENTIONALLY ABANDONED REEXAMINATION NO. 90/008,491 filed by the patent owner on June 10, 2008.

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

37 CFR 1.570(d) states

> If an ex parte reexamination certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

§ 1.183 Suspension of rules.

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

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."

On January, 14, 2008, in the above-identified reexamination proceeding, a final Office action (final rejection) was mailed. In response, on March 12, 2008, in the above-identified reexamination proceeding, a response by the patent owner was filed. On March 17, 2008, in the

above-identified reexamination proceeding, an Advisory action was mailed stating that the period for response was extended to run four (4) months from the mailing date of the final rejection. On May 14, 2008, in reissue application no. 12/108,934, a petition to merge the above-identified reexamination proceeding and reissue application no. 12/108,934 was filed. Also, on May 14, 2008, in the above-identified reexamination proceeding, a petition for extension of time was filed to accord the Office sufficient time to render a decision on the May 14, 2008 petition to merge filed in the reissue application. On May 28, 2008, in the above-identified reexamination proceeding, a decision was mailed dismissing the petition for extension of time, as it did not appear that the petition explained the "sufficient cause" for an extension of time. On June 7, 2008, in the above-identified reexamination proceeding, a Notice of Intent to Issue a Reexamination Certificate was mailed stating that claims 1 and 3-10 have been canceled as patent owner had failed to file a notice of appeal. Thereafter, on June, 10, 2008, in the above-identified reexamination proceeding, the present PETITION TO WAIVE RULE 37 C.F.R. § 1.570(d) UNDER 37 C.F.R. § 1.183, OR ALTERNATIVELY, TO REVIVE UNINTENTIONALLY ABANDONED REEXAMINATION NO. 90/008,491 was filed by the patent owner.

In the June, 10, 2008 petition, in the above-identified reexamination proceeding, petitioners request, in accordance with 37 CFR 1.183, a waiver of 37 CFR 1.570(d), *inter alia*, as applicants timely filed a broadening reissue and a petition in the reissue application to merge the reissue application with the above-identified reexamination proceeding or alternately suspend the above-identified reexamination proceeding prior to the termination of the above-identified reexamination proceeding.

There is no guarantee than any petition filed will necessarily be granted. Pursuant to 37 CFR 1.181(f), "t]he mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings." Thus, the mere filing of a petition to merge prior to the termination of a reexamination prosecution does not rise to the level of an extraordinary situation where justice requires waiver of a rule. Further, as other relief is available to assist the patent owner in this situation (e.g., a proper petition and fee under 37 CFR 1.137, as was filed in the above-identified reexamination proceeding) again justice does not require waiver of a rule. Accordingly, no rationale has been set forth in the petition which presents an extraordinary situation where justice would require waiver of a rule.

In view of the above, the petition under 37 CFR 1.183 to waive 37 CFR 1.570(d) is dismissed.

The petition fee for a petition under 37 CFR 1.183 is $400.00. See 37 CFR 1.17(f). A review of the finance records for the above-identified reexamination proceeding reveals that a petition fee of only a $130.00 was paid on June 10, 2008, for the present petition under 37 CFR 1.183. Accordingly, a balance of $270.00 is due for the petition fee.

In the alternative, petitioner requests entry of late papers (notice of appeal and fee) based upon unintentional delay. The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (notice of appeal and appeal fee (an authorization to charge counsel's deposit account for the appeal fee - item 1), an authorization to charge counsel's deposit account for the

$1,540.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition under 37 CFR 1.137(b) for entry of the late papers is granted.

No terminal disclaimer and disclaimer fee are required for a period of termination in a reexamination proceeding.

$2,320.00 ($270.00 for the balance of the petition fee under 37 CFR 1.183, $1,540.00 for the petition fee under 37 CFR 1.137(b) and $510.00 for the notice of appeal fee) has been charged to counsel's deposit account no. 50-1619.

The time period for filing an appeal brief and the appeal brief fee in response to the Notice of Appeal filed as a response to the outstanding Office action is two (2) months from the date of this decision, MPEP 711.03(c).

Jurisdiction over the above-identified reexamination proceeding is being retained by OPLA for consideration in due course of the petition to merge the above-identified reexamination proceeding and reissue application no. 12/108,934 filed May 14, 2008 in reissue application no. 12/108,934.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Alan Diamond, in CRU Art Unit 3991, who can be reached at 571-272-1338.

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

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

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.
90/008,491	03/22/2007	7034083	KUZ-0019	6986

26259 7590 10/01/2008

LICATA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/01/2008

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

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Licata & Tyrrell P.C.
66 E. Main Street
Marlton, NJ 08053

(For Patent Owner)

MAILED

OCT 01 2008

CENTRAL REEXAMINATION UNIT

In re Hisamitsu Pharmaceutical Co., Inc.
Reissue Application
Application No.: 12/108,934
Filed: April 24, 2008
For: U.S. Patent No. 7,034,083

In re Hisamitsu Pharmaceutical Co., Inc.
Ex Parte Reexamination Control No. 90/008,491
Filed: March 22, 2007
For: U.S. Patent No. 7,034,083

: DECISION DISMISSING
: PETITION FOR MERGER
: OF REISSUE AND
: REEXAMINATION PROCEEDINGS
: OR SUSPENSION
: OF REEXAMINATION
: PROCEEDINGS, AND
: *SUA SPONTE*,
: SUSPENDING REISSUE

This is a decision on patent owner's May 14, 2008 "Petition to Merge Concurrent Proceedings to Allow Prosecution of Broadened Claims, or If Broadened claims Are Not Possible in a Merged Proceeding, to Suspend Reexamination During the Reissue Proceeding Under 37 CFR § 1.182."

The petition, reissue application number 12/108,934 and reexamination control number 90/008,491 are before the Office of Patent Legal Administration for decision.

The petition is dismissed.

Action in the reissue proceeding (reissue application) is *sua sponte* suspended.

FEES

Petitioner patent owner has remitted $130.00 as a petition fee under 37 CFR 1.17(h). However, the fee for a petition filed under 37 CFR 1.182 is $400.00, as established by 37 CFR 1.17(f). As authorized in the "Reissue Application Fee Transmittal Form" filed concurrently with reissue application number 12/108,934, a charge will be made against Deposit Account No. 50-1619 for the balance due of $270.00 for the petition fee under 37 CFR 1.17(f) that is required for the present 37 CFR 1.182 petition.

BACKGROUND

1. U.S. Patent No. 7,034,083 (the '083 patent) issued on April 25, 2006.

2. A request for *ex parte* reexamination of the '083 patent was deposited by patent owner on February 9, 2007, and was assigned control No. 90/008,491 (hereinafter the '491 reexamination proceeding"). A filing date was not granted in view of certain filing defects.

3. On March 22, 2007, patent owner filed a corrected request for *ex parte* reexamination, and a filing date of March 22, 2007 was accorded to the '491 reexamination proceeding.

4. On April 11, 2006, reexamination was granted based on the examiner's finding that the reexamination request established a substantial new question of patentability (SNQ) for patent claims 1, 3 and 6. Reexamination was ordered for claims 1-6 (*i.e.*, all claims) of the '083 patent.

5. The proceeding advanced to the point where, on January 1, 2008, a final rejection of all claims pending in the '491 reexamination proceeding was mailed.

6. On March 12, 2008, patent owner filed an amendment after final rejection proposing certain claim amendments in the '491 reexamination proceeding.

7. On March 17, 2008, an advisory action was mailed in the '491 reexamination proceeding in which patent owner was advised that the March 12, 2008 amendment would not be entered, the period for filing a response to the final rejection was extended to run four (4) months from the mailing date of the final rejection, and that failure of patent owner to file a notice of appeal or take other appropriate action would result in termination of the '491 reexamination prosecution, mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC) and cancellation of all claims that stood finally rejected or that had been objected to in the final rejection.

8. On April 24, 2008, patent owner deposited an application to reissue the '083 patent, and the reissue application was assigned application number 12/108,934 (hereinafter "the '934 reissue application") and accorded a filing date of April 24, 2008.

9. On April 25, 2008, patent owner filed a Notice in the '491 reexamination proceeding advising the Office that the '934 reissue application had been filed.

10. On May 14, 2008, patent owner filed a petition for an extension of time in the '491 reexamination proceeding in order to provide time for the Office to render a decision on the present petition.

11. On May 14, 2008, the present petition to merge the '934 reissue application with the '491 reexamination proceeding, or in the alternative to suspend the '491 reexamination proceeding, was filed by the patent owner.

12. On May 28, 2008, the May 14, 2008 petition for extension of time was dismissed by the Director of the Central Reexamination Unit (CRU) on the grounds that the petition did not set forth sufficient cause. It was noted by the CRU Director that, whereas the issues in the '491 reexamination proceeding had been fully developed and a Notice of Appeal was due, the '934 reissue proceeding was still undergoing pre-examination processing.

13. On June 6, 2008, the Office mailed a "*Notice of Intent to Issue Ex Parte Reexamination Certificate*" for the '491 reexamination proceeding.

14. On June 10, 2008, patent owner filed a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d) which provide that when a reexamination certificate is issued that cancels all claims of a patent, no further Office proceedings will be conducted with that patent or any reissue applications relating to that patent.

15. Also on June 10, 2008, patent owner filed a separate petition under 37 CFR 1.137(b) to revive the terminated '491 reexamination proceeding on the grounds that the delay in filing a response to the final rejection was unintentional. The required response of a Notice of Appeal and the appeal fee accompanied the 37 CFR 1.137(b).

16. On June 30, 2008, the '934 reissue application was docketed to an examiner as being ready for examination.

17. On August 8, 2008, the Office issued a decision that granted the June 10, 2008 petition to revive the '491 reexamination proceeding and dismissed the June 10, 2008 petition to waive the provisions of 37 CFR 1.570(d). [1]

DECISION

I. Relevant Authority

35 U.S.C. § 305 provides, in part:

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

37 CFR 1.565(d) provides, in part:

> If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to both the reissue application and the ex parte reexamination proceeding and will be physically entered into both files. Any *ex parte* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent.

MPEP § 2285 provides, in part:

> The general policy of the Office is that a reissue application examination and an *ex parte* reexamination proceeding will not be conducted separately at the same time as to a particular patent. ... The decision as to whether the proceedings are to be merged, or which proceeding (if any) is to be stayed is made in the Office of Patent Legal Administration (OPLA). ...
>
> The decision on whether to merge the proceedings or stay a proceeding will be made on a case-by-case basis based upon the status of the various proceedings. Due consideration will be given to the finality of the reexamination requested. The decision to merge, or not to merge, is within the sole discretion of the Office to facilitate/carry out the orderly operation of the Office in addressing the

[1] The present petition was filed only in the '934 reissue application. A copy of the present petition is being entered into the record of the '491 reexamination proceeding.

proceedings. The status of the reissue application and the reexamination proceeding will be taken into account in the decision as to whether merger will be ordered, or one of the two proceedings stayed. ...

Where reexamination has already been ordered prior to the filing of a reissue application, the OPLA should be notified as promptly as possible after the reissue application reaches the TC, that the proceedings are ready for consideration of merger. ...

In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination. In addition, consideration will also be given to the status of the reexamination proceeding. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them. ... (Emphasis added.)

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

II. Requested Merger of Reissue and Reexamination Proceedings or Suspension of Reexamination Proceeding

A. Patent Owner's Position

Patent owner asserts that either merger of the '934 reissue application with the '941 reexamination proceeding, or suspension of the '941 reexamination proceeding, is necessary "save USPTO resources" and to allow patent owner "a fair opportunity to claim a full scope of patentable subject matter in the absence of another expedient alternative. [2] Patent owner also asserts that, in the reexamination proceeding, the examiner has improperly failed "to develop all issues prior to the final Office Action." [3] Patent owner also asserts that the final rejection was improper on the merits. [4] According to patent owner, these matters put patent owner in a position where patent owner could not request another reexamination proceeding by establishing an "additional" (*sic*, ("new") SNQ, and can exercise only the options of appealing in the reexamination proceeding and/or filing a broadening reissue application prior to the two year deadline [5] before April 25, 2008. [6]

B. Findings and Analysis

At the time that the present petition was filed, patent owner had elected to file the broadening reissue, resulting in only the following alternatives:

(1) "Abandonment" [7] of the '491 reexamination proceeding for failure to file a response by May 14, 2008, resulting in a possible inability to thereafter prosecute a reissue application;

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[2] "Petition to Merge ... ," May 14, 2008, paragraph bridging pages 1 and 2.
[3] Id., at page 2, first full paragraph.
[4] Id.
[5] See: 35 U.S.C. § 251, last paragraph.
[6] "Petition to Merge ... ," May 14, 2008, paragraph bridging pages 2 and 3.
[7] Reexamination proceedings do not become "abandoned," but may instead may become terminated for failure to file a timely response and then concluded by publication of a Reexamination Certificate. See: 35 U.S.C. § 307(a), 37 CFR 1.570 and MPEP § 2288.

(2) Merger; or

(3) Suspension of the '491 reexamination proceeding, although a response was due.

A review of the PALM/PAIR database shows that at the time of the filing of the present petition, the '934 reissue application was not ripe for examination, or consideration of the merger question, since the reissue application was not forwarded to the Technology Center and assigned to an examiner until June 30, 2008. Further, the prosecution of the '941 reexamination proceeding was on the brink of becoming terminated for failure to timely file a proper response to the January 14, 2008 final rejection. It should be noted that to the extent that petitioner patent owner now argues that the examiner's designation of the January 14, 2008 action as a final rejection was procedurally improper, patent owner had a petition right to seek supervisory review of the examiner's action in doing so. Yet no such petition was filed. Instead, patent owner filed a petition for extension of time on the last day of the period for filing a response to the final rejection, (which period had been previously been extended for two additional month by the Office, acting *sua sponte*). It should further be noted that patent owner's petition for extension was dismissed since it did not present any reasons why patent owner could not have taken the action that it now recognizes that it could have taken, namely to file an appeal in the '941 reexamination proceeding. It is also to be noted that patent owner had the option of requesting, by way of petition, relief analogous to the relief that would exist if the rules provided for a "Request for Continued Reexamination" practice analogous to the "Request for Continued Examination Practice" that exists under 37 CFR 1.114 for nonprovisional applications. [8]

Thus, petitioner patent owner's analysis that there it had no options other than "abandonment" or suspension of the '491 reexamination proceeding, or merger of that proceeding with the '934 reissue application, is mistaken. Patent owner could have filed an appeal at, or prior to, the filing of the present petition (as patent owner subsequently has done). Alternatively, patent owner could have attempted to file a grantable petition in pursuant to subsection D of the above-cited *Official Gazette* Notice, to return the prosecution to a non-final status. Doing so might have obviated the appeal status of the '491 reexamination proceeding and obtained entry of the amendment after final rejection filed on March 12, 2008 as a matter of right. In turn, this might have removed the circumstances that, for the reasons are discussed below, are deemed to preclude both merger of the '491 reexamination proceeding and the '934 reissue application, and suspension of the '491 reexamination proceeding.

Petitioner patent owner's observation that it needed to file a broadening reissue application prior to April 25, 2008 does not explain why, if patent owner was interested in seeking "a full scope of patentable subject matter," it was necessary, (or even desirable), to wait until the last possible date for filing the broadening reissue application. Patent owner could have filed such a reissue application prior to the filing of the '491 reexamination proceeding, contemporaneously with the filing of the '491 reexamination proceeding, or at an earlier stage of the prosecution in the '491 reexamination proceeding, (*e.g.*, when reexamination was ordered.) By delaying, patent owner was permitting the Office to expend resources addressing the reexamination proceeding that it now seeks to either suspend or merge with a reissue proceeding that includes claims to an entirely different statutory class of invention than the claims in the '083 patent.

The requested suspension of the '491 reexamination proceeding at this time would impede

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[8] See: "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending," 1292 OG 20 (March 1, 2005), particularly at Subsection D.

treatment of the '491 reexamination proceeding with special dispatch, in contradiction to the language of 35 U.S.C. § 305 that requires the Office to conduct reexamination proceedings with special dispatch, and specifically includes "any appeal to the Board of Patent Appeals and Interferences" in the special dispatch requirement. Such a suspension could be a period of time that is both indeterminate and potentially lengthy, given that reissue applications are subject to continuation practice and to request for continued reexamination practice. For these reasons, suspension of the '491 reexamination proceeding the present stage of the proceeding is not deemed to be appropriate.

Merger of the '491 reexamination proceeding and the '934 reissue application would result in identical claims being presented in files of both proceedings such that the merged proceeding would have a single set of claims. The merged proceeding would, therefore, include a set of claims directed to the invention patented in the '083 patent and a new set of claims that has been added to the '934 reissue application. These two sets of claims are directed to different statutory classes of inventions. A merged reissue/reexamination proceeding is conducted under the broader practice that applies to reissue applications. [9] Under present reissue guidelines, the likely result would be a requirement for restriction between the patented claims and the newly presented reissue claims, which in turn would result in an election of the claims to the patented invention by "prior presentation." In turn, this would necessitate the filing of a divisional reissue application directed to the newly presented method claims. This would increase the use Office resources, not conserve them, and would further delay the treatment of '491 reexamination with special dispatch. Put simply, examination of the entirely different statutory class of invention together with the reexamination proceeding would delay resolution of the substantial new question of patentability raised in the reexamination request, contrary to the statutory dictate for special dispatch. For these reasons, merger of the '491 reexamination proceeding and the '934 reissue application is not deemed to be appropriate.

III. Suspension, *Sua Sponte*, of the '934 Reissue Application

It is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the '083 patent. The reason for this Office policy is to prevent inconsistent, and possibly conflicting, arguments that refer to limitations found both in the claims of the reissue, and those in the reexamination, from being introduced into the multiple separate proceedings on behalf of the patent owner. Likewise, patent owner could add in the reissue application claims which are directed to invention being reexamined, which might be inconsistent, and possibly conflicting, with the reexamination, and present different arguments.

Given that the examination of the instant reissue and reexamination proceedings will not be conducted separately and at the same time, the proceedings will not be merged, and the reexamination proceeding will not be suspended for the reasons stated above:

Action in the '934 reissue application is hereby suspended pursuant to 37 CFR 1.103(e) in favor of the reexamination proceeding. The reissue application suspension shall remain in effect until the conclusion of the '491 reexamination proceeding by the issuance of the reexamination certificate.

The patent owner has expressed a concern that the resolution of the reexamination proceeding could result in the reissue claims being barred by 37 CFR 1.570(d). However, '934 reissue application will only become subject to the provisions of 37 CFR 1.570(d) in the event that the

[9] See: 37 CFR 1.565(d) and MPEP § 2285.

examiner's final rejection of all of the pending claims is sustained on appeal. In the event that the examiner's position is sustained as a result of the appeal process, patent owner could, at the conclusion of the reexamination proceeding, file a petition under 37 CFR 1.183 in the '934 reissue application requesting waiver of the provisions of 37 CFR 1.570(d) such that the '934 reissue application could then be prosecuted. This would obviate patent owner's concern in that it would provide patent owner with "a fair opportunity to claim a full scope of patentable subject matter."

CONCLUSION

1. The present patent owner petition is dismissed.

2. Prosecution in reissue application number 12/108,934 is hereby suspended pursuant to 37 CFR 1.103(e), until the conclusion of the reexamination proceeding, control number 90/008,491, by the issuance of the reexamination certificate.

3. At the time that a reexamination certificate is issued for the '491 reexamination proceeding, the patent owner is advised to call the issuance of the certificate to the attention of the Office, and to request a resumption of examination of the reissue application. The patent owner may include an amendment of the '934 reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding. Likewise, patent owner may include a petition under 37 CFR 1.183 in the '934 reissue application requesting waiver of the provisions of 37 CFR 1.570(d), if all claims of the patent are canceled via the reexamination certificate.

4. This decision will be entered in the files of the '491 reexamination proceeding and the '934 reissue application.

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

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

sm
September 24, 2008

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(For Patent Owner)

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FEB 06 2009

OFFICE OF PETITIONS

Silicon Valley Patent Group LLP
18805 Cox Avenue, Suite 220
Saratoga CA 95070

(For Requester)

In re Finarov
Reexamination Proceeding
Control No. 90/008,499
Request Deposited: February 16, 2007
Attorney Docket No. NAN127 RX
For: U.S. Patent No. 7,169,015

DECISION DISMISSING PETITION
UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed January 14, 2009, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to a prior-filed nonprovisional application.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000, and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The present petition does not meet requirements (1) and (3) above.

The proposed amendment to the specification, filed on January 14, 2009, is unacceptable as drafted, and therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). Specifically, the proposed amendment to the specification, filed January 14, 2009, is not in compliance with 37 CFR 1.530 because the markings were not made to indicate all the changes from the original patent as indicated in the Advisory Action of January 27, 2009.

It is notes that petitioner has filed this late claim for priority under 37 CFR 1.78(a)(5); however, it should have been filed under 37 CFR 1.78(a)(3) since the priority claim is to a nonprovisional application under 35 U.S.C. § 120. Further, 37 CFR 1.78(a)(3) requires a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR 1.78(a)(3). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

Accordingly, before the petition under 1.78(a)(3) can be granted, petitioner must file a renewed petition under 37 CFR 1.78(a)(3), accompanied by an amendment complying with 37 CFR 1.530. No additional petition fee is required.

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

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Correspondence may also be submitted via EFS-Web.

Any questions concerning this matter may be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Anthony Knight
Supervisor
Office of Petitions

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COMMISSIONER FOR PATENTS
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Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York NY 10036

(For Patent Owner)

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FEB 26 2009

OFFICE OF PETITIONS

Silicon Valley Patent Group LLP
18805 Cox Avenue, Suite 220
Saratoga CA 95070

(For Requester)

In re Finarov :
Reexamination Proceeding :
Control No. 90/008,499 : DECISION GRANTING PETITION
Request Deposited: February 16, 2007 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. NAN127 RX :
For: U.S. Patent No. 7,169,015 :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed February 23, 2009, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to a prior-filed nonprovisional application.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000, and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

This application is being forwarded to Technology Center Art Unit 3993 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed application.

Any questions concerning this matter may be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Anthony Knight
Supervisor
Office of Petitions

Enclosure: Corrected Filing Receipt

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 NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
90/008,499	02/16/2007	3993	2520	NAN127 RX	114	4

CONFIRMATION NO. 9369

CORRECTED FILING RECEIPT

49443
Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York, NY 10036

Date Mailed: 02/26/2009

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

7169015, Residence Not Provided;
Nova Measuring Instruments Ltd.(OWNER), Rehovot, ISRAEL;
Michael J. Halbert(3RD PTY REQ), Saratoga, CA;
Michael J. Halbert, Saratoga, CA

Assignment For Published Patent Application

Nova Measuring Instruments Ltd.

Power of Attorney: The patent practitioners associated with Customer Number 49443

Domestic Priority data as claimed by applicant

This application is a REX of 10/860,019 06/04/2004 PAT 7,169,015
which is a CON of 09/898,467 07/05/2001 PAT 6,752,689
which is a CIP of 09/498,926 02/04/2000 PAT 6,368,181
which is a CON of 08/497,382 06/29/1995 PAT 6,045,433

Foreign Applications

ISRAEL 113829 05/23/1995

If Required, Foreign Filing License Granted: 02/25/2009

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 90/008,499**

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No

Title

APPARATUS FOR OPTICAL INSPECTION OF WAFERS DURING PROCESSING

Preliminary Class

451

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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.
90/008,506	02/26/2007	4,733,159	078944.010600	5715

62204 7590 09/04/2008

GE TRADING & LICENSING
1 RESEARCH CIRCLE
ATTN: BRANDON, K1 - 2C11
NISKAYUNA, NY 12309

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/04/2008

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

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,955	12/05/2007	4733159	40085-7	2192

7590 09/04/2008

EXAMINER	
ART UNIT	PAPER NUMBER

Donald B. Southard
MOTOROLA, INC.
1303 Algonquin Road
Schaumburg, IL 60196

DATE MAILED: 09/04/2008

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

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

GE TRADING & LICENSING
1 RESEARCH CIRCLE
ATTN: BRANDON, K1 - 2C11
NISKAYUNA NY 12309

(For Patent Owner)

MAILED
SEP 04 2008
CENTRAL REEXAMINATION UNIT

Donald B. Southard
MOTOROLA, INC.
1303 Algonquin Road
Schaumburg IL 60196

(For Patent Owner)

GREENBERG TRAURIG, LLP
1200 SEVENTEENTH STREET,
SUITE 2400
DENVER, CO 80202

(For Third Party Requester)

WOODARD, EMHARDT, MORIARTY,
MCNETT & HENRY LLP
111 MONUMENT CIRCLE,
SUITE 3700
INDIANAPOLIS, IN 46204-5137

(For Third Party Requester)

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS
37 C.F.R. § 1.565(c) &
CLARIFICATION OF THE
PATENT OWNER'S
REPRESENTATION
37 CFR § 1.33

In re: Edwards *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,506
Deposited: 26 February 2007
For: US Patent No. 4,733,159

In re: Edwards *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/008,955 :
Deposited: 5 December 2007 :
For: US Patent No. 4,733,159 :

The above-identified reexamination proceedings 90/008,506 and 90/008,955 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).

The Director further wishes to clarify the representation of the patent owner pursuant to 37 CFR § 1.33.

BACKGROUND

1. Patent No. 4,733,159 issued on 22 March 1988.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,506 was requested by a third party requester on 26 February 2007.

3. The Reexamination Order was granted in proceeding, control no. 90/008,506 on 10 April 2007.

4. There are currently no amendments proceeding control number 90/008,506.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,955 was requested by a third party requester filed on 5 December 2007.

6. The Reexamination Order was granted in proceeding, control no. 90/008,955 on 25 January 2008.

7. There are currently no amendments proceeding control number 90/008,955.

8. Proceedings control numbers 90/008,506 and 90/008,955 await action from the assigned examiner.

9. On 7 June 2007 a change of address and power of attorney was received in the proceeding control number 90/008,506.

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 90/008,506 and 90/008,955 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.

CORRESPONDENCE

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings. (in-part)

(a) Correspondence address and daytime telephone number . When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first

named inventor (if provided, see § § 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address.

...

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.32(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to § § 11.5 and 11.11 of this subchapter, or if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. 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. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.

It is noted that there are two addresses given for the patent owner. The addresses are different in each individual proceeding. The patent owner is reminded that double correspondence will not be undertaken and the record of the merged proceedings clarified as to whom the patent owner wishes representation. According to the requirements of 37 CFR 1.33 response to this paper requires clarification as to whom the patent owner has selected for representation in these merged proceedings

CONCLUSION

1. Reexamination Control Nos. 90/008,506and 90/008,955 are hereby **MERGED**.

2. The Patent Owner is hereby required to clarify to whom correspondence shall be addressed.

3. The reexamination files are being forwarded to the examiner for further action.

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

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

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

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

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
P.O. Box 1450
Alexandria, VA 22313-1450
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Daniel P. McCarthy
Parsons Behle & Latimer
201 South Main Street, Suite 1800
P.O. Box 45898
Salt Lake City, UT 84145[1]

(For Patent Owner)

MAILED

MAR 13 2008

CENTRAL REEXAMINATION UNIT

A. John Pate
Pate Pierce & Baird
215 South State Street, Suite 550
Salt Lake City, UT 84111

(For 3rd Party Requester)

Stoel Rives LLP-SLC
201 South Main Street
One Utah Center
Salt lake City, UT 84111

(For 3rd Party Requester)

Reexam Control No.: 90/007,659
Filed : August 5, 2005
For U.S. Patent No. : 6,026,527

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,509
Filed : February 27, 2007
For U.S. Patent No. : 6,026,527

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

Reexamination in application control No. 90/007,659 was ordered in a decision mailed October 14, 2005. Prosecution proceeded to the mailing of a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) on January 16, 2007. The NIRC indicated that claims 1-38, all of the claims in the patent, were confirmed. A decision vacating the NIRC was mailed March 12, 2008. There were no amendments made to the claims, specification and/or drawings in this proceeding.

Reexamination in application control No. 90/008,509 was ordered in a decision mailed April 20, 2007 indicating that claims 1-38 will be reexamined. No patent owner's statement has been filed

[1] Communications from Mr. McCarthy directed to the '7,656 proceeding and received October 26, 2006 and subsequently bear a correspondence address of P.O. Box 71550, Salt Lake City, UT 84171-0550. This address differs from the correspondence address of record. The filing of a formal request to change the correspondence address is suggested to ensure prompt receipt of all Office communications.

nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,659 and reexamination control No. 90/008,509 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-38, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,659 and 90/008,509 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Lissi Mojica Marquis,
Director
Central Reexamination Unit

cc: Daniel P. McCarthy
P.O. Box 71550
Salt Lake City, UT 84171-0550

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,513	02/28/2007	6,990,660	46628-00100	9200

45522 7590 01/22/2008

LEWIS AND ROCA LLP
40 N. CENTRAL AVENUE
Suite 1900
PHOENIX, AZ 85004-4429

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/22/2008

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

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UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,018	09/26/2007	6990660	12554.0038USZA	4671

45522 7590 01/22/2008

LEWIS AND ROCA LLP
40 N. CENTRAL AVENUE
Suite 1900
PHOENIX, AZ 85004-4429

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/22/2008

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JAN 22 2008

CENTRAL REEXAMINATION UNIT

Lewis and Roca LLP
40 North Central Avenue
Phoenix, AZ 85004

(For Patent Owner)

John B. Phillips
Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

(For Third Party Requester)

In re Moshir *et alia*
Reexamination Proceeding
Control No. 90/008,513
Request Deposited: February 28, 2007
For: U.S. Patent No. 6,990,660

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

In re Moshir *et alia*
Reexamination Proceeding
Control No. 90/010,018
Corrected Request Deposited: September 26, 2007
For: U.S. Patent No. 6,990,660

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. 6,990,660 (hereinafter, the '660 patent), issued to Moshir *et alia*, on January 24, 2006.

2. On February 28, 2007, patent owner deposited a Request for *Ex Parte* Reexamination of claims 1, 23, and 55 of the '660 patent. The reexamination proceeding was assigned Control No. 90/008,513 (hereinafter, the '8513 proceeding).

3. The Reexamination Order was granted in the '8513 proceeding on April 12, 2007.

4. There are currently no amendments in the '8513 proceeding.

5. On September 26, 2007, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-61 of the '660 patent. The reexamination proceeding was assigned Control No. 90/010,018 (hereinafter, the '10018 proceeding).

6. The Reexamination Order was granted in the '10018 proceeding on November 5, 2007.

7. There are currently no amendments in the '10018 proceeding.

8. The '8513 and '10018 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 '8513 and the '10018 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. 90/008,513 and 90/010,018 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

MT

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

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. (For Patent Owner)
P.O. BOX 2938
MINNEAPOLIS, MN 55402

BRIGGS AND MORGAN P.A. (For Requester)
2200 IDS CETNER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402

MAILED

JUL 20 2007

CENTRAL REEXAMINATION UNIT

In re Goman et al.
Reexamination Proceeding
Control No. 90/008,517
Filed: March 5, 2007
For: U.S. Patent No. 6,196,459

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on June 7, 2007 (which was refiled with certificate of service on June 26,2007), styled as "Petition From Denial of Request for Reexamination Under 37 CFR § 1.181(b)," (hereinafter Petition) is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated May 4, 2007.

The Petition is GRANTED.

REVIEW OF FACTS

1. U.S. Patent No. 6,196,459 (hereinafter, the '459 patent) issued on March 6, 2001 of an application filed May 11, 1998.

2. On March 5, 2007, the third party requester deposited a request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned Control No. 90/008,517 (hereinafter, the '517 proceeding).

3. Reexamination was requested for claims 1-15 and 18-23 of the '459 patent.

4. A Notice of Reexamination Request Filing Date was issued on March 15, 2007.

5. An order denying the request for reexamination for claims 1-15 and 18-23 was issued on May 4, 2007.

6. On June 7, 2007[1], the third party requester filed the Petition under 37 CFR § 1.181.

7. On June 26, 2007, the third party refiled the Petition with certificate of service showing service of the Petition on the Patent Owner.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges several grounds for which petitioner feels the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the following four arguments:

1. The examiner failed to apply the correct standard of whether there is a substantial new question of patentability in deciding the whether to grant the order for reexamination.
2. The examiner incorrectly interpreted the claims in the '459 patent, which resulted in an unnecessarily narrow interpretation than is required by the specification, drawings and prosecution history.
3. The examiner's determination that four claim elements from the '459 patent is missing from U.S. Patent No. 5,557,679 and JP-07-334631 is incorrect.
4. A request for reconsideration of whether U.S. Patent No. 5,557,679 and JP-07-334631 raises substantial new questions of patentability.

[1] The request was timely because it included a certificate of mailing under 37 CFR 1.8, which was dated June 4, 2007.

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 1-15 and 18-23 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 1-15 and 18-23 of the '459 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC § 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

III. Summary of the prior prosecution:

Claims 1-23 are the current claims in the '459 patent. Of the claims for which reexamination is requested (claims 1-15 and 18-23), claims 1, 5, 10, 18 and 19 are independent.

In a first non-final rejection (10/5/1999) the examiner rejected at least original claim 1-35 as obvious over Linden (US 4,827,425) in view of Laing *et al.* (US 5,534,857). After additional amendments and office actions, a Notice of Allowability (9/15/2000) was issued wherein the examiner indicated the claims to be allowable because the prior art of record did not teach or fairly suggest the "networked" card processing system as the

claimed when reading the claims in light of the specification. The examiner further noted that the claimed personalization stations as understood in light of the specification were networked to a separate server, controller and management system with each personalization system remote from the others. The examiner further considered that there would have been no motivation to significantly alter the prior art (*Linden*) to create the remote personalization systems as claimed.

IV. Analysis of the Request for Reexamination

The Request was denied on May 4, 2007 in the Order Denying Request for Ex Parte Reexamination wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. With regard to U.S. Patent No. 5,557,679 and JP-07-334631, the examiner found that the references were missing certain of the claim elements. The examiner therefore held that U.S. Patent No. 5,557,679 and JP-07-334631 do not raise a SNQ.

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director reviews the request *de novo* in response to the Petition.

Turning to the request, it states that there are two references that raised a substantial new question of patentability.

Reference 1: The request states (at least on pages 3, 7 and 53) that U.S. Patent No. 5,557,679 to Julin et al. (hereinafter *Julin*) raises a substantial new question of patentability regarding claims 1-15 and 18-23 of the '459 patent.

The *Julin* patent is prior art not cited in the prior application. *Julin* teaches, among other things, a networked SIM card processing system (Fig. 1) including a plurality of personalization station systems **3**, **4**, **5** and **6**, each personalization system located remotely from each other and a central server **1** (col. 1, lines 36-41; col. 3, lines 19-29). Since this teaching is directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the *Julin* reference as important in determining the patentability of at least independent claims 1, 5, 10, 15, 18 and 19 (including dependent claims 2-4, 6-9, 11-14, and 20-23 which depend therefrom) which recite or imply a networked system including at least a personalization server and personalization station located remotely from each other. As such, it is agreed that the *Julin* reference raises a substantial new question of patentability with respect to claims 1-15 and 18-23 of the *Goman* patent.

Reference 2: The request states (at least on pages 55 and 82) that that Japanese Patent Document JP 07-334631 (*JP '631*), either alone or in combination, raises a substantial new question of patentability regarding claims 1-15 and 18-23 of the '459 patent.

The *JP '631* patent is prior art not cited in the prior application. *JP '631* teaches, among other things, a networked IC card processing system (Fig. 1) including a plurality of personalization stations **31**, **41**, **51**, and **61**, each of the personalization systems located remotely from each other and a central server **21** [0010-0011] as understood in view of the translation (pages 8-9) of the *JP '631* reference as provided by the requester. Since this teaching is directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the *JP '631* patent as important in determining the patentability of at least independent claims 1, 5, 10, 15, 18 and 19 (including dependent claims 2-4, 6-9, 11-14, and 20-23 which depend therefrom) which recite or imply a networked system including at least a personalization server and personalization station located remotely from each other. As such, it is agreed that the *Julin* reference raises a substantial new question of patentability with respect to claims 1-15 and 18-23 of the *Goman* patent.

Because it is agreed that *Julin* and *JP '631* raises a SNQ with respect to claims 1-15 and 18-23 of the '459 patent, the Petition and Request for Reexamination are GRANTED.

CONCLUSION

1. Given the facts involved in this proceeding, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claims 1-15 and 18-23 of the '459 patent is GRANTED.

3. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Mark Reinhart, Special Program Examiner, at (571) 272-1611, or in their absence to the undersigned at (571) 272-1596.

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

/Mreinhart for/

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,521	02/28/2007	6163776	05-610 A	9664

64828 7590 10/12/2007

LAW OFFICE OF CLAY MCGURK
P.O. BOX 6127
LAGUNA NIGUEL, CA 92677

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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Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041

(For Patent Owner)

MAILED

OCT 12 2007

CENTRAL REEXAMINATION UNIT

Thomas A. Fairhall
McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606

(For Third Party Requester)

In re Periwal
Ex Parte Reexamination Proceeding
Control No.: 90/008,521
Deposited: May 28, 2007
For: U.S. Patent No.: 6,163,776

This is a decision on the May 11, 2007 petition under 37 CFR 1.515(c) and 37 CFR 1.181 requesting reconsideration of the order denying the request for *ex parte* reexamination mailed April 30, 2007. The petition was timely filed. No fee is required. The petition is now before the Director of the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 6,163,776 (hereinafter, the '776 patent) issued on December 19, 2000 to Periwal.

2. On February 28, 2007, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/008,521.

3. An order denying the request for ex parte reexamination was mailed on April 30, 2007.

4. The present petition was timely filed on May 11, 2007.

DECISION

Pursuant to 37 CFR 1.510(b)(1) and (2), any request for reexamination must include:

> "(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
>
> "(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.
>
> "(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication."

At page 2 of the request dated February 28, 2007, it is stated:

Ex parte reexamination of United States Patent 6,163,776, issued December 19, 2000 is hereby requested. This request is being filed by a third party under the provisions of 35 U.S.C. §§ 302-307 and 37 C.F.R. §§ 1.510 et seq. The '776 patent is currently under reexamination by Examiner St. John Courtenay III, control no. 90/007,616, which is currently pending. The present reexamination request is directed to substantial new questions of patentability raised in the patentee's amendment of June 19, 2006 in the pending '616 reexamination.

The request then proceeds to address solely amended claims which are not part of the '776 patent claims, but are stated to be present in reexamination Control Number 90/007,616. While such amended claims may be present in reexamination Control Number 90/007,616 (for reexamination of the '776 patent), 37 CFR 1.530(k) makes it clear that "the proposed amendments will not be effective until the reexamination certificate is issued." [1] Further, 37 CFR 1.515(a) states that "[t]he examiner's determination [on the request] will be based on the claims in effect at the time of the determination...." This is based on the reexamination statute – as follows.

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[1] See also 35 U.S.C. 307 which states "...the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable. " It is not until the reexamination certificate is issued and published that the proposed amendments are "incorporated" into the patent.

35 U.S.C. 302 states:

> Any person at any time may file a request for reexamination by the Office of **any claim of a patent** on the basis of any prior art cited under the provisions of section 301 of this title. [Emphasis added.]

35 U.S.C. 303(a) states:

> 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. [Emphasis added.]

Since the request has not advanced (and explained) any substantial new question with respect to claims which are a part of the '776 patent, the request fails to comply with the requirements for granting a filing date for a reexamination request. [2]

Stated another way, the request does not provide a "statement pointing out each substantial new question of patentability based on prior patents and printed publications" for each cited document, as is required by 37 CFR 1.510(b)(1) as to the patent claims. Nor does the request provide a "detailed explanation of the pertinency and manner of applying the cited prior art" to every patent claim for which reexamination is requested, as is required by 37 CFR 1.510(b)(2).

For each identified substantial new question of patentability (SNQ), the request must explain how the cited documents identified for that SNQ are applied to meet/teach the patent claim limitations to thus establish the identified SNQ. *See* Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings 71 *Fed. Reg.* 44219, (August 4, 2006)), at page 44221, second half of middle column.

If the requester were permitted to omit an explanation of how such documents cited in request are applied to the patent claims, an undue burden would be placed on the Office

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[2] It is observed that MPEP 2240 states:

"The second or subsequent request for reexamination may raise a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the first (or prior) pending reexamination proceeding."

Such information would be considered, however, **only if reexamination is granted on the patent claims,** such that the proceeding can commence as to examination. Such information would be considered only in the examination stage, **after reexamination has been ordered** (if appropriate, e.g., if the later reexamination is merged with the earlier proceeding containing the amended claims, or if the amended claims are added in the later reexamination during the examination stage).

to address each document in the determination on the request, without an explanation of the relevance to the patent claims. Accordingly, such an omission is prohibited by law.

As to the documents that are explained in the request, they must be explained for each of the patent claims (for which a substantial new question of patentability is identified). Since the request is directed to amended claims which are not a part of the patent claims, there is no explanation as to the pertinency and manner of applying the cited prior art to each claim identified in the request.

It is noted that the second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the first (or prior) pending reexamination proceeding. However, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination proceeding for the claims in effect at the time of determination (37 CFR 1.515(a)). If a "different" substantial new question of patentability is not provided by the second request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied.

Upon a *de novo* review of the request papers, it appears requester requests reexamination of amended claims 1-4, 7, 9, 13, and 14 as well as new claims 43, 45, 49-55, 57-58, 60-68, and 70-75 as present in the pending '7616 proceeding. As noted above, the request may provide information raising a SNQ to new claims 43, 45, 49-55, 57-58, 60-68, and 70-75; however, the request must also independently provide a SNQ for claims in effect at the time of the determination. So, the request must provide a different SNQ for claims 1-4, 7, 9, 13, and 14 for the claims in effect at the time of the determination (i.e. claims 1-4, 7, 9, 13, and 14 of the US Patent Number 6,163,776). Requester alleges claims 1-4, 7, 9, and 13 are considered obvious over Chang in combination with the Spruit article, or Chang in combination with the JavaSoft JDBC specification and the Java Reflection Specification. Requester alleges claim 14 is obvious over Chang in combination with the Spruit article and either the JavaSoft JDBC specification, the TOPLink manual or Durand or Chang in combination with the JavaSoft JDBC specification and the Java Reflection Specification.

There is no new SNQ raised by the Chang reference as the Chang reference is applied in the same manner to the limitations present in claims 1-4, 7, 9, 13, and 14 of US Patent Number 6,163,776 as it is applied to those same limitations in the amended claims 1-4, 7, 9, 13, and 14 in the '7616 proceeding. Similarly, Durand does not raise a SNQ as the Durand reference is applied to the limitation in dependent claim 14 in the same manner as in the '7616 proceeding. The Spruit article, the JavaSoft JDBC specification, and the Java Reflection Specification are relied upon solely for the teaching of the object model information derived using a reflection facility of a programming language in the proposed rejection of amended claims 1-4, 7, 9, and 13. This limitation is only present in the amended claims in the pending '7616 proceeding. Therefore, the Spruit article, the JavaSoft JDBC specification, and the Java Reflection

Specification do not raise a SNQ for claims 1-4, 7, 9, and 13 for the claims in effect at the time of the determination (i.e. claims 1-4, 7, 9, and 13 of the US Patent Number 6,163,776). Regarding claim 14, the JavaSoft JDBC specification and the TOPLink manual are relied upon for the teaching of the object relational mapping data structure including a mapping for a stored procedure executable by an engine in the relational system with the stored procedure being invokable by an application program using an exchange unit and creating an object with a value returned by executing the stored procedure. These teachings from the JavaSoft JDBC specification and the TOPLink manual are cumulative to the teachings in Durand. Therefore, they do not present a different new SNQ that could serve as the basis of the request.

Since the present request has not provided a "different" substantial new question of patentability for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied.

SUMMARY AND CONCLUSION

No substantial new question of patentability affecting at least one claim of U.S. Patent No. 6,163,776 has been presented by requester for the reasons set forth above.

The petition is **DENIED**.

The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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MOUNTAIN VIEW, CA 94041

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NOV 09 2007

CENTRAL REEXAMINATION UNIT

In re Application of :
Damodar D. **PERIWAL** :
Control No. 90/008,521 (U.S. Patent 6,163,776) : DECISION ON PETITION
Filed: February 28, 2007 : TO WITHDRAW
Attorney Docket No. 05-610 A : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 06, 2007.

The request is **APPROVED**.

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

The request was signed by Daniel R. Brownstone on behalf of all attorneys of record who are associated with Customer No. 00758. All attorneys/agents associated with the Customer No. 00758 have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

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

/Patricia Volpe for/

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: **DAMODAR D. PERIWAL**
1274 Colleen Way
Campbell, CA 95008

cc: **THE LAW OFFICES OF CLAY MCGURK**
30922 Calle Moraga
Laguna Niguel, CA 92677

cc: **THOMAS A. FAIRHALL** (Third Party Requester)
McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on November 06, 2007. There is no indication it was served on 3rd Party Requester.

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JAN 15 2008

CENTRAL REEXAMINATION UNIT

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P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

(For Patent Owner)

Wien Liu
LIU & LIU
444 S. Flower Street
Suite 1750
Los Angeles, CA 90071

(for Third Party Requester)

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

In re: Whipple
Ex Parte Reexamination Proceeding
Control No. 90/008,522
Deposited: 30 March 2007
For: US Patent No. 5,077,733

This is a decision on the 2 January 2007, petition for "Request for Extension of Time To Respond To The Office Action Under 37 CFR 1.550," requesting that the time for responding to the non-final Office action, mailed 10 December 2007 be extended by one month ending on 10 February 2008.

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

The petition is Dismissed as Moot for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 10 December 2007, which set a two month date for filing a response thereto. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond to the Office action be extended to two-months ending 10 February 2008. Since the time set in the Office action ends on the date which the petitioner seeks the extension, the request is considered moot.

37 CFR 1.550 (c) states:

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

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

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

Analysis and Findings

On balance, the Patent Owner has requested the time to respond to the Office action be extended to 10 February 2008. Since the Office action mailed 10 December set a response time of two months, the request is considered to be moot.

The petition request is **Dismissed as Moot**.

Conclusion

1. The patent owner's petition for extension of two-months time in which to file a response to the Office action dated 10 December 2007 is **dismissed as moot**.

2. The Office action mailed set a two-month response time for which to respond will end on 10 February 2008.

3. The request for extension of time from 10 January to 10 February is moot in light of the examiner's two-month shortened statutory time period for which to respond from the Office action mailed 10 December 2007..

4. 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
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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

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

MARK J. REINHART
CRU SPE-AU 3992

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,522	03/30/2007	5077733	COM/001	3600

22852 7590 02/04/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/04/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WEN LIU
LIU & LIU
444 SOUTH FLOWER STREET SUITE 1750
LOS ANGELES CA 90071

Date:

MAILED

FEB 04 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008522
PATENT NO. : 5077733
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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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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(For Patent Owner)

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FEB 04 2010

CENTRAL REEXAMINATION UNIT

LIU & LIU
444 S. FLOWER STREET
SUITE 1750
LOS ANGELES, CA 90071

(For Third Party Requester)

In re: Whipple *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,522
Deposited: 30 March 2007
For: U.S. Patent No.: 5,077,733

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on 20 November 2008. The petition is entitled "PETITION UNDER 37 CFR § 1.181" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and enter the Declaration filed under 37 CFR 1.182 submitted on 29 September 2008.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated 20 November 2008 is denied with respect to entry of the declaration filed on 29 September 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,077,733 issued on 31 December 1991.

2. A request for *ex parte* reexamination proceeding, assigned control No. 90/008,522 was filed by a third party requester on 30 March 2007.

3. *Ex parte* reexamination was ordered for the proceeding on 01 June 2007.

4. On 10 December 2007, a non-final Office action, was mailed.

5. On 2 February 2008 an interview in the aforementioned proceeding occurred.

6. On 11 February 2008, the patent owner submitted a response .

7. On 28 July 2008, the Office issued a Final rejection Office action.

8. On 23 September 2008 an interview was conducted in the aforementioned proceeding.

9. On 29 September 2008, Patent Owner filed an after Final response and a declaration under 37 CFR § 1.132.

10. On 23 October 2008, the Office issued an advisory action denying entry of the declaration under 37 CFR 1.132 because the patent owner failed to provide good and sufficient reasons as to why it was not earlier presented.

11. On 28 October 2008 the patent owner filed a Notice of Appeal.

12. On 20 November 2008 the instant petition was submitted for consideration.

13. On 21 January 2010, a decision on the petition was mailed in error.

DECISION

The decision mailed 21 January 2010 is hereby *withdrawn.* This decision replaces the 21 January 2010 decision, which was mailed in error.

The patent owner (petitioner) states that the examiner erred in deciding not to enter declaration under 37 CFR 1.132 of 29 September 2008 because the declaration addresses the new and clarified arguments raised by the examiner in the Final rejection Office action and would place the proceeding in better form for appeal. See pages 2-3 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the declaration under 37 CFR 1.132 of 29 September 2008, the director finds there are not good and sufficient reasons to enter the declaration. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection and for consideration of after final responses. See MPEP 2272.

Turning to the facts in this proceeding, the Final rejection of 28 July 2008 sets forth the same grounds of rejection based on prior art as set forth in the first Office action. As was set forth in the non-final Office action of 10 December 2007 and maintained in the 28 July 2008 Office action, claims 11-17 were rejected under 35 U.S.C. 102/103 based on Craft et al., claims 11, 15 & 16 were rejected under 35 U.S.C. 102 based on Jensen, claims 11-17 were rejected under 35 U.S.C. 102/103 based on Stoffel, and claims 11-17 were rejected under 35 U.S.C. 102/103 based on Menot et al. The examiner then addressed arguments presented in the 11 February 2008 response by the patent owner, as required by Office procedures. Specifically, the examiner responded to patent owner's arguments that Stoffel does not describe a group of nodes being responsive to requests to accesses by determining priority (see, e.g., pages 2-8 of the 11 February 2008 response), Monet also does not describe a group of nodes being responsive to requests to accesses by determining priority (see, e.g., pages 8-14 of the 11 February 2008 response), Jensen does not describe a group of nodes being responsive to requests to accesses by determining priority (see, e.g., pages 14-19 of the 11 February 2008 response), and that Craft et al. does not teach a means for giving the highest priority to a different node in response to a predetermined number of accesses of the bus by the device (see, e.g., pages 19-25 of the 11 February 2008 response). It is noted that the patent owner chose not to file a declaration under 37 CFR 1.32 in response to the first Office action, even after the 2 February 2008 personal interview, which discussed what the patent owner believes to be the deficiencies of the Craft et al., Sotffel, Jensen, and Monet et al.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the declaration under 37 CFR 1.132 of 29 September 2008 should not be entered because the patent owner had the opportunity to enter the declaration under 37 CFR 1.132 following the non-final Office action of 10 December 2007. In the petition, patent owner alleges that the examiner raised new and clarified arguments in the Final rejection, and

that the declaration was not necessary until after the Final rejection. However, the examiner set forth the same rejection as in the non-final Office action of 10 December 2007. In addition, patent owner and examiner had an interview of 2 February 2008, which discussed the alleged deficiencies of the references applied in the rejections. The record does not support patent owner's contention that it was only the Final rejection that triggered the need for the declaration under 37 CFR 1.132. To reiterate, in the Final rejection, the examiner was only addressing arguments made by the patent owner, and did not modify or alter the grounds of rejection.

For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the declaration under 37 CFR 1.132 of 29 September 2008.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the declaration under 37 CFR 1.132 of 29 September 2008 is denied.

2. This decision withdraws the decision mailed January 21, 2010. The USPTO regrets the error in mailing the previous version.

3. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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.
90/008,522	03/30/2007	5077733	COM/001	3600

22852 7590 06/24/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WEN LIU
LIU & LIU
444 SOUTH FLOWER STREET SUITE 1750
LOS ANGELES CA 90071

Date:
MAILED

JUN 24 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008522
PATENT NO. : 5077733
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

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

(For Patent Owner) **MAILED**

JUN 24 2010

Wen Liu
Liu & Liu
444 South Flower Street, Suite 1750
Los Angeles, CA 90071

(For Requester) **CENTRAL REEXAMINATION UNIT**

In re Reexamination Proceeding
David L. Whipple
Control No.: 90/008,522
Filed: March 8, 2007
For: U.S. Patent No.: 5,077,733

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

This is a decision on the April 9, 2010 patent owner paper entitled "Petition under 37 CFR 1.182," which is requesting continued reexamination.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 C.F.R. § 1.17(f) for the present petition under 37 C.F.R. § 1.182 has been charged to petitioner's credit card in accordance with petitioner's April 9, 2010 authorization in the submitted Electronic Patent Application Fee Transmittal.

For the reasons set forth below, the petition under 37 C.F.R. § 1.182 is dismissed.

REVIEW OF THE FACTS

1. On December 31, 1991, the Office issued U.S. Patent 5,077,733 (the '733 patent) issued to David L. Whipple.

2. On March 30, 2007, a request for *ex parte* reexamination of claims 11-17 of the '627 patent was filed by a third party requester.[1] The request was assigned reexamination control number 90/008,522 (the '8522 proceeding).

3. On May 22, 2007, a notice of the filing of the '8522 *ex parte* reexamination was published in the *Official Gazette*.

[1] Requester initially deposited a non-compliant request for reexamination on March 8, 2007, failing to secure a filing date. On March 30, 2007, requester perfected the initial request with a supplemental submission, securing the filing date of March 30, 2007.

4. On June 1, 2007, the Office issued an order granting the '8522 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 11-17 of the '627 patent would be subject to reexamination.

5. On August 1, 2007, the time period for filing a patent owner's statement pursuant to 37 C.F.R. § 1.530 in the '8522 *ex parte* reexamination proceeding expired without the submission of a statement by the patent owner.

6. On December 10, 2007, a first Office action on the merits issued rejecting claims 11-17 as unpatentable.

7. On February 2, 2008, patent owner conducted an interview with the examiner of record.

8. On February 11, 2008, patent owner filed a response consisting only of remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.

9. On July 28, 2008, a final Office action was issued in the '8522 proceeding rejecting claims 11-17 as unpatentable.

10. On September 23, 2008, patent owner conducted a second interview with the examiner of record.

11. On September 29, 2008, patent owner submitted an after-final response under 37 C.F.R. § 1.116 consisting of more remarks asserting patentability over the prior art of record. Patent owner also submitted a declaration under 37 CFR 1.132 by Dr. Harold S. Stone in support of the remarks alleging patentability (the "Stone declaration").

12. On October 23, 2008, the Office issued an advisory action denying entry of the Stone declaration as the patent owner failed to provide, in accordance with 37 C.F.R. § 1.116, good and sufficient reasons as to why the declaration was not earlier presented.

13. On October 28, 2008, patent owner timely submitted a notice of appeal.

14. On November 20, 2008, patent owner filed a petition under 37 C.F.R. § 1.181 requesting supervisory review of the denial of entry and entry of the Stone declaration.

15. On December 11, 2008, patent owner submitted an appeal brief.

16. On April 14, 2009, the Office an examiner's answer was issued.

17. On June 12, 2009, patent owner submitted a reply brief.

18. On August 14, 2009, the '8522 proceeding was forwarded to the Board of Patent Appeals and Interferences (BPAI).

19. On September 3, 2009, the BPAI returned the proceeding to the Central Reexamination Unit (CRU) for treatment of the November 20, 2008 petition.

20. On February 4, 2010, the Office issued a decision denying patent owner's November 20, 2008 petition under 37 C.F.R. § 1.181.

21. On March 30, 2010, the BPAI docketed the '8522 proceeding.

22. On April 9, 2010, patent owner filed a petition under 37 C.F.R. § 1.182 requesting opening of the prosecution to permit entry of the Stone declaration in the '8522 proceeding.

23. This decision addresses the April 9, 2010 patent owner petition requesting the opening of prosecution to permit and entry of the Stone declaration.

DECISION ON PETITION UNDER 37 C.F.R. § 1.182

In the present petition, it is requested that the Office continue the prosecution of the '8522 reexamination proceeding to provide consideration of the Stone declaration filed on September 29, 2008 submitted in response to the July 28, 2008 final Office action.

In March of 2005, the Office issued a notice[2] which provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. 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 C.F.R. § 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 advance prosecution through defining the issues for appeal, or towards the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition is to make a showing of the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the showing in a petition for continuation of the reexamination prosecution is to identify the issue that the submission is intended to address, and explain how the issue arose at a point of the prosecution (here, the final Office action) such that patent owner

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

had no earlier opportunity to address the issue. The above showings are critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 unequivocally mandates that reexamination proceedings must be conducted "with special dispatch within the Office." [3] If a patent owner desires a remedy not provided by rule to obtain entry of a submission in a reexamination proceeding and thereby delay the proceeding, equity requires that a petition for such remedy must balance that delay with a showing that patent owner supported the Office's unequivocal statutory mandate to carry out an *ex parte* reexamination proceeding with special dispatch.

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 Stone declaration of September 29, 2008 has not been shown to be a *bona fide* effort to advance prosecution and as such, the granting of the present petition is inconsistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner's sole argument to justify the granting of the extraordinary relief of reopening prosecution and entry of papers is that the Stone Declaration is necessary to respond to new examiner arguments in the July 28, 2008 final Office action, which therefore constitutes a newly raised issue patent owner has not had an opportunity to respond to, justifying continued reexamination to protect an already existing patent right in a proceeding that does not have an automatic continued examination procedure.

The September 29, 2008 Stone Declaration. Petitioner's argument to justify the granting of the relief of a request for continued reexamination and entry of the declaration is that the examiner for the first time is making new, never before posited arguments and interpretations of the prior art references which have been used as the basis of the rejections during open prosecution. It is noted that the granting of a request for continued reexamination under ordinary circumstances, where the petitioner was in control of the prosecution of the proceeding in the normal course of examination could have made a submission without delaying the proceeding, is contrary to the mandate of special dispatch. The thrust of petitioner's argument is that in responding to the patent owner comments regarding the alleged impropriety of a non-final Office action an examiner cannot both respond to patent owner's comments, pointing out patent owner's erroneous contentions regarding the art, and concurrently render the responsive Office action final. Accordingly, as per petitioner's argument, the examiner's discussion of the interpretation of the prior art somehow changed the basis of the rejection in the final Office action in such a manner as to presumably constitute a new grounds of rejection that merits the granting of a request for continued reexamination, and entry of the September 29, 2008 Stone declaration.

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[3] In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit pointed out that:
"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. (*Ethicon*, at 1426.)

Contrary to petitioner's assertion, it is unreasonable for petitioner to justify continued reexamination and reopening of prosecution of a reexamination proceeding based upon the mere further explication of the prior art in response to patent owner's contentions as to what the art does and does not teach. The assertion is untenable, as under current policy, practice and procedure such comments do not serve as grounds of rejection, nor do they alter a grounds of rejection previously made of record. Therefore, the comments are not a rejection of the claims, nor are they part of a stated rejection of record. The comments, at best, are simply part of an after-final response to arguments posited by the patent owner, and nothing more.

Patent owner has not presented a sufficient showing that these issues could not have been addressed during open prosecution. The Stone declaration addresses the Craft, Jensen, Stoffel, and Menon references that were applied in claim rejections in the non-final Office action of December 10, 2007. Despite petitioner's contention that the examiner made new statements in the final Office action, the issue of what these references disclosed and/or taught first arose with the non-final Office action, not with the final Office action. Therefore, petitioner had the opportunity to timely submit evidence relevant to the application of these references in the rejection of the indicated claims following the non-final Office action. Despite the clear notice at MPEP 2272 that evidence submissions should be filed before final action, petitioner did not submit the Stone declaration until after the final Office action. Therefore, petitioner has provided no justifiable reason as to why the September 29, 2008 Stone declaration should be entered.

Furthermore, the effect of entry of the declaration would be contrary to the conduct of reexamination proceedings with the statutory mandate of special dispatch. Congressional intent for 35 U.S.C. § 305 was for reexamination to provide a speedy alternative to litigation of issued patents. The statute explicitly states that reexamination proceedings are to be conducted with special dispatch. A continuation of examination for reexamination proceedings on issued patents, absent extraordinary equitable reasons for such continuation, runs contrary to § 305. Any continuation of a reexamination proceeding must be weighed against the legislative history behind the enactment of § 305, which expresses an intent for rapid and compact reexamination proceedings.[4] It is also noted that the proceeding has been fully briefed and that it is now before the BPAI. Granting petitioner's request to reopen prosecution would require removing jurisdiction of the proceeding from the BPAI after the completion of the entire briefing stage. In the instant petition, petitioner has not persuasively shown that patent owner has made a *bona fide* effort during the proceeding to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate with special dispatch, to justify the delay resulting from a grant of continued prosecution in view of the clear statutory mandate of § 305.

To the extent that patent owner's arguments raise a petitionable issue asserting that a rejection was made in error, or that the final Office action of July 28, 2008 is improper, such is directed to an action taken by the examiner. The sole proper vehicle for actions taken by an examiner is under 37 C.F.R. § 1.181 and not 37 C.F.R. § 1.182. Petitioner filed a petition on November 20, 2008 under 37 C.F.R. § 1.181 that was denied on February 4, 2010; relief from any improper examiner's actions during examination must be sought through that rule.

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[4] A comprehensive discussion of the statutory mandate for special dispatch can be found in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).

Finally, a petition under 37 C.F.R. § 1.182, for relief not otherwise provided under the regulations, is a highly fact-specific inquiry. Based on the facts and circumstances of the present proceeding, reopening of the examination of the '8522 reexamination proceeding and entering the unseasonably presented Stone declaration filed on September 29, 2008 in response to the July 28, 2008 final Office action, is not warranted and contrary to the statutory mandate of special dispatch. Accordingly, the § 1.182 petition is deemed insufficient to satisfy the requirements set forth in the Notice. In view of the above and the facts and circumstances of record, the petition is dismissed.

CONCLUSION

1. The petition under 37 C.F.R. § 1.182 is dismissed.

2. Jurisdiction for the '8522 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 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.
90/008,525	03/07/2007	4916635	007060.00020	5060

24280 7590 10/30/2007

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON, MA 02110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2007

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.
90/008,561	03/28/2007	4916635	007060.00006	9842

24280 7590 10/30/2007

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON, MA 02110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2007

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OCT 30 2007

CENTRAL REEXAMINATION UNIT

Choate, Hall & Stewart LLP
Two International Place
Boston, MA 02110

(For Patent Owner)

Banner & Witcoff, LTD.
1100 13th Street, NW, Suite 1200
Washington, DC 20005-4051

(For Third Party Requester)

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/008,525
Request Deposited: March 7, 2007
For: U.S. Patent No. 4,916,635

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

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/008,561
Request Deposited: March 28, 2007
For: U.S. Patent No. 4,916,635

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. 4,916,635 (hereinafter, the '635 patent), issued to Singer *et alia*, on April 10, 1990.

2. On March 7, 2007, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-4, 11, 21, and 24 of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,525 (hereinafter, the '8525 proceeding).

3. The Reexamination Order was granted in the '8525 proceeding on April 13, 2007.

4. There are currently no amendments in the '8525 proceeding.

5. On March 28, 2007, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-4, 11, 21, and 24 of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,561 (hereinafter, the '8561 proceeding).

6. The Reexamination Order was granted in the '8561 proceeding on May 24, 2007.

7. There are currently no amendments in the '8561 proceeding.

8. The '8525 and the '8561 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 '8525 and the '8561 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. 90/008,525 and 90/008,561 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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JAN 15 2008

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Requester)

In re Singer et al.
Merged *Ex parte* Reexamination Proceeding
Control Nos. 90/008,525 and 90/008,561
Filed: March 7, 2007 and March 28, 2007
For: U.S. Patent No.: 4,916,635

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

This is a decision on the December 18, 2007 petition under 37 CFR 1.182 and 1.183, filed by the third party requester in the above-identified proceeding to (1) permit a representative of the third party requester to attend any examiner interviews; (2) permit any examiner interviews to be recorded by audio and/or videograph; and (3) permit any examiner interviews to be transcribed.

The fee set forth in 37 CR 1.17(f) for a petition under 37 CFR 1.182 and 1.183 is $400. The petition fee for the above proceeding is being charged to the petitioner's deposit account No. 19-0733, as authorized by the petitioner on page 5 of the petition.

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

The petition is dismissed. As the petition paper is not a proper submission, it is being expunged by closing it in the electronic Image File Wrapper (IFW) of the merged '8525 and '8561 proceedings and marking it "not public."

REVIEW OF SALIENT FACTS

1. Reexamination of claims 1-4, 11, 21, and 24 of U.S. Patent No. 4,916,635 (the '635 patent) was ordered on April 13, 2007, as proceeding 90/008,525 (the '8525 proceeding) in response to a third party request for reexamination filed March 7, 2007.

2. No patent owner statement was filed in the '8525 proceeding, and the period for active participation of the third party reexamination requester has ended.

3. A second request for *ex parte* reexamination was requested by the same third party requester on March 28, 2007 and ordered for claims 1-4, 11, 21, and 24 of the '635 patent on May 24, 2007, as proceeding 90/008,561 (the '8561 proceeding).

4. No patent owner statement was filed in '8561 proceeding, and the period for active participation of the third party reexamination requester has ended.

5. A decision merging the proceedings was issued on October 30, 2007.

6. A non-final office action was mailed in the merged '8354 and '8561 proceedings on November 19, 2007.

7. A personal interview was conducted in the merged proceedings on December 13, 2007.

8. On December 18, 2007, the third party requester filed the present petition under 37 CFR 1.182 and 1.183.

DISCUSSION

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

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

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

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

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

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

Pursuant to MPEP 713.04:

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

DECISION

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

The present petition of December 18, 2007, was filed after the period for active participation of the reexamination requester had ended. The present petition is not in compliance with the requirements of 37 CFR 1.510 or 1.535, nor does the present petition qualify as a prior art statement under 37 CFR 1.501. Accordingly, it is an

improper submission, i.e., an improper paper, under the above-quoted portions of 37 CFR 1.550. See *Syntex (USA) Inc. v. U.S. Patent and Trademark Office,* 11 USPQ 2d 1866, 1868-1869 (Fed. Cir. 1989).

Because the December 18, 2007 petition paper is a improper paper, it does not have an entry right under the rules, it is not being made a part of the record of the present proceeding, and it is returnable without consideration of its substance. The copy of the December 18, 2007 petition paper was, however, scanned into the electronic Image File Wrapper (IFW) of the'8525 and the '8561 proceedings, before the discovery of the impropriety. Thus, that copy cannot be physically returned to the third party requester. Rather, the IFW copy of the paper is being expunged by closing it in the IFW file of the'8354 and '8561 proceedings and marking it "not public." It will not constitute part of the record of the present reexamination merged proceedings. The present decision will, however, be made of record in the reexamination files. See also MPEP 2267.

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

Petitioner has requested that the Office permit the third party to attend any examiner interviews, permit recordation of any examiner interview by audio and/or videograph, and permit transcription of any examiner interviews in the merged '8354 and '8561 proceedings. However, only *ex parte* interviews between the examiner and patent owner are permitted. Observation by third parties is not permitted. Pursuant to MPEP 2281, requests by reexamination requesters to participate in or to **attend** interviews will not be granted. The relief requested by petitioner with respect to recording and transcription would permit attendance by a third party in interviews, in addition to the examiner and the patent owner. Such attendance is not permitted.

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

Moreover, the substance of the interview, as made of record in the proceeding files, is available to the public. The information generated by the procedures in MPEP 2281 and 713.04 provides the entirety of the substance of the interview to be made of

record.[1] That record is available to the public and any forum that has an occasion to review the patent that was reexamined.

CONCLUSION

1. The petition requesting permission for a representative of the third party requester to observe and/or to transcribe or videotape any examiner interviews in the merged '8354 and '8561 proceedings is dismissed.

2. The petition paper is not a proper submission; accordingly, it is being expunged by closing it in the electronic Image File Wrapper (IFW) of the'8354 and '8561 proceedings and marking it "not public."

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

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

1-11-08
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[1] Pursuant to 37 CFR 1.2, "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

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Charles L. Gholz
Oblon Spivak McClelland Mauer & Neustadt
1940 Duke St.
Alexandria, VA 22314 (For Patent Owner)

MAILED

FEB 07 2008

CENTRAL REEXAMINATION UNIT

Joseph M. Potenza
Banner & Witcoff, LTD.
1100 13th St., NW, Suite 1200
Washington, DC 20005-4051 (For Requester)

In re Singer et al.	:	
Merged *Ex parte* Reexamination Proceeding	:	**DECISION ON REQUEST TO**
Control Nos. 90/008,525 & 90/008,561	:	**EXPUNGE THIRD PARTY**
Filed: March 7, 2007 & March 28, 2007	:	**PETITION**
For: U.S. Patent No.: 4,916,635	:	

This is a decision on the January 10, 2008 patent owner request to expunge the third party petition filed in the above –captioned merged proceeding on December 18, 2007, which requested permission for a representative of the third party requester to attend any examiner interviews, that any examiner interviews to be recorded by audio and/or videograph, and that any examiner interviews to be transcribed.

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

The request is dismissed as moot since the petition paper has already been expunged from the proceeding by closing it in the electronic Image File Wrapper (IFW) and marking it "not public" as it was not a proper submission. A decision dismissing the third party petition was mailed January 15, 2008.

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

2-5-08

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CENTRAL REEXAMINATION UNIT

CHOATE, HALL & STEWART LLP (For Patent Owner)
TWO INTERNATIONAL PLACE
BOSTON MA 02110

MORRISON & FOERSTER LLP (For Third Party Requester)
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

BANNER & WITCOFF, LTD. (For Third Party Requester)
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

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

In re Singer *et alia*.
Reexamination Proceeding : DECISION *SUA SPONTE*
Control No. 90/008,525 : MERGING
Request Deposited: March 7, 2007 : REEXAMINATION
For: U.S. Patent No. 4,916,635 : PROCEEDINGS

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/008,561
Request Deposited: March 28, 2007
For: U.S. Patent No. 4,916,635

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/010,123
Request Deposited: March 13, 2008
For: U.S. Patent No. 4,916,635

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. 4,916,635 (hereinafter, the '635 patent), issued to Singer *et alia*, on April 10, 1990.

2. On March 7, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,525 (hereinafter, the '8525 proceeding).

3. The Reexamination Order was granted in the '8525 proceeding on April 13, 2007.

4. On March 28, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,561 (hereinafter, the '8561 proceeding).

5. The Reexamination Order was granted in the '8561 proceeding on May 24, 2007.

6. The '8525 and the '8561 proceedings were merged on October 30, 2007.

7. An amendment adding new dependent claims 28 and 29 was filed on January 22, 2008.

8. On March 13, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/010,123 (hereinafter, the '10123 proceeding).

9. The Reexamination Order was granted in the '10123 proceeding on April 9, 2008.

10. The '635 patent expired on September 12, 2008.

DECISION

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.

37 CFR 1.530(j) further states that "[m]oreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent."

The cancellation of the original patent claims is the only "amendatory" change permitted in an expired patent.

The '635 patent expired on September 12, 2008 before the reexamination certificate issued. Since no amendments will be incorporated into the patent by a certificate after the expiration of the patent (other than cancellation of original patent claims), the amendment filed January 22, 2008 is withdrawn. All subsequent reexamination will be on the basis of the unamended patent claims.

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 '8525, '8561, and '10123 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. All subsequent reexamination will be on the basis of the unamended patent claims.

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. 90/008,525, 90/008,561, and 90/010,123 are **merged**.

2. 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

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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MAY 14 2010

CENTRAL REEXAMINATION UNIT

VENABLE LLP
P.O. BOX 34385
WASHINGTON DC 20043-9998

(For Patent Owner)

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

(For Requester)

In re Chandrasegaran
Ex Parte Reexamination Proceeding
Control No. 90/008,526
Filed: April 20, 2007
For: U.S. Patent No. 6,265,196

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 1.182**

This is a decision on the April 8, 2010 patent owner petition entitled "PETITION TO THE DIRECTOR UNDER § 1.182."

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

The petition fee under 37 C.F.R. § 1.17(f) of $400 has been submitted.

The petition is **dismissed as moot**.

BACKGROUND

- On March 13, 2007, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/007,943 ("the '7943 proceeding"), and a filing date of April 20, 2007, the date of fulfillment of the filing date requirements, was assigned to the proceeding.

- On July 13, 2007, the Office issued a decision ordering reexamination.

- On May 21, 2008, the Office issued a non-final action in the proceeding. No patent owner's statement was filed in the proceeding.

- On June 25, 2008, an interview was held between patent owner's representative and Office personnel.

- On April 1, 2009, patent owner filed a response to the non-final Office action of May 21, 2008, comprising remarks and claim amendments.

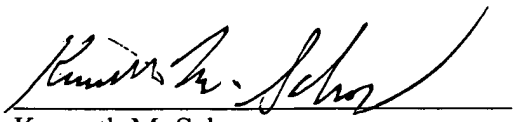
- On November 6, 2009, a final Office action was issued.
- On January 6, 2010, patent owner submitted claim amendments and remarks in response to the final Office action.
- On February 5, 2010, the Office mailed an advisory Office action denying entry of the claim amendments submitted on January 6, 2010.
- On March 8, 2010, patent owner filed a Notice of Appeal.
- On April 8, 2010, patent owner filed the instant petition entitled "PETITION TO THE DIRECTOR UNDER § 1.182," requesting entry of the amendment and remarks filed on January 6, 2010.
- On May 5, 2010, a final Office action was issued which considered, on the merits, the amendment and remarks filed on January 6, 2010.

DECISION

On May 5, 2010, the Office reopened prosecution in the instant proceeding to enter and consider, on the merits, the patent owner's amendment filed on January 6, 2010. Accordingly, patent owner's petition of April 8, 2010, requesting entry of the January 6, 2010 amendment is moot, as the relief desired by patent owner has been provided in the May 5, 2010 Office action.

CONCLUSION

- The petition is **dismissed as moot**.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.



Kenneth M. Schor
Senior Legal Advisor

Office of Patent Legal Administration

May 12, 2010
Kenpet8

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,528	03/14/2007	5679977		7588

7590 02/12/2008

EXAMINER	

LERNER, DAVID, LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,695	06/11/2007	5679977		5843

7590 02/12/2008

EXAMINER	

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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.
90/008,484	02/09/2007	5679977	8188.002.RXUS00	6502

7590 02/12/2008

EXAMINER	

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date: MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008484
PATENT NO. : 5679977
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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

MAILED
FEB 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008528
PATENT NO. : 5679977
ART UNIT : 3900

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
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1000 LOUISANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008695
PATENT NO. : 5679977
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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FEB 12 2008

CENTRAL REEXAMINATION UNIT

Lerner David Littenberg Krumholz & Mentlik (For Patent Owner)
600 South Avenue West
Westfield, NJ 07090-1497

Tracy Druce (For Third Party Requester)
Novak Druce & Quigg LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

In re Khandros *et alia*
Reexamination Proceeding
Control No. 90/008,484
Request Deposited: February 9, 2007
For: U.S. Patent No. 5,679,977

In re Khandros *et alia*
Reexamination Proceeding
Control No. 90/008,528
Request Deposited: March 15, 2007
For: U.S. Patent No. 5,679,977

In re Khandros *et alia*
Reexamination Proceeding
Control No. 90/008,695
Corrected Request Deposited: June 11, 2007
For: U.S. Patent No. 5,679,977

: 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. 5,679,977 (hereinafter, the '977 patent), issued to Khandros *et alia*, on October 21, 1997.

2. On February 9, 2007, a third party requester deposited a Request for *Ex Parte* Reexamination of the '977 patent. The reexamination proceeding was assigned Control No. 90/008,484 (hereinafter, the '8484 proceeding).

3. The Reexamination Order was granted in the '8484 proceeding on April 19, 2007.

4. There are currently no amendments in the '8484 proceeding.

5. On March 15, 2007, a third party requester deposited a Request for *Ex Parte* Reexamination of the '977 patent. The reexamination proceeding was assigned Control No. 90/008,528 (hereinafter, the '8528 proceeding).

6. The Reexamination Order was granted in the '8528 proceeding on June 12, 2007.

7. There are currently no amendments in the '8528 proceeding.

8. On June 11, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '977 patent. The reexamination proceeding was assigned Control No. 90/008,695 (hereinafter, the '8695 proceeding).

9. The Reexamination Order was granted in the '8695 proceeding on August 15, 2007.

10. There are currently no amendments in the '8695 proceeding.

11. The '8484, 8528, and '8695 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 '8484, '8528, and the '8695 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;484, 90/008,528, and 90/008,695 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.
90/008,528	03/14/2007	5679977		7588

7590 03/03/2010

EXAMINER	
ART UNIT	PAPER NUMBER

LERNER, DAVID, LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

DATE MAILED: 03/03/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED
MAR 03 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008695
PATENT NO. : 5679977
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,484	02/09/2007	5679977	8188.002.RXUS00	6502

7590 03/03/2010

EXAMINER	

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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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
TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date:
MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008484
PATENT NO. : 5679977
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.
90/008,695	06/11/2007	5679977		5843

7590 03/03/2010

EXAMINER	

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008695
PATENT NO. : 5679977
ART UNIT : 3900

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Marcus J. Millet.
LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVE. WEST
WESTFIELD NJ 07090

(For Patent Owner)

MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,484
Deposited: 09 February 2007
For: US Patent No. 5,679,977

DECISION
GRANTING
ENTRY OF MODEL
PETITION
37 CFR § 1.91(A)(3)

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,528
Deposited: 14 March 2007
For: US Patent No. 5,679,977

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,695
Deposited: 11 June 2007
For: US Patent No. 5,679,977

This is a decision on the 01 December 2009, "Petition Under 37 CFR § 1.91(a)(3)" requesting entry of models into the official record of the instant proceeding. The petition includes the required certificate of service. The petition included the required petition fee pursuant to 37 CFR § 1.17(h).

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

The petition is granted for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 21 October 1997 US Patent No. 5,679,977 was granted to Khandros *et alia.*

2. On 09 February 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,484.

3. On 19 April 2007 the Order was granted for *ex parte* reexamination in control number 90/008,483.

4. On 14 March 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,528.

5. On 12 June 2007 the Order was granted for *ex parte* reexamination in control number 90/008,528.

6. On 11 June 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008, 695.

7. On 15 August 2007 the Order was granted for *ex parte* reexamination in control number 90/008,695.

8. On 01 October 2009 the Final Office action was mailed.

9. On 01 December 2009 the instant petition and models were received.

DISCUSSION

The Patent Owner requests entry of models into the *ex parte* reexamination proceeding by filing a petition pursuant to 37 CFR 1.91(a)(3). The petitioner seeks entry to rebut statements made by the examiner. The petitioner has submitted a certificate of service and appropriate fees under 37 CFR § 1.17(h).

The extension of the model is granted.

STATEMENT OF RELEVANT AUTHORITY

MPEP § 1002.02(c) Petitions and Requests Decided by the Technology Center Directors (in-part)

> 20. Petitions under 37 CFR § 1.91 to admit a model or exhibit as part of the record of an application.

37 CFR § 1.91 Models or exhibits not generally admitted as part of application or patent.

> (a) A model or exhibit will not be admitted as part of the record of an application unless it:
> (1) Substantially conforms to the requirements of § 1.52 or § 1.84;
> (2) Is specifically required by the Office; or
> (3) Is filed with a petition under this section including:
> (i) The fee set forth in § 1.17(h); and
> (ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.
> (b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.
> (c) Unless the model or exhibit substantially conforms to the requirements of § 1.52 or § 1.84 under paragraph (a)(1) of this section, it must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of § 1.84.

ANALYSIS AND FINDINGS

The petitioner has submitted four (4) models for the purpose of rebutting statements made by the examiner. The explanation by the petitioner meets the requirement of 37 CFR 1.91(a)(3)(ii) as to why the models are necessary to demonstrate the patent owner's position and rebut statement made by the examiner. In addition the petitioner has provided the requires fee pursuant to 37 CFR 1.17(h).

Further pursuant to 37 CFR 1.91(c), photographs of the four (4) models are provided with the petition.

It is noted that the fourth model is physically located in the artifact folder associated with proceeding control number 90/008,483 since a second model of this type was unavailable to the petitioner for submission in the above identified merged proceedings.

The petitioner has met the requirements for submission of models into the *ex parte* reexamination proceedings and thus the petition is hereby granted.

CONCLUSION

1. The patent owner's petition for entry of models into the *ex parte* reexamination proceedings is hereby **granted.**

2. The proceedings are hereby forwarded to the examiner in charge of the proceeding for further handling.

3. Response should be addressed as follows:

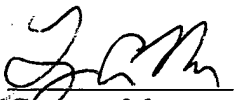
By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

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..



Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,528	03/14/2007	5679977		7588

7590 03/11/2010

EXAMINER	
ART UNIT	PAPER NUMBER

LERNER, DAVID, LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

DATE MAILED: 03/11/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

MAILED

MAR 11 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008528
PATENT NO. 5,679,977
ART UNI 3993

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

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

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P.O. Box 1450
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Marcus J. Millet.
LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVE. WEST
WESTFIELD NJ 07090

(For Patent Owner)

MAILED

MAR 11 2010

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,484
Deposited: 09 February 2007
For: US Patent No. 5,679,977

DECISION
DISMISSING
PETITION

37 CFR §§ 1.550(c) & 1.181

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,528
Deposited: 14 March 2007
For: US Patent No. 5,679,977

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,695
Deposited: 11 June 2007
For: US Patent No. 5,679,977

This is a decision on the 04 March 2010, "Petition for Extension of Time" requesting one (1) month extension of time. The petition includes the required certificate of service. The petition included the required petition fee pursuant to 37 CFR § 1.17(h).

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

The petition is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 21 October 1997 US Patent No. 5,679,977 was granted to Khandros *et alia*.

2. On 09 February 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,484.

3. On 19 April 2007 the Order was granted for *ex parte* reexamination in control number 90/008,483.

4. On 14 March 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,528.

5. On 12 June 2007 the Order was granted for *ex parte* reexamination in control number 90/008,528.

6. On 11 June 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008, 695.

7. On 15 August 2007 the Order was granted for *ex parte* reexamination in control number 90/008,695.

8. On 01 October 2009 the Final Office action was mailed.

9. On 01 December 2009 a petition for entry of models were received.

10. On 03 March 2010 the petition for entry of models was granted.

11. On 04 March 2010 a petition was submitted under 37 CFR § 1.181.

11. On 04 March the instant petition for extension of time was received.

DISCUSSION

The Patent Owner requests an extension of time while awaiting a decision of a petition filed pursuant to 37 CFR § 1.181. Since MPEP § 2272 is explicit about extensions of time filed for the purpose of

awaiting a decision on a petition filed after notice of appeal noting that the filing of a petition under 37 CFR § 1.181 does not toll the time period for filing a notice of appeal.

The petition for extension of time is dismissed.

STATEMENT OF RELEVANT AUTHORITY

37 CFR § 1.550 (c) states:

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

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

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

MPEP 2265 (in-part)

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

ANALYSIS AND FINDINGS

The petitioner seeks extension of time awaiting a decision on co-filed petition under 37 CFR § 1.181. Pursuant to MPEP § 2272 the filing of a petition under 37 CFR § 1.181 does not toll the time period for filing a notice of appeal. Absent a showing of sufficient cause the petition for extension of time is dismissed.

The petition for extension of time is hereby dismissed.

CONCLUSION

1. The patent owner's petition for one (1) month extension of time is hereby dismissed.

2. The proceedings are hereby forwarded to the examiner in charge of the proceeding for further handling.

3. Response should be addressed as follows:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft

scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,528	03/14/2007	5679977		7588

7590 04/13/2010

EXAMINER

LERNER, DAVID, LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

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APR 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008528
PATENT NO. : 5679977
ART UNIT : 3900

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

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,484	02/09/2007	5679977	8188.002.RXUS00	6502

7590 04/13/2010

EXAMINER	

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date:

MAILED

APR 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008484
PATENT NO. : 5679977
ART UNIT : 3900

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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.
90/008,695	06/11/2007	5679977		5843

7590 04/13/2010

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2010

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

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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

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

Date:

MAILED

APR 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008695
PATENT NO. : 5679977
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
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Marcus J. Millet
LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVE. WEST
WESTFIELD, NJ 07090

(For Patent Owner)

MAILED

APR 13 2010

CENTRAL REEXAMINATION UNIT

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUSIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

In re: Khandros *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,484
Deposited: 09 February 2007
For: U.S. Patent No.: 5,679,977

In re: Khandros *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,528
Deposited: 14 March 2007
For: U.S. Patent No.: 5,679,977

In re: Khandros *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,695
Deposited: 11 June 2007
For: U.S. Patent No.: 5,679,977

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on 04 March 2010. The petition is entitled "PETITION UNDER 37 CFR §§ [sic] 1.181 FOR ENTRY OF EXHIBITS AND PHYSICAL SAMPLES ACCOMPANYING PATENT OWNER'S RESPONSE TO FINAL

OFFICE ACTION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to enter the evidence submitted 01 December 2009 in response to the final rejection.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated 04 March 2010 is granted with respect to entry of the evidence submitted on 01 December 2009.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 5,679,977 issued on 21 October 1997.
- Three requests for *ex parte* reexamination were filed and assigned control nos. 90/008,484, 90/008,528, and 90/008,695.
- *Ex parte* reexamination was ordered in each proceeding and they were merged in a decision mailed 12 February 2008.
- Prosecution progressed in the merged proceeding until a Final Rejection was mailed on 01 October 2009.
- On 01 December 2009, the Patent owner filed an after-final amendment. The submission included various evidence, including exhibits 1-4, 7-9, and 11 and Samples A-D [collectively, "Rebuttal Evidence"] that are the subject of the instant petition.
- On 14 January 2010, an Advisory Action was mailed, entering the after-final amendment but refusing entry of the Rebuttal Evidence, stating that Patent owner failed to provide a showing of good and sufficient reasons why the evidence was necessary and not earlier presented as required by 37 CFR § 1.116(e).
- On 20 January 2010, another Advisory Action was mailed because the previous action did not set a time period for response. The time was set at 4 months from the date of the Final Rejection. The reasoning for not entering the Rebuttal Evidence was repeated from the prior Advisory Action.

- On 04 February 2010, the Patent owner filed a Notice of Appeal to the Board of Patent Appeals and Interferences.

- On 04 March 2010 the instant petition was received.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal (in part):

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

37 CFR § 1.181 Petition to the Director (in part):

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court . . . .

DECISION

The Patent owner [hereinafter "petitioner"] states that the examiner erred in deciding not to enter the Rebuttal Evidence filed on 01 December 2009 after the Final Rejection. Petitioner explains that the examiner provided new arguments and evidence for the first time in the Final Rejection, and the Rebuttal Evidence is necessary to rebut the examiner's position. It is noted that petitioner does not seek withdrawal of the finality of the action or continued prosecution, but simply seeks that the evidence be entered for the purpose of appeal.

Rule 1.116(e) requires that there be "a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." The Director agrees with the petitioner that the required showing has been made here. The Rebuttal Evidence is necessary in that it directly rebuts the positions set forth by the examiner. For example, dictionary definitions

are provided to rebut the examiner's definition of a word, web pages citing the Young's modulus of various materials are provided to rebut the examiner's assertion that such materials are inherently flexible, and declarations are provided asserting the examiner's statements as to some references are incorrect. The Rebuttal Evidence will provide a more complete record on which the Board can base its decision.

Additionally, the Rebuttal Evidence could not have been earlier presented because the rebuttal is of points first made by the examiner in the Final Rejection. For example, the examiner argued for the first time in the Final Rejection that the dimensions of certain substrates render them inherently flexible. Further, the examiner first relied on the Stout and Otsuka references in the Final Rejection to support her arguments. Without knowing that the examiner would take such positions, there was no reason for petitioner to provide at an earlier time evidence of, for example, the flexibility of certain materials or evidence rebutting the Stout and Otsuka references.

This is not a case where the petitioner withheld useful evidence hoping it would not be needed, and provided it only when other avenues were unsuccessful. This is a situation where the petitioner provided the evidence in the next submission after the examiner first made these particular statements. The Director finds that there is a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented. Rule 1.116(e) is therefore satisfied.

Accordingly, the Rebuttal Evidence is entered into the record and patent owner's petition is granted.

CONCLUSION

1. The petition under 37 CFR § 1.181 for reconsideration of the entry of the Rebuttal Evidence filed 01 December is granted. Exhibits 1-4, 7-9, and 11 and Samples A-D of that submission are entered into the record.

2. The time period for response is not changed by this decision. See the Decision mailed 11 March 2010.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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.
90/008,534	03/19/2007	6947254	10760/346	2377

24978 7590 03/03/2008

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,463	02/02/2007	6947254	4389.77166	4685

24978 7590 03/03/2008

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas R. Fitzsimons
Greer, Burns & Crain, Ltd.
300 S. Wacker Drive, Suite 2500
Chicago, IL 60606

(For Patent Owner)

MAILED

MAR 03 2008

CENTRAL REEXAMINATION UNIT

Michelle Camaiux
Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

(For Third Party Requester)

In re Edwards *et alia*
Reexamination Proceeding
Control No. 90/008,463
Request Deposited: February 2, 2007
For: U.S. Patent No. 6,947,254

In re Edwards *et alia*
Reexamination Proceeding
Control No. 90/008,534
Corrected Request Deposited: March 19, 2007
For: U.S. Patent No. 6,947,254

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. 6,947,254 (hereinafter, the '254 patent), issued to Edwards *et alia*, on September 20, 2005.

2. On February 2, 2007, Patent Owner deposited a Request for *Ex Parte* Reexamination of the '254 patent. The reexamination proceeding was assigned Control No. 90/008,463 (hereinafter, the '8463 proceeding).

3. The Reexamination Order was granted in the '8463 proceeding on April 25, 2007.

4. There are currently no amendments in the '8463 proceeding.

5. On March 19, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '254 patent. The reexamination proceeding was assigned Control No. 90/008,534 (hereinafter, the '8534 proceeding).

6. The Reexamination Order was granted in the '8534 proceeding on April 25, 2007.

7. There are currently no amendments in the '8534 proceeding.

8. The '8463 and '8534 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 '8463 and the '8534 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. 90/008,463 and 90/008,534 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,534	03/19/2007	6947254	10760/346	2377

24978 7590 09/10/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/10/2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Michelle Camiaux
Kenyon and Kenyon LLP
One Broadway
New York, NY 10004

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SEP 10 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,463, 90/008,534

PATENT NO. 6947254.

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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Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

(For Requester)

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SEP 10 2009

CENTRAL REEXAMINATION UNIT

In re Edwards et al
Ex Parte Reexamination Proceeding
Control No. 90/008,463
Filed: February 2, 2007
For: U.S. Patent 6,947,254

DECISION DISMISSING PETITION

In re Edwards et al
Ex Parte Reexamination Proceeding
Control No. 90/008,534
Filed: March 19, 2007
For: U.S. Patent No. 6,947,254

This is a decision on the June 15, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the June 15, 2009 patent owner petition to revive").

The June 15, 2009 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been received.

SUMMARY

The June 15, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding . . .

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed

by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon . . . for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.116 provides, in pertinent part:

(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).

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 § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

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

37 CFR 41.37 provides, in pertinent part:

(a)

(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

MPEP 711.03(c) II A 2 (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 . . .

An application subject to a final action in which a proposed amendment under 37 CFR 1.116 is filed as the required reply will normally be routed by the Office of Petitions to the Technology Center (TC) to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The examiner is instructed that if the reply places the application in condition for allowance, the examiner should write in the margin of the reply "OK to enter upon revival." For Image File Wrapper (IFW) processing, see IFW Manual. If the petition is otherwise grantable and the examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If, on the other hand, the reply would not place the application in condition for allowance, the examiner is instructed to complete form PTOL-303 and return the form to the Office of Petitions with the application. Form PTOL-303 should not be mailed to the applicant by the examiner. In this situation, the Office of Petitions will not grant the petition. A copy of the form PTOL-303 is marked with the notation "Courtesy Copy" by the Office of Petitions. The courtesy copy is sent as an attachment with the decision on the petition. The advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the amendment after final rejection.

MPEP 711.03(c) II A 2 (c) provides, in pertinent part:

Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995. . . ; or

(C) the filing of a continuing application under 37 CFR 1.53(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 II, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response[1] to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

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 June 15, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively. The patent owner has not, however, satisfied item (1), because the patent owner has not provided a proper response to the outstanding Office action.

Regarding item (1), the required response must be an appeal brief in compliance with 37 CFR 41.37(c) and (b) an appeal brief fee.[2] The filing of an amendment, however, that places the proceeding in condition for issuance of a reexamination certificate, i.e., in a condition in which all of the claims under reexamination are cancelled, or in a condition in which all of the claims under reexamination are patentable or confirmed, may also satisfy the reply requirement in a reexamination proceeding.[3] The patent owner, however, has not satisfied item (1), because the patent owner has not filed an appeal brief and appropriate fee, and because the amendment filed by the patent owner on June 15, 2009 does not place the proceeding in condition for issuance of a reexamination certificate, i.e., a condition in which all of the claims under reexamination are cancelled, or in a condition in which all of the claims under reexamination are patentable or confirmed. See the advisory action, which is attached to this decision. For the reasons given in the attached advisory action, the amendment filed on June 15, 2009 fails to comply with the reply requirement of 37 CFR 1.137(b)(1).

Accordingly, the June 15, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[4] is **dismissed**.

---

[2] See MPEP 2268 IV and, in addition, MPEP 711.03(c) II A 2 (c), which also states that the reply may be the filing of an RCE accompanied by a submission and the requisite fee, or the filing of a continuing application under 37 CFR 1.53(b). The Request for Continued Reexamination (RCE) practice established by 37 CFR 1.114, however, does not apply to a patent under reexamination. See 37 CFR 1.114(e)(5). A continuing application under 37 CFR 1.53(b) also does not apply to a patent under reexamination. RCE practice, and continuation practice, does not apply in reexamination because a reexamination proceeding is not an "application" under 37 CFR 1.53.

[3] An amendment pursuant to 37 CFR 1.116, however, does apply to a patent under reexamination. See 37 CFR 1.113 and 37 CFR 1.116. See also 37 CFR 41.33(a), which provides:

> Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

To satisfy the reply requirement for a petition to revive under 37 CFR 1.137(b), however, an amendment pursuant to 37 CFR 1.116 must "[cancel] all rejected claims or otherwise *prima facie* [place] the [proceeding] in condition for allowance." See MPEP 711.03(c) II A 2 (b), which provides, in pertinent part:

> A reply under 37 CFR 1.113 to a final action must include . . . cancellation of . . . each claim so rejected. Accordingly, . . . the reply required for consideration of a petition to revive must be:
>
> *
>
> (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 . . .

[4] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file an appeal brief pursuant to 37 CFR 41.37(a).

CONCLUSION

- The June 15, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

- Any grantable renewed petition under 37 CFR 1.137(b), that is filed in response to this decision, must be accompanied by either an appeal brief and appropriate fee, or by an amendment that places the proceeding in a condition in which all of the claims under reexamination are cancelled, or in a condition in which all of the claims under reexamination are patentable or confirmed. If the patent owner desires to submit such an amendment, the amendment should be included in a cover letter entitled **"Renewed Petition under 37 CFR 1.137(b)."**

- Jurisdiction over this merged reexamination proceeding is being retained by the Office of Patent Legal Administration pending a response to this decision, or the expiration of time to respond to this decision.

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

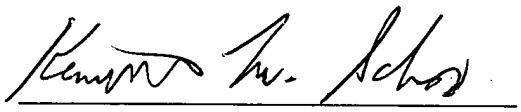
- All correspondence relating to this petition in this merged *ex parte* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Ex Parte* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



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

Attachment: Advisory Action

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.
90/008,534	03/19/2007	6947254	10760/346	2377

24978 7590 11/12/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Kenyon & Kenyon
One Broadway
New York, NY 10004

Date:

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008534
PATENT NO. : 6947254
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.
90/008,463	02/02/2007	6947254	4389.77166	4685

24978 7590 11/12/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Greer, Burns, & Crain
300 S.Wacker Drive
25th Floor
Chicago, IL 60606

(For Patent Owner)

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

(For Requester)

In re Edwards et al
Ex Parte Reexamination Proceeding
Control No. 90/008,463
Filed: February 2, 2007
For: U.S. Patent 6,947,254

DECISION GRANTING PETITION

In re Edwards et al
Ex Parte Reexamination Proceeding
Control No. 90/008,534
Filed: March 19, 2007
For: U.S. Patent No. 6,947,254

This is a decision on the October 5, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the October 5, 2009 patent owner petition to revive").

The October 5, 2009 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to deposit account no. 07-2069 as authorized in the paper entitled "Reexamination Transmittal" filed on October 5, 2009.

SUMMARY

The October 5, 2009 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 1.116 provides, 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).

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 § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

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

37 CFR 41.37 provides, in pertinent part:

(a)

(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

MPEP 711.03(c) II A 2 (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 . . .

An application subject to a final action in which a proposed amendment under 37 CFR 1.116 is filed as the required reply will normally be routed by the Office of Petitions to the Technology Center (TC) to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The examiner is instructed that if the reply places the application in condition for allowance, the examiner should write in the margin of the reply "OK to enter upon revival." For Image File Wrapper (IFW) processing, see IFW Manual. If the petition is otherwise grantable and the examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If, on the other hand, the reply would not place the application in condition for allowance, the examiner is instructed to complete form PTOL-303 and return the form to the Office of Petitions with the application. Form PTOL-303 should not be mailed to the applicant by the examiner. In this situation, the Office of Petitions will not grant the petition. A copy of the form PTOL-303 is marked with the notation "Courtesy Copy" by the Office of Petitions. The courtesy copy is sent as an attachment with the decision on the petition. The advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the amendment after final rejection.

MPEP 711.03(c) II A 2 (c) provides, in pertinent part:

Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995. . . ; or

(C) the filing of a continuing application under 37 CFR 1.53(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 II, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response[1] to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the October 5, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), the required response must be an appeal brief in compliance with 37 CFR 41.37(c) and (b) an appeal brief fee.[2] The filing of an amendment, however, that places the proceeding in condition for issuance of a reexamination certificate, i.e., in a condition in which all of the claims under reexamination are cancelled, or in a condition in which all of the claims under reexamination are patentable or confirmed, may also satisfy the reply requirement in a reexamination proceeding.[3] The amendment filed on October 5, 2009 has satisfied item (1), because the amendment places the proceeding in a condition that permits the processing by the Office of a notice of intent to issue a reexamination certificate (NIRC), and has been entered by the examiner as indicated on the attached copy of the amendment. For this reason, the amendment is deemed to comply with the reply requirement of 37 CFR 1.137(b)(1).

Accordingly, the October 5, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[4] is **granted**.

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[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

[2] See MPEP 2268 IV and, in addition, MPEP 711.03(c) II A 2 (c), which also states that the reply may be the filing of an RCE accompanied by a submission and the requisite fee, or the filing of a continuing application under 37 CFR 1.53(b). The Request for Continued Reexamination (RCE) practice established by 37 CFR 1.114, however, does not apply to a patent under reexamination. See 37 CFR 1.114(e)(5). A continuing application under 37 CFR 1.53(b) also does not apply to a patent under reexamination. RCE practice, and continuation practice, does not apply in reexamination because a reexamination proceeding is not an "application" under 37 CFR 1.53.

[3] An amendment pursuant to 37 CFR 1.116, however, does apply to a patent under reexamination. See 37 CFR 1.113 and 37 CFR 1.116. See also 37 CFR 41.33(a), which provides:

> Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

To satisfy the reply requirement for a petition to revive under 37 CFR 1.137(b), however, an amendment pursuant to 37 CFR 1.116 must "[cancel] all rejected claims or otherwise *prima facie* [place] the [proceeding] in condition for allowance." See MPEP 711.03(c) II A 2 (b), which provides, in pertinent part:

> A reply under 37 CFR 1.113 to a final action must include . . . cancellation of . . . each claim so rejected. Accordingly, . . . the reply required for consideration of a petition to revive must be:
>
> *
>
> (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 . . .

[4] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file an appeal brief pursuant to 37 CFR 41.37(a).

CONCLUSION

- The October 5, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

- Jurisdiction over this merged reexamination proceeding is being returned to the Central Reexamination Art Unit 3992 for processing of the October 5, 2009 patent owner amendment.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Matthew Heneghan, of CRU Art Unit 3992, at (571) 272-3834.

- Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7724.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

Attachment: Copy of October 5, 2009 Amendment Initialed by Examiner

4389.77166
71338 U.S. PTO

PATENT

10/05/09

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Edwards et al.
Reexamination No.	90/008,463; 90/008,534 (merged)
U.S. Patent No.	6,947,254
Issue Date:	September 20, 2005
For:	INTERCHANGEABLE CARTRIDGE DATA STORAGE SYSTEM FOR DEVICES PERFORMING DIVERSE FUNCTIONS

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

October 1, 2009
Date

Registration No. 40,007
Attorney for Applicant(s)

OK TO ENTER: /MH/
11/09/2009

REEXAMINATION AMENDMENT B

AFTER FINAL (FOURTH RESUBMISSION)

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

Sir:

This Amendment B is being Resubmitted a fourth time in response to the Decision Dismissing Petition mailed on September 10, 2009. That Decision indicated that errors remained in the Amendment B, Third Resubmission, since claims 11-20 were not labeled "New" and since rejected claims were not cancelled. Corresponding changes have been made in this Amendment B, FOURTH Resubmission. No other changes are made.

Further, it is noted that no appeal brief has been filed, and that this Reexamination proceeding has been closed, leaving the reexamination application abandoned. A Petition to Revive was filed with the Amendment B, Third Resubmission.

The present Fourth Resubmission is being filed together with a Renewed Petition under 37 CFR §1.137(b) as suggested so that the attached Amendment can be entered, which will result in the claims being placed into allowable form. The amendments only place claims that were previously objected to in a condition suitable to be allowed, and change the dependency of some other claims to depend from newly allowable claim 2. All other rejected claims are cancelled.

AMENDMENTS TO THE CLAIMS

Pursuant to 1.530(d)-(j), please cancel claims 1, 6-10, 14-17, and 19-20.

The status of the claims is:

1. (Cancelled)

2. (Twice Amended) [The data storage system recited in claim 1 further comprising:] An interchangeable data storage system comprising:

a drive in one of a plurality of devices for generating signals, wherein a first of the plurality of devices is a host computer, a second device is a portable game, and a third of the plurality of devices is selected from the group consisting of: electronic books, global positioning systems, personal digital systems, cellular phones and digital cameras;

a miniature storage device having a rotatable medium capable of storing signals from each of the plurality of devices; wherein said drive writes said signals to and reads said signals from said storage device so that said storage device can be interchangeably operated upon by said first, second, and third of the plurality of devices, said miniature storage device dimensioned smaller than a standard full size cartridge; and [.]

a caddy for accommodating said storage device, said caddy having an interface for transferring signals between said caddy and said host computer, each of the plurality of devices having a motor for driving rotation of said rotatable medium at a first speed, said caddy having a plurality of gears that translate said first speed from said motor to a higher rotational speed, one or more of said plurality of gears linked to said rotatable medium wherein said rotatable medium rotates at a speed in said caddy that is higher than said first speed.

3. (Currently Amended) The data storage system recited in claim [1]2, wherein said storage device comprises flexible magnetic media.

4. (Currently Amended) The data storage system recited in claim [1]2, wherein said storage device comprises rigid magnetic media.

5. (Currently Amended) The data storage system recited in claim [1]2, wherein said storage device comprises optical media.

6.-10. (Cancelled)

11. (New) An interchangeable data storage system as defined by claim 2 wherein said miniature storage device further comprises a mini-cartridge including a shell enclosing said medium, said shell providing access to said rotating medium wherein the device may write to and read from said rotating medium, said shell being generally square shaped with a top wall, a bottom wall, and having opposing sidewalls and endwalls connecting said top wall to said bottom wall, a wedge shaped cut-out in at least one of said sidewalls configured to receive a cooperating wedge lock from each of said plurality of devices, wherein engagement of said wedge lock with said wedge shaped cut-out locks said shell in place in said device.

12. (New) An interchangeable data storage system as defined by claim 2 wherein said rotatable medium is contained in a shell that includes a shutter moveable into an open position wherein said rotatable medium may have data written thereto and read therefrom by one or more moveable arms in each of said host computer, portable game, and a third device, movement of said shutter allowing said arms from each of said host computer, portable game, and a third device to operatively access said rotatable medium.

13. (New) An interchangeable data storage system as defined by claim 12 wherein said shell is configured to engage a spring in each of said host computer,

second, and third devices, said spring providing a spring force useful to eject said miniature storage device from said at least one of said plurality of devices.

14.-17. (Cancelled)

18. (Previously Presented) An interchangeable data storage system as defined by claim 2, wherein said plurality of gears include at least three gears and are configured to cause said medium to rotate at the same angular velocity but a greater speed than a full size drive magnetic medium.

19.-20. (Cancelled)

STATUS OF THE CLAIMS

Pursuant to §1.530(e), the status of the claims as of the date of the above amendments is:

Claim:	Status:	Support for Amendment:
1	Cancelled	
2	Twice Amended	(See Remarks below)
3	Amended	(See Remarks below)
4	Amended	(See Remarks below)
5	Amended	(See Remarks below)
6	Cancelled	
7	Cancelled	
8	Cancelled	
9	Cancelled	
10	Cancelled	
11	Amended	(See Remarks below)
12	Amended	(See Remarks below)
13	Previously Presented	
14	Cancelled	
15	Cancelled	
16	Cancelled	
17	Cancelled	
18	Previously Presented	
19	Cancelled	
20	Cancelled	

REMARKS

This Amendment B is being resubmitted a Fourth time in response to the Decision Dismissing Petition mailed on September 10, 2009. That Decision indicated that errors remained in the proposed amendment to claims since claims were not cancelled and claims 11-20 were not labeled as "new." That Decision indicated that if all claims were put in a condition for reissuance (by canceling rejected claims and correcting label errors to claims 11-20) and a Renewed Petition under 37 CFR §1.137(b) were submitted, the amendment could be entered. Corresponding changes have been made in this Amendment B, Fourth Resubmission. In particular, claims 1, 6-10, 14-17, 19 and 20 have been cancelled and claims 11-13 and 18 relabeled as "New."

It is noted that no appeal brief has been filed, and that this Reexamination proceeding has been closed leaving the reexamination application abandoned. A Renewed Petition to Revive has been filed herewith so that the attached Amendment can be entered, which will result in the claims being placed into allowable form. The amendments only place claims that were previously objected to in a condition suitable to be allowed, and change the dependency of some other claims to depend from newly allowable claim 2. Other rejected claims have been cancelled.

In the Reexamination Final Office Action mailed on December 17, 2008, claims 2 and 18 were patented or confirmed, and indicated to be allowable if rewritten in independent form. Claims 2 and 18 were also rejected under §112 based on a typographical error. Claim 2 has been amended to include the limitations of claim 1 from which it formerly depended, and to address the typographical errors pointed out in the Final Action. Claim 2 as amended is therefore allowable. Other claims (3, 4, 5, 11 and 12) have been amended to depend from allowable claim 2, and these other claims are therefore allowable. All other claims have been cancelled.

Pursuant to §1.550(f), this submission is being served on third party requestor at the correspondence address indicated on the Office Action on today's date by first class mail.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

Thomas R. Fitzsimons
Registration No. 40,607

October 1, 2009

Suite 2500
300 South Wacker Drive
Chicago, Illinois 60606
(312) 360-0080
Customer No. 24978
P:\DOCS\4389\77166\F76059.DOC

Reexam

4389.77166

PATENT

71338 U.S. PTO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

10/05/09

OIPE IAP10 OCT 05 2009 PATENT & TRADEMARK OFFICE

Applicant:	Edwards et al.
Reexamination No.	90/008,463; 90/008,534 (merged)
U.S. Patent No.	6,947,254
Issue Date:	September 20, 2005
For:	INTERCHANGEABLE CARTRIDGE DATA STORAGE SYSTEM FOR DEVICES PERFORMING DIVERSE FUNCTIONS

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

October 1, 2009
Date

Registration No. 40,607
Attorney for Applicant(s)

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

REEXAMINATION TRANSMITTAL

Sir:

Transmitted herewith is a communication regarding the above-identified reexamination proceeding. This proceeding is a Merged Reexamination of two Reexaminations. The below referenced submissions are being provided in duplicate with original signatures in a single filing in accordance with the March 3, 2008 Decision Sua Sponte Merging Reexamination Proceedings.

Fee Calculation For Claims As Amended

	As Amended		Previously Paid For		Present Extra		Rate		Additional Fee
Total Claims	8	-	20	=	0	x	$52.00	=	$ 00.00
Independent Claims	1	-	3	=	0	x	$220.00	=	$ 00.00
Fee for Multiple Dependent Claims							$390.00	=	$ 00.00
					Total Additional Fee				$ 00.00
					Small Entity Fee (reduced by half)				$ 00.00

(X) Renewed Petition Under 37 CFR 1.137(b) with Reexamination Amendment B After Final (FOURTH RESUBMISSION) with Certificate of Service.

(X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By: _____
Thomas R. Fitzsimons
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4389.77166 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Edwards et al.
Reexamination No.	90/008,463; 90/008,534 (merged)
U.S. Patent No.	6,947,254
Issue Date:	September 20, 2005
For:	INTERCHANGEABLE CARTRIDGE DATA STORAGE SYSTEM FOR DEVICES PERFORMING DIVERSE FUNCTIONS

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October 1, 2009
Date

Registration No. 40,607
Attorney for Applicant(s)

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

REEXAMINATION TRANSMITTAL

Sir:

Transmitted herewith is a communication regarding the above-identified reexamination proceeding. This proceeding is a Merged Reexamination of two Reexaminations. The below referenced submissions are being provided in duplicate with original signatures in a single filing in accordance with the March 3, 2008 Decision Sua Sponte Merging Reexamination Proceedings.

Fee Calculation For Claims As Amended

	As Amended		Previously Paid For		Present Extra		Rate		Additional Fee
Total Claims	8	-	20	=	0	x	$52.00	=	$ 00.00
Independent Claims	1	-	3	=	0	x	$220.00	=	$ 00.00
Fee for Multiple Dependent Claims							$390.00	=	$ 00.00
					Total Additional Fee				$ 00.00
					Small Entity Fee (reduced by half)				$ 00.00

(X) Renewed Petition Under 37 CFR 1.137(b) with Reexamination Amendment B After Final (FOURTH RESUBMISSION) with Certificate of Service.

(X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Mail

International Business Machines Corporation
Intellectual Property Law
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For Patent Owner

Kinton, John
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401 B Street
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San Diego, CA 92101-4297

For Requester

MAILED

JUL 27 2007

CENTRAL REEXAMINATION UNIT

In re Hetzler
Ex Parte Reexamination Proceeding
Control No. 90/008,541
Filed: March 19, 2007
For: US Patent No. 5,440,474

DECISION GRANTING PETITION UNDER 37 CFR 1.515(c)

This is a decision on the May 30, 2007, "Requestor's Petition Under 37 CFR 1.181." Petitioner, the Third Party Requester, requests that the decision denying the request for reexamination of US Patent 5,440,474 be reversed.

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

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

Background

1. On March 19, 2007, a third party REQUEST FOR *EX PARTE* REEXAMINATION of U.S. Patent No.5,44,474 was filed. Reexamination was requested based on a variety of references in various combinations. Reference is made to the Request for details thereof.

2. On April 30, 2007, 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 May 30, 2007, the present petition was timely 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.*

Petitioner argues that a substantial new question of patentability is raised by the following:
1. Fischler in view of the CL-SH350 datasheet;
2. The CL-SH350 datasheet in view of King;
3. Fischler in view of Kowal.

The standard for determining the presence of a substantial new question of patentability is discussed in MPEP 2242:

> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.
>
> For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. It is not necessary that a "prima facie" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications. As to the importance of the difference between "a substantial new question of patentability" and a "prima facie" case of unpatentability see generally In re Etter, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).

Taking the above into account, is cannot be agreed that Fischler in view of the CL-SH350 datasheet (simply 'the datasheet' hereafter) raises a substantial new question of patentability. While the datasheet arguably discloses servo sectors located within data sectors, the datasheet does not show "a plurality of equally angularly-spaced" servo sectors. Contrary to petitioner's arguments, Fischler in no way cures this deficiency. The radial lines in Fischler's Figure 6, which petitioner apparently

feels are servo sectors, are not described in Fischler as such. They are in fact not specifically described in Fischler at all. Petitioner's assumption that they are servo tracks is simply that – an assumption. Thus the combination of Fischler and the datasheet lacks a key element of each claim. Given that, a reasonable examiner would not consider their combination important in deciding whether or not the claims are patentable.

However, it is agreed that the datasheet in view of King does indeed raise a substantial new question of patentability. As previously noted the datasheet arguably includes servo sectors located within data sectors, but not a plurality of equally angularly spaced servo sectors. As alleged in the petition, King arguably does show a plurality of equally angularly-spaced servo sectors. Thus a reasonable examiner would consider the teachings of the datasheet and King important in deciding whether or not the claims 1 and 3 are patentable.

With respect to Fischler in view of Kowel, is agreed that Kowel discloses "a data sector that spans a servo field" and hence arguably discloses servo sectors located within data sectors. However, neither Fischler (as discussed above) nor Kowel appear to disclose 'equally angularly-spaced" servo sectors, nor was this limitation addressed in the petition in regards to this combination of references. Thus, a reasonable examiner would not consider their combination important in deciding whether or not the claims are patentable.

Conclusion

The CL-SH350 datasheet in view of King raises a substantial new question of patentability with regards to at least independent claims 1 and 3. The Office will further exercise its discretion to reexamine dependent claims 2, 4, 5, and 6 as well.

The petition is therefore **GRANTED**.

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.

The Patent Owner's statement is due 2-months from the mailing date of this response under 37 CFR 1.530. The Patent Owner's statement 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

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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Last Page

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Mail

International Business Machines Corporation Intellectual Property Law 650 Harry Road San Jose, CA 95120	:	For Patent Owner
Kinton, John DLA Pitper US, LLP 401 B Street Suite 1700 San Diego, CA 92101-4297	:	For Requester
In re Hetzler *Ex Parte* Reexamination Proceeding Control No. 90/008,541 Filed: March 19, 2007 For: US Patent No. 5,440,474	:	DECISION GRANTING PETITION UNDER 37 CFR 1.515(c)

MAILED

JUL 27 2007

CENTRAL REEXAMINATION UNIT

This is a decision on the May 30, 2007, "Requestor's Petition Under 37 CFR 1.181." Petitioner, the Third Party Requester, requests that the decision denying the request for reexamination of US Patent 5,440,474 be reversed.

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

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

Background

1. On March 19, 2007, a third party REQUEST FOR *EX PARTE* REEXAMINATION of U.S. Patent No.5,44,474 was filed. Reexamination was requested based on a variety of references in various combinations. Reference is made to the Request for details thereof.

2. On April 30, 2007, 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 May 30, 2007, the present petition was timely 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.*

Petitioner argues that a substantial new question of patentability is raised by the following:
1. Fischler in view of the CL-SH350 datasheet;
2. The CL-SH350 datasheet in view of King;
3. Fischler in view of Kowal.

The standard for determining the presence of a substantial new question of patentability is discussed in MPEP 2242:

> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.
>
> For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. It is not necessary that a "prima facie" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications. As to the importance of the difference between "a substantial new question of patentability" and a "prima facie" case of unpatentability see generally In re Etter, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).

Taking the above into account, is cannot be agreed that Fischler in view of the CL-SH350 datasheet (simply 'the datasheet' hereafter) raises a substantial new question of patentability. While the datasheet arguably discloses servo sectors located within data sectors, the datasheet does not show "a plurality of equally angularly-spaced" servo sectors. Contrary to petitioner's arguments, Fischler in no way cures this deficiency. The radial lines in Fischler's Figure 6, which petitioner apparently

feels are servo sectors, are not described in Fischler as such. They are in fact not specifically described in Fischler at all. Petitioner's assumption that they are servo tracks is simply that – an assumption. Thus the combination of Fischler and the datasheet lacks a key element of each claim. Given that, a reasonable examiner would not consider their combination important in deciding whether or not the claims are patentable.

However, it is agreed that the datasheet in view of King does indeed raise a substantial new question of patentability. As previously noted the datasheet arguably includes servo sectors located within data sectors, but not a plurality of equally angularly spaced servo sectors. As alleged in the petition, King arguably does show a plurality of equally angularly-spaced servo sectors. Thus a reasonable examiner would consider the teachings of the datasheet and King important in deciding whether or not the claims 1 and 3 are patentable.

With respect to Fischler in view of Kowel, is agreed that Kowel discloses "a data sector that spans a servo field" and hence arguably discloses servo sectors located within data sectors. However, neither Fischler (as discussed above) nor Kowel appear to disclose 'equally angularly-spaced" servo sectors, nor was this limitation addressed in the petition in regards to this combination of references. Thus, a reasonable examiner would not consider their combination important in deciding whether or not the claims are patentable.

Conclusion

The CL-SH350 datasheet in view of King raises a substantial new question of patentability with regards to at least independent claims 1 and 3. The Office will further exercise its discretion to reexamine dependent claims 2, 4, 5, and 6 as well.

The petition is therefore **GRANTED**.

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.

The Patent Owner's statement is due 2-months from the mailing date of this response under 37 CFR 1.530. The Patent Owner's statement may be submitted as follows:

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

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

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Alexandria, VA 22314

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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AUG 0 1 2007

CENTRAL REEXAMINATION UNIT

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ONE BROADWAY
NEW YORK, NY 10004 : (for requestor)

In re VOGEL
Ex Parte Reexamination Proceeding
Control No. 90/007,746
Filed: October 13, 2005
US Patent No: 4,930,158
Title: **Selective Video Playing System** : *SUA SPONTE* DECISION MERGING REEXAMINATION PROCEEDINGS

In re VOGEL
Ex Parte Reexamination Proceeding
Control No. 90/008,544
Filed: January 31, 2007
US Patent No: 4,930,158
Title: **Selective Video Playing System**

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

BACKGROUND

1. Patent No. 4,930,158 issued on May 29, 1990.

2. A first request for Reexamination control number 90/007,746 was made by a third party requester was made October 13, 2005 by a third party requester for reexamination of claims 1-10 and 12-21.

3. Reexamination was ordered in the '7746 reexamination proceeding on December 13, 2005.

4. A request for reexamination, Reexamination Control No. 90/008,544, was filed by the third party requester on January 31, 2007. This request was directed to claims 1-10 and 12-21

5. Reexamination was ordered in the '8,544 reexamination proceeding on April 20, 2007.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '7,746 and 8,544 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. Since there are no amendments to the claims in either proceeding there is no requirement for a "housekeeping" amendment.

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/7,746 and 90/008,544 are merged. The proceeding is returned to the Examiner in charge for response after non-final action entered.

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

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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.
90/008,544	01/31/2007	4930158	10760/326	2896

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.

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David L. Fehrman
MORRISON & FOERSTER LLP
555 W. Fifth Street, Suite 3500
Los Angeles, CA 90013

MAILED

APR 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,544, 90/007,746

PATENT NO. 4930158.

ART UNIT 3992.

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

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

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
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For Patent Owner)

Morrison & Foerster LLP
555 West Fifth Street
Suite 3500
Los Angeles, CA 90013-1024

(For Third-Party Requester)

In re: Vogel
Reexamination Proceeding
Control No. 90/007,746
Request Deposited: October 13, 2005
For: U.S. Patent No. 4,930,158

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

In re: Vogel
Reexamination Proceeding
Control No. 90/008,544
Request Deposited: January 31, 2007
For: U.S. Patent No. 4,930,158

This is a decision on the April 21, 2008, "PATENT OWNER'S REQUEST FOR EXTENSION OF TIME TO FILE RESPONSE TO OFFICE ACTION PURSUANT TO 37 CFR 1.550(C)" requesting that the time to submit a Patent Owner response be extended an additional 35 days.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 4,930,158 (hereinafter, the '158 patent), issued to Vogel, on May 29, 1990 from application number 07/237,175, filed August 29, 1988.

2. On October 13, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '158 patent. The reexamination proceeding was assigned Control No. 90/007,746 (hereinafter, the '7746 proceeding).

3. The reexamination order was granted in the '7746 proceeding on December 13, 2005.

4. A non-final rejection was mailed on May 19, 2006.

5. A petition for extension of time was filed on July 17, 2006 requesting an additional nine days for response. Said petition was granted on July 24, 2006.

6. A response was timely filed on July 28, 2006.

7. On January 31, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '158 patent. The reexamination proceeding was assigned Control No. 90/008,544 (hereinafter, the '8544 proceeding).

8. The reexamination order was granted in the '8544 proceeding on April 20, 2007.

9. The '7746 and '8544 proceedings were merged on August 1, 2007.

10. A housekeeping amendment was filed on January 31, 2008.

11. A final rejection was mailed on February 8, 2008 setting a one-month period for response as an order granting the joint motion to stay litigation pending reexamination proceedings was issued on January 17, 2008.

12. An after-final amendment was timely filed on March 10, 2008 (March 8th being a Saturday).

13. An advisory action was mailed on March 25, 2008 extending the period for response to run three months from the mailing date of the final rejection (i.e. May 8, 2008).

14. A request for extension of time was timely filed on April 21, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the final office action mailed February 8, 2008 and the advisory action mailed March 25, 2008. The request for extension is the second request for an extension of time. The present petition for extension of time was timely filed on April 21, 2008, together with the petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor ....

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

Patent owner states:

"A response to the Advisory Action in the above-referenced reexamination is currently due on or before April 25, 2008. Patent Owner's counsel has met with Patent Owner and discussed strategy for response to the Advisory Action and determined that additional time is needed to prepare an adequate response. As the Office is familiar, Patent Owner has an identical response period ending on April 25, 2008 for a Final Office Action in another reexamination proceeding (Control Nos. 90/007,733 and 90/008,243). This other case presents several complicated and time consuming response aspects, including arguing several new issues presented for the first time in a Final Office Action and which merit declaration testimony from foreign declarants - - the coordination with which has been time consuming relative to the shortened period for response of one month from mailing."

However, the period for response is incorrect as the final rejection in the merged '7746 and '8544 proceedings was mailed on February 8, 2008 and the advisory action of March 25, 2008 extended the period for response to run three months from the mailing date of the final rejection. Therefore, the response in the merged '7746 and '8544 proceedings is due on or before May 8,

2008. Furthermore, the present petition does not explain why additional time is needed in the merged '7746 and '8544 proceedings. The showing is directed to another proceeding. Accordingly, there is no showing in the present petition that warrants extension beyond the current period for response that ends on May 8, 2008.

It is also noted that the '158 patent expires on August 29, 2008.

37 CFR 1.530(j) states:

No enlargement of claim scope. No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

MPEP 2250 (III) states, in part:

Pursuant to 37 CFR 1.530(j), "[n]o amendment may be proposed for entry in an expired patent." Thus, if a patent expires during the pendency of a reexamination proceeding for a patent, all amendments to the patent claims and all claims added during the proceeding are withdrawn. This is carried out by placing a diagonal line across all amended and new claims (and text added to the specification) residing in the amendment papers. The patent owner should be notified of this in the next Office action. The Office action will hold the amendments to be improper, and state that all subsequent reexamination will be on the basis of the unamended patent claims. This procedure is necessary since no amendments will be incorporated into the patent by a certificate after the expiration of the patent.

Since an appeal by Patent Owner can extend the pendency of the reexamination beyond the expiration of the '158 patent (i.e. 2 months to file an appeal brief after the Notice of Appeal and 2 months to file a reply brief after the examiner's answer would prolong prosecution into at least September 2008), the Office will entertain an after-final amendment to return the claims to the original, unamended patent claims at the present time.

CONCLUSION

1. Petitioner's request is dismissed. The period during which Patent Owner may file a response ends on May 8, 2008.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

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.
90/008,547	04/26/2007	6047530	26.03.3.235/A	8225

27572 7590 12/13/2007

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2007

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P.O. BOX 1450
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Harness Dickey & Pierce. PLC
P.O. Box 828
Bloomfield Hills, MI 48303

(For Patent Owner)

James W. Miller
Suite 1960 Rand Tower
527 Marquette Avenue
Minneapolis, MN 55402

(Third Party Requester)

MAILED

DEC 13 2007

CENTRAL REEXAMINATION UNIT

In re Textron Innovations Inc.
Ex Parte Reexamination Proceeding
Control No.: 90/008,547
Filed: April 26, 2007
For: U.S. Patent No.: 6,047,530

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

This is a decision on the December 10, 2007 third party requester petition entitled "PETITION UNDER 37 CFR 1.182 or 1.183 TO DENY OR PROHIBIT INTERVIEWS.

The petition and the 90/008,547 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration of the above petition.

The petition is dismissed for the reasons set forth below.

FEES

The petition fee of $ 400.00 (37 CFR 1.17(f)) has been charged to Deposit Account No. 20-1315 as authorized in the third party requester petition.

REVIEW OF SALIENT FACTS

1. Patent number 6,047,530 ("the '530 patent") issued on April 11, 2000.

2. A request for *ex parte* reexamination of the '530 patent was filed on April 26, 2007, and was assigned control No. 90/008,547 ("the '547 *ex parte* reexamination proceeding").

3. An order granting reexamination in the '547 *ex parte* reexamination proceeding was mailed on May 4, 2007.

4. On July 16, 2007, *inter partes* reexamination was ordered for U.S. Patent No. 6,336,111 ("the '111 patent"), which is a continuation of the '530 patent and is the subject of *inter partes* reexamination control number 95/000,245.

5. On July 16, 2007, *inter partes* reexamination was ordered for U.S. Patent No. 6,336,112 ("the '112 patent"), which is a continuation-in-part of the '111 patent and is the subject of *inter partes* reexamination control number 95/000,244.

6. All three reexamination proceedings are assigned to the same Primary Examiner.

7. On November 14, 2007, a non-final Office action on the patentability of the claims for which reexamination was ordered was mailed in the '547 *ex parte* reexamination proceeding.

8. On November 27, 2007, patent owner filed a petition and request for an extension of time in which to file a response to the November 14, 2007 non-final Office action in the '547 proceeding. The request for an extension of time was based, in part, on patent owner's desire to schedule a personal interview with the examiner.

9. On December 10, 2007, third party requester filed the present petition to deny or prohibit interviews in the '547 *ex parte* reexamination proceeding.

DECISION

I. Relevant Authority

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.

37 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

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."

II. Background and Relief Requested

A review of the record shows that the '530 patent is the subject of the present *ex parte* reexamination proceeding, a continuation patent of the '530 patent is the subject of a pending *inter partes* reexamination proceeding, and a continuation-in-part patent based on the continuation patent is the subject of a second pending *inter partes* reexamination proceeding. A review of the records of the three pending reexamination proceedings reveals that the third party requester and real party in interest in each proceeding is The Toro Company, that the owner of each of the patents being reexamined is Textron Innovations, Incorporated, and that these parties are in litigation with respect to the three involved patents. A review of the records of the three reexamination proceedings further reveals that there are rejections of record based on the same prior patents and printed publications in each proceeding. Also, the record of *inter partes* reexamination proceeding 95/000,244 contains a double patenting rejection of certain claims of the '111 patent based upon the claims of the '112 patent.

Third party requester takes the position that the '530, '111 and '112 patents are clearly closely related, and that the patentability issues in the '547 *ex parte* reexamination proceeding are clearly closely related to the patentability issues in the two pending *inter partes* reexamination proceedings. Patent owner opines that any interview conducted by patent owner with the examiner in the '547 *ex parte* reexamination proceeding will be tantamount to conducting such an interview in the two *inter parties* reexamination proceedings, particularly in light of the fact the same Primary Examiner is handling all three reexamination proceedings. Third party requester takes the position that unless the requested relief of prohibiting or denying such an interview in the '547 *ex parte* reexamination proceeding is granted, the Office will in fact be conducting an interview in the two *inter partes* reexamination proceedings, in contravention of 37 CFR 1.955.

III. Analysis and Findings

Initially, it is to be noted that the regulations permit a patent owner to have interviews with the examiner in *ex parte* reexamination proceedings, subject to certain conditions that are set forth in MPEP § 2281. Although the Office has discretion to refuse an interview, patent owner has not established a reason why the Office should decline to exercise its discretion to grant an interview in the '547 *ex parte* reexamination proceeding.

While there may certain patentability issues that are identical as between the '547 *ex parte* reexamination proceeding and the two copending *inter partes* reexamination proceedings, and other issues that may be similar if not identical, there is no reason to preclude patent owner from being able to conduct an interview in the '547 *ex parte* reexamination proceeding in accordance with 37 CFR 1.560. Further, the regulations require that the interview be conducted on an ex parte basis, *i.e.*, there is no right for the third party requester to participate in the interview or to comment on the interview summary form resulting from the interview. A third party requester should not be able to divest the patent owner of the benefits of the regulations by filing *inter partes* reexamination proceedings that are not directed to the same patent that is the subject of an *ex parte* reexamination proceeding.

Third party requester's argument that any interview conducted in the '547 *ex parte* reexamination proceeding will effectively result in interviews in the two copending *inter partes* reexamination proceedings is not persuasive because:

1) Notwithstanding that some issues may be based on identical prior art in each proceeding, the issues of patentability are, nevertheless, different issues because the claims are different claims. It may or may not be the case that information from an interview in the '547 *ex parte* reexamination proceeding will be utilized in the two copending *inter partes* reexamination proceedings.

2) The information resulting from the interview in the '547 *ex parte* reexamination proceeding will be only that which appears in the examiner's Interview Summary form PTOL-474 that must be completed after the interview, as required by MPEP § 2281, the patent owner's written comments that are required by 37 CFR 1.560, and any objections/comments thereon that the examiner may place in the written record. The record of the '547 *ex parte* reexamination proceeding is a public record. To the extent that the written synopses of the interview is available to the public, it should also available to the examiners in the two copending *inter partes* reexamination proceedings, whether they are the same examiner who is handling the '547 *ex parte* reexamination proceeding or not.

3) A third party requester in an *inter partes* reexamination proceeding actually has more ability to deal with information utilized by the examiner in such a proceeding than a third party requester has in an *ex parte* reexamination proceeding. To the extent that an examiner's action an *inter partes* reexamination might result from publicly available information in the file of an *ex parte* reexamination proceeding, and is commented on by the patent owner in response to an Office action, 37 CFR 1.947 provides a third party requester the right to file written comments directed thereto. Thus, if a patent owner responds under 37 CFR 1.945 to a rejection, a third party requester may file written comments. Even where a claim is indicated to be allowable and the examiner provides the required reasons for allowance to support the action in allowing the claim, a third party requester would have the right to file comments directed thereto, to file prior art under 37 CFR 1.948 to rebut the position of the examiner and/or the patent owner, and ultimately, to file an appeal. No analogous rights exist in an *ex parte* reexamination proceeding.

Therefore, the Office will not preclude patent owner from requesting an interview in the '547 *ex parte* reexamination proceeding, and conducting the interview if such is granted by the examiner.

CONCLUSION

1. The third party requester petition requesting that the Office prohibit or deny an interview in the '547 *ex parte* reexamination proceeding is dismissed.

2. Jurisdiction of the '547 *ex parte* reexamination proceeding will be returned to the Central Reexamination Unit for action as may be, or become, appropriate.

3. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

Kenneth M. Schor

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

sm
December 13, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner) **MAILED**

APR 0 1 2009

CENTRAL REEXAMINATION UNIT

Goodwin Procter LLP
901 New York Avenue, NW
Washington, DC 20001

(For Requester)

James W. Miller
Suite 1960 Rand Tower
527 Marquette Avenue
Minneapolis, MN 55402

In re Bednar
Reexamination Proceeding
Control No. 90/008,547
For: U.S. Patent No. 6,047,530

: RESPONSE TO
: PETITION UNDER
: 37 CFR § 1.59(b)
:

This is a response to the petition under 37 CFR 1.59(b), filed February 29, 2008, 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 the following documents, which were submitted in the Information Disclosure Statement for Reexamination on February 29, 2008, be expunged from the record:

- Box 2: documents in tabs 93-104, 161 and 162
- Box 3: documents in tabs 163-175
- Box 4: documents in tabs 176-184
- Box 5: documents in tabs 185-194
- Box 6: documents in tabs 195-205

Petitioner states 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. Petitioner also states their commitment to retain the information contained in the document requested to be expunged until the U.S. Patent No. 6,047,530 has expired. 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.

CONCLUSION

1. The decision on the petition under 37 CFR 1.59(b) 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.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or Jeanne Clark at (571) 272-7714, or in their absence to the undersigned at (571) 272-3838.

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.
90/008,549	04/30/2007	6043230		8392

25000 7590 04/18/2008

GILEAD SCIENCES INC
333 LAKESIDE DR
FOSTER CITY, CA 94404

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DAVID B. RAVICHER, ESQ.
PUBLIC PATENT FOUNDATION, INC.
1375 BROADWAY, SUITE 600
NEW YORK, NY 10018

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,549*.

PATENT NO. *6043230*.

ART UNIT *3991*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Erich E. Veitenheimer
Gilead Sciences, Inc.
333 Lakeside Drive
Foster City, CA 94404

(For Patent Owner)

Daniel B. Ravicher
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

(For Third Party)

In re: Arimilli et al.
Ex Parte Reexamination Proceeding
Control Number: 90/008,549
Filed: April 30, 2007
For: U.S. Patent 6,043,230

DECISION GRANTING PETITION FOR CHANGE OF INVENTORSHIP [37 CFR §1.324]

This is a decision on the petition of March 7, 2008 filed under 37 CFR 1.324(a) requesting correction of inventorship. Specifically, the petition requests that William A. Lee be added as an inventor to U.S. Patent 6,043,230, which issued to Arimilli et al. on March 28, 2000.

The petition for change of inventorship under 37 CFR 1.324(a) is **GRANTED**.

Legal Standard

37 CFR §1.324 reads in part:

> (a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may on application of all the parties and assignees, or on order of a court before which such matter is called in

question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under §41.121(a)(2) or §41.121(a)(3) of this title.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention or stating that they have no disagreement in regard to the requested change.

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change or inventorship or stating that they have no disagreement to the change.

(3) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of 3.73(b) of this chapter; and

(4) The fee of $130.00 set forth in §1.20(b).

Analysis and Findings

The Patent Owner has submitted (1) a statement by William A. Lee that the error in inventorship occurred without any deception on his part; (2) statements from each of the current inventors agreeing to the change in inventorship; (3) a statement from the sole assignee, Gilead Sciences, Inc., agreeing to the change inventorship; and (4) the fee set forth in 37 CFR 1.20(b).

Conclusion

1. The Patent Owner's petition requesting correction of inventorship under 37 CFR 1.324(a) is **granted**.

2. Response may be submitted as follows:

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

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

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

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

Deborah Jones 4/8/08

Deborah Jones, Supervisory Patent Examiner
Art Unit 3991

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,550	04/30/2007	5977089		8068

25000 7590 04/18/2008

GILEAD SCIENCES INC
333 LAKESIDE DR
FOSTER CITY, CA 94404

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2008

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Daniel B. Ravicher, Esq.
Public Patent Foundation, INC.
1375 Broadway, Suite 600
New York, NY 10018

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,550*.

PATENT NO. *5977089*.

ART UNIT *3991*.

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

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

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

Erich E. Veitenheimer
Gilead Sciences, Inc.
333 Lakeside Drive
Foster City, CA 94404

(For Patent Owner)

Daniel B. Ravicher
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

(For Third Party)

In re: Arimilli et al.
Ex Parte Reexamination Proceeding
Control Number: 90/008,550
Filed: April 30, 2007
For: U.S. Patent 5,977,089

DECISION GRANTING PETITION FOR CHANGE OF INVENTORSHIP [37 CFR §1.324]

This is a decision on the petition of March 7, 2008 filed under 37 CFR 1.324(a) requesting correction of inventorship. Specifically, the petition requests that William A. Lee be added as an inventor to U.S. Patent 5,977,089, which issued to Arimilli et al. on November 2, 1999.

The petition for change of inventorship under 37 CFR 1.324(a) is **GRANTED**.

Legal Standard

37 CFR §1.324 reads in part:

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may on application of all the parties and assignees, or on order of a court before which such matter is called in

question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under §41.121(a)(2) or §41.121(a)(3) of this title.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention or stating that they have no disagreement in regard to the requested change.

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change or inventorship or stating that they have no disagreement to the change.

(3) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of 3.73(b) of this chapter; and

(4) The fee of $130.00 set forth in §1.20(b).

Analysis and Findings

The Patent Owner has submitted (1) a statement by William A. Lee that the error in inventorship occurred without any deception on his part; (2) statements from each of the current inventors agreeing to the change in inventorship; (3) a statement from the sole assignee, Gilead Sciences, Inc., agreeing to the change inventorship; and (4) the fee set forth in 37 CFR 1.20(b).

Conclusion

1. The Patent Owner's petition requesting correction of inventorship under 37 CFR 1.324(a) is **granted**.

2. Response may be submitted as follows:

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

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

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

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

Deborah Jones 4/8/08

Deborah Jones, Supervisory Patent Examiner
Art Unit 3991

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,552	03/26/2007	6560236	E2003-701350	7389

37462 7590 10/31/2008

LOWRIE, LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/31/2008

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

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

TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

OCT 31 2008

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008552
PATENT NO. : 6560236
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

James C. De Vellis
LOWRIE, LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE MA 02142

(For Patent Owner)

OCT 31 2008

Tracy Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA
WELLS FARGO PLAZA
53RD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

DECISION
GRANTING
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.550(c) and § 1.181]

In re: George Varghese, *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,552
Deposited on: 26 May 2007
For: US Patent No. 6,560,236

This is a decision on the 28 October 2008, patent owner "Petition for One-Month Extension of Time Under 37 CFR § 1.550 (c)," requesting that the time for responding to the non-final Office action mailed 5 September 2008, be extended by one-month.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests the period for an extension of time in which to file a response to the Office action mailed 5 September 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 28 October 2008, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g). This is the first request for extension of time.

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

In addressing any request for extension of time filed in reexamination proceedings one must always balance the need for the patent owner to have a fair opportunity to respond to the office action with the need for special dispatch. Thus, when evaluating any request for extension of time there must be "sufficient cause" for granting any extension of time.

On balance the petitioner has noted that one of the references was filed nine months prior to the application resulting in the patent under which reexamination has been requested. As such, the reference may be traversed with a declaration submitted under 37 CFR § 1.131. Given that the time period under consideration is 16 years prior, identifying and pursuing witnesses and evidence does provide "sufficient cause" for granting a one-month extension for time.

The petition request is hereby **granted** for a period of one-month .

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 5 September 2008 is hereby **granted.**

2. The period for response is extended by one-month.

3. The Patent Owner's response is due **5 December 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

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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LANDO & ANASTASI, LLP : (For Patent Owner)
ONE MAIN STREET, SUITE 1100 :
CAMBRIDGE, MA 02142 :

TRACY DRUCE : (For Third-Party Requester)
NOVAK DRUCE & QUIGG, LLP :
1000 LOUISIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

MAILED

JUL 24 2009

CENTRAL REEXAMINATION UNIT

In re Varghese *et alia* : DECISION
Reexamination Proceeding : ON PETITION
Control No. 90 / 008,552 :
Request Deposited: March 26, 2007 :
For: U.S. Patent No.6,560,236 :

This is a decision on the July 10, 2009 petition entitled "Petition under 37 CFR 1.181 to Withdraw Finality of Rejections in Ex Parte Reexamination Proceeding". The petition is before the Director of the Central Reexamination Unit for consideration. The petition is considered pursuant to 37 CFR 1.181; No fee is required.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,560,236 (hereinafter, the '236 patent), issued to Varghese *et alia* on May 6, 2003.

2. On March 26, 2007, a third party deposited a Request for Ex Parte Reexamination of the '236 patent. The reexamination proceeding was assigned Control No. 90/008,552 (hereinafter, the '8552 proceeding).

3. The reexamination order was granted in the '8552 proceeding on May 4, 2007.

4. A final rejection was mailed by the Office on June 1, 2009.

DECISION

In response to the first office action mailed September 5, 2008, Patent Owner filed a response with amendment on December 5, 2009. This amendment, along with the corrected amendment of January 12, 2009 was held non-compliant as to matters of form. A proper amendment was received on May 8, 2009. No amendments were made to the patented claims however new claims were added. A final rejection issued on June 1, 2009. The final rejection maintained all previous rejections presented in the first office action and those rejections included newly added claims. New grounds of rejection were added against the newly submitted claims, necessitated by amendment. All arguments presented by Owner were responded to in the final Office action.

The criteria for making a rejection final in an ex parte reexamination proceeding is analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application. Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Owner, in his petition, submits the issuance of the final rejection was improper as claim 24 was not treated on the merits in the action. As noted in the advisory action recently mailed, the subject matter of claim 24, like that of claim 5, was confirmed. No rejection stands against the claim and as such Owner has not been prejudiced by the omission in the office action. Owner further contends the final is improper as claim 29 was only rejected under 35 USC 305 for broadening and is not addressed on the merits. As is noted in the advisory action recently mailed, this is the only rejection standing against claim 29; accordingly the closing of prosecution does not appear in error. The remainder of Owner's petition is directed to preemptive hypothetical argument presuming either reconsideration/reopening of prosecution by the examiner and/or the grant of petition removing finality. The arguments are directed to why, if prosecution is reopened, the proposed after-final amendment should be entered and any subsequent office action be made non-final. As evidenced by the advisory action recently mailed the proposed after final amendment has not been entered into the record. Thus, Owner's points appear moot as the final rejection stands.

Accordingly, there appears no basis for granting Owner's petition as the petition has failed to point out where the examiner introduced a new ground of rejection that is neither necessitated by applicant's amendment of the claims, and the positions advanced for examiner error have been answered by the advisory action provided to the record. The final rejection appears proper and the petition is dismissed.

CONCLUSION

1. Petitioner's request is **DISMISSED.**

2. **All** correspondence relating to this *ex.parte* reexamination proceeding should be directed:

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

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

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

By hand: Customer Service Window
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For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,552	03/26/2007	6560236	E2003-701350	7389

37462 7590 10/22/2009

LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

OCT 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008552
PATENT NO. : 6560236
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

James C De Vellis
LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE MA 02142

(For Patent Owner)

MAILED

OCT 22 2009

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re: Varghese *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,552
Deposited: 26 March 2007
For: US Patent No. 6,560,236

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
37 CFR §§ 1.550(c) & 1.181

This is a decision on the 14 October 2009, "Petition for One-Month Extension of Time Under to 37 CFR §1.550(c)" requesting that the time for responding to the notice of appeal, be extended by one (1) month. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g).

The petition 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 further extended in which to file a response to Notice of Appeal, which sets a two (2) months date for filing a response thereto. The petition for extension of time was timely submitted 14 October 2009. The petition seeks a one (1) month extension of time

The extension of time is dismissed

37 CFR § 1.550 (c) states:

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

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

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

MPEP 2265 (in-part)

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> ...
>
> Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. Any request for an extension of time in a reexamination proceeding to file a notice of appeal to the Board of Patent Appeals and Interferences, a brief or reply brief, or a request for reconsideration or rehearing will be considered under the provisions of 37 CFR § 1.550(c). The time for filing the notice and reasons of appeal to the U.S. Court of Appeals for the Federal

Circuit or for commencing a civil action will be considered under the provisions of 37 CFR § 1.304.

ANALYSIS AND FINDINGS

The patent owner's representative petitions to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The patent owner timely submitted a petition for extension of time on 14 October 2009. The patent owner sought an extension of time awaiting response to petitions previously filed. The mere filing of a petition will not stay any period for reply that may be running nor act as a stay of proceedings.

The petition request to extend the response time is hereby dismissed.

CONCLUSION

1. The patent owner's petition for extension of time is hereby **dismissed.**

2. The time to respond to the notice of appeal continues to run.

3. Response is due on **31 October 2009.**

4. Response and/or submissions to the Office should be addressed as follows:

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

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

By Hand: Customer Service Window

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

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MAR 30 2010

CENTRAL REEXAMINATION UNIT

LANDO & ANASTASI, LLP : (For Patent Owner)
ONE MAIN STREET, SUITE 1100 :
CAMBRIDGE, MA 02142 :

TRACY DRUCE : (For Third-Party Requester)
NOVAK DRUCE & QUIGG, LLP :
1000 LOUISIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

In re Varghese *et alia* : DECISION ON
Reexamination Proceeding : PETITION UNDER
Control No. 90 / 008,552 : 37 CFR 1.181 IN
Request Deposited: March 26, 2007 : REEXAMINATION
For: U.S. Patent No.6,560,236 :

This is a decision on the August 18, 2009 petition entitled "Petition under 37 CFR 1.181 to Withdraw Finality of Rejections in Ex Parte Reexamination Proceeding". The petition is before the Director of the Central Reexamination Unit for consideration. The petition is considered pursuant to 37 CFR 1.181; No fee is required.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,560,236 (hereinafter, the '236 patent), issued to Varghese *et alia* on May 6, 2003.

2. On March 26, 2007, a third party deposited a Request for Ex Parte Reexamination of the '236 patent. The reexamination proceeding was assigned Control No. 90/008,552 (hereinafter, the '8552 proceeding).

3. The reexamination order was granted in the '8552 proceeding on May 4, 2007.

4. A final rejection was mailed by the Office on June 1, 2009.

5. An amendment after final rejection was presented to the Office on July 1, 2009. An advisory action mailed July 24, 2009 advising Owner of the non-entry of proposed amendments.

6. Owner filed a petition stylized to "Petition under 37 CFR 1.181 Withdraw Finality of Rejections in Ex Parte Reexamination Proceeding" on August 13, 2009. This petition was Dismissed in the decision mailed July 24, 2009.

7. A second petition stylized "Petition under 37 CFR 1.181 Withdraw Finality of Rejections in Ex Parte Reexamination Proceeding" was filed by Owner August 13, 2009.

8. A third petition stylized "Petition under 37 CFR 1.181 to Request Entry of the July 1, 2009 Amendment" was filed by Owner August 18, 2009

DECISION

Background

In response to the first office action mailed September 5, 2008, Patent Owner filed a response with amendment on December 5, 2009. This amendment, along with the corrected amendment of January 12, 2009 was held non-compliant as to matters of form. A proper amendment was received on May 8, 2009. No amendments were made to the patented claims however new claims were added. A final rejection issued on June 1, 2009. The final rejection maintained all previous rejections presented in the first office action and those rejections included newly added claims. New grounds of rejection were added against the newly submitted claims, necessitated by amendment. All arguments presented by Owner were responded to in the final Office action. An amendment was presented by owner after Final rejection on July 1, 2009. This amendment proposed changes to previously added claims 25, 27 and 28 and the further addition of new claims 30 – 36. This amendment was denied entry in the Advisory Action of July 24, 2009.

Applicable Regulations and Notice Sections

§ 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.
> ...

Entry of amendments after Final rejection in *ex parte* reexamination is outlined in MPEP 2272 which states in part:

> It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution. Consideration of amendments submitted after final rejection and prior to, or with, the appeal will be governed by the strict standards of 37 CFR 1.116...
> It should be kept in mind that a patent owner cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection, or reinstate previously canceled claims. For an amendment filed after final rejection and prior to the appeal brief, a showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after final rejection except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner. An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided:
>
> (A) the total effect of the amendment is to cancel claims or comply with any requirement of form expressly set forth in a previous Office action, or present rejected claims in better form for consideration on appeal;
>
> (B) for an amendment touching the merits of the patent under reexamination, the patent owner provides a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.
>
> 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.

Discussion

In this petition requesting entry of the amendment presented after final rejection on July 1, 2009, petitioner submits that good and sufficient reasons exist why the amendment is necessary and was not earlier presented and requests the amendments be entered and considered for purposes of appeal. Petitioner admits that in the examiner considered all limitations of the claims and addressed them in the non-final Office action of September 5, 2008. Petitioner then observes that in the Final rejection the examiner states for the first time " Patent Owner's argument focuses...contrary" and concludes the examiner has entered a new grounds of rejection by responding to an argument presented by Owner. Owner then submits that his response to the alleged new rejection could not have been anticipated and presented earlier thus good and

sufficient reasons for amendment entry have been demonstrated. Owner does not address how the proposed amendment of July 1, 2009 addresses or otherwise overcomes this "alleged" new grounds of rejection set forth by the examiner in response to Owner's argument. Further, Owner does not address how the proposed amendment presents rejected claims in better form for consideration on appeal.

Respectfully, Owner's contentions fail on several levels. Review of the Final Office action reveals the grounds or legal basis of rejection, and the reasons in support thereof, are verbatim to those set forth in the non-final Office action . The only differences seen are the addition of newly added claim numbers to the statement of the rejections and discussions of the newly added claims' limitations in the discussion of how the prior art meets the claims. No new grounds of rejection was proffered by the examiner. Every limitation of the claims has been considered and given weight as every limitation of the claims appears to have been addressed. It seems Owner is confusing the examiner's response to argument – which the examiner is required to provide in a complete and thorough Office action – with a new grounds of rejection. Examiner counter-argument in a Final rejection is not a new ground of rejection and can not serve as a basis for entry of amendment presented subsequent close of prosecution. If such were allowed, prosecution would not conclude in the proceeding as long as Owner presented argument. Clearly this is not the intent of the Reexamination statute.

Here, the proposed After final amendment did not merely cancel claims (claims were added), adopts examiner's suggestions (no suggestions were made) , solely remove issues for appeal (does not overcome any rejection), or in some other way requires only a cursory review by the examiner. It proposed claim amendments and the addition of more new claims. Owner fails to explain what good and sufficient reason prevented presentation of proposed claims 30 -36 from earlier submission after the first Office action. Owner fails explain how the entry of additional claims coupled with amendment of pending claims renders the proceeding in better form for appeal or how entry of the whole amendment reduces issues for appeal. Thus it appears the examiner properly denied entry of the July 1, 2009 proposed amendment and the instant petition fails to persuade over that decision. No basis for granting Owner's desired relief is seen.

CONCLUSION

1. Petitioner's request is **Dismissed**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office

P.O. Box 1450
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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

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CENTRAL REEXAMINATION UNIT

LANDO & ANASTASI, LLP : (For Patent Owner)
ONE MAIN STREET, SUITE 1100 :
CAMBRIDGE, MA 02142 :

TRACY DRUCE : (For Third-Party Requester)
NOVAK DRUCE & QUIGG, LLP :
1000 LOUISIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

In re Varghese *et alia* : DECISION ON
Reexamination Proceeding : PETITION UNDER
Control No. 90 / 008,552 : 37 CFR 1.181
Request Deposited: March 26, 2007 : REEXAMINATION
For: U.S. Patent No.6,560,236 :

This is a decision on the August 13, 2009 petition entitled "Petition under 37 CFR 1.181 to Withdraw Finality of Rejections in Ex Parte Reexamination Proceeding". This is the second petition submitted requesting relief on the propriety of the Final Office action. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is considered pursuant to 37 CFR 1.181; No fee is required.

The petition is denied.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,560,236 (hereinafter, the '236 patent), issued to Varghese *et alia* on May 6, 2003.

2. On March 26, 2007, a third party deposited a Request for Ex Parte Reexamination of the '236 patent. The reexamination proceeding was assigned Control No. 90/008,552 (hereinafter, the '8552 proceeding).

3. The reexamination order was granted in the '8552 proceeding on May 4, 2007.

4. A final rejection was mailed by the Office on June 1, 2009.

5. An amendment after final rejection was presented to the Office on July 1, 2009. An advisory action mailed July 24, 2009 advising Owner of the non-entry of proposed amendments.

6. Owner filed a petition stylized to "Petition under 37 CFR 1.181 Withdraw Finality of Rejections in Ex Parte Reexamination Proceeding" on August 13, 2009. This petition was Dismissed in the decision mailed July 24, 2009.

7. A second petition stylized "Petition under 37 CFR 1.181 Withdraw Finality of Rejections in Ex Parte Reexamination Proceeding" was filed August 13, 2009.

DECISION

In response to the first office action mailed September 5, 2008, Patent Owner filed a response with amendment on December 5, 2009. This amendment, along with the corrected amendment of January 12, 2009 was held non-compliant as to matters of form. A proper amendment was received on May 8, 2009. No amendments were made to the patented claims however new claims were added. A final rejection issued on June 1, 2009. The final rejection maintained all previous rejections presented in the first office action and those rejections included newly added claims. New grounds of rejection were added against the newly submitted claims, necessitated by amendment. All arguments presented by Owner were responded to in the final Office action.

The criteria for making a rejection final in an ex parte reexamination proceeding is analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application. Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Owner, in his second petition regarding the finality of the June 1, 2009 Office action, continues to contend the finality of said action is improper as claim 29 was allegedly improperly treated on the merits. Owner submits three points for consideration.

First, Owner contents the June 1, 2009 Office action was improperly made Final because it was not completely and thoroughly examined with clear grounds of rejection articulated. However, review of the final rejection shows claim 29 was rejected based upon 35 USC 305 as the grounds or legal basis. The reasoning in support of the rejection was clearly articulated by the examiner in that the record reflects the examiner felt the claim was enlarging the scope of the patent. The examiner noted "35 U.S.C. 305 states that "[n]o proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding .... " A claim presented in a reexamination "enlarges the scope" of the patent claim(s) where the

claim is broader than any claim of the patent. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect, even though it may be narrower in other respects." Continuing, the examiner stated "Every independent method claim of the patent being reexamined recites the act of receiving a communication on a first port. Claim 29 fails to recite this step making the claim broader than the claims of the patent in at least one respect." It is not seen why this rejection is not "complete and thorough" as Owner continues to argue. A grounds or legal basis for rejection of the claim has been articulated. Reasoning in support of the position has been articulated. Owner's argument that claim 29 does recite the indicated language and therefore is not broadened is an argument against the merits of the rejection and therefore an eligible subject for appeal and not evidence that the examiner proffered an untimely Final.

Second, Owner contends the July 24, 2009 Advisory action sets forth a new ground of rejection of claim 29 with new reasons provided in support thereof. Respectfully, Advisory actions do not set forth grounds of rejections. Advisory actions advise Owner of the status of proposed submission(s) where the submission is not entitled to entry as a matter of right as prosecution of the proceeding has been closed by Final Office action. Appeal can not be taken from an Advisory action. See 35 USC 134(b). Notwithstanding, while the advisory action may have elaborated upon the examiner's reasoning, Owner is further reminded not to confuse the ground of rejection with the reasons in support thereof. MPEP 1207.03 notes: "There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. at1303, 190 USPQ at 427". Thus Owner's position that a new grounds of rejection was advanced in the Advisory action fails to warrant removal of the final rejection and entry of all amendments submitted after Final rejection.

Finally, Owner submits the remedy for an improper Final Office action is to withdraw the finality of the last Office action and to enter all amendments submitted after final rejection. While it is generally agreed that the remedy for an improper Final Office action is to withdraw the finality of that action, Owner has failed to satisfactorily establish the Final Office action in the instant proceeding was improper. The merits of any Final rejection are subject to appeal. However, the fact that Owner believes the merits of a particular rejection to be so weak as to be clearly erroneous, in and of itself, is insufficient to establish the impropriety and untimeliness of the close of prosecution and does not serve as a basis for reopening prosecution de novo.

Accordingly, there appears no basis for granting Owner's petition as the petition has failed to point out where the examiner introduced a new ground of rejection that was not necessitated by applicant's amendment of the claims. The final rejection appears proper and the petition is denied.

CONCLUSION

1. Petitioner's request is **Denied.**

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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Central Reexamination Unit
Commissioner for Patents
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For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,553	03/19/2007	6,785,091	10760/346	8113

24978 7590 03/03/2008

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2008

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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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,478	02/02/2007	6,785,091	4389.77167	3155

24978 7590 03/03/2008

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2008

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MAR 0 3 2008

CENTRAL REEXAMINATION UNIT

Thomas R. Fitzsimons (For Patent Owner)
Greer, Burns & Crain, Ltd.
300 S. Wacker Drive, Suite 2500
Chicago, IL 60606

Michelle Camaiux (For Third Party Requester)
Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

In re Edwards *et alia*
Reexamination Proceeding
Control No. 90/008,478
Request Deposited: February 2, 2007
For: U.S. Patent No. 6,785,091

In re Edwards *et alia*
Reexamination Proceeding
Control No. 90/008,553
Corrected Request Deposited: March 19, 2007
For: U.S. Patent No. 6,785,091

: 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. 6,785,091 (hereinafter, the '091 patent), issued to Edwards *et alia*, on August 31, 2004.

2. On February 2, 2007, Patent Owner deposited a Request for *Ex Parte* Reexamination of the '091 patent. The reexamination proceeding was assigned Control No. 90/008,478 (hereinafter, the '8478 proceeding).

3. The Reexamination Order was granted in the '8478 proceeding on May 8, 2007.

4. There are currently no amendments in the '8478 proceeding.

5. On March 19, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '091 patent. The reexamination proceeding was assigned Control No. 90/008,553 (hereinafter, the '8553 proceeding).

6. The Reexamination Order was granted in the '8553 proceeding on May 8, 2007.

7. There are currently no amendments in the '8553 proceeding.

8. The '8478 and '8553 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 '8478 and the '8553 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. 90/008,478 and 90/008,553 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,555	04/30/2007	5922695		8170

25000 7590 04/18/2008

GILEAD SCIENCES INC
333 LAKESIDE DR
FOSTER CITY, CA 94404

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DANIEL B. RAVICHER
PUBLIC PATENT FOUNDATION, INC.
1375 BROADWAY, SUITE 600
NEW YORK, NEW YORK 10018

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,555*.

PATENT NO. *5922695*.

ART UNIT *3991*.

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

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

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Erich E. Veitenheimer (For Patent Owner)
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333 Lakeside Drive
Foster City, CA 94404

Daniel B. Ravicher (For Third Party)
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

In re: Arimilli et al.
Ex Parte Reexamination Proceeding
Control Number: 90/008,555
Filed: April 30, 2007
For: U.S. Patent 5,922,695

DECISION GRANTING PETITION FOR CHANGE OF INVENTORSHIP [37 CFR §1.324]

This is a decision on the petition of March 7, 2008 filed under 37 CFR 1.324(a) requesting correction of inventorship. Specifically, the petition requests that William A. Lee be added as an inventor to U.S. Patent 5,922,695 which issued to Arimilli et al. on July 13, 1999.

The petition for change of inventorship under 37 CFR 1.324(a) is **GRANTED**.

Legal Standard

37 CFR §1.324 reads in part:

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may on application of all the parties and assignees, or on order of a court before which such matter is called in

question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under §41.121(a)(2) or §41.121(a)(3) of this title.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention or stating that they have no disagreement in regard to the requested change.

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change or inventorship or stating that they have no disagreement to the change.

(3) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of 3.73(b) of this chapter; and

(4) The fee of $130.00 set forth in §1.20(b).

Analysis and Findings

The Patent Owner has submitted (1) a statement by William A. Lee that the error in inventorship occurred without any deception on his part; (2) statements from each of the current inventors agreeing to the change in inventorship; (3) a statement from the sole assignee, Gilead Sciences, Inc., agreeing to the change inventorship; and (4) the fee set forth in 37 CFR 1.20(b).

Conclusion

1. The Patent Owner's petition requesting correction of inventorship under 37 CFR 1.324(a) is **granted**.

2. Response may be submitted as follows:

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

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

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

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

Deborah Jones 4/9/08

Deborah Jones, Supervisory Patent Examiner
Art Unit 3991

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Genetic Applications
P.O. Box 2306
Manchaca TX 78652

(For Patent Owner)

Laurie A. Axford
Gordon & Rees LLP
101 West Broadway, Suite 1600
San Diego, CA 92101

(For Third Party Requester)

MAILED

MAY 23 2008

CENTRAL REEXAMINATION UNIT

In re Gopal
Reexamination Proceeding
Control No.: 90/008,557
Filed: March 23, 2007
For: U.S. Patent No.: RE 39,220

DECISION ON PETITION

This is a decision on the April 26, 2008 patent owner petition under 37 CFR 1.182 styled as a notice of related proceedings, but which is being treated as an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed April 11, 2008, has not been entered for consideration by the examiner.

BACKGROUND

1. On September 23, 1997 the Office issued US Patent number 5,670,347 (the '347 patent).
2. On September 22, 1999 patent owner filed a reissue application on the '347 patent.
3. On August 1, 2006 the Office reissued the '347 patent as Reissued Patent RE39,220 (the '220 patent).
4. On March 23, 2007 third party requester filed a request for *ex parte* reexamination of the '220 patent, which was assigned reexamination proceeding number 90/008,557 (the '8557 proceeding).
5. The '220 patent was the subject of litigation in the United States District Court for the Eastern District of Texas at the time requester filed the request for reexamination. *Genetics Applications LLC v. Invitrogen Corp.*, {Case No. 6:06-cv-00434 (E.D. Tex.) (The litigation)}.
6. On May 17, 2007 the Office issued an order granting the request for reexamination.
7. The'8557 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on April 11, 2008.

8. On April 26, 2008, patent owner submitted a listing of references cited in the '220 patent's related litigation.

9. Also on April 26, 2008, the instant petition was filed requesting the references be made of record after NIRC.

10. The reexamination proceeding is being processed toward publication of the reexamination certificate.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings states (in part):

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2256 states (in part):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present proceeding from the publication process, for entry of the accompanying references, has been appropriately filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for entry of references, the policy for withdrawal from the publication

process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

> ...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

In the present instance, the submission fails to satisfy both items (A) and (B), because there is no full ***factual accounting*** to explain why the information submitted could not be submitted earlier or an ***explanation of the relevance*** of the information submitted with respect to the **claimed invention** in the reexamination proceeding. The instant petition was filed very late in the reexamination proceeding, and no substantive attempt is made to satisfy the guidance of MPEP 2256. The patent owner has not provided a discussion of the substance of the information, i.e. patent owner has not made a full factual accounting to explain why the information is being submitted so late, nor has patent owner explained the relevance of the same with respect to the claim limitations in the present reexamination proceeding.

In regards to providing a factual accounting (A) to explain why the information could not be submitted earlier, the petitioner/patent owner indicates that a related proceeding had produced the references, but the third party requester, who was involved in the related litigation, did not submit the references when they made the request for reexamination. Patent owner makes no other statements, i.e., as to when patent owner became aware of the references and as to their diligence to make the references of record before the '8557 proceeding progressed to the point of issuance of a NIRC. Patent owner simply concludes that in light of the requester's failure to cite references in the reexamination proceeding, but which were cited in the litigation, the references should be made of record after issuance of the NIRC, without any explanation of any particularity as to why they did not timely submit the references upon becoming aware of their existence in the related litigation. Without a factual accounting as to the delay in submitting the references from the litigation into the '8557 proceeding, patent owner has not met its burden of factual accounting as to why the information could not have been submitted earlier. Accordingly, patent owner has failed to satisfy MPEP § 2256, item (A), requirement for submission of post NIRC references.

In regard to explaining the relevance of the submitted information (B), patent owner has not provided any explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. Therefore, patent owner has failed to satisfy the MPEP § 2256, item (B), requirement for submission of post NIRC references.

In summary, patent owner does not make a full factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; nor does patent owner explain the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. Therefore, the present petition does not satisfy the

requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on April 11, 2008, and the proceeding is being prepared to enter the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite discussion (factual accounting and explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered references. Accordingly the petition is dismissed as to the request for consideration of the IDS papers.

If, however, the patent owner in fact believes that any reference submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s).

The IDS papers submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the references will not be considered by the examiner.

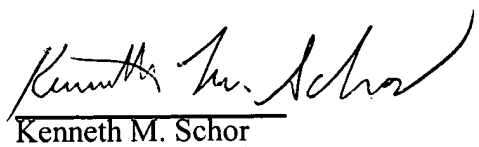
CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on April 26, 2008.

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

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

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



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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,558	03/23/2007	6,539,022 B1	106293.00042	2110

54975 7590 11/24/2009

EXAMINER	

Donald Quigg
Novak, Druce & Quigg, LLP
1000 Louisiana Avenue
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Houston, Texas 77002

ART UNIT	PAPER NUMBER

DATE MAILED: 11/24/2009

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,558*.

PATENT NO. *6,539,022 B1 ET*.

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,558	03/23/2007	6,539,022 B1	106293.00042	2110

54975 7590 11/24/2009

HOLLAND & KNIGHT LLP
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BOSTON, MA 02116-3889

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(For Patent Owner)

Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

In re: Virgile
Inter Partes Reexamination Proceeding
Control No. 90/008,558
Filed: March 23, 2007
For: U.S. Patent No. 6,359,022

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

This is a decision on the November 9, 2009 patent owner petition entitled "PETITION TO EXPEDITE PURSUANT TO 37 CFR 1.182". The petition requests expedited review of the "PETITION UNDER 37 CFR 1.181 TO REQUEST ENTRY 17 AUGUST 2009 AMENDMENT", filed concurrently with the instant petition.

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 1.182 will be charged to patent owner's Deposit Account No. 50-2324 pursuant to the authorization on page 1 of the petition.

The patent owner request to expedite, pursuant 37 CFR 1.182, the concurrently filed petition under 37 CFR 1.181 is dismissed for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On 25 March 2003, U.S. Patent No. 6,539,022 was granted to Virgile ("the 022 patent").

2. On 23 March 2007, a request for *ex parte* reexamination of the '022 patent was submitted by a third party requester, which request was assigned control number 90/008,558 ("the '558 proceeding").

3. On 12 June 2007, an Order granting *ex parte* reexamination in the '558 proceeding was mailed.

4. Prosecution in the '558 proceeding progressed to the point where, on 15 June 2009, a final Office action was issued.

5. On 17 August 2009, patent owner filed an amendment after final rejection.

6. On 08 September 2009 a first advisory action was issued, declining to enter patent owner's 17 August 2009 after-final amendment.

7. On 09 October 2009, patent owner filed a supplemental response after final rejection.

8. On 23 October 2009 a second advisory Office action was issued, declining to enter patent owner's 17 August 2009 amendment.

9. On 09 November 2009 patent owner filed the instant petition under 37 CFR 1.182 entitled "PETITION TO EXPEDITE PURSUANT TO 37 CFR 1.182," requesting an expedited decision on the petition, filed concurrently on 09 November 2009, entitled "PETITION UNDER 37 CFR 1.181 TO REQUEST ENTRY OF THE 17 AUGUST 2009 AMENDMENT".

RELEVANT AUTHORITY

37 CFR 1.181 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 1.182 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 USC 305 provides in part:

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

DECISION

I. Patent Owner's Petition of 09 November 2009

In the instant petition, petitioner requests an expedited decision on the concurrently filed petition under 37 CFR 1.181, requesting entry of the amendment filed on 17 August 2009 in response to the final rejection of 15 June 2009. Petitioner requests an expedited decision on the petition under 37 CFR 1.181 as a notice of appeal was filed on 15 October 2009, which renders patent owner's appeal brief due on 15 December 2009.

II. Analysis and findings

The instant petition under 37 CFR 1.182 has been fully considered. Petitioner's request to expedite the review of the concurrently filed petition under 37 CFR 1.181 requesting entry of an amendment after final rejection is without merit, as all reexamination proceedings are to be conducted with special dispatch within the Office (35 U.S.C. 305). The assertion that the appeal brief is due 15 December 2009 does not warrant further expedited review on the petition under 37 CFR 1.181 other than the special dispatch already provided for in the statute. Since all matters in a reexamination proceeding are conducted with special dispatch, petitions are taken up for consideration in the order that they are received by the Office.

Patent owner's 09 November 2009 petition under 37 CFR 1.181 is before the Central Reexamination Unit (CRU) and will be taken up for consideration by the CRU in due course based on the order in which it was received. Patent owner is free to request an extension of time to file its appeal brief from the CRU, under 37 CFR 1.550(c).

Accordingly, patent owner's petition under 37 CFR 1.182 is **dismissed**.

CONCLUSION

1. The patent owner petition under 37 CFR 1.182 is **dismissed**.

2. The concurrently filed patent owner petition under 37 CFR 1.181 is before the CRU and will be taken up for consideration by the CRU in due course, based on the order in which it was received.

3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150.

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

Kenpet7/ 11-24-09

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,558	03/23/2007	6,539,022 B1	106293.00042	2110

54975 7590 03/15/2010

EXAMINER	

Donald Quigg
Novak, Druce & Quigg, LLP
1000 Louisiana Avenue
Wells Fargo Plaza, 53rd Floor
Houston, Texas 77002

ART UNIT	PAPER NUMBER

DATE MAILED: 03/15/2010

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DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Foundry Networks, Inc.

4980 Great America Parkway

Santa Clara, CA 9505

MAILED

MAR 15 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,558*.

PATENT NO. *6,539,022 B1 ET*.

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,558	03/23/2007	6,539,022 B1	106293.00042	2110

54975 7590 03/15/2010

HOLLAND & KNIGHT LLP
10 ST. JAMES AVENUE
BOSTON, MA 02116-3889

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/15/2010

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MAR 15 2010

CENTRAL REEXAMINATION UNIT

Holland & Knight, LLP
10 St James Avenue
Boston, MA 02116

: (For Patent Owner)

Novak Druce & Quigg
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

: (For Third-Party Requester)

In re VIRGILE
Reexamination Proceeding
Control No. 90/008,558
Request Deposited: March 23, 2007
For: U.S. Patent No. 6,539,022

: DECISION DISMISSING
: PETITION FOR
: ENTRY OF AMENDMENT
: AFTER FINAL REJECTION
: UNDER 37 CFR 1.181

This is a decision on patent owner's petition styled "Petition Under 37 CFR 1.181 to Request Entry of the 17 August 2009 Amendment" filed November 9, 2009. The petition is before the Director of the Central Reexamination Unit for consideration. No fee is due. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. On 25 March 2003, U.S. Patent No. 6,539,022 was granted to Virgile ("the 022 patent").

2. On 23 March 2007, a request for ex parte reexamination of the '022 patent was submitted by a third party requester, which request was assigned control number 90/008,558 ("the '558 proceeding").

3. On 12 June 2007, an Order granting ex parte reexamination in the '558 proceeding was mailed.

4. Prosecution in the '558 proceeding progressed to the point where, on 15 June 2009, a final Office action was issued.

5. On 17 August 2009, patent owner filed an amendment after final rejection.

6. On 08 September 2009 a first advisory action was issued, declining to enter patent owner's 17 August 2009 after-final amendment.

7. On 09 October 2009, patent owner filed a supplemental response after final rejection.

8. On 15 October 2009, patent owner filed a Notice of Appeal.

9. On 23 October 2009 a second advisory Office action was issued, declining to enter patent owner's 17 August 2009 amendment.

10. On 09 November 2009 patent owner filed the instant petition styled "Petition Under 37 CFR 1.181 to Request Entry of the 17 August 2009 Amendment" and a under 37 CFR 1.182 styled "Petition to Expedite Pursuant to 37 CFR 1.182," requesting an expedited decision on the 37 CFR 1.181 petition.

11. On 24 November 2009 the 37 CFR 1.182 petition was dismissed.

Applicable Statute or Regulation

37 CFR 1.181 states in pertinent part:

> ***§ 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 Appeal sand Interferences, see § 41.3 of this title.*
>
> .
> .
> ..
> *(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.*
>
> *[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR*

76756, Dec. 7, 2000, effective Feb. 5, 2001; paras. (a), (a)(2)-(3), (c)-(e) & (g) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(3) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

DECISION

As outlined in MPEP 2272, 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. MPEP 2272 further states:

> "In the event that the patent owner is of the opinion that (A) a final rejection is improper or premature, or (B) that an amendment submitted after final rejection complies with 37CFR 1.116 but the examiner improperly refused entry of such an amendment, the patent owner may file a petition under 37 CFR 1.181 requesting that the final rejection be withdrawn and that prosecution be reopened, or file a petition under 37 CFR 1.181 requesting entry of the amendment, where appropriate. The petition under 37 CFR 1.181 *must be filed within the time period for filing a notice of appeal.*"

Once a notice of appeal is filed, however, 37 CFR 1.181 is inapplicable as 37 CFR 1.181 (a)(1) limits applicability to reexamination proceedings which are not subject to appeal to the Board of Patent Appeals and Interferences. As the 37 CFR 1.181 petition under consideration herein was filed after notice of appeal, no basis for relief is seen as the petition is untimely.

CONCLUSION

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

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.

/J. Harrison/

J. Harrison
SPE AU 3992
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,561	03/28/2007	4916635	007060.00006	9842

24280 7590 10/30/2007

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON, MA 02110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2007

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.
90/008,525	03/07/2007	4916635	007060.00020	5060

24280 7590 10/30/2007

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON, MA 02110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2007

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Choate, Hall & Stewart LLP
Two International Place
Boston, MA 02110

(For Patent Owner)

MAILED
OCT 30 2007
CENTRAL REEXAMINATION UNIT

Banner & Witcoff, LTD.
1100 13th Street, NW, Suite 1200
Washington, DC 20005-4051

(For Third Party Requester)

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/008,525
Request Deposited: March 7, 2007
For: U.S. Patent No. 4,916,635

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

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/008,561
Request Deposited: March 28, 2007
For: U.S. Patent No. 4,916,635

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. 4,916,635 (hereinafter, the '635 patent), issued to Singer *et alia*, on April 10, 1990.

2. On March 7, 2007, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-4, 11, 21, and 24 of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,525 (hereinafter, the '8525 proceeding).

3. The Reexamination Order was granted in the '8525 proceeding on April 13, 2007.

4. There are currently no amendments in the '8525 proceeding.

5. On March 28, 2007, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-4, 11, 21, and 24 of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,561 (hereinafter, the '8561 proceeding).

6. The Reexamination Order was granted in the '8561 proceeding on May 24, 2007.

7. There are currently no amendments in the '8561 proceeding.

8. The '8525 and the '8561 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 '8525 and the '8561 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. 90/008,525 and 90/008,561 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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JAN 15 2008

CENTRAL REEXAMINATION UNIT

Charles L. Gholz
Oblon Spivak McClelland Mauer & Neustadt
1940 Duke St.
Alexandria, VA 22314

(For Patent Owner)

Joseph M. Potenza
Banner & Witcoff, LTD.
1100 13th St., NW, Suite 1200
Washington, DC 20005-4051

(For Requester)

In re Singer et al.
Merged *Ex parte* Reexamination Proceeding
Control Nos. 90/008,525 and 90/008,561
Filed: March 7, 2007 and March 28, 2007
For: U.S. Patent No.: 4,916,635

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

This is a decision on the December 18, 2007 petition under 37 CFR 1.182 and 1.183, filed by the third party requester in the above-identified proceeding to (1) permit a representative of the third party requester to attend any examiner interviews; (2) permit any examiner interviews to be recorded by audio and/or videograph; and (3) permit any examiner interviews to be transcribed.

The fee set forth in 37 CR 1.17(f) for a petition under 37 CFR 1.182 and 1.183 is $400. The petition fee for the above proceeding is being charged to the petitioner's deposit account No. 19-0733, as authorized by the petitioner on page 5 of the petition.

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

The petition is dismissed. As the petition paper is not a proper submission, it is being expunged by closing it in the electronic Image File Wrapper (IFW) of the merged '8525 and '8561 proceedings and marking it "not public."

REVIEW OF SALIENT FACTS

1. Reexamination of claims 1-4, 11, 21, and 24 of U.S. Patent No. 4,916,635 (the '635 patent) was ordered on April 13, 2007, as proceeding 90/008,525 (the '8525 proceeding) in response to a third party request for reexamination filed March 7, 2007.

2. No patent owner statement was filed in the '8525 proceeding, and the period for active participation of the third party reexamination requester has ended.

3. A second request for *ex parte* reexamination was requested by the same third party requester on March 28, 2007 and ordered for claims 1-4, 11, 21, and 24 of the '635 patent on May 24, 2007, as proceeding 90/008,561 (the '8561 proceeding).

4. No patent owner statement was filed in '8561 proceeding, and the period for active participation of the third party reexamination requester has ended.

5. A decision merging the proceedings was issued on October 30, 2007.

6. A non-final office action was mailed in the merged '8354 and '8561 proceedings on November 19, 2007.

7. A personal interview was conducted in the merged proceedings on December 13, 2007.

8. On December 18, 2007, the third party requester filed the present petition under 37 CFR 1.182 and 1.183.

DISCUSSION

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

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

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

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

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

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

Pursuant to MPEP 713.04:

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

DECISION

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

The present petition of December 18, 2007, was filed after the period for active participation of the reexamination requester had ended. The present petition is not in compliance with the requirements of 37 CFR 1.510 or 1.535, nor does the present petition qualify as a prior art statement under 37 CFR 1.501. Accordingly, it is an

improper submission, i.e., an improper paper, under the above-quoted portions of 37 CFR 1.550. See *Syntex (USA) Inc. v. U.S. Patent and Trademark Office,* 11 USPQ 2d 1866, 1868-1869 (Fed. Cir. 1989).

Because the December 18, 2007 petition paper is a improper paper, it does not have an entry right under the rules, it is not being made a part of the record of the present proceeding, and it is returnable without consideration of its substance. The copy of the December 18, 2007 petition paper was, however, scanned into the electronic Image File Wrapper (IFW) of the'8525 and the '8561 proceedings, before the discovery of the impropriety. Thus, that copy cannot be physically returned to the third party requester. Rather, the IFW copy of the paper is being expunged by closing it in the IFW file of the'8354 and '8561 proceedings and marking it "not public." It will not constitute part of the record of the present reexamination merged proceedings. The present decision will, however, be made of record in the reexamination files. See also MPEP 2267.

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

Petitioner has requested that the Office permit the third party to attend any examiner interviews, permit recordation of any examiner interview by audio and/or videograph, and permit transcription of any examiner interviews in the merged '8354 and '8561 proceedings. However, only *ex parte* interviews between the examiner and patent owner are permitted. Observation by third parties is not permitted. Pursuant to MPEP 2281, requests by reexamination requesters to participate in or to **attend** interviews will not be granted. The relief requested by petitioner with respect to recording and transcription would permit attendance by a third party in interviews, in addition to the examiner and the patent owner. Such attendance is not permitted.

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

Moreover, the substance of the interview, as made of record in the proceeding files, is available to the public. The information generated by the procedures in MPEP 2281 and 713.04 provides the entirety of the substance of the interview to be made of

record.[1] That record is available to the public and any forum that has an occasion to review the patent that was reexamined.

CONCLUSION

1. The petition requesting permission for a representative of the third party requester to observe and/or to transcribe or videotape any examiner interviews in the merged '8354 and '8561 proceedings is dismissed.

2. The petition paper is not a proper submission; accordingly, it is being expunged by closing it in the electronic Image File Wrapper (IFW) of the'8354 and '8561 proceedings and marking it "not public."

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

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

1-11-08
C:\Kiva\Kenpet6\8525 for 3rd p interview particip+record.doc

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

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Charles L. Gholz
Oblon Spivak McClelland Mauer & Neustadt
1940 Duke St.
Alexandria, VA 22314 (For Patent Owner)

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FEB 07 2008

CENTRAL REEXAMINATION UNIT

Joseph M. Potenza
Banner & Witcoff, LTD.
1100 13th St., NW, Suite 1200
Washington, DC 20005-4051 (For Requester)

In re Singer et al.	:	
Merged *Ex parte* Reexamination Proceeding	:	**DECISION ON REQUEST TO**
Control Nos. 90/008,525 & 90/008,561	:	**EXPUNGE THIRD PARTY**
Filed: March 7, 2007 & March 28, 2007	:	**PETITION**
For: U.S. Patent No.: 4,916,635	:	

This is a decision on the January 10, 2008 patent owner request to expunge the third party petition filed in the above –captioned merged proceeding on December 18, 2007, which requested permission for a representative of the third party requester to attend any examiner interviews, that any examiner interviews to be recorded by audio and/or videograph, and that any examiner interviews to be transcribed.

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

The request is dismissed as moot since the petition paper has already been expunged from the proceeding by closing it in the electronic Image File Wrapper (IFW) and marking it "not public" as it was not a proper submission. A decision dismissing the third party petition was mailed January 15, 2008.

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

2-5-08

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CENTRAL REEXAMINATION UNIT

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON MA 02110

(For Patent Owner)

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

(For Third Party Requester)

BANNER & WITCOFF, LTD.
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

(For Third Party Requester)

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

(Courtesy Copy)

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/008,525
Request Deposited: March 7, 2007
For: U.S. Patent No. 4,916,635

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/008,561
Request Deposited: March 28, 2007
For: U.S. Patent No. 4,916,635

In re Singer *et alia*
Reexamination Proceeding
Control No. 90/010,123
Request Deposited: March 13, 2008
For: U.S. Patent No. 4,916,635

: 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. 4,916,635 (hereinafter, the '635 patent), issued to Singer *et alia*, on April 10, 1990.

2. On March 7, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,525 (hereinafter, the '8525 proceeding).

3. The Reexamination Order was granted in the '8525 proceeding on April 13, 2007.

4. On March 28, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/008,561 (hereinafter, the '8561 proceeding).

5. The Reexamination Order was granted in the '8561 proceeding on May 24, 2007.

6. The '8525 and the '8561 proceedings were merged on October 30, 2007.

7. An amendment adding new dependent claims 28 and 29 was filed on January 22, 2008.

8. On March 13, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '635 patent. The reexamination proceeding was assigned Control No. 90/010,123 (hereinafter, the '10123 proceeding).

9. The Reexamination Order was granted in the '10123 proceeding on April 9, 2008.

10. The '635 patent expired on September 12, 2008.

DECISION

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.

37 CFR 1.530(j) further states that "[m]oreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent."

The cancellation of the original patent claims is the only "amendatory" change permitted in an expired patent.

The '635 patent expired on September 12, 2008 before the reexamination certificate issued. Since no amendments will be incorporated into the patent by a certificate after the expiration of the patent (other than cancellation of original patent claims), the amendment filed January 22, 2008 is withdrawn. All subsequent reexamination will be on the basis of the unamended patent claims.

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 '8525, '8561, and '10123 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. All subsequent reexamination will be on the basis of the unamended patent claims.

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. 90/008,525, 90/008,561, and 90/010,123 are **merged**.

2. 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

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

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

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MAY 13 2008

CENTRAL REEXAMINATION UNIT

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
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(For Patent Owner)

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32ND FLOOR
CHICAGO, IL 60606

(For Third Party Requester)

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

In re: Lowery *et alia*
Ex parte Reexamination Proceeding
Control No. 90/008,342
Deposited: 27 November 2006
For U.S. Patent No. 5,894,554

In re: Lowery *et alia*
Ex parte Reexamination Proceeding
Control No. 90/008,562
Deposited: 29 March 2007

For U.S. Patent No. 5,894,554 :

In re: Lowery *et alia* :
Ex parte Reexamination Proceeding :
Control No. 90/008,574 :
Deposited: 3 April 2007 :
For U.S. Patent No. 5,894,554 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of Reexamination control number 90/008,342; 90/008,562 and 90/008,574 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.

Per **MPEP 2283**

> If a second request for reexamination is filed prior to the issuance of a Notice of Intent to Issue a Reexamination Certificate for the first reexamination proceeding, the proceedings generally will be merged. In this situation, the second request is decided based on the original patent claims, and if reexamination is ordered, the reexamination proceedings generally would be merged.
>
> ...
>
> A decision by the CRU Director to merge the reexamination proceedings should include a requirement that the patent owner maintain identical claims in both files. It will further require that responses by the patent owner, and any other paper filed in the merged proceeding, must consist of a single response, addressed to both files, filed in duplicate, each bearing a signature and containing identifying data for both files, for entry in both files. The decision will point out that both files will be maintained as separate complete files. Where the claims are not the same in both files, the decision of merger will indicate at its conclusion that the patent owner is given 1 month to provide an amendment to make the claims the same in each file. Where the claims are already the same in both files, the decision will indicate at its conclusion that an Office action will be mailed in due

course, and that the patent owner need not take any action at present. The decision of merger will be mailed immediately.

Since all of the requirements of MPEP 2283 and 37 CFR § 1.565(c) are met, accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/008,342; 90/008,562 and 90/008,574 reexamination proceedings are hereby merged. There are no amendments to any of the above noted proceedings at this time. The merged proceeding will be conducted in accordance with the following guidelines and requirements:

I. Requirements for Same Amendments in All Proceedings

There are no amendments at this time in any of the reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,342; 90/008,562 and 90/008,574 are hereby **merged**.

2. The merged proceeding is returned to the examiner assigned these proceedings to issue an Office action in due course.

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents

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

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

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

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

MARK J. REINHART
CRU SPE-AU 3992

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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JUL 09 2008

CENTRAL REEXAMINATION UNIT

Mark W. Hetzler
Fitch, Even, Tabin & Flannery (For Patent Owner)
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Suite 1600
Chicago, IL 60603

Lawrence A. Hoffman
Ostrolenk, Faber, Gerb & Soffen, LLP (For Third Party Requester)
1180 Avenue of the Americas
New York, NY 10036

In re Christian T. Gregory	:	
Reexamination Proceeding	:	**DECISION DISMISSING PETITION**
Control No: 90/008,563	:	**TO SUSPEND *EX PARTE***
Filed: March 30, 2007	:	**REEXAMINATION PROCEEDING**
For: U.S. Patent No.: 6,802,458	:	

This is a decision on the petition filed by the patent owner on April 28, 2008, titled "Emergency Petition To Suspend Reexamination Proceeding To Permit Interference Issue To Be Decided First in Litigation."

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

For the reasons set forth below, the petition to suspend *ex parte* reexamination is dismissed. The *ex parte* reexamination proceeding for Control No. 90/008,563 will proceed with special dispatch.

FEES

The petition fee of $400 has been charged to patent owner's deposit account, pursuant to the authorization for same at page 2 of the April 28, 2008 petition.

BACKGROUND

1. Patent number 6,802,458 ("the '458 patent") issued on October 12, 2004, with claims 1-37.

2. The '458 patent owner filed a lawsuit against K-Rain Manufacturing Corporation in the U.S. District Court for the Central District of California on April 12, 2006, alleging infringement of the '458 patent (Case No. 2:06cv2223, styled *Rain Bird Corporation v. K Rain Manufacturing Company*).

3. K-Rain Manufacturing Corporation filed a third-party request for *ex parte* reexamination of claims 1-10, 12-14, 19-28, and 33-35 of the '458 patent on March 30, 2007, that was assigned control no. 90/008,563 ("the '8563 proceeding").

4. On April 20, 2007, the district court stayed the lawsuit in view of the '8563 proceeding.

5. The request for *ex parte* reexamination was granted on June 15, 2007.

6. A first Office action was issued on March 31, 2008, in the '8563 proceeding confirming claims 14 and 28 of the '458 patent and rejecting claims 1-10, 12-13, 19-27, and 33-35 of the '458 patent.

7. On April 28, 2008, patent owner filed this petition to suspend the '8563 reexamination proceeding until the district court determines priority of inventorship.

DECISION

I. Pertinent Statute and 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. 1.183 Suspension of rules.

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

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

The patent owner filed this petition pursuant to 37 CFR 1.182, 1.183, and 1.565(b) to suspend the '8563 reexamination proceeding. The patent owner states in the petition that the suspension is necessary to allow priority of inventorship between the '458 patent and a patent publication applied under 35 USC 102(e) in the March 31, 2008 Office action to be decided first in the concurrent lawsuit in the U.S. District Court for the Central District of California. According to the patent owner, its only recourse is in the district court, because "the PTO will not determine priority of inventorship in a reexamination proceeding."

III. Findings and Analysis

There is no specific framework for requesting a suspension of action in an *ex parte* reexamination proceeding. However, 37 CFR 1.103 provides a framework for requesting a suspension of action in an application. Also, MPEP 2686.01 provides guidance on the possibility of suspending one proceeding where there are multiple copending reexamination proceedings. Both 37 CFR 1.103 and MPEP 2686.01 are instructive in the present instance.

37 CFR 1.103(a) states that "[t]he Office will not suspend action if a reply by applicant to an Office action is outstanding." MPEP 2686.01 states that a "[s]uspension will not be granted when there is an outstanding Office action." In the present instance, the patent owner is requesting suspension based on a litigation proceeding as to the '458 patent; yet, the patent owner has not responded to the Office action of March 31, 2008. Thus, a response to the Office action is still outstanding, and the petition must be dismissed.

In view of the above, the petition is dismissed, and the reexamination proceeding will be continued with special dispatch within the Office.

IV. Additional Discussion

Even if a response to the Office action of March 31, 2008, were not outstanding in this instance, it is noted that, 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] 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.

---

[1] *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988).
[2] *Id.* at 1425.

> "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.)

Thus, an *ex parte* reexamination proceeding will not be suspended for an indefinite period of time to await the conclusion of litigation.

CONCLUSION

1. The patent owner petition filed on April 28, 2008, is dismissed.

2. The '8563 *ex parte* reexamination proceeding will not be suspended and will proceed with special dispatch.

3. Jurisdiction over the proceeding is being returned to the Central Reexamination Unit, Art Unit 3993.

4. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

7-8-08
C:\Kiva\Kenpet7\stay\8563_ decision dismissing suspension req.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.
90/008,563	03/30/2007	6802458	8473/90349	4905

22242 7590 02/02/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2009

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
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

Date:
MAILED
FEB 02 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008563
PATENT NO. : 6802458
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

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

(For Patent Owner)

MAILED

FEB 0 2 2009

CENTRAL REEXAMINATION UNIT

Lawrence A. Hoffman
Ostrolenk, Faber, Gerb & Soffen, LLP
1180 Avenue of the Americas
New York, NY 10036

(For Third Party Requester)

In re Christian T. Gregory	:	**DECISION DISMISSING PETITION**
Reexamination Proceeding	:	**FOR RECONSIDERATION OF**
Control No: 90/008,563	:	**DECISION DISMISSING PETITION**
Filed: March 30, 2007	:	**TO SUSPEND *EX PARTE***
For: U.S. Patent No. 6,802,458	:	**REEXAMINATION PROCEEDING**

This is a decision on the July 21, 2008 patent owner petition under 37 CFR 1.181 titled "Petition For Reconsideration Of Decision Dismissing Petition To Suspend *Ex Parte* Reexamination Proceeding."

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

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

FEES

A petition fee under 37 CFR 1.17(f) of $400 has been charged to patent owner's deposit account, pursuant to the authorization for same at pages 2 and 16 of the July 21, 2008 petition.

BACKGROUND

1. Patent number 6,802,458 ("the '458 patent") issued on October 12, 2004, with claims 1-37.

2. The '458 patent owner filed a lawsuit against K-Rain Manufacturing Corporation in the U.S. District Court for the Central District of California on April 12, 2006, alleging infringement of the '458 patent (Case No. 2:06cv2223, styled *Rain Bird Corporation v. K Rain Manufacturing Company*).

3. K-Rain Manufacturing Corporation filed a third-party request for *ex parte* reexamination of claims 1-10, 12-14, 19-28, and 33-35 of the '458 patent on March 30, 2007, that was assigned control no. 90/008,563 ("the '8563 proceeding").

4. On April 20, 2007, the district court stayed the lawsuit in view of the '8563 proceeding.

5. The request for *ex parte* reexamination was granted on June 15, 2007.

6. A first Office action was issued on March 31, 2008, in the '8563 proceeding confirming claims 14 and 28 of the '458 patent and rejecting claims 1-10, 12-13, 19-27, and 33-35 of the '458 patent.[1] The March 31, 2008 Office action sets a 1-month shortened statutory period for response.

7. On April 28, 2008, patent owner filed (i) a paper titled "Emergency Petition To Suspend Reexamination Proceeding To Permit Interference Issue To Be Decided First In Litigation" seeking to suspend the '8563 reexamination proceeding until the district court determines priority of inventorship, and (ii) a paper titled "Expedited Petition Under 37 C.F.R. § 1.550(c) For Extension Of Time To Respond To Office Action In *Ex Parte* Reexamination" seeking a 90-day extension of time to respond to the March 31, 2008 Office action.

8. On June 12, 2008, the district court lifted the stay in the lawsuit.

9. On July 9, 2008, a Decision Dismissing Petition To Suspend *Ex Parte* Reexamination Proceeding was issued in the '8563 proceeding, dismissing the April 28, 2008 petition to suspend.

10. On July 21, 2008, patent owner filed the instant petition seeking reconsideration of the July 9, 2008 Decision and suspension of the '8563 reexamination proceeding until the district court determines priority of inventorship.

DECISION

I. Pertinent 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, $1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $500.

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

[1] Claims 11, 15-18, 29-32, and 36-37 are correctly identified in the Office action as being not subject to reexamination.

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:

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 CFR 1.111 provides, in pertinent part:

(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment.

*

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

37 CFR 1.137 provides, in pertinent part:

(a) *Unavoidable.* If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination 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 showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable ...

(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 ...

*

*

(d) *Terminal Disclaimer.*

*

*

(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.181(f) provides:

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.

37 CFR 1.550 provides, in pertinent part:

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension.

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

(e) If a response by the patent owner is not timely filed in the Office,

(1) The delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable; a petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a); or

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 2268 provides, in pertinent part:

I. PETITION BASED ON UNAVOIDABLE DELAY

The unavoidable delay provisions of 35 U.S.C. 133 are imported into, and are applicable to, *ex parte* reexamination proceedings by 35 U.S.C. 305. See *In re Katrapat*, 6 USPQ2d 1863 (Comm'r Pat. 1988). Accordingly, the Office will consider, in appropriate circumstances, a petition showing unavoidable delay under 37 CFR 1.137(a) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide an adequate showing of the cause of unavoidable delay, including the details of the circumstances surrounding the unavoidable delay and evidence to support the showing. Additionally, the petition must be accompanied by the petition fee set forth in 37 CFR 1.17(l) and a proposed response to continue prosecution (unless it has been previously filed).

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).

II. Findings and Analysis

Patent owner has not responded to the March 31, 2008 Office action, as is required by 37 CFR 1.111. In both the petition to suspend filed April 28, 2008, and the instant petition seeking reconsideration filed July 21, 2008, patent owner identifies U.S. Patent Application Publication No. 2002/0074432 ("the '432 publication") as precluding a response to the March 31, 2008 Office action. Specifically, patent owner states that it cannot reply to rejections contained within the Office action in which the '432 publication is applied as a prior art reference under 35 U.S.C. 102(e).

The March 31, 2008 Office action, however, contains a total of six rejections. Four of the six rejections do not rely on the '432 publication. Patent owner could have responded to the four rejections that do not rely on the '432 publication. Patent owner could have requested the Office to permit the petition to suspend reexamination to serve as the response to the two rejections that rely on the '432 publication.

Patent owner's decision to file the April 28, 2008 petition to suspend and the instant petition seeking reconsideration is noted. Under 37 CFR 1.181(f), however, the mere filing of those petitions did not serve to stay the period for responding to the March 31, 2008 Office action. Also noted is the April 28, 2008 petition for extension of time. Under 37 CFR 1.550(c), the mere filing of the April 28, 2008 extension petition did not effect any extension. Further, patent owner did not show diligence in following up on the results of the extension petition; a decision on the petition apparently was never issued. Still further, even if the entire requested extension of 90 days had been granted, the extended period would have expired on July 29, 2008.

In view of patent owner's failure to act in accordance with 37 CFR 1.181(f), i.e., failure to respond to the March 31, 2008 Office action, the '8563 reexamination proceeding prosecution is terminated and not pending, in accordance with 35 U.S.C. 133. The Office does not have jurisdiction to decide a petition under 37 CFR 1.181 on the merits, where the underlying proceeding is not pending. Therefore, the instant petition is dismissed.

ADDITIONAL DISCUSSION

Patent owner has the option to seek revival of the '8563 reexamination proceeding, pursuant to 37 CFR 1.137, based upon either unintentional or unavoidable delay.

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

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

With respect to the response required to the March 31, 2008 Office action, patent owner must include therein a reply to the four of the six rejections that do not rely on the '432 publication. For the two rejections that rely on the '432 publication, patent owner may include a response on the merits, or patent owner may include a request to treat a renewed petition to suspend reexamination as its response to the two rejections based on the '432 publication. However, if the renewed petition to suspend is not granted, the response will be deemed an incomplete response, which patent owner will be required to complete at that point.

CONCLUSION

1. The patent owner petition filed on July 21, 2008, is dismissed. This is not a final agency decision.

2. The '8563 *ex parte* reexamination proceeding will not be suspended. Jurisdiction over the proceeding is being retained by the Office of Patent Legal Administration for ONE MONTH from the mailing of this Decision to provide patent owner with an opportunity to revive the proceeding. If a petition to revive is not filed within the ONE MONTH time period, jurisdiction over the '8563 reexamination proceeding will be returned to the Central Reexamination Unit, for processing as a terminated prosecution.

3. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

1-30-09
C:\Kiva\Kenpet7\stay included\8563_ decision dismissing reconsideration req for stay for priority of patent suit.doc

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.
90/008,563	03/30/2007	6802458	8473/90349	4905

22242 7590 03/10/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2009

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

Date:
MAILED

MAR 10 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008563
PATENT NO. : 6802458
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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Mark W. Hetzler
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(For Patent Owner)

MAILED

MAR 10 2009

CENTRAL REEXAMINATION UNIT

Lawrence A. Hoffman
Ostrolenk, Faber, Gerb & Soffen, LLP
1180 Avenue of the Americas
New York, NY 10036

(For Requester)

In re Christian T. Gregory
Ex Parte Reexamination Proceeding
Control No. 90/008,563
Filed: March 30, 2007
For: U.S. Patent No. 6,802,458

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the March 2, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination ("the March 2, 2009 patent owner petition to revive").[1]

The March 2, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The March 2, 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 response under 37 CFR 1.550(b) to the March 31, 2008 Office action.

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:

> (b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.
>
> *

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

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 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[2] and a proper statement under 37 CFR 1.137(b)(3) were

[2] The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the present petition has been paid.

submitted as part of the March 2, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a response to the March 31, 2008 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a response to any Office action. The March 31, 2008 Office action set a one-month period for response. A response to the March 31, 2008 Office action was not filed until March 2, 2009, which was untimely. However, for the purpose of evaluating whether the March 2, 2009 patent owner petition to revive is a grantable petition, the submission of the March 2, 2009 response to the March 31, 2008 Office action satisfies item (1).[3]

Accordingly, the March 2, 2009 patent owner petition to revive is **granted**.

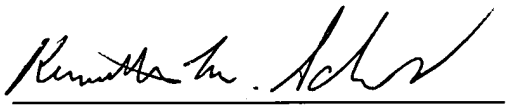
CONCLUSION

1. The March 2, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being retained by the Office of Patent Legal Administration, for treatment of patent owner's March 2, 2009 Petition for Reconsideration of Decision Dismissing Petition for Reconsideration of Decision Dismissing Petition to Suspend *Ex Parte* Reexamination Proceeding.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Aaron Lewis, of CRU Art Unit 3993, at (571) 272-4795.

4. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



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

[3] This decision is not directed to the persuasiveness and propriety of the arguments presented in the March 2, 2009 response as to each of the rejections set forth in the March 31, 2008 Office action; such is the examiner's province.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,563	03/30/2007	6802458	8473/90349	4905

22242 7590 04/08/2009

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120 SOUTH LASALLE STREET
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/08/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

Date:
MAILED
APR 08 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008563
PATENT NO. : 6802458
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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Lawrence A. Hoffman (For Requester)
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1180 Avenue of the Americas
New York, NY 10036

In re Christian T. Gregory :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,563 : **DISMISSING**
Filed: March 30, 2007 : **WITHDRAWN PETITION**
For: U.S. Patent No. 6,802,458 :

This is a decision on the March 2, 2009 patent owner petition titled "Petition For Reconsideration Of Decision Dismissing Petition For Reconsideration Of Decision Dismissing Petition To Suspend *Ex Parte* Reexamination Proceeding" ("the March 2, 2009 patent owner petition").

Subsequent to the March 2, 2009 patent owner petition, patent owner filed, on March 16, 2009, a paper titled "Withdrawal Of Petition For Reconsideration Of Decision Dismissing Petition For Reconsideration Of Decision Dismissing Petition To Suspend *Ex Parte* Reexamination Proceeding" ("the March 16, 2009 withdrawal").

The March 2, 2009 patent owner petition and the March 16, 2009 withdrawal of petition are before the Office of Patent Legal Administration (OPLA) for consideration.

The March 16, 2009 withdrawal is accepted. Therefore, the March 2, 2009 patent owner petition is **dismissed** as withdrawn.

CONCLUSION

1. The March 2, 2009 patent owner petition is **dismissed** as withdrawn.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, for processing of the March 2, 2009 Response To Office Action In *Ex Parte* Reexamination Proceeding.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Aaron Lewis, of CRU Art Unit 3993, at (571) 272-4795.

4. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

3-7-09
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,565	04/24/2007	4,707,592	CUI-1B	3461

7055 7590 06/26/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/26/2008

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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UNITED PLAZA, SUITE 1600
PHILADELPHIA, PA 19103

MAILED

JUN 26 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008565

PATENT NO. 4,707,592

ART UNI 3993

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

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

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

(For Patent Owner)

MAILED

JUN 26 2008

VOLPE AND KOENIG PC
Attn: Gerald B. Halt, Jr.
30 S 17th St Ste 1600
Philadelphia, PA 19103

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

KRAMER & AMADO, P.C.
Attn: Andreas Baltatzis
1725 DUKE STREET
SUITE 240
ALEXANDRIA, VA 22314

(For Third Party Requester)

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

In re: Ware
Ex Parte Reexamination Proceeding
Control No. 90/008,565
Deposited: 24 April 2007
For U.S. Patent No. 4,707,592

In re: Ware
Ex Parte Reexamination Proceeding
Control No. 90/008,641
Deposited: 17 May 2007
For U.S. Patent No. 4,707,592

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/008,641 and the reexamination control number 90/008,565 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 90/008,565 and 90/008,641 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. 90/008,565 and 90/008,641 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 a first Office action on the merits.

CONCLUSION

1. Reexamination Control Nos. 90/008,565 and 90/008,641 are hereby **merged**.

2. The proceedings are thus returned to the examiner in charge of the proceedings for a first Office action on the merits.

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
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
CRU SPE-AU 3992
for

Gregory Morse,
Director,
Central Reexamination Unit