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.

/MJR/

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.
90/008,568	03/29/2007	6415335	06-455	7319

7590 08/13/2009

EXAMINER	
ART UNIT	PAPER NUMBER

MATTHEW B. TALPIS, ESQ.
BAKER BOTTS LLP
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201

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.
90/008,343	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.
90/008,584	04/03/2007	6415335	FRIENDFINDER.RX2	3276

7590 08/13/2009

EXAMINER	

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

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

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)).

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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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
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(For Third Party Requester)

Thomas A Fairhill
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
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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

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.
90/008,570	03/28/2007	6406499	OHI 1717-061C	8964

8698 7590 06/02/2008

STANDLEY LAW GROUP LLP
495 METRO PLACE SOUTH
SUITE 210
DUBLIN, OH 43017

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Dr. Aldo A. Laghi
c/o Ronald A. Christaldi
P.O.Box 2350
Tampa, FL 33601-2350

MAILED

JUN 02 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,570*.

PATENT NO. *6406499*.

ART UNIT *3993*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STANDLEY LAW GROUP, LLP 495 Metro Place South Suite 210 Dublin, OH 43017	:	(for Patent Owner)
Dr. Aldo A. Laghi c/o Ronald A. Christaldi P.O. Box 2350 Tampa, FL 33601-2350	:	(for Third Party Requester)
In re Kanin *Ex Parte* Reexamination Proceeding Control No.: 90/008,257 Filed: October 5, 2006 For: U.S. Patent 6,406,499 *In re Kanin* *Ex Parte* Reexamination Proceeding Control No.: 90/008,570 Filed: March 28, 2007 For: U.S. Patent 6,406,499	:	DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 3900 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 6,406,499 which issued June 18, 2002, is the subject of Reexamination Control Nos. 90/008,257 and 90/008,570.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,257 ('8257), was filed October 5, 2006, by Dr. Aldo A. Laghi of Tampa, Florida. The request urged that a substantial new question of patentability was raised by two industry catalogs, U.S. Patent No. 4,822,371 to Jolly *et al.* and U.S. Patent No. 5,633,286 to Chen. None of these references were cited in the prosecution of U.S. Patent No. 6,406,499.

3. Reexamination was ordered for '8257 on December 1, 2006.

4. A second request for reexamination, assigned Reexamination Control No. 90/008,570 ('8570), was filed March 28, 2007, Dr. Aldo A. Laghi of Tampa Florida. The request urged that a substantial new question of patentability was raised by two advertisements and the teachings of US. Patent No. 5,258,037 to Caspers in addition to the two catalogs and two patents cited in the first request for reexamination. None of these references were cited in the prosecution of U.S. Patent No. 6,406,499.

5. Reexamination was ordered for '8570 on May 18, 2007.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,257 and 90/008,570 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control No. 90/008,257 as:

Reexamination Control Ns. 90/008,257 and 90/008,570

Standley Law Group LLP
495 Metro Place South
Suite 210
Dublin, OH 43017

A copy of all correspondence from the USPTO will be served on the third party requesters at the address listed in Reexamination Control Nos. 90/008,257 and 90/008,570, respectively as:

Dr. Aldo A. Laghi
c/o Ronald A. Christaldi
PO Box 2350
Tampa, FL 33601-2350

CONCLUSION

Reexamination Control Nos. 90/008,257 and 90/008,570 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

Lissi M. Marquis, Director
Central Reexamination Unit

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

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
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(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

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.
90/008,576	05/25/2007	6,772,132	07-1021-US-REX1	1735

39310 7590 04/21/2008

MBHB/TRADING TECHNOLOGIES
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BRINKS HOFER GILSON & LIONE
NBC TOWER, SUITE 3600
455 NORTH CITYFRONT PLAZA DRIVE
CHICAGO, IL 60611

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008576
PATENT NO. : 6772132
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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Jennifer M. Kurcz : (for Patent Owner)
MBHB/TRADING TECHNOLOGIES :
300 South Wacker Drive :
Suite 3200 :
Chicago, IL 60606 :

James L. Katz : (for Third Party Requester)
Brinks, Hofer, Gilson & Lione :
NBC Tower Suite 3600 :
455 North City Front Plaza Drive :
Chicago, IL 60611 :

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.59(b) To
: EXPUNGE INFORMATION

In re: Kemp *et al.* :
Ex Parte Reexamination Proceeding :
Control No. 90/008,576 :
Filed: May 25, 2007 :
For: US Patent No. 6,772,132 :

This is a decision on the petition under 37 CFR § 1.59(b) to expunge information not material to patentability filed by Patent Owner on March 13, 2008.

By this petition Patent Owner requests that a single document, the "Summary chart of TradePad" be expunged from the record. The petition was filed in a timely manner with the authorization to debit a deposit account for the appropriate fee pursuant to 37 CFR § 1.17(g).

The petition to expunge filed under 37 CFR 1.59(b) is **granted.**

CITATION OF APPROPRIATE PROCEDURE

MPEP § 724.04

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) Material submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is portent to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.

(E) If a petition to expunge is not timely filed, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

DECISION

Petitioner requests that a document filed in the Information Disclosure Statement (IDS) filed on March 4, 2008 identified as "Summary chart of Trade Pad[1], dated September 18, 2000, be expunged from the record.

Petitioner states that the information contained in "Summary chart of Trade Pad" is subject to a protective order which has not been made public.

The petition fee set forth in 37 CFR § 1.17(g) has been paid.

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

Accordingly, the petition is **granted**.

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

The expunged material has been closed from the Official file.

CONCLUSION

1. The petition to expunge filed under 37 CFR 1.59(b) is **granted.**

2. The electronic file with the IDS paper in question will be closed.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commission 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

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[1] Item no. G0020725-20726 listed on Sheet 15/16 I.b.

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 Lynne H. Browne, Special Program Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-3670.

Lissi Mojica Marquis
Director,
Central Reexamination Unit.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,576	05/25/2007	6,772,132	07-1021-US-REX1	1735

39310 7590 06/23/2008

MBHB/TRADING TECHNOLOGIES
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2008

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

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CENTRAL REEXAMINATION UNIT

MBHB/TRADING TECHNOLOGIES
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Suite 3200
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(For Patent Owner)

James L. Katz
Brinks, Hofer, Gilson & Lione
NBC Tower Suite 3600
455 North City Front Plaza Drive
Chicago, IL 60611

(For Third Party Requester)

In re Kemp et al.
Reexamination Proceeding
Control No.: 90/008,576
Filed: April 6, 2007
For: U.S. Patent No.: 6,772,132

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

This is a decision on the April 28, 2008 patent owner petition under 37 CFR 1.182 to enter, and have the examiner consider, an information disclosure statement (IDS) re-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 granted for the reasons set forth below.

BACKGROUND

1. Patent number 6,772,132 issued on August 3, 2004 (the '132 patent).
2. On April 6, 2007, third party requester filed a request for reexamination of the '132 patent. The request was assigned reexamination control No. 90/008,576 (the '8576 proceeding).
3. On August 1, 2007 the Office issued an order granting the '8576 reexamination request.
4. The '8576 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on January 16, 2008.
5. On January 15, 2008, one day prior to the issuance of the NIRC in the '8576 proceeding, the patent owner submitted an IDS in the '8576 proceeding, which was partially considered by the Office.
6. On March 4, 2008, the Office issued a miscellaneous communication contained an annotated copy of the PTOSB08 from the January 15, 2008 IDS. The communication noted that several references were not considered because the submission did not comply with the copy requirement of 37 CFR 1.98.

7. On April 28, 2008, patent owner re-submitted the portion of the January 15, 2008 IDS directed to the unconsidered references, including copies of the unconsidered references, in the '8576 proceeding.

8. Concurrently on April 28, 2008 patent owner filed a petition under 37 CFR 1.182 in accordance with MPEP 2256 and 609.05(b) requesting consideration of the IDS and including, as exhibits, a declaration by patent owner's document specialist with first hand knowledge of the composition of the January 15, 2008 IDS and a copy of a postcard receipt from the Office acknowledging receipt of the IDS on January 15, 2008.

9. 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 1.98(a)(2) states:

(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.

MPEP 2256 states (in part):

Typically, the primary source of prior art will be the patents and printed publications cited in the request for *ex parte* reexamination.

Subject to the discussion provided below in this section, the examiner must also consider patents and printed publications:

(A) cited by another reexamination requester under 37 CFR 1.510 or 37 CFR 1.915;

(B) cited in a patent owner's statement under 37 CFR 1.530 or a requester's reply under 37 CFR 1.535 if they comply with 37 CFR 1.98;

(C) cited by the patent owner under a duty of disclosure (37 CFR 1.555) in compliance with 37 CFR 1.98;

(D) discovered by the examiner in searching;

(E) of record in the patent file from earlier examination; and

(F) of record in the patent file from any 37 CFR 1.501 submission prior to date of an order if it complies with 37 CFR 1.98. . . .

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. . .

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, petitioner is not submitting a new IDS after NIRC, but instead alleging an Office error in the processing of a pre-NIRC IDS, resulting in the IDS not being fully considered by the examiner of record. Therefore, a statement addressing the requirements of MPEP 2256 items (A) and (B) is not required, as the petition is for consideration of a pre-NIRC IDS submission. Specifically, petitioner asserts that, contrary to the examiner's notation on the record that the January 15, 2008 IDS did not fully comply with the copy requirement of 37 CFR 1.98, the submission did contain a copy of each and every cited reference listed on the PTOSB08. In support of this assertion petitioner has submitted a declaration executed by Brendan Dineen. In the declaration Mr. Dineen states that he prepared the January 15, 2008 IDS. In paragraph six of the declaration, he states that he personally verified that all the documents cited in the IDS forms of the January 15, 2008 IDS submission were present. Finally, Mr. Dineen notes that the January 15, 2008 IDS submission consisted of 10 boxes. Petitioner submits as evidence in Exhibit B of the instant petition proof of receipt by the Office of ten boxes of documents for the January 15, 2008 IDS submission, in the form of a copy of the USPTO date stamped post card receipt which lists *inter alia* 10 boxes of copies of non-US patent literature and cited references. Petitioner also resubmitted copies of all the documents which were not considered by the examiner from the January 15, 2008 IDS submission. In light of the evidentiary showing by an affiant with a statement of first hand knowledge as to the presence of copies of all the cited references in satisfaction of the copy requirement of 37 CFR 1.98 along with proof of receipt of the complete IDS submission prior to issuance of a NIRC, the April 28, 2008 petition is granted.

Jurisdiction over the proceeding is being transferred to the Central Reexamination Unit for consideration of the references resubmitted by petitioner on April 28, 2008. It is to be noted that where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above, unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent Office action. See Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 *Off. Gaz. Pat. Office* at 125 (response to comment 6) and see MPEP 609 (Eighth Edition, Rev. 5, August 2006).

When, as in the instant case, an unusually large number of references are cited, and in the absence of any description of the relevance of the references, it should be assumed that only the most cursory review of the cited documents consistent with these guidelines has been performed. If petitioner is aware of any information that might be of particular relevance, it should be pointed out in order to insure a higher degree consideration.

CONCLUSION

1. The petition is granted as to the request for consideration of the IDS filed on April 28, 2008.

2. The IDS papers will be considered by the examiner of record in the '8576 proceeding, as outlined above.

3. Jurisdiction of the present proceeding will be transferred to the Central Reexamination Unit for consideration of the April 28, 2008 IDS submission in due course. After consideration is complete, the '8576 proceeding will then be returned to the publication process, to be processed 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

6-17-08
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CENTRAL REEXAMINATION UNIT

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Suite 3200
Chicago, IL 60606

James L. Katz
Brinks, Hofer, Gilson & Lione (For Third Party Requester)
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455 North City Front Plaza Drive
Chicago, IL 60611

In re Kemp et al. :
Reexamination Proceeding :
Control No.: 90/008,577 : **DECISION**
Filed: April 6, 2007 : **ON PETITION**
For: U.S. Patent No.: 6,766,304 : **UNDER 37 CFR 1.182**
:

This is a decision on the February 1, 2008 patent owner petition under 37 CFR 1.182 to enter, and have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed February 1, 2008, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,766,304 issued on July 20, 2004 (the '304 patent) and claiming the benefit of U.S. Application Serial number 09/894,637 which issued as Patent number 6,772,132 on August 3, 2004 (the '132 patent).
2. On April 6, 2007 third party requester filed reexamination requests for the reexamination of both the '132 patent and the '304 patent. The requests were assigned reexamination control Nos. 90/008,576 (the '8576 proceeding) and Nos. 90/008,577 (the '8577 proceeding) respectively. The '8577 proceeding is the present proceeding, for which the petition was filed.
3. On August 1, 2007 the Office issued an order granting the '8576 reexamination request.
4. On August 2, 2007 the Office issued an order granting the '8577 reexamination request.
5. The'8577 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on January 7, 2008.
6. The **'8576** proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on January 16, 2008.

7. On January 15, 2008, one day prior to the issuance of the NIRC in the **'8576** proceeding, the patent owner submitted an IDS in the **'8576** proceeding, which was considered by the Office.

8. On February 1, 2008, patent owner submitted an IDS in the present '8577 proceeding that was virtually identical to the IDS submitted on January 15, 2008 in the '8576 proceeding.

9. Also on February 1, 2008, the instant petition was submitted with the IDS, which petition the patent owner requests the Office to consider 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 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 not a full ***factual accounting*** to explain why the information submitted could not be submitted earlier or an ***explanation of the relevance*** of the information submitted with respect to the **claimed invention** in the reexamination proceeding. The instant petition was filed very late in the reexamination proceeding, and no substantive attempt is made to satisfy the guidance of MPEP 2256. The patent owner has not provided a 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 number of various proceedings had produced a large volume of references in the October 2007 time frame. Patent owner states they discussed these references and their materiality to examination in an October 24, 2007 interview. Patent owner further states that the references were reviewed and assembled into an IDS, but that between holidays and the volume of references, the task took longer than expected. Finally, patent owner asserts that on the same day they received the NIRC in the '8577 proceeding, they had submitted virtually the same IDS in the 90/008576 *ex parte* reexamination proceeding to the '304 patent's parent patent. The record of the '8576 proceeding reflects that day to be January 15, 2008. Patent owner thus concludes that in light of the above facts and circumstances, and the IDS submitted in the '8577 proceeding is virtually the same, the examiner of record on both cases is the same and because the issues between the two proceedings substantially overlap the IDS should be considered. This is not a full and proper factual accounting in accordance with MPEP 2256 guidance. Patent owner includes when they became aware of the information and a partial explanation as to why it could not submit the references any earlier than January 15, 2008, i.e. because of the unexpected length needed to review the references for relevancy. However, patent owner presents no explanation as to why there was the need for an additional sixteen day delay from the January 15, 2008 submission in the companion reexamination proceeding until submission of the IDS in the '8577 on February 1, 2008 in the present proceeding. If the IDS package prepared for the '8576 proceeding was virtually identical to the IDS for submission in the '8577 proceeding, then only a *de minimus* difference in the submission dates of the IDSs

would be expected. Therefore, without a factual accounting as to the delay in IDS submissions between the two proceedings, it is unclear as to why there would an additional sixteen day delay in regard to the IDS submission in the '8577 proceeding. Accordingly, patent owner has failed to satisfy the MPEP 2256, item (A), requirement for submission of a post NIRC IDS.

In regard to explaining the relevance of the submitted information (B), the patent owner makes only a broad generalization that the information "may be material to the examination for the present reexamination proceeding," the predecessor phrasing of the current "material to patentability" standard in 37 CFR 1.56. As justification for the delay in submitting the IDS patent owner asserts that the delay was caused by the lengthy processing and assessing of the voluminous amount of references for their relevancy to the claimed invention of the reexamination proceeding. However, despite going through this lengthy and arduous process of assessing relevancy of a voluminous amount of references, patent owner makes no attempt to explain the relevancy any of the references 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 a post NIRC IDS.

In summary, patent owner does not make a full factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; nor does patent owner explain the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on January 7, 2008, and the proceeding is being prepared to enter the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite discussion (factual accounting and explanation) of 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 February 1, 2008.

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,577	05/25/2007	6766304	95549/99998	6362

39310 7590 03/25/2008

MBHB/TRADING TECHNOLOGIES
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2008

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MBHB/TRADING TECHNOLOGIES
300 South Wacker Drive
Suite 3200
Chicago, IL 60606

(For Patent Owner)

James L. Katz
Brinks, Hofer, Gilson & Lione
NBC Tower Suite 3600
455 North City Front Plaza Drive
Chicago, IL 60611

(For Third Party Requester)

In re Kemp et al.
Reexamination Proceeding
Control No.: 90/008,577
Filed: April 6, 2007
For: U.S. Patent No.: 6,766,304

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

This is a decision on the March 20, 2008 renewed 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 granted to the extent that the examiner will consider the IDS to the same extent as it was considered in 90/008,576.

BACKGROUND

1. Patent number 6,766,304 issued on July 20, 2004 (the '304 patent) and claiming the benefit of U.S. Application Serial number 09/894,637 which issued as Patent number 6,772,132 on August 3, 2004 (the '132 patent).
2. On April 6, 2007 third party requester filed reexamination requests for the reexamination of both the '132 patent and the '304 patent. The requests were assigned reexamination control Nos. 90/008,576 (the '8576 proceeding) and Nos. 90/008,577 (the '8577 proceeding) respectively. The '8577 proceeding is the present proceeding, for which the petition was filed.
3. On August 1, 2007 the Office issued an order granting the '8576 reexamination request.
4. On August 2, 2007 the Office issued an order granting the '8577 reexamination request.
5. The'8577 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on January 7, 2008.
6. The **'8576** proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on January 16, 2008.

7. On January 15, 2008, one day prior to the issuance of the NIRC in the **'8576** proceeding, the patent owner submitted an IDS in the **'8576** proceeding, which was considered by the Office.
8. On February 1, 2008, patent owner submitted an IDS in the present '8577 proceeding that was virtually identical to the IDS submitted on January 15, 2008 in the '8576 proceeding.
9. Also on February 1, 2008, patent owner filed a petition under 37 CFR 1.182 to enter, and have the examiner consider, the IDS.
10. On March 12, 2008, the Office mailed a decision dismissing the February 1, 2008 petition.
11. On March 20, 2008, patent owner filed the present renewed petition under 37 CFR 1.182 to enter, and have the examiner consider, the IDS.

DECISION

The petition requests that the examiner consider the IDS "at least, to the same extent the IDS was considered in Reexam Control No. 90/008,576 (the '8576 proceeding)." Based upon the individual facts and circumstances of this situation, it is considered that the statutory mandate of 35 U.S.C. 305 that *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office" can be served, while providing relief to patent owner. Accordingly, the petition is granted such that the February 1, 2008 IDS will be considered to the same extent as the corresponding IDS considered in the 90/008,576 proceeding.

CONCLUSION

1. The petition is granted to the extent that the examiner will consider the IDS filed on February 1, 2008, to the same extent as the corresponding IDS was considered in the 90/008,576 proceeding.

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

4. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7710.

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

3-25-08

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,577	05/25/2007	6766304	95549/99998	6362

39310 7590 04/21/2008

MBHB/TRADING TECHNOLOGIES
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BRINKS HOFER GILSON & LIONE
NBC TOWER, SUITE 3600
455 NORTH CITYFRONT PLAZA DRIVE
CHICAGO, IL 60611

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008577
PATENT NO. : 6766304
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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Jennifer M. Kurcz : (for Patent Owner)
MBHB/TRADING TECHNOLOGIES :
300 South Wacker Drive :
Suite 3200 :
Chicago, IL 60606 :

James L. Katz : (for Third Party Requester)
Brinks, Hofer, Gilson & Lione :
NBC Tower Suite 3600 :
455 North City Front Plaza Drive :
Chicago, IL 60611 :

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.59(b) To
: EXPUNGE INFORMATION

In re: Kemp *et al.* :
Ex Parte Reexamination Proceeding :
Control No. 90/008,577 :
Filed: May 25, 2007 :
For: US Patent No. 6,766,304 :

This is a decision on the petition under 37 CFR § 1.59(b) to expunge information not material to patentability filed by Patent Owner on March 13, 2008.

By this petition Patent Owner requests that a single document, the "Summary chart of TradePad" be expunged from the record. The petition was filed in a timely manner with the authorization to debit a deposit account for the appropriate fee pursuant to 37 CFR § 1.17(g).

The petition to expunge filed under 37 CFR 1.59(b) is **granted.**

CITATION OF APPROPRIATE PROCEDURE

MPEP § 724.04

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) Material submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is portent to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.

(E) If a petition to expunge is not timely filed, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

DECISION

Petitioner requests that a document filed in the Information Disclosure Statement (IDS) filed on February 1, 2008 identified as "Summary chart of Trade Pad[1], dated September 18, 2000, be expunged from the record.

Petitioner states that the information contained in "Summary chart of Trade Pad" is subject to a protective order which has not been made public.

The petition fee set forth in 37 CFR § 1.17(g) has been paid.

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

Accordingly, the petition is **granted**.

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

The expunged material has been closed from the Official file.

CONCLUSION

1. The petition to expunge filed under 37 CFR 1.59(b) is **granted.**

2. The electronic file with the IDS paper in question will be closed.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

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

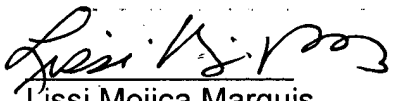
By Fax to: (571) 273 9900
Central Reexamination Unit

---

[1] Item no. G0020725-20726 listed on Sheet 15/16 I.b.

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 Lynne H. Browne, Special Program Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-3670.



Lissi Mojica Marquis
Director,
Central Reexamination Unit.

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Standley Law Group LLP
495 Metro Place South
Suite 210
Dublin, OH 43017

(For Patent Owner)

MAILED

OCT 26 2007

CENTRAL REEXAMINATION UNIT

Enclosure: copy of third party requester's Change of Correspondence Address filed September14, 2007.

Dr. Aldo Laghi
c/o Ronald A. Christaldi
101 East Kennedy Boulevard, Suite 2800
Tampa, FL 33602[1]

(For 3rd Party Requester)

Reexam Control No.: 90/008,271
Filed : October 5, 2006
For U.S. Patent No. : 6,964,688

DECISION MERGING REEXAMINATION PROCEEDINGS

Reexam Control No.: 90/008,578
Filed : May 7, 2007
For U.S. Patent No. : 6,964,688

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/008,271 was ordered in a decision mailed December 1, 2006 indicating that claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69 would be reexamined. A non-final Office action was mailed June 21, 2007. On July 30, 2007 an amendment was filed. The amendment amended claim 1. No further action has taken place in this reexamination proceeding.

[1] Third party requester filed a Change of Correspondence Address on September 14, 2007. The submission did not include an indication that it had been served on patent owner as is required by 37 CFR 1.550(f). A copy of the September 14, 2007 communication is being sent with this decision to patent owner.

Reexamination in application control No. 90/008,578 was ordered in a decision mailed June 20, 2007 indicating that claims 4-7, 9, 20-22, 24, 25, 28, 48, 57-59, 61 and 67 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. An Information Disclosure Statements was filed October 3, 2007. Thus, there have been no changes made to the specification, claims, or drawings.

As evidenced by the above facts, reexamination control No. 90/008,271 and reexamination control No. 90/008,578 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claim 1 has been amended in the '271 reexamination proceeding by virtue of the amendment filed July 30, 2007. No amendments have been filed in the '578 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

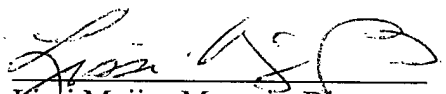
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1, 2, 4-13, 16-28, 48, 50, 51, 54-67 and 69, the only claims for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,271 and 90/008,578 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files**. Upon receipt of the response, an Office action will issue in due course.

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



Lissi Mojica Marquis, Director
Central Reexamination Unit

PTO/SB/123 (01-08)
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Patent Number	6964668
Issue Date	November 15, 2005
Reexam Control Number	90/008,578
Filing Date	October 15, 1999
First Named Inventor	Bruce G. Kania
Attorney Docket Number	

THIRD PARTY PAPER
3PR

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OR

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Address C/O Ronald A. Christaldi, 101 East Kennedy Boulevard, Suite 2800 33602

City Tampa State Florida ZIP 33602

Country USA

Telephone 813-229-7600 Email rchristaldi@slk-law.com

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I am the:

☐ Patentee.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ Third Party Requestor

Signature

Typed or Printed Name Dr. Aldo A. Laghi

Date 9/14/07 Telephone (727) 528-8566

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Post Issue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Standley Law Group LLP
495 Metro Place South
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Dublin, OH 43017

(For Patent Owner)

Dr. Aldo Laghi
c/o Ronald A. Christaldi
101 East Kennedy Boulevard, Suite 2800
Tampa, FL 33602

(For 3rd Party Requester)

Reexam Control No.: 90/008,271
Filed : October 5, 2006
For U.S. Patent No. : 6,964,688

Reexam Control No.: 90/008,578
Filed : May 9, 2007
For U.S. Patent No. : 6,964,688

Reexam control No.: 90/008,979
Filed : January 2, 2008
For U.S. Patent No. : 6,964,688

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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SEP 10 2008

CENTRAL REEXAMINATION UNIT

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/008,271 was ordered in a decision mailed December 1, 2006 indicating that claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69 would be reexamined. A non-final Office action was mailed June 21, 2007. On July 30, 2007 an amendment was filed. The amendment amended claim 1.

Reexamination in application control No. 90/008,578 was ordered in a decision mailed June 20, 2007 indicating that claims 4-7, 9, 20-22, 24, 25, 28, 48, 57-59, 61 and 67 would be reexamined.

In a decision mailed October 26, 2007, reexamination proceedings 90/008,271 and 90/008,578 were merged. A condition for the merger was the filing of a housekeeping amendment placing identical claims in each of the two proceedings. A housekeeping amendment was received December 6, 2007 (informal), and a corrected housekeeping amendment was received December 10, 2007. In addition a "Terminal Disclaimer to Obviate a Double Patenting Rejection Over a "Prior Art"" was filed December 14, 2007 (approved December 17, 2007), and a "Supplemental Notification of Prior and/or Concurrent Proceedings" was filed March 3, 2008.

Reexamination in application control 90/008,979 was ordered in a decision mailed February 6, 2008 indicating that claims 2, 8, 10, 12, 13, 16-19, 23, 26, 27, and 69 would be reexamined. A "Waiver of Right to File Patent Owner Statement and Notification of Prior and/or Concurrent Proceedings' was filed on March 3, 2008. An Information Disclosure Statement was filed July 28, 2008. No amendments to the claims, specification and/or drawings have been filed in this proceeding. No Office action has been issued in this proceeding since the mailing of the decision granting reexamination.

As evidenced by the above facts, reexamination control No. 90/008,271, reexamination control No. 90/008,578, and reexamination control No. 90/008,979 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims, Drawings, and Specification in Each Proceeding

As noted above, claim 1 has been amended in the '271 and '578 reexamination proceedings by virtue of the amendment filed December 10, 2007. No amendments have been filed in the '979 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the three files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1, 2, 4-13, 16-28, 48, 50, 51, 54-67 and 69, the only claims for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the three reexaminations. All papers issued by the Office will contain the identifying data for each of the cases, and each action will be entered into each of the files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a

paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,271, 90/008,578, and 90/008,979 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files.** Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,582	04/18/2007	4976320	6065-000033/RXA	2632

61263 7590 07/30/2008

PROSKAUER ROSE LLP
1001 PENNSYLVANIA AVE, N.W.,
SUITE 400 SOUTH
WASHINGTON, DC 20004

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/30/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Ryan W. Massey
HARNESS, DICKEY, & PIERCE, P.L.C.
P.O. BOX 828
Bloomfield Hills, MI 48303

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JUL 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,582*.

PATENT NO. *4976320*.

ART UNIT *3993*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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Washington, DC 20004

(Patent Owner)

MAILED

JUL 30 2008

Daniel M. Cislo
Cislo & Thomas
233 Wilshire Boulevard, Suite 900
Santa Monica, CA 90401

(Third Part Requester) CENTRAL REEXAMINATION UNIT

In re Polan
Reexamination Proceeding
Control No.: 90/008,582
Filed: April 14, 2007
For: U.S. Patent No.: 4,976,320

: **DECISION**
: **DISMISSING AND**
: **EXPUNGING PETITON**

This is a decision on the July 7, 2008 third party requester paper entitled "PETITION UNDER 37 CFR § 1.183 SUSPENSION OF RULES."

The third party requester petition paper is before the Office of Patent Legal Administration.

The petition is dismissed.

The third party requester petition paper is an improper paper. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the third party requester. Thus, the present petition paper will be marked "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

BACKGROUND

1. Patent No. 4,976,320 (the '320 patent) issued on December 11, 1990.

2. A request for reexamination, assigned Control No. 90/008,582 (the '8582 proceeding), was filed by a third party requester on April 14, 2007.

3. Reexamination was ordered in the '8582 reexamination proceeding on June 29, 2007.

4. A first non-final Office action was issued on June 24, 2008.

6. On July 7, 2008, the third party requester filed the present petition paper, which is the subject of this decision.

DISCUSSION

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."

37 CFR 1.181(a) provides, in part:

> "Petition may be taken to the Director:
> *****
> (3) To invoke the supervisory authority of the Director in appropriate circumstances."

37 CFR 1.183 provides:

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

37 CFR §1.550 provides as to third parties in general:

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

DECISION

I. The present petition is being expunged from the record to the reexamination proceeding.

As noted, *supra*, the present request for reexamination of the '320 patent was filed on April 14, 2007, and reexamination was ordered on June 29, 2007. The record does not reveal that the patent owner filed a statement prior to third party requester's filing of the present petition on July 7, 2008. Thus, the third party requester was not entitled to file a reply, or any other submission, at the time the present petition was filed.

Further, the present petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, is not a reply to a patent owner's statement pursuant to 37 CFR 1.535, and does not qualify as a prior art citation under 37 CFR 1.501. Thus, 37 CFR 1.550 prohibits the consideration of the present third party requester submission.

In view of the above, the present petition does not have an entry right under the rules.

II. The petition is filed under 37 CFR 1.183; however, the rules cannot be waived to provide the third party requester the right to file a paper directed to how the Office should conduct the proceeding, or as to the patent owner's conduct.

Neither the rules nor any provision of the statute provide authority for a third party requester of a reexamination proceeding requested under 35 U.S.C. § 302 to file a paper directed to the issues and merits of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent are clear that the examination and prosecution in a reexamination proceeding requested under 35 U.S.C. § 302 must be *ex parte*. In the present instance, the third party requester has filed a petition discussing patent owner conduct and requesting that the Office take certain action in the proceeding based on same. See for example page 3, paragraph 2. The petition, therefore, attempts to convert the instant reexamination proceeding into other than an *ex parte* proceeding, at a point in the proceeding beyond which the active participation of the requester has ended. Thus, the petition seeks to go beyond the reexamination statute. Relief cannot, therefore, be provided.

The discussion and procedure proffered by the third party requester at this stage are precluded, since a reexamination proceeding requested under 35 U.S.C. 302 is an ***ex parte*** proceeding (after the expiration of the statement/reply period under 37 CFR §§ 1.530 and 1.535). The waiver/suspension of the rules requested in the present instance to permit the third party submission via the petition would not be justified in view of the legislation and implementing rules which make reexamination under 35 U.S.C. 302 - 307 an *ex parte* proceeding. See *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the Court said (paragraph bridging pages 1868 & 1869):

> "If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination. *See* 35 U.S.C. § 305 ("**[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination**"). Thus, a reexamination is conducted *ex parte* after it is instituted. *See In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1 , 5-6 n.6 (Fed. Cir.), *cert.* denied, 474 U.S. 828 (1985)." [Emphasis added in bold]

////

To the extent that the requested relief requires waiver pursuant to 37 CFR 1.183, § 1.183 provides for waiver of a "requirement of the regulations... which is not a requirement of the statutes." In the present instance, the waiver requested would contravene the intent and content of the statute. Thus, the petition cannot be granted under 37 CFR 1.183. In addition, 37 CFR 1.182 provides for relief not addressed by the regulations, provided that such relief is within the statute. The petition cannot, therefore, be granted based upon 37 CFR 1.182.

The petition requests consideration of matters that are outside of the Office's jurisdiction to conduct reexamination proceedings created by the statute. On this independent basis alone, the

third party requester petition cannot be considered and the request relief cannot be granted pursuant to 37 CFR 1.183.

Accordingly, the petition is dismissed.

III. In view of the above, the present petition will not be retained of record in the reexamination file, and it is being expunged ***without consideration of the substance of the petition***. Because the present reexamination proceeding is contained in an electronic Image File Wrapper (IFW) and the present petition was scanned into the IFW prior to the discovery that it is an improper paper, the petition paper cannot be physically returned to the third party requester. However, the present petition paper will be marked "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding. The present decision will be made of record in the reexamination file. See also MPEP 2267.

CONCLUSION

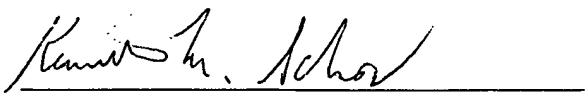
1. The petition is dismissed.

2. The petition paper filed by the third party requester on July 7, 2008 is being expunged as not having an entry right. This will be carried out by closing the petition paper (document) in the IFW file of the '8582 *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 for the proceeding, or elsewhere in the Office.

4. A copy of this decision will be made of record in the reexamination file.

5. Telephone inquiries related to the present decision should be directed to the undersigned at 571-272-7710.



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

July 29, 2008
C:\kiva\kimpropa\3PR\8582_improper 1.183 pet for 3PR participation.doc

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

MAY 13 2008

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

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

In re: 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
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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

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.
90/008,343	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

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Public Patent Foundation
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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
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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	
ART UNIT	PAPER NUMBER

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DATE MAILED: 08/13/2009

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

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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

Commissioner for Patents
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MAILED
AUG 13 2009
CENTRAL REEXAMINATION UNIT

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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

Commissioner for Patents
United States Patent and Trademark Office
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AUG 0 9 2007

CENTRAL REEXAMINATION UNIT

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

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

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

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

for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,065	03/03/2008	6103286	10884-000108-B-US	7198

23552 7590 09/26/2008

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/26/2008

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

MAILED

SEP 26 2008

CENTRAL REEXAMINATION UNIT

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

HELENA C. RYCHLICKI, EQS.
CONNOLLY BOVE LODGE & HUTZ LLP
1007 N. ORANGE STREET
P.O. BOX 2207
WILMINGTON, DE 19899

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,065*.

PATENT NO. *6103286*.

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

Elizabeth Cary Miller (For Patent Owner)
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

Helena C. Richlicki, Esq. (For Third Party)
Connally Bove Lodge & Hutz LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

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SEP 26 2008

CENTRAL REEXAMINATION UNIT

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control Number: 90/008,587
Filed: April 12, 2007
For: U.S. Patent 6,103,286

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control Number: 90/009,065
Filed: March 3, 2008
For: U.S. Patent 6,103,286

DECISION MERGING REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,103,286 issued August 15, 2000, is the subject of Reexamination Control Nos. 90/008,587 and 90/009,065.

2. A first request for Reexamination, assigned Reexamination Control No. 90/008,587 was filed April 12, 2007 for the Patent Owner by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references and by references that were previously cited but not applied in a rejection regarding claims 1 - 3 and 6 - 8.

3. Reexamination was ordered for 90/008,587 on July 11, 2007.

4. No Patent Owner's statement was received in the 90/008,587 proceeding.

5. A second request for Reexamination, assigned Reexamination Control No. 90/009,065, filed for a Third Party Requester by Helena C. Richlicki of Connolly, Bove, Lodge & Hutz LLP in Wilmington, Delaware. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1 - 4.

6. Reexamination was order for 90/009,065 on May 22, 2008.

7. No Patent Owner's statement was received in the 90/009,065 proceeding.

LEGAL BASIS

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 paragraph 1.570.

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

If the second request is based upon essentially the same patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as 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 90/008,587 and 90/009,065 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 MERGER 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 duplicate**, each bearing a signature and identifying data for **all** files, for entry into each file. See MPEP 2283, "Merger of Reexaminations."

CORRESPONDENCE

All correspondence from the USPTO will be addressed to the Patent Owner's representative address listed in Reexamination Control Nos. 90/008587 and 90/009,065 as:

Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control Nos. 90/008,587 and 90/009,065 as:

Helena C. Richlicki, Esq.
Connally Bove Lodge & Hutz, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

CONCLUSION

Reexamination Control Nos. 90/008,587 and 90/009,065 are merged. **Since there has been no amendment in any of the files, the requirement to file a "housekeeping amendment" is waived.** The merged reexamination files are being forwarded to the examiner for preparation of an Office action to be issued in due course.

Any inquiry concerning this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at telephone no. (571) 272-1535.

/Deborah Jones/ for

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Malloy & Malloy
2800 SW Third Avenue
Historic Coral Way
Miami, FL 33129

(For Patent Owner)

MAILED

SEP 22 2008

CENTRAL REEXAMINATION UNIT

SHEMWELL MAHAMEDI LLP
4880 Stevens Creek Blvd
Suite 201
San Jose, CA 95129

(For Requester)

In re Rothschild
Reexamination Proceeding
Control No. 90/008,591
For: U.S. Patent No. 6,101,534

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

This is a decision on the September 15, 2008, "REQUEST FOR EXTENSION OF TIME" requesting that the time to submit a Patent Owner response be extended an additional two months.

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

The petition is 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. 6,101,534 (hereinafter, the '534 patent), issued to Rothschild, on August 8, 2000.

2. On April 11, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '534 patent. The reexamination proceeding was assigned Control No. 90/008,591 (hereinafter, the '8591 proceeding).

3. The reexamination order was granted in the '8591 proceeding on June 21, 2007.

4. A non-final rejection was mailed on August 28, 2008 setting a one-month period for response because litigation has been stayed pending the reexamination of the '534 patent.

5. The present petition was filed on September 15, 2008.

DECISION

The Patent Owner requests an extension of time to respond to the non-final office action mailed August 28, 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 September 15, 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 generally notes that Patent Owner has "taken some time to review the basis for the Examiner's refusal" and has "conferred extensively regarding the nature of the references, the relevant priority dates associated therewith, and the terminology of the patent, and it has become apparent that a great deal of additional review and analysis of the references cited by the examiner are necessary..." The request also notes time has been spent "in preparation for the anticipated and potentially devastating effects from Tropical Storm Hanna and Hurricane Ike in South Florida." 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 two weeks is considered sufficient. It is noted that the examiner has only cited one reference not already of record and the terminology of the patent should be well known to Patent Owner. The rest of the work outlined in the petition that is associated with the response appears to be routine prosecution. However, the time spent in preparation for a tropical storm and hurricane is noteworthy and warrants some additional time.

Accordingly, the time for filing the response is extended for two weeks and therefor the response is due on or before October 14, 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 in part. The period during which Patent Owner may file a response has been extended to October 14, 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

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OCT 29 2008
CENTRAL REEXAMINATION UNIT

Malloy & Malloy, P.A.

FAX COVER SHEET

Patent, Trademark & Copyright Law

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DATE: October 29, 2008

TO: Examiner, James Mathews

OF: U.S. Patent and Trademark Office

FAX NO.: (571) 273-9900

FROM: Peter A. Matos

OUR REF: Applicant: Leigh M. Rothschild
Reexamination Control No.: 90/008,591
Filing Date: April 11, 2007
U.S. Patent No.: 6,101,534
Our Ref.: 7.062.07

NO. OF PAGES, INCLUDING THIS FAX COVER SHEET: 4

MESSAGE:

In accordance with our telephone conference earlier today, attached is a copy of the Decision Granting in Part Petition for Extension of Time, as requested.

If you have any questions, please do not hesitate to contact our office.

2800 S.W. Third Avenue • Miami, Florida 33129 • Tel (305) 858-8000 • Fax (305) 858-0008

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Peng Chen and Elizabeth Cary Miller (For Patent Owner)
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

Audrey A. Millemann (For Third Party)
Weintraub Genshlea Chediak Law Corporation
400 Capitol Mall, 11th floor
Sacramento, CA 95814

Helena C. Richlicki, Esq. (For Third Party)
Connally Bove Lodge & Hutz LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

MAILED

OCT 07 2008

CENTRAL REEXAMINATION UNIT

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control Number: 90/008,592
Filed: April 12, 2007
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control Number: 90/008,879
Filed: October 16, 2007
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control Number: 90/009,066
Filed: March 3, 2008
For: U.S. Patent 6,010,729

DECISION MERGING REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,010,729 issued January 4, 2000, is the subject of Reexamination Control Nos. 90/008,592, 90/008,879 and 90/009,066.

2. A first request for Reexamination, assigned Reexamination Control No. 90/00,592, was filed April 12, 2007 for the Patent Owner by Peng Chen and Elizabeth Cary Miller of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references and by references that were previously cited but not applied in a rejection regarding claims 1-7,9, 13, 16, 17 and 21.

3. Reexamination was ordered for 90/008,592 on July 11 2007.

4. No Patent Owner's response was received in the 90/008,592 proceeding.

5. A second request for Reexamination, assigned Reexamination Control No. 90/008,879, was filed October 18, 2007 for a Third Party Requester by Audrey A. Millemann of Weintraub Genshlea Chediak Law Corporation in Sacramento, California. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1-9, 13, 17 and 21.

6. Reexamination was order for 90/008,879 on January 11, 2008.

7. No Patent Owner's response was received in the 90/008,879 proceeding.

8. A third request for Reexamination, assigned Reexamination Control No. 90/009,066, was filed March 3, 2008 for a Third Party Requester by Helena C. Richlicki of Connolly, Bove, Lodge & Hutz LLP in Wilmington, Delaware. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1, 7, 17 and 22

9. Reexamination was order for 90/009,066 on May 20, 2008.

10. No Patent Owner's response was received in the 90/009,066 proceeding.

LEGAL BASIS

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 paragraph 1.570.

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

If the second request is based upon essentially the same patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as 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

In accordance with 37 C.F.R. 1.565(c), the 90/008,592, 90/008,879 and 90/009,066 proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements. 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 duplicate**, each bearing a signature and identifying data for **all** files, for entry into each file. See MPEP 2283, "Merger of Reexaminations."

CONCLUSION

Reexamination Control Nos. 90/008,592, 90/008,879 and 90/009,066 are merged. **Since there has been no amendment in any of the files, the requirement to file a "housekeeping amendment" is waived.** The merged reexamination files are being forwarded to the examiner for preparation of an Office action to be issued in due course.

CORRESPONDENCE

All correspondence from the USPTO will be addressed to the Patent Owner's representative address listed in Reexamination Control Nos. 90/008,592, 90/008,879 and 90/009,066 as:

Peng Chen and Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control No. 90/008,879 as:

Audrey A. Millemann
Weintraub Genshlea Chediak Law Corporation
400 Capitol Mall, 11th floor
Sacramento, CA 95814

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control No. 90/009,066 as:

Helena C. Richlicki, Esq.
Connally Bove Lodge & Hutz, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

for Gregory A. Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Peng Chen and Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

(for Patent Owner)

MAILED

JUN 19 2009

(for Third Party)

CENTRAL REEXAMINATION UNIT

Audrey A. Millemann
WEINTRAUB GENSHLEA CHEDIAK LAW CORP.
400 Capitol Mall, 11th Floor
Sacramento, CA 95814

Helena C. Richlicki, Esq. and Robert G. McMorrow, Esq.
CONNALLY BOVE LODGE & HUTZ, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

(for Third Party)

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,592
Filed: April 12, 2007
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,879
Filed: October 16, 2007
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/009,066
Filed: March 3, 2008
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/010,462
Filed: March 20, 2009
For: U.S. Patent 6,010,729

DECISION MERGING REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,010,729, issued January 4, 2000, is the subject of Ex Parte Reexamination Control Nos. 90/008,592; 90/008,879; 90/009,066; and 90/010,462.

2. A first request for Ex Parte Reexamination, assigned Reexamination Control No. 90/008,592 ('8592), was filed April 12, 2007 for the Patent Owner by Peng Chen and Elizabeth Cary Miller of Morrison & Foerster, LLP in San Diego, California. The request urged that a substantial new question of patentability was raised by newly cited references and by references that were previously cited but not applied in a rejection regarding claims 1 - 7, 9, 13, 16, 17, and 21.

3. Reexamination was ordered for 90/008,592 on July 11, 2007.

4. No Patent Owner statement was received in the 90/008,592 proceeding.

5. A second request for Ex Parte Reexamination, assigned Reexamination Control No. 90/008,879, was filed on October 16, 2007 for a Third Party Requester by Audrey A. Millemann of Weintraub Genshlea Chediak Law Corporation in Sacramento, California. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1 - 9, 13, 17, and 21.

6. Reexamination was ordered for 90/008,879 on January 11, 2008.

7. No Patent Owner statement was received in the 90/008,879 proceeding.

8. A third request for Ex Parte Reexamination, assigned Reexamination Control No. 90/009,066, was filed March 3, 2008 for a Third Party Requester by Helena C. Richlicki of Connolly, Bove, Lodge & Hutz, LLP in Wilmington, Delaware. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1, 7, 17, and 22.

9. Reexamination was ordered for 90/009,066 on May 20, 2008.

10. No Patent Owner's statement was received in the 90/009,066 proceeding.

11. A Decision Merging Reexamination Control Nos. 90/008,592; 90/008,879; and 90/009,066 was mailed on October 7, 2008.

12. A non-final Office action was mailed on October 30, 2008.

13. Personal Interview with the Examiner on December 9, 2008.

14. Patent Owner filed an amendment on December 30, 2008 and a corrected amendment on January 2, 2009.

15. A fourth request for Ex Parte Reexamination, assigned Reexamination Control No. 90/010,462 was filed on March 20, 2009 for a Third Party Requester by Robert G. McMorrow of Connally, Bove, Lodge & Hutz, LLP in Wilmington, Delaware. The request urged that a substantially new question of patentability was raised by a newly cited reference and references that were previously cited but not applied in a rejection regarding claims 1, 4 - 9, 13, 16, 17, 21, 22, 25 - 29, 31, 34, 35, 39, 40, and 43 - 47.

16. Reexamination was ordered for 90/010,462 on April 28, 2009.

17. Patent Owner filed a "Waiver of the Right to File a Statement under 37 CFR 1.530" on May 18, 2009.

LEGAL BASIS

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 paragraph 1.570.

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,592; 90/008,879; 90/009,066; and 90/010,462 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 all four files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of this 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 quadruplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

CORRESPONDENCE

All correspondence from the USPTO will be addressed to the Patent Owner's representative address listed in Reexamination Control Nos. 90/008,592; 90/008,879; 90/009,066 and 90/010,462.

Peng Chen and Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control No. 90/008,879 as:

Audrey A. Millemann
WEINTRAUB GENSHLEA CHEDIAK LAW CORP.
400 Capitol Mall, 11th Floor
Sacramento, CA 95814

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control Nos. 90/009,066 and 90/010,462

Helena C. Richlicki, Esq. and Robert G. McMorrow, Esq.
CONNALLY BOVE LODGE & HUTZ, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

CONCLUSION

Reexamination Control Nos. 90/008,592; 90/008,879; 90/009,066 and 90/010,462 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

for

Greg Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JUL 19 2008

CENTRAL REEXAMINATION UNIT

Mailed :

DDJ

Peng Chen and Elizabeth Cary Miller
Morrison & Foerster LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130-2040

(for Patent Owner)

Helena C. Rychlicki, Esq.
Connolly Bove Lodge & Hutz LLP
1007 N. Orange Street
P.O. Box 2207
Wilmington, DE 19899

(for Third Party Requester)

In re Gutzmann et al
Reexamination Proceeding
Control No.: 90/008,593
Filed: April 12, 2007

Control No.: 90/009,068
Filed: March 3, 2008

For: U.S. Patent 6,113,963

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 6,113,963 issued September 5, 2000, is the subject of Reexamination Control Nos. 90/008,593 and 90/009,068.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,593, was filed April 4, 2007 by Elizabeth Cary Miller of Morrison & Foerster LLP in San Diego, CA on behalf of the patent owner. The request urged that a substantial new question of patentability was raised by the newly cited references with regards to claims 1-7, 9, 13, 16, 17, 21, 25-27 and 30-32.

3. Reexamination was ordered for 90/008,593 on July 10, 2007.

4. No patent owner's response was received.

5. A subsequent request for re-examination, assigned Reexamination Control No. 90,009,068, was filed March 3, 2008 by Helena C. Rychlicki of Connolly Bove Lodge & Hutz LLP in Wilmington, DE. The request urged that a substantial new question of patentability was raised by the newly cited references with regards to claims 1-7, 17, 22, and 25-28 of the patent.

6. Reexamination was ordered for 90/009,068 on May 20, 2008.

7. No patent owner's statement has been received.

DISCUSSION

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

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* 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 90/008,593 and 90/009,068 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/008,593 and 90/009,068 as:

Peng Chen and Elizabeth Cary Miller
Morrison & Forester LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130-2040

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/009,068 as:

Helena C. Rychlicki, Esq.
Connolly Bove Lodge & Hutz LLP
1007 N. Orange Street
P.O. Box 2207
Wilmington, DE 19899

CONCLUSION

Reexamination Control Nos. 90/008,593 and 90/009,068 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.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,593	04/12/2007	6113963	235722000330	7758

25225 7590 06/19/2009

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2009

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

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,068	03/03/2008	6113963	10884-00108-C-US	3467

25225 7590 06/19/2009

MORRISON & FOERSTER LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2009

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

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,463	03/20/2009	6113963	10884-00108	9635

25225 7590 06/19/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2009

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

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JUN 19 2009

CENTRAL REEXAMINATION UNIT

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

HELENA C. RICHLICKI, ESQ. AND ROBERT G. MCMORROW, ESQ.
CONNALLY BOVE LODGE & HUTZ, LLP
1007 NORTH ORANGE STREET
P.O. BOX 2207
WILMINGTON, DE 19899

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,593*. ; 90/009,068 ; 90/010,463

PATENT NO. *6113963*.

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
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Peng Chen and Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

(for Patent Owner)

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Helena C. Richlicki, Esq. and Robert G. McMorrow, Esq.
CONNALLY BOVE LODGE & HUTZ, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

(for Third Party)

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,593
Filed: April 12, 2007
For: U.S. Patent 6,113,963

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/009,068
Filed: March 3, 2008
For: U.S. Patent 6,113,963

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/010,463
Filed: March 20, 2008
For: U.S. Patent 6,113,963

DECISION MERGING REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,113,963, issued September 5, 2000, is the subject of Ex Parte Reexamination Control Nos. 90/008,593; 90/009,068; and 90/010,463.

2. A first request for Ex Parte Reexamination, assigned Reexamination Control No. 90/008,593 ('8593), was filed April 12, 2007 for the Patent Owner by Peng Chen and Elizabeth Cary Miller of Morrison & Foerster, LLP in San Diego, California. The request urged that a substantial new question of patentability was raised by newly cited references and by references that were previously cited but not applied in a rejection regarding claims 1 - 7, 9, 13, 16, 17, 21, 25 - 27 and 30 - 32.

3. Reexamination was ordered for 90/008,593 on July 10, 2007.

4. No Patent Owner statement was received in the 90/008,592 proceeding.

5. A second request for Ex Parte Reexamination, assigned Reexamination Control No. 90/009,068, was filed March 3, 2008 for a Third Party Requester by Helena Richlicki of Connally Bove Lodge & Hutz, LLP in San Diego, California. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1 - 7, 17, 22 and 25 - 28.

6. Reexamination was ordered for 90/009,068 on May 20, 2008.

7. No Patent Owner statement was received in the 90/009,068 proceeding.

8. Non-Final Office action was mailed on October 29, 2008.

9. Personal Interview with Examiner on December 9, 2008.

10. Patent Owner response with amendment filed December 29, 2008.

11. A third request for Ex Parte Reexamination, assigned Reexamination Control No. 90/010,463 was filed March 20, 2009 for a Third Party Requester by Robert G. McMorrow of Connolly, Bove, Lodge & Hutz, LLP in Wilmington, Delaware. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1, 4 - 6, 8 - 9, 13, 16, 21, 25 - 28, 35 - 41, 45, 48 and 50.

9. Reexamination was ordered for 90/010,463 on April 28, 2009.

10. Patent Owner filed a "Waiver of the Right to File a Patent Owner's Statement" under 37 CFR 1.530 on May 18, 2009.

LEGAL BASIS

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 paragraph 1.570.

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,593; 90/009,068 and 90/010,463 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 all four files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of this 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 quaduplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

CORRESPONDENCE

All correspondence from the USPTO will be addressed to the Patent Owner's representative address listed in Reexamination Control Nos. 90/008,593; 90/009,068 and 90/010,463.

Peng Chen and Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control Nos. 90/009,068 and 90/010,463

Helena C. Richlicki, Esq. and Robert G. McMorrow, Esq.
CONNALLY BOVE LODGE & HUTZ, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

CONCLUSION

Reexamination Control Nos. 90/008,593; 90/009,068 and 90/010,463 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

for Deborah Jones
Greg Morse, Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Michael N. Haynes (For Patent Owner)
1341 Huntersfield Close
Keswick, VA 22947

Hovey Williams, LLP (For Requester)
2405 Grand Blvd.
Suite 400
Kansas City, MO 64108

In re Thomas A. Williams :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,595 : **GRANTING**
Filed: May 21, 2007 : **PETITION UNDER**
For: U.S. Patent No. 5,495,635 : **37 CFR 1.137(b)**

This is a decision on the January 16, 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 January 16, 2009 patent owner petition to revive").[1]

The January 16, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The small entity petition fee of $810.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

SUMMARY

The January 16, 2009 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of July 22, 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) must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. Patent owner submitted a notice of appeal and paid the corresponding fee of $270.00 on January 16, 2009, thereby satisfying item (1).[2] A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the January 16, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the January 16, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The January 16, 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 3991, for processing of the January 16, 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, Krisanne Jastrzab, of CRU Art Unit 3991, at (571) 272-1279.

[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.

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

February 6, 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.
90/008,597	04/18/2007	6677894	042933/288702	9912

23696 7590 04/20/2009

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2009

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

JEFFREY E. YOUNG
ALSTON & BIRD LLP
101 SOUTH TRYON STREET SUITE 4000
CHARLOTTE NC 28280-4000

Date:

MAILED

APR 2 0 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008597
PATENT NO. : 6677894
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Andrea L Mays
QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO CA 92121

(For Patent Owner)

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APR 2 0 2009

CENTRAL REEXAMINATION UNIT

Jeffrey E Young Esq
ALSTON & BIRD LLP
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101 SOUTH TRYON STREET,
SUITE 4000
CHARLOTTE, NC 28280-4000

(For Third Party Requester)

DECISION
GRANTING
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.550(c) and
§ 1.181]

In re: Sheynblat *et alia*
Ex parte Reexamination Proceeding
Control No. 90/008,597
Deposited on: 18 April 2007
For: US Patent No. 6,677,894

This is a decision on the 13 April 2009, "Request for Extension of Time under 37 C.F.R. § 1.550(c)" requesting that the time for responding to the Final Office action mailed 20 February 2009, be extended by one (1) month. The petition was timely filed.

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 13 January 2004 US Patent No. 6,677,894 was granted to Sheynblat *et alia*.

2. On 18 April 2007 a request for *ex parte* reexamination was submitted by a third party requester.

3. On 12 July 2007 the Order was granted for *ex parte* reexamination.

4. On 8 August 2008 a non-Final Office action was mailed.

5. On 8 October 2008 the patent owner's response was entered into the record.

6. On 20 February 2009 a Final Office action was mailed.

7. On 13 April 2009 the instant petition was submitted.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 20 February 2009, which set a two (2) months date for filing a response thereto. The Office action is a Final Office action. The petition for extension of time was timely filed on 13 April 2009, 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). The petition provided a certificate of service to the third party requester.

37 CFR § 1.550 (c) states:

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

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

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

...

MPEP § 2265 Extensions of Time (in-part)

> An extension of time in an *ex parte* reexamination proceeding is requested pursuant to 37 CFR § 1.550(c). Accordingly, a request for an extension (A) must be filed on or before the day on which action by the patent owner is due and (B) must set forth sufficient reason for the extension, and (C) must be accompanied by the petition fee set forth in 37 CFR § 1.17(g). Requests for an extension of time in an *ex parte* reexamination proceeding will be considered only after the decision to grant or deny reexamination is mailed. Any request filed before that decision will be denied.
>
> ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR § 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR § 1.515(c) will be granted only in extraordinary situations.

ANALYSIS AND FINDINGS

The patent owner's representative petitions under 37 CFR § 1.550(c) 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 Final rejection mailed 20 February 2009. The patent owner submitted a timely filed petition with the appropriate fee and certificate of service.

The petition dated 13 April 2009 cites the length of the Office action as well as complexity of claims technology in the prior art rejections, the analysis of establishing the priority of claimed subject matter to establish what is prior art under 35 USC § 102(e).

The patent owner also notes that an interview may be sought but this is generally not considered to support "sufficient cause" for the purpose of granting an extension of time in reexamination proceedings.

On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time.

The petition request to extend the response time by one (1) month is hereby granted.

CONCLUSION

1. The patent owner's petition for extension of one (1) month time in which to file a response to the Office action dated 20 February 2009 is hereby **granted**

2. The period for response is extended by one (1) month.

3. The Patent Owner's response is due **20 May 2009.**

4. Response may be submitted as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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Jane Massey Licata
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Marlton, NJ 08053

(Patent Owner)

MAILED

SEP 18 2007

CENTRAL REEXAMINATION UNIT

Budde, Shou & Ostenfeld, A/S
Vester Soegadè 10, 5TH Floor
Copenhagen, Denmark DK 160-1

(Third Party Requester)

In re Natures Remedies Limited
Ex Parte Reexamination Proceeding
Control No.: 90/008,598
Filed: April 19, 2007
For: U.S. Patent No. 5,945,107

: **DECISION DISMISSING**
: **PETITION TO VACATE**
: **ORDER GRANTING**
: **REEXAMINATION**

This is a decision on the August 20, 2007 patent owner petition entitled "PETITION TO HAVE *ULTRA VIRES* REEXAMINATION ORDER VACATED UNDER 37 CFR 1.181." In addition, on August 30, 2007, third party requester filed a paper opposing the patent owner's petition.

The petition, the opposition paper and the 90/008,598 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The patent owner's petition is dismissed for the reasons set forth below.

REVIEW SALIENT OF FACTS

1. U.S. Patent No. 5,945,107 (the '107 patent) issued to Lasse Lief Hessel *et al* on August 31, 1999, and is currently assigned to re Natures Remedies Limited.

2. On October 31, 2005, a first request for *ex parte* reexamination of the '107 patent was filed Jemo_Pharm A/S, a third party requester. The request was assigned control 90/007,785 (the '785 *ex parte* reexamination proceeding) and was accorded the filing date of October 31, 2005.

3. Reexamination was ordered in the '785 *ex parte* reexamination proceeding for claims 1-3, i.e., all of the claims, of the '107 patent, on December 5, 2005. The reexamination order was based, in part on a product label for a product named "Tab-let," alleged to have been distributed in Denmark at least as early as May 1996.

4. Prosecution on the patentability of patent claims 1-3 was conducted in the '785 *ex parte* reexamination proceeding, resulting in an appeal to the Board of Patent Appeals and

Interferences (BPAI) from the final rejection of patent claims 1-3. The appealed final rejection included a ground of rejection based upon the product label for Tab-let. [1]

5. Jurisdiction of the appeal was transferred to the BPAI on June 15, 2007, and the appeal is currently awaiting disposition.

6. A second request for *ex parte* reexamination of the '107 patent was deposited by an anonymous third party requester on April 19, 2007. The request was assigned Control No. 90/008,598 (the '598 *ex parte* reexamination proceeding), and was granted a filing date of April 19, 2007.

7. On July 6, 2007, reexamination was ordered in the '598 *ex parte* reexamination proceeding for patent claims 1-3 of the '107 patent based upon the second request for reexamination. The basis for the Order was a product label a product named "Tab-let," alleged to have been distributed in Denmark during May-June 1996, together with supporting verified statements by two different individuals purport to demonstrate that the Tab-let label constitutes a printed publication by reason of public distribution of the Tab-let product label. [2]

8. On August 20, 2007 the patent owner filed the present petition under 37 CFR 1.181 to vacate the reexamination order and the present '598 *ex parte* reexamination proceeding as *ultra vires*.

9. On August 30, 2007, third party requester filed an opposition to the August 20, 2007 patent owner petition.

RELEVANT STATUTES AN EXAMINING PRACTICE

35 U.S.C. § 301 provides:

> Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

35 U.S.C. § 302 provides:

> 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.

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[1] See *ex parte* reexamination proceeding 90/007,785, Order Granting *Ex Parte* Reexamination at pages 15 and 16 of the Image File Wrapper (IFW) RXREXO paper dated December 5, 2005, the IFW 1449 paper that accompanied the Order.

[2] See *ex parte* reexamination proceeding 90/008,598, Order Granting *Ex Parte* Reexamination at pages 6 and 7 of the Image File Wrapper (IFW) RXREXO paper dated July 6, 2007, the IFW 1449 paper that accompanied the Order.

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

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. **The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.** [Emphasis added.]

...

(c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable.

MPEP § 2216, **Substantial New Question of Patentability**, provides, in part:

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination. See MPEP § 2258.

MPEP § 2217, **Statement in the Request Applying Prior Art,** provides, in part:

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination. See MPEP § 2258.

MPEP § 2242(II)(A) provides, in part:

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

In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier Office examination of the patent (e.g., in the examination of the application for the patent, or in a concluded or pending reexamination proceeding). For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of *In re Hiniker*, 150 F.3d 1362,1365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998).

In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. **For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light,** or in a different way, **as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.** [Emphasis in bold is added.]

MPEP § 2246 (II) provides in pertinent part:

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> (A) the reexamination order is not based on prior art patents or printed publications;
> (B) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
> (C) reexamination was ordered for the wrong patent;
> (D) reexamination was ordered based on a duplicate copy of the request; or
> (E) the reexamination order was based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding). ...
>
> When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. [Emphasis in the original.]

MPEP § 2258(I)(E) provides:

> Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.

DECISION

I. Patent Owner's Position

Patent owner argues that the July 6, 2007 Order Granting *Ex Parte* Reexamination in the in the '598 *ex parte* reexamination proceeding is an improper ultra vires action, because the relevance of the Tab-Let product label relied upon by third party requester has been previously raised in the prior '785 *ex parte* reexamination proceeding for the '107 patent that is still pending. [3] Patent owner also argues that the Tab-let product label constitutes neither a prior art patent nor a printed publication, because the Tab-let product label was not accessible to the public. [4] Patent owner points out that the issue of whether the Tab-let product label in question qualifies as a printed publication was extensively argued in the prior '785 *ex parte* reexamination proceeding, concludes that the present '598 *ex parte* reexamination proceeding is essentially a duplicate of the '785 *ex parte* reexamination proceeding and argues that a substantial new question of patentability has not, therefore, been demonstrated in the '598 *ex parte* reexamination proceeding.

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[3] See the August 20, 2007 patent owner petition, page 2, second paragraph and pages 4-6
[4] *Id.*, at pages 3, 6 and 7.

II. Third Party Requester's Position

Third party requester takes the position that the Tab-let product label relied upon in the '598 *ex parte* reexamination proceeding raises a substantial new question of patentability with respect to the '107 patent claims, because in the prior '785 *ex parte* reexamination proceeding, patent owner has argued, based in part on declaration evidence, that the Tab-let product label relied upon in that proceeding was not a printed publication. This argument was supported by evidence in the form of verified statements that the Tab-let product had not then been "distributed and sold to the public." [5] Third party requester argues that insofar as the record of the '785 *ex parte* reexamination proceeding establishes that the Tab-let product label relied upon in that proceeding is not a printed publication, the examiner has not abused his discretion in finding that the Tab-let product label relied upon in the present '598 *ex parte* reexamination proceeding is a printed publication that raises a substantial new question of patentability.

III. Patent Owner's Position is Not Persuasive

A. Substantial New Question Based On "Old Art"

Patent owner argues that the examiner's decision to order reexamination in the present '598 *ex parte* reexamination proceeding is an *ultra vires* action because the order is solely based upon the Tab-let product label. The Tab-let product label was previously considered and discussed on the record in the prior '785 *ex parte* reexamination proceeding for the '107 patent.

However, patent owner's position is not persuasive. 35 U.S.C. § 303(a), as amended November 2, 2002, concludes by stating that "[T]he existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office." MPEP § 2242(II)(A) implements the language of the statute, and makes it clear that it is entirely proper (in a reexamination decision to order reexamination made on or after November 2, 2002) for a second or subsequent *ex parte* reexamination proceeding to be based upon so-called "old art," e.g., prior patents or printed publications that were considered or discussed during a prior reexamination proceeding for the same patent currently undergoing reexamination, provided that the "old art" is being considered in a new light as compared with its consideration in the earlier proceeding. It is to be noted that MPEP § 2258(I)(E) also provides that during the examination on the merits, i.e., whether the claims of a patent for which reexamination has been ordered are or are not patentable, it is proper to consider verified statements that explain the contents or pertinent dates of the references. [6]

A review of the record of the present '598 *ex parte* reexamination proceeding reveals that in that proceeding, the third party requester has provided two verified statements that allege that the Tab-let product label was affixed to a product that was publicly disseminated in May-June 1996. A review of the prior '785 *ex parte* reexamination shows that no such verified statement was in the record. In fact, a review of the '785 *ex parte* reexamination proceeding reveals that patent owner has provided therein verified statements that assert that the Tab-let product label relied upon in that proceeding was not publicly disseminated.

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[5] See third party requester opposition paper filed August 30, at page 1, which in turn references an argument made by patent owner at page 22 of patent owner's October 31, 2006 appeal brief (which corresponds to page 26 of the October 31, 2006 IFW AP.B paper).

[6] It is further to be noted that MPEP § 2258.01 states that so-called "old art" may form the basis for a rejection of claims in an *ex parte* reexamination proceeding where the "old art" is viewed in a new light. See Manual of Patent Examining Procedure, Eighth Edition, August 2001, Rev. 5, August 2006, at page 2200-91.

Inasmuch as (1) it is entirely proper pursuant to 35 U.S.C. § 303(a), last sentence, and the practice that implements the statutory provision as set forth in MPEP §§ 2216 and 2217, for a reexamination order to be based upon a consideration of verified statements that explain the contents and/or the dates of printed publications of prior patents or printed publications; (2) verified statements directed to establishing that the Tab-let product was publicly disseminated have been provided in the '598 *ex parte* reexamination to support the proposition that the Tab-let product label qualifies as a printed publication, (3) no such verified statements were provided in the prior '785 *ex parte* reexamination proceeding, and (4), patent owner provided evidence contesting the status of the Tab-let product label as a printed publication in the '785 *ex parte* reexamination proceeding, it is clear that the request for reexamination in the '598 *ex parte* reexamination producing presents the Tab-let product label in a new light. Accordingly, the examiner's reliance upon the Tab-let product label as the sole prior art basis for ordering reexamination in the '598 *ex parte* reexamination proceeding does not render the order an *ultra vires* action. The order was properly based upon "old art" viewed in a new light with respect to consideration of the Tab-let product label in the prior '785 *ex parte* reexamination proceeding.

B. Requirement for Prior Patents or Printed Publications

MPEP § 2246 (II) sets forth examples of appropriate circumstances that would require the Office to vacate an order for *ex parte* reexamination after granting the order. The circumstance of a reexamination order having been based on information that does not qualify as a prior art patent or printed publication is the circumstance that is relevant to the present '598 *ex parte* reexamination proceeding.

As will be discussed below, 35 U.S.C. 303(c) provides that an order granting reexamination "shall be final and non-appealable." Accordingly, a heavy burden is clearly on petitioner to establish an *ultra vires* act; it is not sufficient, in this instance to establish a question as to whether the references applied in the order are prior art patents or printed publications. If a legitimate question is raised that the references applied in the order are prior art patents or printed publications, the requisite question of patentability has been satisfied, and reexamination must go forward in the examination stage to resolve that question. It is emphasized that nothing in this Decision is intended to reach the ultimate conclusion/resolution as to whether the documents that the examiner has relied on as being prior art printed publications that support an order granting reexamination are in fact printed publications that qualify as prior art. The gravamen of the instant petition is not whether it can be definitively established that the prior art documents relied on are printed publications, but only whether there is a colorable argument that the relied upon documents are printed publications and qualify as prior art to the '107 patent so that the ordered reexamination can move forward.

Only where there is no reasonable basis to believe that the documents relied upon by third party requester are printed publications that qualify as prior art to the '107 patent, and therefore would provide no basis for reexamination pursuant to the statute, could the '598 *ex parte* reexamination proceeding be vacated based on an *ultra vires* act in ordering reexamination. Barring that situation, the patent owner's statutory rights are those of (a) addressing the question of patentability raised during the examination phase of the proceeding, and (b) should the examiner continue to believe that the documents in question are prior art printed publications, and that such prior art is applicable to the patent claims, appealing a final agency decision in the '598 *ex parte* reexamination proceeding on the grounds that the applied references are not prior art printed publications (or do not meet the claims).

The Order granting *ex parte* reexamination addresses the issue of the whether the Tab-let product label constitutes a printed publication, and if so, the date to be accorded to the printed publication. [7] It is only necessary to establish that legitimate questions could be raised as to the publication date of the Tab-let product label, and to the issue of whether the label qualifies as a printed publication. Here, based upon two verified statements that were filed with the request for reexamination, the examiner has determined that the Tab-let product label is properly datable as prior art to the '107 patent and was disseminated to the public. The examiner has therefore concluded that the Tab-let product label is a printed publication.

Thus, it is clear that the examiner's holding that the Tab-let product label is a printed publication, and that it is prior art to the claims of the '107 patent, is not an arbitrary holding. Rather, it is founded in an analysis of the facts that is not facially without merit. The examiner's decision represents the exercise of discretion in reaching the conclusion that the requester has proffered prior art printed publications for consideration as the basis for the request for *ex parte* reexamination of the '107 patent. In *Heinl v. Godici*, 143 F. Supp. 2d 593, 601 (E.D. Va. 2001), the court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "Under the well established *ultra vires* doctrine, the exhaustion and final agency requirements are excused 'only if plaintiff is able to show that the PTO clearly exceeded its statutory authority', quoting from *Philip Morris, Inc. v. Block*, 755 F.2d 368, 370 (4th Cir 1985 (quoting *Mayor and City Council of Baltimore v. Mathews*, 562 F.2d 914, 920 (4th Cir. 1977), vacated on other grounds, 571 F.2d 1273 (4th Cir. 1978).

The court then went on to state:

> "Put differently, when an agency acts in 'brazen defiance' of its statutory authorization, courts need not await the conclusions of underlying proceedings."

After a review of the record, and based upon the above discussion, it is found that patent owner has not established that the Office "clearly exceeded its statutory authority," or acted "in brazen defiance of its statutory authorization," in the Office's determination that the reexamination request properly raised a substantial new question of patentability.

For the forgoing reasons, the order granting reexamination will not be disturbed, and the '598 *ex parte* reexamination proceeding will continue in its examination stage.

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[7] See note 2, *supra*.

CONCLUSION

1. The patent owner petition filed on August 20, 2007, is dismissed.

2. A copy of this decision will be made of record in the IFW of the '598 *ex parte* reexamination proceeding.

3. Jurisdiction over the '598 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit.

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

Stephen Marcus, Legal Advisor
Office of Patent Legal Administration

sm
September 12, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,598	04/19/2007	5945107		2033

23973 7590 11/12/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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MAILED

NOV 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008598
PATENT NO. 5,945,107
ART UNI 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

NOV 12 2008

CENTRAL REEXAMINATION UNIT

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DENMARK

(For Requester)

In re Hessel, *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/008,598
Filed: April 19, 2007
For: U.S. Patent No. 5,945,107

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

This is a decision on the October 6, 2008 patent owner petition under 37 CFR 1.137(b) to revive a terminated reexamination proceeding, based on unintentional delay ("the October 6, 2008 patent owner petition to revive").[1]

The October 6, 2008 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $810.00 (small entity) set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

SUMMARY

The October 6, 2008 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of March 5, 2008.

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 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) must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. Patent owner submitted a notice of appeal and paid the corresponding fee of $270.00 on October 6, 2008, thereby satisfying item (1).[2] A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the October 6, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the October 6, 2008 patent owner petition to revive is **granted**.

CONCLUSION

1. The October 6, 2008 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3991, for processing of (i) the September 4, 2008 patent owner amendment/response to the July 30, 2008 Advisory Action and (ii) the October 6, 2008 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, Evelyn Huang, of CRU Art Unit 3991, at (571) 272-0686.

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[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.

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

United States Patent and Trademark Office

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(For Patent Owner)

MAILED
JAN 12 2010
CENTRAL REEXAMINATION UNIT

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RESTON, VA 20190

(For Requester)

WILMERHALE/DC
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(Courtesy Copy)

In re Connell et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,602
Filed: October 29, 2007
For: U.S. Patent No. 5,744,027

DECISION
DISMISSING PETITION
UNDER § 1.182

This is a decision on the November 3, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION."

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

The petition is **dismissed**.

BACKGROUND

- On October 29, 2007, the filing date requirements were met for a request for *ex parte* reexamination filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,602 ("the '602 proceeding").

- Prosecution in the '602 proceeding progressed until, on May 28, 2009, a final Office action was mailed. The final Office action addressed claims 7, 10, 11, 17-30, 32, 34, 35, and 38, which are subject to reexamination. The action listed claims 1-6, 8, 9, and 12-16 as not subject to reexamination.

- On July 28, 2009, patent owner filed a response, including amendments to claims 12, 14, 17, 26-30, 32, 34, 35, and 38, to the final Office action of May 28, 2009.

- On October 9, 2009, an advisory Office action was mailed by the Office, refusing entry of the amendments submitted on July 28, 2009, and setting a time period for response to run 6 months from the date of the final Office action.

- On November 3, 2009, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the amendments filed on July 28, 2009, and refused entry on October 9, 2009.

- On November 24, 2009, a Notice of Appeal was filed by patent owner.

- On December 3, 2009, third party requester filed a petition under 37 C.F.R. § 1.183 seeking waiver of 37 C.F.R. § 1.550(g).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 C.F.R. § 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.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a

claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

37 C.F.R. § 1.525(a) provides, in pertinent part:

If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for ex parte reexamination of the patent for **resolution of the question**. (emphasis added)

DECISION

The November 3, 2009, patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of the amendments and entirety of the response filed July 28, 2009, and refused entry by the examiner in an advisory Office action mailed October 9, 2009.

1. Basis of Relief For the Instant Petition

37 C.F.R. § 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 C.F.R. § 1.182 is, according to the terms of that regulation, not an appropriate mechanism for relief. For example, a petition under §1.182 should not be filed where the petitioner merely seeks further review of issues which have previously been considered and rejected by the examiner. Such a situation is already provided for in the regulations by 37 C.F.R. §1.181. Where an examiner has, for instance, stated that a particular amendment would not overcome a rejection and would not simplify issues for appeal, a petition requesting continued examination under 37 C.F.R. § 1.182 is not the proper vehicle for a further request for entry of that identical amendment based on the assumption that the examiner's determination was flawed or improper. Rather, patent owner should file a petition under §1.181.

Here, the petition under 37 C.F.R. § 1.182 alleges that sufficient reasons for the Examiner's refusal to enter the July 28, 2009 amendment were not given in the advisory action mailed October 9, 2009. See section III, pages 5-7 of the November 3, 2009 patent owner petition. Each of the allegations made in the instant 37 C.F.R. § 1.182 petition addresses alleged impropriety as to the final Office action and the advisory action. While such allegations of impropriety of an Office action are properly addressed under 37 C.F.R. § 1.181, they are not the basis for a petition requesting continued examination under 37 C.F.R. § 1.182. Therefore, the propriety of the Office action will not be discussed in this decision.

2. Merits of the Request for Relief

The procedure for requesting continuation of an *ex parte* reexamination proceeding following a final rejection has been set forth in a March 1, 2005 Office Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* reexamination prosecution (after a final Office action) was made available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 C.F.R. § 1.182 can provide relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the requirement of special dispatch. The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office."

Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or further the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the case without the amendment or evidence), since these are key factors in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution. And, the grant or dismissal of a § 1.182 petition depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request.

The first issue, then, is whether patent owner's submission, if entered, constitutes a *bona fide* effort that would advance the issues towards resolution of the questions of patentability at issue in the proceeding. Patent owner states that the amendment simplifies and clarifies the issues for appeal, relative to the issues presented in the claims currently at issue in the proceeding, through deletion of terms stated by the examiner to be new matter, addition of limitations to clarify

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

claims, and addition of limitations to previously allowed claims to further define the invention. See page 4 of the November 3, 2009 patent owner petition.

However, the examiner, in the advisory Office action mailed October 9, 2009, reviewed the identical amendment and found that consideration and entry of the amendment would not reduce and simplify matters for appeal. The examiner provided multiple specific discussions explaining why the proposed amendments would not advance prosecution. See page 2 of the October 9, 2009 action, listing in detail the examiner's rationale for that finding.[2] Continuation of prosecution under §1.182 for the purpose of consideration of an amendment, where the petitioner has been put on notice that the amendment would not advance the prosecution, would not appear to be a *bona fide* effort to define issues for appeal or for the issuance of a reexamination certificate. To the contrary, entry of the amendment would merely replicate the discussion already set forth in the advisory Office action and thereby retard the proceeding. Therefore, continuation of the reexamination, in this instance, would not further the statutory mandate for special dispatch in *ex parte* reexamination proceedings.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is deemed not to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office." Should patent owner desire further review of the examiner's position expressed in the October 9, 2009 advisory Office action, patent owner may, if timely, file a petition under § 1.181. Alternately, should patent owner desire entry of an amendment that takes into account the positions taken in the advisory Office action, patent owner may, if timely, refile a petition under § 1.182 accompanied by an amendment designed to advance prosecution in some specific manner for review and consideration. Note that the filing of a petition does not stay the time for response to an Office action.

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. The patent owner addresses is not the same as that in the reexamination proceeding. *The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings* pursuant to 37 C.F.R. § 1.33(c), and it is that of Klarquist Sparkman, One World Trade Center Suite 1600, 121 S. W. Salmon Street, Portland, OR 97204. Accordingly, all future correspondence will be directed to Klarquist Sparkman, One World Trade Center Suite 1600, 121 S. W. Salmon Street, Portland, OR 97204, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123. As a courtesy, a copy of this decision is

[2] For instance, the examiner noted that amendments were proposed to claims (12 and 14) which are not under reexamination; to claims (17, 26-28, and 34) such that the rejection would not be overcome, and to claims (30, 32, and 38) that would remain subject to a new matter rejection even were the amendment entered.

being mailed to the address of record in the reexamination file, WilmerHale/DC, 1875 Pennsylvania Ave, NW, Washington, DC 20006.

CONCLUSION

- The November 3, 2009 patent owner petition is **dismissed**.
- 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.

Brian E. Hanlon

Brian Hanlon
Director,
Office of Patent Legal Administration

December 8, 2009
Kenpet7/RCR

United States Patent and Trademark Office

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MAILED
MAR 29 2010
CENTRAL REEXAMINATION UNIT

In re Connell et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,602
Filed: October 29, 2007
For: U.S. Patent No. 5,744,027

DECISION DISMISSING RENEWED PETITION UNDER § 1.182

This is a decision on the February 22, 2010 patent owner petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION."

The patent owner petition is before the Office of Patent Legal Administration. The petition fee of $400 under 37 C.F.R. § 1.17(f) has been charged.

The petition is **dismissed**.

BACKGROUND

- On April 28, 1998, U.S. Patent Number 5,744,027 was issued to Connell et al., having 16 claims.
- On October 29, 2007, the filing date requirements were met for a request for *ex parte* reexamination filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,602 ("the '602 proceeding").
- On January 17, 2008, the Office issued an Order granting *ex parte* reexamination of claims 7, 10, and 11.
- On March 28, 2008, the Office issued a first Office action rejecting claims 7, 10, and 11. Claims 1-6, 8, 9, and 12-15 were stated not to be subject to reexamination.

- On May 28, 2008, patent owner submitted a response to the first Office action, including amendments to claims 12 and 14, and adding new claims 17-39. This response was noted to be defective in an Office communication issued on August 6, 2008. Patent owner submitted a corrective amendment on September 3, 2008, including amendments to claims 12 and 14 and the claims added on May 28, 2008.

- On May 28, 2009, a final Office action was mailed. The final Office action addressed claims 7, 10, 11, 17-30, 32, 34, 35, and 38, which are pending and subject to reexamination. The action listed claims 1-6, 8, 9, and 12-16 as not subject to reexamination.

- On July 28, 2009, patent owner filed a paper in response to the final Office action of May 28, 2009, including amendments to claims 12, 14, 17, 26-30, 32, 34, 35, and 38,.

- On October 9, 2009, an advisory Office action was mailed by the Office, refusing entry of the amendments submitted on July 28, 2009, and setting a time period for response to run 6 months from the date of the final Office action.

- On November 3, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the amendments filed on July 28, 2009, and refused entry on October 9, 2009.

- On November 24, 2009, a Notice of Appeal was filed by patent owner.

- On December 3, 2009, third party requester filed a petition under 37 C.F.R. § 1.183 seeking waiver of 37 C.F.R. § 1.550(g).

- On January 12, 2010, the Office issued a decision dismissing the November 3, 2009 patent owner petition requesting continued reexamination.

- On February 4, 2010, an interview was conducted between patent owner's representative and the Office. Proposed amendments were discussed and stated by the Office to be refused entry for the same reasons noted in the advisory Office action of October 9, 2009.

- On February 22, 2010, the instant petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION" was filed to enter claim amendments and cancellations in a newly presented amendment submitted therewith. Patent owner also submitted a statement of the substance of the interview of February 4, 2010.

- On February 24, 2010, patent owner timely filed an appeal brief.

- On March 12, 2010, patent owner filed an amended appeal brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 C.F.R. § 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.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

37 C.F.R. § 1.525(a) provides, in pertinent part:

If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for ex parte reexamination of the patent for **resolution of the question**. (emphasis added)

DECISION

The February 22, 2010, patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of the amendments and entirety of the response filed therewith. A Notice of Appeal and an Appeal Brief have been filed by the patent owner in this proceeding.

The procedure for requesting continuation of an *ex parte* reexamination proceeding following a final rejection has been set forth in a March 1, 2005 Office Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* reexamination prosecution (after a final Office action) was made available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 C.F.R. § 1.182 can provide relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the requirement of special dispatch. The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office."

Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or further the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the case without the amendment or evidence), since these are key factors in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution should explain why the patent owner did not become aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution. And,

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

the grant or dismissal of a § 1.182 petition depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request.

In this instance, patent owner's submission consists of a proposed amendment cancelling certain claims and amending others. Currently, claims 7, 10, 11, 17-30, 32, 34, 35, and 38 are subject to reexamination. Among the claims proposed to be cancelled are claims 7, 10, and 11, which were held invalid in a Federal Circuit decision of September 10, 2009. Also proposed to be cancelled is claim 12, which is not under reexamination. Claims added during the reexamination proceeding are proposed to be either cancelled (17-20, 30, 32, 34, 35, and 38) or amended (21 and 26-28), in view of the Federal Circuit decision and rejections under 35 U.S.C. § 112 made in the final rejection of May 28, 2009.

The first issue is whether patent owner's submission, if entered, constitutes a *bona fide* effort that would advance the issues towards resolution of the questions of patentability at issue in the proceeding. Patent owner states that the claim amendments comprising the submission "represent a *bona fide* effort to narrow remaining issues for appeal." Petition at 4.

Patent owner first notes that cancellation of claims 7, 10, and 11, found by the Federal Circuit to be invalid, would reduce the remaining claims for appeal. However, these claims which were held invalid will be withdrawn from consideration in the reexamination pursuant to MPEP 2286, and are not required to be addressed by patent owner as a response to the Federal Circuit decision. Furthermore, patent owner may cancel these claims even after the filing of an appeal brief; see 37 C.F.R. § 41.33(b)(1).

Patent owner then notes that the cancellation of claims 17-20, 30, 32, 35, and 38 would reduce the issues remaining to be addressed. However, patent owner may cancel these claims even after the filing of an appeal brief; see 37 C.F.R. § 41.33(b)(1). No purpose would be furthered by reopening prosecution merely to permit patent owner to cancel claims.

Patent owner's amendment also attempts to cancel claim 12. However, claim 12 was not subject to reexamination, and was therefore not subject to rejection. Patent owner's petition does not provide any rationale for the cancellation of claim 12, which is not subject to cancellation as it is not a claim under reexamination, and would thus merely raise a new issue.

Patent owner notes, at pages 5-6 of the petition, that the amendment of claim 21 is proposed in the submission to incorporate the features of the claims (claims 17 and 20) from which claim 21 depends. However, patent owner may rewrite dependent claims into independent form even after the filing of an appeal brief; see 37 C.F.R. § 41.33(b)(2). No purpose would be furthered by reopening prosecution merely to permit patent owner to rewrite confirmed claims into independent form. Also note that confirmed claims dependent on cancelled claims need not be rewritten in independent form.

Patent owner then notes that the amendment of claims 26-29 would reduce issues by overcoming rejections based on § 112 issues, in response to a discussion with the examiner during the interview of February 4, 2010. However, the examiner's interview summary stated that "these

[proposed] amendments were not entered and would not be entered for the same reasons noted in the Advisory. The amendments are not limited to cancellation of claims, would raise issues, and would not simplify issues for Appeal." There is therefore no certainty that the proposed amendments would overcome the rejections. Even if the proposed amendment would overcome the new matter rejections, there is no certainty that art rejections would not be required for these new claims. Furthermore, these claims are not the original patent claims, but were newly added. These claims were not rejected over art, but rather as presenting new matter, which is an issue that was not part of the original purpose of the reexamination of the patent, since these claims were added during the proceeding. The question of patentability for which the reexamination was ordered, the patentability of claims 7, 10, and 11, has been finally adjudicated by the Federal Circuit. Continuation of prosecution under §1.182 for the purpose of consideration of this amendment would therefore not appear to be a *bona fide* effort to advance the proceeding towards resolution of the substantial new question of patentability for which the reexamination was ordered.

In this case, patent owner's proposed amendment would not further the reexamination proceeding by reducing issues for appeal, except to the extent that the proposed amendment includes claim cancellations and claims written into independent form. These claim cancellations and rewriting of claims into independent form may be separately submitted as amendments after submission of an appeal brief pursuant to 37 C.F.R. § 41.33(b), and thus a § 1.182 is not appropriate, since a rule exists that can accomplish the purpose. Therefore, continuation of the reexamination, in this instance, would not further the statutory mandate for special dispatch in *ex parte* reexamination proceedings.

The second issue is whether the petition adequately explains why the need for the proposed amendments could not have been anticipated earlier. The petition cites both the September 10, 2009 Federal Circuit decision on claims 7, 10, and 11 as the rationale for the cancellation of claims 7, 10, and 11. The petition cites that decision, and the May 28, 2009 final rejection, as providing the impetus for the proposed amendments or cancellations affecting the remaining claims under examination, which were added following the first action and first addressed by the Office in the final rejection.

With respect to claims 7, 10, and 11, patent owner states that the need for cancellation of these claims originated with the September 10, 2009 Federal Circuit decision. However, in patent owner's proposed amendments to the claims set forth in the November 3, 2009 petition for continued reexamination, patent owner did not propose cancellation of those claims. Nor did patent owner file a separate amendment under 37 C.F.R. § 1.116, which permits an amendment cancelling claims after a final rejection. Furthermore, these claims which were held invalid will be withdrawn from consideration in the reexamination pursuant to MPEP 2286, and are not required to be addressed by patent owner as a response to the Federal Circuit decision. Based upon patent owner's petition, and the facts of the proceeding, there is no reason why the cancellation of claims 7, 10, and 11 could not have been presented earlier.

With respect to the proposed cancellation of claim 12, claim 12 is, like claims 7, 10, and 11, an original patent claim. However, claim 12 was not subject to reexamination, and was therefore not subject to rejection. Furthermore, claim 12 was not the subject of the September 10, 2009

Federal Circuit decision. Patent owner's petition does not provide any rationale for the cancellation of claim 12 at this stage of the proceedings.

With respect to the proposed cancellation of claims 17-20, and the amendment to claim 21, these claims were held patentable in the final Office action of May 28, 2009. Claims 17-20 were not proposed to be cancelled in the July 28, 2009 amendment, nor was claim 21 proposed to be amended, by incorporating the limitations of claims 17 and 20 from which it depends, as proposed in the instant submission. The proposed amendments to the claims set forth in the November 3, 2009 petition for continued reexamination did not propose cancellation of those claims. Nor did patent owner file a separate amendment under 37 C.F.R. § 1.116, which permits an amendment cancelling claims after a final rejection. Although the petition mentions that "the examiner raised concerns over previously confirmed claims with elements drawn from other claims now deemed invalid by the Federal Circuit," the interview summary made of record by the Office does not reflect this statement; nor does patent owner's interview summary elaborate on this statement. Based upon patent owner's petition, and the facts of the proceeding, there is no reason why the cancellation of claims 17-20 and the amendment to claim 21 could not have been presented earlier.

With respect to the proposed amendment to claims 26-29, these claims were first proposed in the September 3, 2008 response to the nonfinal Office action, for the purpose of providing narrow claims that more particularly recite features of the invention. These claims were rejected in the final Office action of May 28, 2009 as containing new matter. Patent owner proposed amendments to these claims in the after-final amendment filed on July 28, 2009 to overcome the new matter rejection. However, the examiner found those proposed amendments insufficient to overcome the new matter rejections, as set forth in the advisory Office action of October 9, 2009. Patent owner, therefore, may not argue that patent owner has had no fair opportunity to address the new matter rejections; on the contrary, patent owner has had the opportunity to address this new matter rejection with an amendment at an earlier stage in the proceedings.

In view of the facts of this proceeding, patent owner's proposed amendment would not further the reexamination proceeding by reducing issues for appeal such that continuation of the prosecution is the appropriate action. Patent owner may cancel or place into independent form the majority of these claims at this stage subsequent the filing of an appeal brief pursuant to 37 C.F.R. § 41.33(b), without the need for, and delay resulting from, reopening of prosecution. The other proposed amendments address new matter issues brought into the proceeding by patent owner, and which may increase, rather than reduce, the issues for appeal. Furthermore, patent owner has had the opportunity to present each of the proposed claim amendments or cancellations at an earlier stage in the proceedings. Additionally, it is noted that the question of patentability for which the reexamination was ordered, the patentability of claims 7, 10, and 11, has been finally adjudicated by the Federal Circuit. Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is deemed not to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office." Note that the filing of a petition does not stay the time for response to an Office action. In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The February 22, 2010 patent owner petition is **dismissed**.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

March 25, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,602	10/29/2007	5744027	SMALT-5604DXD3(112713-176	2037

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EXAMINER	
ART UNIT	PAPER NUMBER

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(For Requester)

In re Connell et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,602
Filed: October 29, 2007
For: U.S. Patent No. 5,744,027

DECISION DISMISSING RENEWED PETITION UNDER § 1.182

REMAILING

This is a remailing of a March 29, 2010 Office decision on a petition under 37 C.F.R. § 1.182. This decision is remailed solely to correct an erroneous third party requester address. The decision which follows is identical to the March 29, 2010 Office decision.

This is a decision on the February 22, 2010 patent owner petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION."

The patent owner petition is before the Office of Patent Legal Administration. The petition fee of $400 under 37 C.F.R. § 1.17(f) has been charged.

The petition is **dismissed**.

BACKGROUND

- On April 28, 1998, U.S. Patent Number 5,744,027 was issued to Connell et al., having 16 claims.

- On October 29, 2007, the filing date requirements were met for a request for *ex parte* reexamination filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,602 ("the '602 proceeding").

- On January 17, 2008, the Office issued an Order granting *ex parte* reexamination of claims 7, 10, and 11.

- On March 28, 2008, the Office issued a first Office action rejecting claims 7, 10, and 11. Claims 1-6, 8, 9, and 12-15 were stated not to be subject to reexamination.

- On May 28, 2008, patent owner submitted a response to the first Office action, including amendments to claims 12 and 14, and adding new claims 17-39. This response was noted to be defective in an Office communication issued on August 6, 2008. Patent owner submitted a corrective amendment on September 3, 2008, including amendments to claims 12 and 14 and the claims added on May 28, 2008.

- On May 28, 2009, a final Office action was mailed. The final Office action addressed claims 7, 10, 11, 17-30, 32, 34, 35, and 38, which are pending and subject to reexamination. The action listed claims 1-6, 8, 9, and 12-16 as not subject to reexamination.

- On July 28, 2009, patent owner filed a paper in response to the final Office action of May 28, 2009, including amendments to claims 12, 14, 17, 26-30, 32, 34, 35, and 38,.

- On October 9, 2009, an advisory Office action was mailed by the Office, refusing entry of the amendments submitted on July 28, 2009, and setting a time period for response to run 6 months from the date of the final Office action.

- On November 3, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the amendments filed on July 28, 2009, and refused entry on October 9, 2009.

- On November 24, 2009, a Notice of Appeal was filed by patent owner.

- On December 3, 2009, third party requester filed a petition under 37 C.F.R. § 1.183 seeking waiver of 37 C.F.R. § 1.550(g).

- On January 12, 2010, the Office issued a decision dismissing the November 3, 2009 patent owner petition requesting continued reexamination.

- On February 4, 2010, an interview was conducted between patent owner's representative and the Office. Proposed amendments were discussed and stated by the Office to be refused entry for the same reasons noted in the advisory Office action of October 9, 2009.

- On February 22, 2010, the instant petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION" was filed to enter claim amendments and cancellations in a newly presented amendment submitted

therewith. Patent owner also submitted a statement of the substance of the interview of February 4, 2010.

- On February 24, 2010, patent owner timely filed an appeal brief.
- On March 12, 2010, patent owner filed an amended appeal brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 C.F.R. § 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.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

37 C.F.R. § 1.525(a) provides, in pertinent part:

> If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for ex parte reexamination of the patent for **resolution of the question.** (emphasis added)

DECISION

The February 22, 2010, patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of the amendments and entirety of the response filed therewith. A Notice of Appeal and an Appeal Brief have been filed by the patent owner in this proceeding.

The procedure for requesting continuation of an *ex parte* reexamination proceeding following a final rejection has been set forth in a March 1, 2005 Office Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* reexamination prosecution (after a final Office action) was made available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 C.F.R. § 1.182 can provide relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the requirement of special dispatch. The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office."

Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or further the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the case without the amendment or evidence), since these are key factors in

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

reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution should explain why the patent owner did not become aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution. And, the grant or dismissal of a § 1.182 petition depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request.

In this instance, patent owner's submission consists of a proposed amendment cancelling certain claims and amending others. Currently, claims 7, 10, 11, 17-30, 32, 34, 35, and 38 are subject to reexamination. Among the claims proposed to be cancelled are claims 7, 10, and 11, which were held invalid in a Federal Circuit decision of September 10, 2009. Also proposed to be cancelled is claim 12, which is not under reexamination. Claims added during the reexamination proceeding are proposed to be either cancelled (17-20, 30, 32, 34, 35, and 38) or amended (21 and 26-28), in view of the Federal Circuit decision and rejections under 35 U.S.C. § 112 made in the final rejection of May 28, 2009.

The first issue is whether patent owner's submission, if entered, constitutes a *bona fide* effort that would advance the issues towards resolution of the questions of patentability at issue in the proceeding. Patent owner states that the claim amendments comprising the submission "represent a *bona fide* effort to narrow remaining issues for appeal." Petition at 4.

Patent owner first notes that cancellation of claims 7, 10, and 11, found by the Federal Circuit to be invalid, would reduce the remaining claims for appeal. However, these claims which were held invalid will be withdrawn from consideration in the reexamination pursuant to MPEP 2286, and are not required to be addressed by patent owner as a response to the Federal Circuit decision. Furthermore, patent owner may cancel these claims even after the filing of an appeal brief; see 37 C.F.R. § 41.33(b)(1).

Patent owner then notes that the cancellation of claims 17-20, 30, 32, 35, and 38 would reduce the issues remaining to be addressed. However, patent owner may cancel these claims even after the filing of an appeal brief; see 37 C.F.R. § 41.33(b)(1). No purpose would be furthered by reopening prosecution merely to permit patent owner to cancel claims.

Patent owner's amendment also attempts to cancel claim 12. However, claim 12 was not subject to reexamination, and was therefore not subject to rejection. Patent owner's petition does not provide any rationale for the cancellation of claim 12, which is not subject to cancellation as it is not a claim under reexamination, and would thus merely raise a new issue.

Patent owner notes, at pages 5-6 of the petition, that the amendment of claim 21 is proposed in the submission to incorporate the features of the claims (claims 17 and 20) from which claim 21 depends. However, patent owner may rewrite dependent claims into independent form even after the filing of an appeal brief; see 37 C.F.R. § 41.33(b)(2). No purpose would be furthered by reopening prosecution merely to permit patent owner to rewrite confirmed claims into

independent form. Also note that confirmed claims dependent on cancelled claims need not be rewritten in independent form.

Patent owner then notes that the amendment of claims 26-29 would reduce issues by overcoming rejections based on § 112 issues, in response to a discussion with the examiner during the interview of February 4, 2010. However, the examiner's interview summary stated that "these [proposed] amendments were not entered and would not be entered for the same reasons noted in the Advisory. The amendments are not limited to cancellation of claims, would raise issues, and would not simplify issues for Appeal." There is therefore no certainty that the proposed amendments would overcome the rejections. Even if the proposed amendment would overcome the new matter rejections, there is no certainty that art rejections would not be required for these new claims. Furthermore, these claims are not the original patent claims, but were newly added. These claims were not rejected over art, but rather as presenting new matter, which is an issue that was not part of the original purpose of the reexamination of the patent, since these claims were added during the proceeding. The question of patentability for which the reexamination was ordered, the patentability of claims 7, 10, and 11, has been finally adjudicated by the Federal Circuit. Continuation of prosecution under §1.182 for the purpose of consideration of this amendment would therefore not appear to be a *bona fide* effort to advance the proceeding towards resolution of the substantial new question of patentability for which the reexamination was ordered.

In this case, patent owner's proposed amendment would not further the reexamination proceeding by reducing issues for appeal, except to the extent that the proposed amendment includes claim cancellations and claims written into independent form. These claim cancellations and rewriting of claims into independent form may be separately submitted as amendments after submission of an appeal brief pursuant to 37 C.F.R. § 41.33(b), and thus a § 1.182 is not appropriate, since a rule exists that can accomplish the purpose. Therefore, continuation of the reexamination, in this instance, would not further the statutory mandate for special dispatch in *ex parte* reexamination proceedings.

The second issue is whether the petition adequately explains why the need for the proposed amendments could not have been anticipated earlier. The petition cites both the September 10, 2009 Federal Circuit decision on claims 7, 10, and 11 as the rationale for the cancellation of claims 7, 10, and 11. The petition cites that decision, and the May 28, 2009 final rejection, as providing the impetus for the proposed amendments or cancellations affecting the remaining claims under examination, which were added following the first action and first addressed by the Office in the final rejection.

With respect to claims 7, 10, and 11, patent owner states that the need for cancellation of these claims originated with the September 10, 2009 Federal Circuit decision. However, in patent owner's proposed amendments to the claims set forth in the November 3, 2009 petition for continued reexamination, patent owner did not propose cancellation of those claims. Nor did patent owner file a separate amendment under 37 C.F.R. § 1.116, which permits an amendment cancelling claims after a final rejection. Furthermore, these claims which were held invalid will be withdrawn from consideration in the reexamination pursuant to MPEP 2286, and are not required to be addressed by patent owner as a response to the Federal Circuit decision. Based

upon patent owner's petition, and the facts of the proceeding, there is no reason why the cancellation of claims 7, 10, and 11 could not have been presented earlier.

With respect to the proposed cancellation of claim 12, claim 12 is, like claims 7, 10, and 11, an original patent claim. However, claim 12 was not subject to reexamination, and was therefore not subject to rejection. Furthermore, claim 12 was not the subject of the September 10, 2009 Federal Circuit decision. Patent owner's petition does not provide any rationale for the cancellation of claim 12 at this stage of the proceedings.

With respect to the proposed cancellation of claims 17-20, and the amendment to claim 21, these claims were held patentable in the final Office action of May 28, 2009. Claims 17-20 were not proposed to be cancelled in the July 28, 2009 amendment, nor was claim 21 proposed to be amended, by incorporating the limitations of claims 17 and 20 from which it depends, as proposed in the instant submission. The proposed amendments to the claims set forth in the November 3, 2009 petition for continued reexamination did not propose cancellation of those claims. Nor did patent owner file a separate amendment under 37 C.F.R. § 1.116, which permits an amendment cancelling claims after a final rejection. Although the petition mentions that "the examiner raised concerns over previously confirmed claims with elements drawn from other claims now deemed invalid by the Federal Circuit," the interview summary made of record by the Office does not reflect this statement; nor does patent owner's interview summary elaborate on this statement. Based upon patent owner's petition, and the facts of the proceeding, there is no reason why the cancellation of claims 17-20 and the amendment to claim 21 could not have been presented earlier.

With respect to the proposed amendment to claims 26-29, these claims were first proposed in the September 3, 2008 response to the nonfinal Office action, for the purpose of providing narrow claims that more particularly recite features of the invention. These claims were rejected in the final Office action of May 28, 2009 as containing new matter. Patent owner proposed amendments to these claims in the after-final amendment filed on July 28, 2009 to overcome the new matter rejection. However, the examiner found those proposed amendments insufficient to overcome the new matter rejections, as set forth in the advisory Office action of October 9, 2009. Patent owner, therefore, may not argue that patent owner has had no fair opportunity to address the new matter rejections; on the contrary, patent owner has had the opportunity to address this new matter rejection with an amendment at an earlier stage in the proceedings.

In view of the facts of this proceeding, patent owner's proposed amendment would not further the reexamination proceeding by reducing issues for appeal such that continuation of the prosecution is the appropriate action. Patent owner may cancel or place into independent form the majority of these claims at this stage subsequent the filing of an appeal brief pursuant to 37 C.F.R. § 41.33(b), without the need for, and delay resulting from, reopening of prosecution. The other proposed amendments address new matter issues brought into the proceeding by patent owner, and which may increase, rather than reduce, the issues for appeal. Furthermore, patent owner has had the opportunity to present each of the proposed claim amendments or cancellations at an earlier stage in the proceedings. Additionally, it is noted that the question of patentability for which the reexamination was ordered, the patentability of claims 7, 10, and 11, has been finally adjudicated by the Federal Circuit. Based on the facts and circumstances of the

present situation, it is found that petitioner patent owner's response is deemed not to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office." Note that the filing of a petition does not stay the time for response to an Office action. In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The February 22, 2010 patent owner petition is **dismissed**.
- 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

April 5, 2010

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90/008,602	10/29/2007	5744027	SMALT-5604DXD3(112713-176	2037

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(Courtesy Copy)

In re Connell et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,602
Filed: October 29, 2007
For: U.S. Patent No. 5,744,027

DECISION
DISMISSING PETITION
UNDER § 1.182

REMAILING

This is a remailing of a January 12, 2010 Office decision on a petition under 37 C.F.R. § 1.182. This decision is remailed solely to correct an erroneous third party requester address. The decision which follows is identical to the January 12, 2010 Office decision.

This is a decision on the November 3, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION."

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

The petition is **dismissed**.

BACKGROUND

- On October 29, 2007, the filing date requirements were met for a request for *ex parte* reexamination filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,602 ("the '602 proceeding").

- Prosecution in the '602 proceeding progressed until, on May 28, 2009, a final Office action was mailed. The final Office action addressed claims 7, 10, 11, 17-30, 32, 34, 35, and 38, which are subject to reexamination. The action listed claims 1-6, 8, 9, and 12-16 as not subject to reexamination.

- On July 28, 2009, patent owner filed a response, including amendments to claims 12, 14, 17, 26-30, 32, 34, 35, and 38, to the final Office action of May 28, 2009.

- On October 9, 2009, an advisory Office action was mailed by the Office, refusing entry of the amendments submitted on July 28, 2009, and setting a time period for response to run 6 months from the date of the final Office action.

- On November 3, 2009, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the amendments filed on July 28, 2009, and refused entry on October 9, 2009.

- On November 24, 2009, a Notice of Appeal was filed by patent owner.

- On December 3, 2009, third party requester filed a petition under 37 C.F.R. § 1.183 seeking waiver of 37 C.F.R. § 1.550(g).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 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 C.F.R. § 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.

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

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

37 C.F.R. § 1.525(a) provides, in pertinent part:

> If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for ex parte reexamination of the patent for **resolution of the question**. (emphasis added)

DECISION

The November 3, 2009, patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of the amendments and entirety of the response filed July 28, 2009, and refused entry by the examiner in an advisory Office action mailed October 9, 2009.

1. Basis of Relief For the Instant Petition

37 C.F.R. § 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 C.F.R. § 1.182 is, according to the terms of that regulation, not an appropriate mechanism for relief. For example, a petition under §1.182 should not be filed where the petitioner merely seeks further review of issues which have previously been considered and rejected by the examiner. Such a situation is already provided for in the regulations by 37 C.F.R. §1.181. Where an examiner has, for instance, stated that a particular amendment would not overcome a rejection and would not simplify issues for appeal, a petition requesting continued examination under 37 C.F.R. § 1.182 is not the proper vehicle for a further request for entry of that identical amendment based on the assumption that the examiner's determination was flawed or improper. Rather, patent owner should file a petition under §1.181.

Here, the petition under 37 C.F.R. § 1.182 alleges that sufficient reasons for the Examiner's refusal to enter the July 28, 2009 amendment were not given in the advisory action mailed October 9, 2009. See section III; pages 5-7 of the November 3, 2009 patent owner petition. Each of the allegations made in the instant 37 C.F.R. § 1.182 petition addresses alleged impropriety as to the final Office action and the advisory action. While such allegations of impropriety of an Office action are properly addressed under 37 C.F.R. § 1.181, they are not the basis for a petition requesting continued examination under 37 C.F.R. § 1.182. Therefore, the propriety of the Office action will not be discussed in this decision.

2. Merits of the Request for Relief

The procedure for requesting continuation of an *ex parte* reexamination proceeding following a final rejection has been set forth in a March 1, 2005 Office Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* reexamination prosecution (after a final Office action) was made available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. The petition under 37 C.F.R. § 1.182 can provide relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the requirement of special dispatch. The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office."

Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or further the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the case without the amendment or evidence), since these are key factors in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution. And, the

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

grant or dismissal of a § 1.182 petition depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request.

The first issue, then, is whether patent owner's submission, if entered, constitutes a *bona fide* effort that would advance the issues towards resolution of the questions of patentability at issue in the proceeding. Patent owner states that the amendment simplifies and clarifies the issues for appeal, relative to the issues presented in the claims currently at issue in the proceeding, through deletion of terms stated by the examiner to be new matter, addition of limitations to clarify claims, and addition of limitations to previously allowed claims to further define the invention. See page 4 of the November 3, 2009 patent owner petition.

However, the examiner, in the advisory Office action mailed October 9, 2009, reviewed the identical amendment and found that consideration and entry of the amendment would not reduce and simplify matters for appeal. The examiner provided multiple specific discussions explaining why the proposed amendments would not advance prosecution. See page 2 of the October 9, 2009 action, listing in detail the examiner's rationale for that finding.[2] Continuation of prosecution under §1.182 for the purpose of consideration of an amendment, where the petitioner has been put on notice that the amendment would not advance the prosecution, would not appear to be a *bona fide* effort to define issues for appeal or for the issuance of a reexamination certificate. To the contrary, entry of the amendment would merely replicate the discussion already set forth in the advisory Office action and thereby retard the proceeding. Therefore, continuation of the reexamination, in this instance, would not further the statutory mandate for special dispatch in *ex parte* reexamination proceedings.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is deemed not to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office." Should patent owner desire further review of the examiner's position expressed in the October 9, 2009 advisory Office action, patent owner may, if timely, file a petition under § 1.181. Alternately, should patent owner desire entry of an amendment that takes into account the positions taken in the advisory Office action, patent owner may, if timely, refile a petition under § 1.182 accompanied by an amendment designed to advance prosecution in some specific manner for review and consideration. Note that the filing of a petition does not stay the time for response to an Office action.

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

[2] For instance, the examiner noted that amendments were proposed to claims (12 and 14) which are not under reexamination; to claims (17, 26-28, and 34) such that the rejection would not be overcome, and to claims (30, 32, and 38) that would remain subject to a new matter rejection even were the amendment entered.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. The patent owner addresses is not the same as that in the reexamination proceeding. *The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings* pursuant to 37 C.F.R. § 1.33(c), and it is that of Klarquist Sparkman, One World Trade Center Suite 1600, 121 S. W. Salmon Street, Portland, OR 97204. Accordingly, all future correspondence will be directed to Klarquist Sparkman, One World Trade Center Suite 1600, 121 S. W. Salmon Street, Portland, OR 97204, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123. As a courtesy, a copy of this decision is being mailed to the address of record in the reexamination file, WilmerHale/DC, 1875 Pennsylvania Ave, NW, Washington, DC 20006.

CONCLUSION

- The November 3, 2009 patent owner petition is **dismissed**.
- 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.

Brian E. Hanlon

Brian Hanlon
Director,
Office of Patent Legal Administration

April 5, 2010
Kenpet7/RCR

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

APR 15 2010

CENTRAL REEXAMINATION UNIT

Baxter Healthcare Corporation
1 Baxter Parkway
DF2-2E
Deerfield, IL 60015

(For Requester)

In re Connell et al
Ex Parte Reexamination Proceeding
Control No. 90/008,602
Filed: October 29, 2007
For: U.S. Patent No. 5,744,027

: **DECISION DISMISSING**
: **AND EXPUNGING**
: **PETITION**

This is a decision on the December 3, 2009 third party requester petition entitled "Third Party Requester Petition Under 37 CFR 1.183 Seeking Waiver of 37 CFR 1.550(g) and Withdrawal of Confirmation of Claims 17-25" ("the December 3, 2009 requester petition").

The December 3, 2009 requester petition is before the Office of Patent Legal Administration.

SUMMARY

The December 3, 2009 requester petition is **dismissed**.

The December 3, 2009 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]

BACKGROUND

- On April 28, 1998, U.S. Patent 5,744,027 ("the '027 patent) issued to Connell et al.
- On October 29, 2007, a completed request for *ex parte* reexamination, that was in compliance with the rules, was filed by the third party requester. The resulting reexamination proceeding was assigned control number 90/008,602 ("the '8602 proceeding").
- On January 17, 2008, an order granting *ex parte* reexamination was mailed by the Office.
- The proceeding progressed until, on May 28, 2009, a final rejection was mailed by the Office.

[1] See MPEP 2267.

- On July 28, 2009, the patent owner filed a response after final rejection.
- Also on July 28, 2009, the third party requester filed a petition under 37 CFR 1.181.
- On August 3, 2009, a decision expunging the July 28, 2009 requester petition, as improper, was mailed by the Office.
- On October 9, 2009, an advisory action was mailed by the Office.
- On November 3, 2009, the patent owner filed a petition under 37 CFR 1.182 requesting continued reexamination (RCR).
- On November 24, 2009, the patent owner filed a notice of appeal.
- On December 3, 2009, the third party requester filed the present petition under 37 CFR 1.183 seeking waiver of 37 CFR 1.550(g).
- On December 18, 2009, the patent owner filed a petition for a one-month extension of time under 37 CFR 1.550(c).
- On December 23, 2009, a decision granting the December 18, 2009 petition under 37 CFR 1.550(c), was mailed by the Office.
- On January 12, 2010, a decision dismissing the November 3, 2009 patent owner petition under 37 CFR 1.182, was mailed by the Office.
- On February 22, 2010, the patent owner filed a renewed petition under 37 CFR 1.182 requesting continued reexamination (RCR).
- On February 24, 2010, the patent owner filed an appeal brief.
- On March 12, 2010, the patent owner filed an amended brief.
- On March 29, 2010, a decision dismissing the February 22, 2010 renewed patent owner petition under 37 CFR 1.182, 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 1.183 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.

DECISION

The December 3, 2009 third party requester petition is filed under 37 CFR 1.183. Attached to the present petition are various court documents which the requester apparently wishes the Office to review. However, the relief requested is barred by the statute, as discussed in detail *infra*. The rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '8602 proceeding. In addition, 37 CFR 1.183 does not apply to the facts of this case, because the requester has failed to show that the requested relief, i.e., a review by the Office of the court documents attached to the present petition, cannot be obtained by filing a notice of concurrent proceedings, which would be permitted pursuant to MPEP 2282.

Waiver/suspension of the rules to permit the third party submission via the present petition is not permitted 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]

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 timely filed. In the present '8602 proceeding, the statutory statement and reply period ended when the patent owner did not file a statement in response to the January 17, 2008 order granting reexamination, and the two month period for doing so expired.

On its face, requester's present petition under 37 CFR 1.183, filed on December 3, 2009, was filed after the statutory statement and reply period ended for the '8602 proceeding.

Furthermore, 35 U.S.C. 305 states that reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of title 35. 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.

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 December 3, 2009 requester petition is clearly an attempt by the third party requester to participate in the *ex parte* reexamination process. In this petition, the requester requests the Office to:

- withdraw the Office's confirmation of new claims 17-25 of the '027 patent;
- deny or otherwise refuse to consider all of the patent owner's outstanding filings, including the notice of appeal filed on November 24, 2009;
- preclude the patent owner from filing any further papers in this reexamination proceeding;
- impose a monetary sanction on the patent owner;
- terminate the prosecution of the *ex parte* reexamination proceeding; and
- issue a NIRC cancelling all of the patent claims.[2]

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 was necessary for Congress to amend the patent 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).[3] 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

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[2] See page 11 of the present petition.
[3] See, generally, 35 U.S.C. 311-318.

November 29, 1999,[4] but did not do so for *ex parte* reexamination,[5] 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. However, the rules cannot be waived to provide the third party requester the right to file a paper in the examination stage of the '8602 proceeding (during which the present petition has been filed), since the requester's right to file a paper at this stage of the proceeding 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. The requester's attempt to intervene in an *ex parte* reexamination at this stage of the proceeding is equivalent to the attempt by a third party to intervene in the *ex parte* prosecution of a nonprovisional utility application, where the third party has no legal standing.[6] Because the statute does not authorize the requested intervention by the present petition, the relief requested in the December 3, 2009 requester petition cannot be granted.

A brief discussion as to the history of reexamination impacts on the intervention requested by the petition: It is clearly without statutory authority to permit a third party requester to participate in an *ex parte* reexamination by requesting the Office to (1) withdraw the Office's confirmation of new claims 17-25 of the '027 patent, (2) deny or otherwise refuse to consider all of the patent owner's outstanding filings, (3) preclude the patent owner from filing any further papers in this reexamination proceeding, (4) terminate the ex parte reexamination proceeding, and (5) issue a NIRC cancelling all of the patent claims.[7] The Office is required under 35 U.S.C. 305 to conduct reexamination proceedings with special dispatch. 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 for a third party 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

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[4] P.L. No. 106-113, 113 STAT. 1501A-571.

[5] 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).

[6] The filing of the present petition 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.

[7] Furthermore, the third party requester may not, by petition, request the Office to impose sanctions on the patent owner in a reexamination proceeding, because the conduct of the patent owner is not an issue that is within the scope of reexamination. See MPEP 2258, subsection I B.

> 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 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. 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 is not permitted to provide such intervention in the present process. To enter and consider the December 3, 2009 petition, at the stage in the proceeding at which this petition was filed, 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 December 3, 2009 requester petition under 37 CFR 1.183 is **dismissed**. 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]

If the requester wishes the Office to review the court documents attached to the present petition, the requester may file a notice of concurrent proceedings, and must include only the court documents that are attached to the present petition, without any comment, discussion, or argument regarding these documents, or their content. For example, the claim chart entitled "Appendix 4", which is attached to the present petition, is apparently not a court document, and therefore cannot be included in the notice of concurrent proceedings. See MPEP 2282, which provides, in pertinent part (emphasis added):

> . . . 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 . . . **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**

[8] See MPEP 2267.

> **party's arguments** . . . Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office. It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return , expunge or discard, at its sole discretion, all or part of the submission. . . **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.

Finally, the requester requests the Office to issue a final agency action within the meaning of 5 U.S.C. 704.[9] This decision is a **dismissal**, and is **not** a final agency action under 5 U.S.C. 704. While the Office has previously dismissed a similar petition by the requester under 37 CFR 1.181, the December 3, 2009 petition is the first petition filed by the requester under 37 CFR 1.183. As such, the requester must have the opportunity to respond to the Office's position and to the case law cited in the present decision. Accordingly, the present decision, which is in response to the first petition under 37 CFR 1.183 filed by the requester, is not a final agency action.

Reminder to Patent Owner

The patent owner is reminded of the provisions of 37 CFR 1.565(a), which require the patent owner to notify the Office of the results of concurrent court proceedings in which the patent under reexamination is involved, such as the result, when available, of patent owner's petition for a writ of certiorari in the Supreme Court of the United States, filed in the United States Court of Appeals for the Federal Circuit on February 16, 2010, to review the judgment of that court, reported at 582 F.3d 1288 (Fed. Cir. 2009). [10]

CONCLUSION

- The December 3, 2009 requester petition under 37 CFR 1.183 is **dismissed**. This decision is **not** a final agency action within the meaning of 5 U.S.C. 704.

- The petition paper filed by the third party requester on December 3, 2009 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 '8602 *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.

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[9] See page 12 of the present petition.

[10] See *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 92 USPQ2d 1163 (Fed. Cir. 2009).

- A copy of this decision will be made of record in the reexamination file.

- 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 Petition
  Commissioner for Patents
  Post Office Box 1450
  Alexandria, VA 22313-1450

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

- Any inquiry concerning this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Hancock Hughey LLP
P.O. Box 6553
Portland, OR 97228

(For Patent Owner)

MAILED

JAN 28 2008

John E. Carlson, Esq.
Carlson, Gaskey & Olds, P.C.
400 W. Maple Road, Suite 350
Birmingham, MI 48009

(For 3rd Party Requester)

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/008,603
Filed : April 23, 2007
For U.S. Patent No. : 5,601,557

Reexam Control No.: 90/010,029
Filed : October 12, 2007
For U.S. Patent No. : 5,601,557

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. 90/008,603 was ordered in a decision mailed June 8, 2007 indicating that claims 1-7 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. An Information Disclosure Statement was filed on November 26, 2007. There are no amendments to the claims specification or drawings in this reexamination proceeding. No further action has taken place in this reexamination proceeding.

Reexamination in application control No. 90/010,029 was ordered in a decision mailed October 12, 2007 indicating that claims 1-7 will be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. There are no amendments to the claims specification or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/008,603 and reexamination control No. 90/010,029 are currently pending. Since the order to reexamine has been mailed in

both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

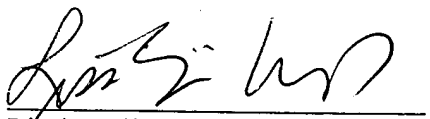
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-7, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,603 and 90/010,029 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,608	09/25/2007	4963736	102993-100	4395

26646 7590 11/06/2008

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/06/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,608	09/25/2007	4963736	102993-100	4395

26646 7590 11/06/2008

EXAMINER	
ART UNIT	PAPER NUMBER

HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
HALF MOON BAY, CA 94019

DATE MAILED: 11/06/2008

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

Wlater E. Hanley, Jr. : (For Patent Owner)
KENYON & KENYON LLP :
ONE BROADWAY :
NEW YORK NY 10004 :

: (For Third Party
HAYNES BEFFEL & WOLFELD LLP : Requester)
P O BOX 366 :
HALF MOON BAY, CA 94019 :

: DECISION
: GRANTING
: PETITION FOR EXTENSION
: OF TIME
: [37 CFR § 1.550(c) and § 1.181]

In re: Douglas *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/008,608 :
Deposited on: 25 September 2007 :
For: US Patent No. 4,963,736 :

MAILED

NOV 06 2008

CENTRAL REEXAMINATION UNIT

This is a decision on the 21 October 2008,patent owner's petition for "Patent Owner's Request for Extension of Time," pursuant to 37 CFR § 1.550 (c) and §1.181 requesting that the time for responding to the non-final Office action mailed 26 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 an extension of time in which to file a response to the Office action mailed 30 September 2008, which set a one-month date for

filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 21 October 2008, together with authorization to charge a Deposit Account 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 the petition before the Office there is always the consideration of balance between the need of the patent owner to have a fair opportunity to respond to the Office action and the need for special dispatch. As a consequence there is a consideration of the "sufficient cause" to grant an extension of time in reexamination proceedings.

On balance the patent owner in the petition for extension of time dated 21 October 2008 has noted that patent owner's simultaneous extensive preparations for the concurrent infringement trial commencing 3 November 2008. As such, on balance, the patent owner has shown diligence and "sufficient cause" to grant a one-month extension of 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 26 September 2008 is hereby **granted**

2. The period for response is hereby extended by one-month.

3. The Patent Owner's response is due **26 November 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, or Eric Keasel at (571) 272-4929 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

Gregory Morse
Director,
Central Reexamination Unit 3999

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

mail

WOOD, HERRON & EVANS
2700 Carew Tower
Cincinnati, OH 45202

(For Patent Owner)

MAILED

JUL 19 2007

CENTRAL REEXAMINATION UNIT

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111

(For Requester)

In re Brooks
Reexamination Proceeding
Control No. 90/008,609
Corrected Request Dated: July 3, 2007
For: U.S. Patent No. 5,467,002

: DECISION ON
: PETITION TO HAVE
: RESPONSE DEEMED
: TIMELY FILED

On July 3, 2007, the third party requester (petitioner) filed a paper entitled "Petition to Have Response Deemed Timely Filed" (hereinafter "Petition"), which states that the corrected request should be treated as timely because the "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" was not received until June 5, 2007. The "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" was mailed on May 2, 2007.

The petition is before the Director of the Office of Patent Legal Administration for consideration of whether or not to accept the reply to the "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement" as timely.

The petition is dismissed. For the reasons set forth below, the corrected request for *ex parte* reexamination dated July 3, 2007 is not accepted as timely, the reexamination preprocessing remains terminated, and the reexamination filing fee submitted with the proceeding will be refunded to requester pursuant to 37 CFR 1.26(a).

REVIEW OF FACTS

1. U.S. Patent No. 5,467,002 (hereinafter, the '002 patent), issued to Brooks, on November 14, 1995.

2. On April 25, 2007, a third party filed a paper requesting *ex parte* reexamination of the '002 patent pursuant to 37 CFR 1.510. The reexamination request was assigned Control No. 90/008,609 (hereinafter, the '8609 proceeding).

3. On May 2, 2007, a "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" was mailed in the '8609 proceeding. As basis for the Office's finding that the request is non-compliant with the reexamination filing date requirements, the notice identified the absence of (a) a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and (b) a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination was requested. The notice provided a 30-day time period for requester to complete the request.

4. On July 3, 2007, the third party requester filed a corrected request for *ex parte* reexamination and the Petition.

5. On July 5, 2007, a "NOTICE OF TERMINATION OF PREPROCESSING OF *EX PARTE* REEXAMINATION REQUEST (37 CFR 1.510(c))" was mailed for the '8609 proceeding. The notice stated that the request for *ex parte* reexamination filed 04/25/2007 would not be granted a filing date, and the reexamination filing fee submitted with the proceeding would be refunded to requester pursuant to 37 CFR 1.26(a).

DECISION

I. The Notice of Incomplete Request for *Ex Parte* Reexamination:

The " Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" mailed on May 2, 2007, identified the following items required by 37 CFR 1.510 were missing from the request:

> A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

An attachment to the " Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" explained the deficiencies in the request in more detail, and also set forth the required response to rectify each deficiency. Specifically, the notice required

an explanation of the pertinency and manner of applying each patent and printed publication to every claim for which reexamination is requested. The notice required a detailed explanation for the following patents and printed publications:

U.S. Patent No. 4,792,186 to Benjamin et al.
U.S. Patent No. 5,340,953 to Krebs et al.
HealthCo Brochure
Schein Publication

The notice, which was mailed on May 2, 2007, provided a 30-day time period to respond.

II. Requester's response to the Notice of Incomplete Request for *Ex Parte* Reexamination:

As pointed out above, a response from the requester to the "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" was received on July 3, 2007. The response was received well after the 30-day time period for response expired. The present Petition states that the "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" was not received until June 5, 2007. The petition is accompanied by two affidavits, one by Mr. Todd Zenger and one by Ms. Margaret L. Carlson. Both affidavits state "Our offices, Kirton & McConkie, neither received by U.S. mail nor email the Notice of Failure to Comply with the Ex Parte Reexam Request and has no record of receiving the Notice until June 5, 2007." No other evidence was submitted with the Petition.

The present Petition is analogous to a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of an abandonment of an application based on non-receipt of an Office action. As such, the present Petition is decided following the Office procedures for petitions under 37 CFR 1.181(a). MPEP 711.03(c) states that:

> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. **A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.** For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. [Emphasis added in bold and underlining.]

As stated above, the Petition is supported by two affidavits, each by an employee of Kirton & McConkie, which state that, to their knowledge, the notice was not received until June 5, 2007. The Petition is not accompanied by the requisite evidence - a copy of

the docket record where the non-received Office communication would have been entered had it been received and docketed. Also, there is no averment in the affidavits that a search of the file jacket and docket records was made, to support affiants' conclusion. It is further noted that the mailing address on the "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" appears to be correct, and that the office of Kirton & McConkie eventually received the Notice. It may be that the notice was timely received by office of Kirton & McConkie, and misdirected within that office, and a search of the Kirton & McConkie records might reveal that to be the case. The record fails to clearly support the conclusion stated in the Petition that the "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirement (37 CFR 1.510(c))" was not received in the office of Kirton & McConkie until June 5, 2007. Accordingly, the Petition cannot be granted.

Furthermore, a review of the untimely requester response reveals that the response is **not** sufficient to complete the *ex parte* reexamination request pursuant to 37 CFR 1.510, even if it was timely. For example, the corrected request fails to provide a detailed explanation of the pertinency and manner of applying the Benjamin et al. patent to every claim for which reexamination is requested.

In view of the above, the request has not properly advanced (and explained) a substantial new question with respect to all of the '002 patent claims for which reexamination has been requested, the request fails to comply with the requirements for granting a filing date for a reexamination request.

III. Requester's recourse

In this instance, the third party requester is not without remedy. This decision is without prejudice to the right of the requester to file a new request for reexamination to address the missing information noted above. In the event that requester desires to initiate an *ex parte* reexamination of the '002 patent, requester may file a new and complete request for *ex parte* reexamination, and a filing date can be granted as of the date of filing the new request, should it be determined to be compliant with the reexamination filing date requirements. It is to be noted that, even if a further supplement to the present request could be filed in this Control Number, a filing date could not be awarded until the further supplement were received. Thus, requester is not losing any perceived advantage of an earlier filing date by filing a new request.

IV. The preprocessing has been terminated:

In the present instance, the requester has been notified that the *ex parte* reexamination request does **not** meet all the requirements of 37 CFR1.510, and preprocessing of the *ex parte* reexamination request has been terminated in the "NOTICE OF TERMINATION OF PREPROCESSING OF *EX PARTE* REEXAMINATION REQUEST (37 CFR 1.510(c)," which

was mailed on July 5, 2007. Because the preprocessing has been terminated, a refund of the entire reexamination filing fee will be made to requester in due course.

CONCLUSION

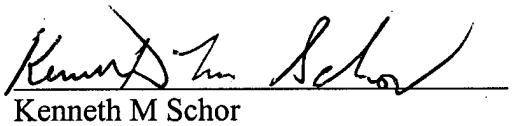
1. The pre-processing of reexamination proceeding Control No. 90/008,609 is **terminated**, in accordance with the "NOTICE OF TERMINATION OF PREPROCESSING OF *EX PARTE* REEXAMINATION REQUEST (37 CFR 1.510(c)," which was mailed on July 5, 2007.

2. The petition to accept, as timely, the July 3, 2007 corrected response is DISMISSED.

3. A refund of the reexamination filing fee will be made to requester in due course.

4. The vacated *ex parte* reexamination proceeding will continued to be processed to terminate it, including making the refund of the reexamination filing fee, after which the file will be forwarded to the Files Repository Unit. The request for reexamination will be added to the patent file, as a Prior Art Citation under 37 CFR 1.501(a), since the papers comply with the requirements of § 1.501(a).

5. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, Mark Reinhart, Special Program Examiner, at (571) 272-1611, or in his 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
Office of the Deputy Commissioner
for Patent Examination Policy

July 18, 2007
C:\kiva\kenreex\file-date\8609_dismiss petition to accept response as timely_.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.
90/008,612	04/27/2007	5410516	1141-64778/516	9334

7590 03/18/2008

MILLEN, WHITE, ZELANO & BRANIGAN
Arlington Courthouse Plaza 1
2200 Clarendon Blvd.
Suite1400
Arlington, VA 22201

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2008

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Ivan S. Kavrukov
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

MAILED

MAR 18 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008612
PATENT NO. : 5410516
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

Millen, White, Zelano & Branigan
Arlington Courthouse Plaza 1
2200 Clarendon Blvd.
Suite 1400
Arlington, VA 22201

(For Patent Owner)

MAILED

MAR 18 2008

CENTRAL REEXAMINATION UNIT

Ivan S. Kavrukov
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

(For Third Party Requester)

In re Bayer Schering Pharma Aktiengesellschaft
Ex Parte Reexamination Proceeding
Control No.: 90/008,612
Filed: April 27, 2007
For: U.S. Patent No.: 5,410,516

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

This is a decision on the March 10, 2008 patent owner petition entitled PETITION UNDER 37 CFR § 1.182 PURSUANT TO OG NOTICE OF MARCH 1, 2005.

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

FEES

A petition under 37 CFR 1.182 requires a petition fee of $ 400.00 (37 CFR 1.17(f)). The $400.00 petition fee has been charged Deposit Account No. 13-3402 as authorized by patent owner.

For the reasons set forth below the petition is dismissed as being premature.

REVIEW OF FACTS

1. Patent number 5,410,516 (the '516 patent) issued on April 25, 1995.

2. A request for *ex parte* reexamination, was deposited on April 27, 2007, assigned control No. 90/008,612 (the '8612 reexamination proceeding), and was accorded a filing date of April 27, 2007.

3. On June 15, 2007, reexamination was ordered in the '8612 *ex parte* reexamination proceeding for patent claims 1, 3-6, 10 and 11.

4. Prosecution on the patentability of the claims in the '8612 *ex parte* reexamination proceeding ultimately resulted in a final rejection of patent claims 1, 3-6, 10 and 11, and newly added claims 18-20, which was mailed on January 10, 2008.

5. On March 10, 2008, patent owner filed a notice of appeal, together with response to the final rejection that included a request for reconsideration of the final rejection, a verified statement pursuant to 37 CFR 1.132 addressing the final rejection, and the present petition.

6. The examiner has not reviewed the response to the request for reconsideration and the concurrently filed verified statement.

DECISION

In paragraphs 8 and 9 of the present petition, patent owner states that the requested relief being sought is the entry of the verified showing submitted after final rejection. Stated differently, patent owner appears to have filed the present petition in order to "continue" this reexamination proceeding by obtaining entry and consideration of the verified statement, for the purpose of evidencing patentability of the finally rejected claims.

On March 1, 2005, the Office published a notice entitled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending" ("the Notice"). The Notice was published at 1192 OG 20. The Notice principally discusses a change to reexamination practice whereby a second or subsequent request for reexamination of a patent for which a pending reexamination proceeding had been ordered would not be granted unless the second or subsequent request was based on one or more substantial new questions of patentability that differed from the substantial new question(s) of patentability upon which the pending reexamination was based.

The Notice also established a practice to address the situation in which a patent owner in a pending *ex parte* reexamination proceeding that had received a final rejection might, as a result of the policy set forth in the Notice, be prevented from obtaining entry and consideration of an amendment and/or evidence filed after the final rejection that was refused entry pursuant to 37 CFR 1.113 and 1.116, by merely filing a new request for *ex parte* reexamination. The Notice pointed out that unless the patent owner could demonstrate a "new" substantial new question of patentability in the newly filed request for *ex parte* reexamination, the newly filed request for *ex parte* reexamination would not be ordered. Therefore, the amendment and/or evidence would not receive consideration with respect to claim patentability in the newly filed reexamination proceeding. The Notice addressed this issue by establishing a practice to continue prosecution in a reexamination proceeding. The practice provides that a patent owner may petition for "continued prosecution" in an existing *ex parte* reexamination proceeding based upon entry of an amendment and/or other evidence that had been denied entry after a final rejection had closed prosecution in an existing *ex parte* reexamination proceeding. The Notice provides that a patent owner may file a petition under 37 CFR 1.181 to obtain supervisory review of an examiner's refusal to enter a response after final rejection if such refusal is deemed to be arbitrary and capricious, or an abuse of discretion. The practice alternatively provides that a patent owner may file a petition under 37 CFR 1.182 requesting relief not otherwise provided by the rules, (*e.g.*, entry of a response after final rejection that had been denied entry after a final rejection where such denial is not arbitrary or capricious or an abuse of discretion), by demonstrating how such entry would materially advance prosecution to a final disposition.

In the present proceeding, the examiner has not denied entry of the 37 CFR 1.132 verified statement filed by patent owner after final rejection. Rather, the 37 CFR 1.132 verified statement has not yet been addressed by the examiner, as to entry or lack thereof. Accordingly, the practice described in the Notice is currently inapplicable in the present '8612 *ex parte* reexamination proceeding, because patent owner has not yet been informed that entry of the verified statement has been refused. It may be that the examiner will enter the verified statement and find that it overcomes the final rejection entirely. Alternatively, the examiner may indicate that the verified statement is to be entered for purposes of appeal. If the verified statement is entered for appeal, but fewer than all of the finally rejected claims are indicated as being patentable, patent owner may then choose to proceed with the appeal, or to accept the claims found patentable. Only in the event that the examiner denies entry of the verified statement would the procedure provided in the Notice be available to obtain "continued reexamination" based upon entry of material that the examiner had refused to enter after final rejection. In that event, patent owner's recourse under the Notice would be to file a petition under 37 CFR 1.181 or to file a renewed petition under 37 CFR 1.182 as discussed in the preceding paragraph above.

Thus, it is considered that the present petition is premature, because the '8612 reexamination is presently "continuing" in the sense that a submission after final rejection has not yet been refused entry, and either confirmation of all patent claims or an appeal that is capable of being based on a record that includes the 37 CFR 1.132 verified statement that has been filed may yet result without the necessity of filing a petition when the examiner reviews the March 10, 2008 submission after final rejection. If entry of the March 10, 2008 after final submission is refused, patent owner may then seek relief by filing an appropriate petition pursuant to the Notice.

CONCLUSION

1. The patent owner petition requesting "continuing reexamination" is dismissed as premature.

2. Jurisdiction of the '8612 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit for consideration of the papers filed on March 10, 2008 in response to the final rejection, and such action as is appropriate.

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

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

sm
March 18, 2008

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.
90/008,615	04/27/2007	6034922	SCH-1463-C04-RX2	1288

23599 7590 03/18/2008

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Ivan S. Kavrukov
Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

MAILED

MAR 18 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008615
PATENT NO. : 6034922
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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2200 Clarendon Blvd.
Suite 1400
Arlington, VA 22201

(For Patent Owner)

MAILED

MAR 18 2008

CENTRAL REEXAMINATION UNIT

Ivan S. Kavrukov
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

(For Third Party Requester)

In re Bayer Schering Pharma Aktiengesellschaft
Ex Parte Reexamination Proceeding
Control No.: 90/008,615
Filed: April 27, 2007
For: U.S. Patent No.: 6,034,922

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

This is a decision on the March 10, 2008 patent owner petition entitled PETITION UNDER 37 CFR § 1.182 PURSUANT TO OG NOTICE OF MARCH 1, 2005.

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

FEES

A petition under 37 CFR 1.182 requires a petition fee of $ 400.00 (37 CFR 1.17(f)). The $400.00 petition fee has been charged Deposit Account No. 13-3402 as authorized by patent owner.

For the reasons set forth below the petition is dismissed as being premature.

REVIEW OF FACTS

1. Patent number 6,034,922 (the '922 patent) issued on March 7, 2000.

2. A request for *ex parte* reexamination, was deposited on April 27, 2007, assigned control No. 90/008,615 (the '8615 reexamination proceeding), and was accorded a filing date of April 27, 2007.

3. On June 14, 2007, reexamination was ordered in the '8615 *ex parte* reexamination proceeding for patent claims 8-27.

4. Prosecution on the patentability of the claims in the '8615 *ex parte* reexamination proceeding ultimately resulted in a final rejection of patent claims 8-27, which was mailed on January 11, 2008.

5. On March 10, 2008, patent owner filed a notice of appeal, together with response to the final rejection that included a request for reconsideration of the final rejection, a verified statement pursuant to 37 CFR 1.132 addressing the final rejection, and the present petition.

6. The examiner has not yet reviewed the request for reconsideration and the concurrently filed verified statement.

DECISION

In paragraphs 8 and 9 of the present petition, patent owner states that the requested relief being sought is the entry of the verified showing submitted after final rejection. Stated differently, patent owner appears to have filed the present petition in order to "continue" this reexamination proceeding by obtaining entry and consideration of the verified statement, for the purpose of evidencing patentability of the finally rejected claims.

On March 1, 2005, the Office published a notice entitled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending" ("the Notice"). The Notice was published at 1192 OG 20. The Notice principally discusses a change to reexamination practice whereby a second or subsequent request for reexamination of a patent for which a pending reexamination proceeding had been ordered would not be granted unless the second or subsequent request was based on one or more substantial new questions of patentability that differed from the substantial new question(s) of patentability upon which the pending reexamination was based.

The Notice also established a practice to address the situation in which a patent owner in a pending *ex parte* reexamination proceeding that had received a final rejection might, as a result of the policy set forth in the Notice, be prevented from obtaining entry and consideration of an amendment and/or evidence filed after the final rejection that was refused entry pursuant to 37 CFR 1.113 and 1.116, by merely filing a new request for *ex parte* reexamination. The Notice pointed out that unless the patent owner could demonstrate a "new" substantial new question of patentability in the newly filed request for *ex parte* reexamination, the newly filed request for *ex parte* reexamination would not be ordered. Therefore, the amendment and/or evidence would not receive consideration with respect to claim patentability in the newly filed reexamination proceeding. The Notice addressed this issue by establishing a practice to continue prosecution in a reexamination proceeding. The practice provides that a patent owner may petition for "continued prosecution" in an existing *ex parte* reexamination proceeding based upon entry of an amendment and/or other evidence that had been denied entry after a final rejection had closed prosecution in an existing *ex parte* reexamination proceeding. The Notice provides that a patent owner may file a petition under 37 CFR 1.181 to obtain supervisory review of an examiner's refusal to enter a response after final rejection if such refusal is deemed to be arbitrary and capricious, or an abuse of discretion. The practice alternatively provides that a patent owner may file a petition under 37 CFR 1.182 requesting relief not otherwise provided by the rules, (*e.g.*, entry of a response after final rejection that had been denied entry after a final rejection, where such denial is not arbitrary or capricious or an abuse of discretion), by demonstrating how such entry would materially advance prosecution to a final disposition.

In the present proceeding, the examiner has not denied entry of the 37 CFR 1.132 verified statement filed by patent owner after final rejection. Rather, the 37 CFR 1.132 verified statement has not yet been addressed by the examiner, as to entry or lack thereof. Accordingly, the practice described in the Notice is currently inapplicable in the present '8615 *ex parte* reexamination proceeding, because patent owner has not yet been informed that entry of the verified statement has been refused. It may be that the examiner will enter the verified statement and find that it overcomes the final rejection entirely. Alternatively, the examiner may indicate that the verified statement is to be entered for purposes of appeal. If the verified statement is entered for appeal, but fewer than all of the finally rejected claims are indicated as being patentable, patent owner may then choose to proceed with the appeal, or to accept the claims found patentable. Only in the event that the examiner denies entry of the verified statement would the procedure provided in the Notice be available to obtain "continued reexamination" based upon entry of material that the examiner had refused to enter after final rejection. In that event, patent owner's recourse under the Notice would be to file a petition under 37 CFR 1.181 or to file a renewed petition under 37 CFR 1.182 as discussed in the preceding paragraph above.

Thus, it is considered that the present petition is premature, because the '8615 reexamination is presently "continuing" in the sense that a submission after final rejection has not yet been refused entry, and either confirmation of all patent claims or an appeal that is capable of being based on a record that includes the 37 CFR 1.132 verified statement that has been filed may yet result without the necessity of filing a petition when the examiner reviews the March 10, 2008 submission after final rejection. If entry of the March 10, 2008 after final submission is refused, patent owner may then seek relief by filing an appropriate petition pursuant to the Notice.

CONCLUSION

1. The patent owner petition requesting "continuing reexamination" is dismissed as premature.

2. Jurisdiction of the '8615 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit for consideration of the papers filed on March 10, 2008 in response to the final rejection, and such action as is appropriate.

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

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

sm
March 18, 2008

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.
90/008,615	04/27/2007	6034922	SCH-1463-C04-RX2	1288

23599 7590 08/29/2008

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
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ARLINGTON, VA 22201

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/29/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Ivan S. Kavrukov
Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

MAILED

AUG 29 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008615
PATENT NO. : 6034922
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 1400
ARLINGTON, VA 22201

(For Patent Owner)

MAILED

AUG 29 2008

CENTRAL REEXAMINATION UNIT

IVAN S. KAVRUKOV
COOPER & DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

(For Third Party Requester)

In re Uhlendorf *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,615
Filed: April 27, 2007
For: U.S. Patent No. 6,034,922

: DECISION
: GRANTING
: PETITION

This is a decision on patent owner's "Petition Under 37 CFR 1.182" filed August 19, 2008. The petition and the above-captioned reexamination proceeding are before the Office of Patent Legal Administration for decision on the petition.

FEES

Petitioner patent owner paid the $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition.

REVIEW OF FACTS

1. U.S. Patent No. 6,034,922 (hereinafter, the '922 patent) issued on March 7, 2000.

2. On April 27, 2007, a third party requester filed a request for *ex parte* reexamination, which proceeding was assigned Control No. 90/008,615 (hereinafter "the '8615 proceeding").

3. On June 14, 2007, the Office mailed an Order granting the request for *ex parte* reexamination.

4. The proceeding has progressed to the point where, on June 11, 2008, the Office mailed a "Notice of Intent to Issue *Ex Parte* Reexamination Certificate" (NIRC).

5. On June 13, 2008, patent owner filed an amendment.

6. On July 28, 2008, the Office mailed a "Decision *Sua Sponte* Returning Untimely Filed Papers," expunging from the record of the '8615 proceeding the untimely paper filed on June 13, 2008.

7. On August 19, 2008, patent owner filed the present petition, accompanied by the amendment previously filed on June 13, 2008.

DECISION

37 CFR 1.182 provides:

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

The *ex parte* reexamination rules do not provide for consideration or entry of an amendment in an *ex parte* reexamination proceeding after prosecution of the *ex parte* reexamination prosecution has been terminated by the mailing of a NIRC. Accordingly, consideration (and entry) of an amendment filed after the mailing of a NIRC in an *ex parte* reexamination proceeding is a situation not specifically provided for in the regulations of Part 1 of Title 37 of the Code of Federal Regulations. Therefore, any relief would only be available by way of a grantable petition under 37 CFR 1.182, requesting consideration and entry of such amendment.

Consideration and entry of an amendment filed after the mailing of a NIRC in an *ex parte* reexamination proceeding is somewhat analogous to consideration and entry of an amendment filed after allowance under 37 CFR 1.312 in a nonprovisional patent application. Therefore, it is expected that a 37 CFR 1.182 petition requesting consideration and entry of an amendment filed after the mailing of a NIRC will include remarks accompanying the amendment that fully and clearly state the reasons on which reliance is placed to show: (A) why the amendment is needed; (B) why the proposed amended or new claims require no additional search or examination; (C) why the claims are patentable; and (D) why they were not presented earlier. [1]

The present petition under 37 CFR 1.182 appears to include sufficient reasons why the amendment, filed on August 19, 2008, is needed. The present petition provides that the amendment was filed to correct a typographical error in the priority claim. In particular, a reference to the national stage entry of a parent Patent Cooperation Treaty (PCT) application is averred to have been incorrectly identified as a "continuation application." A cursory inspection of the record shows that the proposed amendment would appear to be necessary for

[1] *See* MPEP § 714.16

the sake of clarity, thereby putting the public on notice of the correct chain of priority. As no claim amendments are proposed and no specification amendment has been proposed which would affect the date or scope of the claims, no additional search or examination is required.

In view of the above, the '8615 proceeding is being forwarded to the Primary Examiner for consideration of the August 19, 2008 amendment and, if appropriate, entry of the amendment. [2]

Accordingly, jurisdiction of the '8615 proceeding will be returned to the Central Reexamination Unit. The Primary Examiner will issue an appropriate action, which may (if appropriate) be a supplemental Notice of Intent to Issue Reexamination Certificate indicating consideration of the August 19, 2008 amendment and the results thereof. If the Primary Examiner enters the amendment, the Primary Examiner is to update the associated paperwork, for example, any changes to the reexamination checklists necessitated by the entry of the amendment.

CONCLUSION

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

2. Jurisdiction of the '8615 proceeding is being returned to the Central Reexamination Unit for consideration by the Primary Examiner of the amendment filed on August 19, 2008.

3. Prosecution is not being reopened in the '8615 proceeding by this Decision.

4. Following appropriate action by the Primary Examiner, the '8615 proceeding will be returned to the jurisdiction of the Office of Patent Legal Administration.

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

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

Aug. 28, 2008
C:\kiva\kenpet 7\ 8615 Amdt after NIRC-grant consideration

[2] Absent any overriding issue that would be raised by entry of the amendment.

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Peter J. Dehlinger
PERKINS COIE LLP
101 Jefferson Dr.
Menlo Park CA 94025

(for Patent Owner)

MAILED

MAR 14 2008

CENTRAL REEXAMINATION UNIT

Paul T. Clark
Clark & Ebling LLP
101 Federal Street
Boston MA 02111

(for Third Party Requester)

In re Boyse et al
Reexamination Proceeding
Control No.: 90/007,091
Filed: June 18, 2004
For: U.S. Patent 5,192,553

Philip H. Coelo
THERMOGENISIS CORP.
2711 Citrus Road
Rancho Cordova CA 95742

(for Third Party Requester)

In re Boyse et al
Reexamination Proceeding
Control No.: 90/008,618
Originally submitted: May 7, 2007
Filing Date: May 31, 2007
For: U.S. Patent 5,192,553

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 5,192,553, issued March 9, 1993, is the subject of Reexamination Control Nos. 90/007,091 and 90/008,618.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,091, was filed June 18, 2004 by Paul T. Clark of Clark & Ebling LLP in Boston MA. The request urged that a substantial new question of patentability was raised by the newly cited references which either inherently or expressly disclose the subject matter of the present claims.

3. Reexamination was ordered for 90/007,091 (the '7091 reexam) on August 27, 2004.

4. A non-final Office action issued in the '7091 reexam on February 2, 2005.

5. An amendment was filed in the '7091 reexam on April 4, 2005.

6. A supplemental amendment was filed on May 18, 2005.

7. Another non-final office action issued on May 25, 2006.

8. Patent Owner submitted a response and amendment in the 7091 reexam on July 15, 2006.

9. A Notice of Intent to Issue a Reexam Certificate issued on December 15, 2006.

10. A second request for re-examination, assigned Reexamination Control No. 90,008,618, was filed May 31, 2007 by Philip Coelo of Thermogenesis Corp in Rancho Cordova, CA. The request urged that a substantial new question of patentability was raised by the newly cited references which are directed to the subject matter of the present claims.

5. Reexamination was ordered for 90/008,618 (the '8618 reexam) on July 12, 2007.

6. No Patent Owner statement of Office action has issued in the '8618 reexam.

7. A Notice of concurrent proceedings was filed in the '7091 reexam.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,091 and 90/008,618 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,091 and 90/008,618 as:

Peter J. Dehlinger
PERKINS COIE LLP
101 Jefferson Dr.
Menlo Park CA 94025

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,091 as:

Paul T. Clark
Clark & Ebling LLP
101 Federal Street
Boston MA 02111

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/008,618 as:

Philip H. Coelo
THERMOGENISIS CORP.
2711 Citrus Road
Rancho Cordova CA 95742

CONCLUSION

Reexamination Control Nos. 90/007,091 and 90/008,816 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.

for Lissi M. Marquis, Director
Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090618

DATE : June 18, 2009

TO SPE OF : ART UNIT 3991

SUBJECT : Request for Certificate of Correction on Patent No.: 5,192,553

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 (6621st) US 5,192,553 C1

SPE: Eric Keasel **Art Unit** 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

Fulwider Patton LLP
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045

(For Patent Owner)

MAILED
OCT 26 2007
CENTRAL REEXAMINATION UNIT

Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, VA 22102

(For 3rd Party Requester)

MAILED
OCT 26 2007
CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/007,890
Filed : January 23, 2006
For U.S. Patent No. : 6,066,168

Reexam Control No.: 90/008,619
Filed : May 7, 2007
For U.S. Patent No. : 6,066,168

DECISION MERGING REEXAMINATION PROCEEDINGS

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/007,890 was ordered in a decision mailed February 14, 2006. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the response. There have been no changes made to the specification, claims or drawings. Claims 1-18, all of the claims, are being reexamined in this proceeding.

Reexamination in application control No. 90/008,619 was ordered in a decision mailed June 20, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the mailing of the order granting reexamination. There have been no changes made to the specification, claims, or drawings. Claims 1-8, 12 and 14, are being reexamined in this proceeding.

As evidenced by the above facts, reexamination control No. 90/007,890 and reexamination control No. 90/008,619 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

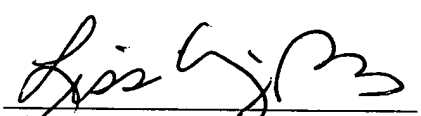
Conduct of Proceedings

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

Conclusion

Reexamination Control Nos. 90/007,890 and 90/008,619 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Lissi Mojica Marquis, Director
Central Reexamination Unit

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(For 3rd Party Requester)

Reexam Control No.: 90/007,890
Filed : January 23, 2006
For U.S. Patent No. : 6,066,168

Reexam Control No.: 90/008,619
Filed : May 7, 2007
For U.S. Patent No. : 6,066,168

Reexam Control No.: 90/009,158
Filed : May 23, 2008
For U.S. Patent No. : 6,066,168

DECISION MERGING
REEXAMINATION
PROCEEDINGS

MAILED

SEP 24 2008

CENTRAL REEXAMINATION UNIT

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/007,890 was ordered in a decision mailed February 14, 2006 indicating that claims 1-3, and 11 of the patent would be reexamined.

Reexamination in application control No. 90/008,619 was ordered in a decision mailed June 20, 2007 indicating that claims 1-8, 12 and 14 of the patent would be reexamined.

In a decision mailed October 26, 2007, reexamination proceedings 90/007,890 and 90/008,619 were merged. This merged proceeding received an Office action on February 11, 2008. Following the grant of an extension of time request, a response to the Office action was received May 14, 2008. Subsequently, on July 11, 2008 two Supplemental Disclosure Statements were

filed. No further action has taken place in this merged reexamination proceedings. Further, there have been no amendments made to the claims, specification and/or drawings.

Reexamination in application control No. 90/009,158 was ordered in a decision mailed July 11, 2008 indicating that claims 1-3, and 11 would be reexamined. No amendments to the claims, specification and/or drawings have been made in this reexamination proceeding. No office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,890, reexamination control No. 90/008,619, and reexamination control No. 90/009,158 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims, Drawings, and Specification in Each Proceeding

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

Conduct of Proceedings

The reexamination proceedings are hereby consolidated and will result in the issuance of a single certificate. Claims 1-8, 11, 12, and 14, the claims of the patent for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexamination proceedings. All papers issued by the Office will contain the identifying data for each case, and each action will be entered into each of the files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,890, 90/008,619 and 90/009,158 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Gregory Morse, Director
Central Reexamination Unit

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OCT 26 2007

CENTRAL REEXAMINATION UNIT

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(For 3rd Party Requester)

Reexam Control No.: 90/007,889
Filed : January 23, 2006
For U.S. Patent No. : 6,066,167

Reexam Control No.: 90/008,620
Filed : May 7, 2007
For U.S. Patent No. : 6,066,167

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/007,889 was ordered in a decision mailed February 14, 2006. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the response. There have been no changes made to the specification, claims or drawings. Claims 1-8, all of the claims, are being reexamined in this proceeding.

Reexamination in application control No. 90/008,620 was ordered in a decision mailed June 14, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the mailing of the order granting reexamination. There have been no changes made to the specification, claims, or drawings. Claims 1-8, all of the claims, are being reexamined in this proceeding.

As evidenced by the above facts, reexamination control No. 90/007,889 and reexamination control No. 90/008,620 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

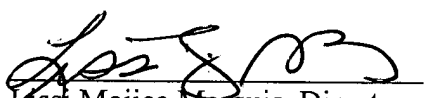
Conduct of Proceedings

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

Conclusion

Reexamination Control Nos. 90/007,889 and 90/008,620 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Lissi Mojica Marquis, Director
Central Reexamination Unit

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Reexam Control No.: 90/007,889
Filed : January 23, 2006
For U.S. Patent No. : 6,066,167

Reexam Control No.: 90/008,620
Filed : May 7, 2007
For U.S. Patent No. : 6,066,167

Reexam Control No.: 90/009,159
Filed : May 23, 2008
For U.S. Patent No. : 6,066,167

DECISION MERGING
REEXAMINATION
PROCEEDINGS

MAILED

SEP 10 2008

CENTRAL REEXAMINATION UNIT

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/007,889 was ordered in a decision mailed February 14, 2006 indicating that claims 1-8, all of the claims in the patent would be reexamined.

Reexamination in application control No. 90/008,620 was ordered in a decision mailed June 14, 2007 indicating that claims 1-8, all of the claims in the patent would be reexamined.

In a decision mailed October 26, 2007, reexamination proceedings 90/007,889 and 90/008,620 were merged. This merged proceeding received an Office action on February 11, 2008. Following the grant of an extension of time request, a response to the Office action was received

May 14, 2008. Subsequently, on July 10, 2008 a Supplemental Disclosure Statement was filed. No further action has taken place in this merged reexamination proceedings. Further, there have been no amendments made to the claims, specification and/or drawings.

Reexamination in application control No. 90/009,159 was ordered in a decision mailed June 17, 2008 indicating that claims 5 and 8 would be reexamined. An Information Disclosure Statement was filed on July 11, 2008. No amendments to the claims, specification and/or drawings have been made in this reexamination proceeding. No office action has been issued in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,889, reexamination control No. 90/008,620, and reexamination control No. 90/009,159 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims, Drawings, and Specification in Each Proceeding

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

Conduct of Proceedings

The reexamination proceedings are hereby consolidated and will result in the issuance of a single certificate. Claims 1-8, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexamination proceedings. All papers issued by the Office will contain the identifying data for each case, and each action will be entered into each of the files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,889, 90/008,620 and 90/009,159 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Gregory Morse, Director
Central Reexamination Unit

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MAILED

AUG 15 2007

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(For Requester)

In re Lau et al.
Reexamination Proceeding
Control No. 90/008,622
Filed: May 7, 2007
For: U.S. Patent No. 5,514,154

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on July 13, 2007, styled as "Third Party Requester's Petition Under 37 CFR § 1.181 for Review of Order Denying Request for *Ex Parte* Reexamination of U.S. Patent No. 5,514,154," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated June 12, 2007. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,514,154 (hereinafter, the '154 patent) issued on May 7, 1996.

2. On May 7, 2007, the third party requester deposited a request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned Control No. 90/008,622 (hereinafter, the '8622 proceeding).

3. Reexamination was requested for claims 1, 3, 4, 8, 9, and 11 of the '154 patent.

4. A Notice of Reexamination Request Filing Date was issued on May 10, 2007.

5. An order denying the request for reexamination for claims 1, 3, 4, 8, 9, and 11 was issued on June 12, 2007.

6. On July 12, 2007, the third party requester filed the above-mentioned petition under 37 CFR § 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges several grounds for which petitioner feels the examiner in not finding that substantial new question of patentability exists. The basis for most of petitioner's arguments is that the 1989 article entitled "Early Experience With the Palmaz Stent in Human Iliac Angioplasty," by Gary J. Becker, et al. (hereinafter "the Becker Article") establishes a substantial new question of patentability because it provides a new teaching in regards to U.S. Patent No. 5,102,417 to Palmaz and U.S. Patent No. 5,195,984 to Schatz.

In support of their showing that the examiner's finding that the references cited do not present a substantial new question of patentability is unreasonable, the petitioner advances the following three arguments:

1. The Becker Article provides a new teaching such that a reasonable examiner would consider the Becker Article important in deciding whether or not to allow the claims.
2. The reexamination examiner erred in considering Palmaz '417 by itself and not in view of the Becker Article as specifically raised in the request.
3. The reexamination examiner erred in considering Schatz by itself and not in view of the Becker Article as specifically raised in the request.

As previously mentioned, Petitioner arguments hinge on establishing that the Becker Article establishes a substantial new question of patentability.

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1, 3, 4, 8, 9, and 11 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, 3, 4, 8, 9, and 11 of the '154 patent. The review will not consider evidence not of record at the time of the request for reexamination (e.g., evidence made of record for the first time in the petition).

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[1] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial**

[1] Public Law 96-517, enacted on December 12, 1980.

> **examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 states that:

> No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.
>
> The decision denying the request will then indicate, for each patent and printed publication cited in the request, why the citation is:
>
> (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
>
> (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
>
> (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or
>
> (D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

The examiner should also, in the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

A. The request fails to raise a substantial new question of patentability regarding the Becker Article that is different from patentability issues raised in the prosecution of application number 08/281,790, which issued as the 5,514,154 patent.

The request for reexamination, dated May 7, 2007, stated that a substantial new question of patentability (SNQ) existed for claims 1, 3, 4, 8, 9, and 11 of the '154 patent based upon Palmaz '417 alone, Palmaz '417 in view of the Becker Article, Schatz alone, and Schatz in light of the Becker Article. As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated May 7, 2007. The request for reexamination did not contain the Birdsall Declaration, attached to the instant petition as Exhibit 2, nor the annotated pictures of the Becker Article on page 6 of the instant petition. Accordingly, as such evidence was not before the examiner because it was not of record in the request for reexamination, such evidence will not be consider during this *de novo* review.

The Palmaz '417 was considered and applied in a rejection during the prosecution of application number 08/281,790, which issued as the 5,514,154 patent. Specifically, the teachings of Figure 10 in Palmaz '417 were applied against the claims in a rejection and the rejection was overcome by amendments, evidence, and arguments. The request for reexamination, dated May 7, 2007, also relies upon the teaching of Figure 10 in Palmaz '417 to establish a substantial new question of patentability. The Schatz patent was not considered during the previous prosecution, but provides substantially the same teachings as Palmaz '417. The Schatz patent provides no new teaching regarding the projecting edges when the stent is expanded.

As the request for reexamination stated, the Becker article was not considered in the prosecution of application number 08/281,790, which issued as the 5,514,154 patent, and is prior art under 35 U.S.C. 102(b). The Becker article, however, fails to provide any new information as presented in the request for reexamination dated May 7, 2007. In the request, the Becker article is described as showing the projecting edges when the Palmaz stent is expanded (see page 31 of the request). The request further states that the Becker article is being used as evidence that the Palmaz '417 anticipates claims 1, 3, 4, 8, 9, and 11 of the '154 patent, or that alternatively, the teachings of the Becker Article can be combined with Palmaz '417 to render the claims obvious. To support such statement, the request only depicts a blurry expanded picture of Figure 1 of the Becker Article that is annotated by stating that the bottom edge has projecting edges. No other evidence was provided regarding the Becker article in the request dated May 7, 2007.

The evidence and explanation, as set forth in the request dated May 7, 2007, simply does not support ordering a request for reexamination. The Becker Article, as presented in the May 7, 2007 request, does not present sufficient evidence to present the Palmaz '417 in a new light, or

provides new information. The teachings Palmaz '417 were extensively considered and applied in a rejection in a previous examination. The '154 patent was allowed when the evidence of record overcame the rejection based on Palmaz '417 by showing the Palmaz '417 did not teach a smooth edge when the stent is not expanded and project edges when the stent is expanded. The teaching of projecting edges allegedly shown in Figure 1 of the Becker Article is not enough to create a new light or new information to the teachings of Figure 10 of Palmaz '417, which is pre-existing technology already considered. Specifically, the issue of whether Figure 10 of Palmaz '417 teaches projecting edges was raised and considered during the previously examination. The request relies on only Figure 1 of the Becker Article, and states that it shows projecting edges in the expanded stent. The Becker Article does not make such a statement, and no other evidence is provided to support the requester's position. Accordingly, the limited teachings of the Becker article are not sufficiently clear to rise to the level where a reasonable examiner would consider these teachings important in light of the entire record of the previous examination. In accordance with the legislative history of legislation concerning reexamination, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. Accordingly, as the Becker article presented in the May 7, 2007 request, does not provide a new light or new information to the teachings of Palmaz '417, a request for reexamination cannot be granted.

B. The request fails to raise a substantial new question of patentability regarding the Palmaz '417 patent and Schatz patent alone, and in view of the Becker Article, that is different from patentability issues raised in the prosecution of application number 08/281,790, which issued as the 5,514,154 patent.

As explained above, Palmaz '417 was considered and applied in a rejection during prosecution of application number 08/281,790, which issued as the 5,514,154 patent. The Schatz patent was not considered during the previous prosecution, but provides substantially the same teachings as Palmaz '417. The Schatz patent provides no new teaching regarding the projecting edges when the stent is expanded.

In this case, the request failed to raise a different substantial new question of patentability because it does not seemingly provide new information about the Palmaz '417 and Schatz references (e.g., pre-existing technology), either alone or in combination with the Becker Article. As explained above, the Becker article fails to provide new information or a new light. The previous examination considered whether the Palmaz '417 stent has a smooth edge when not expanded, and projected edges when expanded. Because a previous examination already considered this issue, the requester must provide a different substantial new question of patentability by, for example, providing a "new light" to references already considered in the other proceeding. As discussed in the section above, a reference may be read in a "new light" if

the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. The request failed to clearly provide this information, and the examiner appropriately denied the request for reexamination on this ground.

The policy is consistent with the legislative history as discussed above, and accordingly, petitioner's arguments concerning legislative history are not persuasive. As discussed above, petitioner can still avail themselves of the *ex parte* reexamination proceeding, if petitioner can formulate a request that brings forth some new technological information that was not consider in a previous examination.

As explained in the order denying reexamination, in accordance with MPEP 2242, "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.

REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '154 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination, (which new request includes the missing information identified above). The third party requester should file all evidence, with a new and complete request for reexamination, which supports the third party requester's position that the Becker Articles provides a new teaching or presents a new light to the teachings of Palmaz '417 and Schatz. This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. Also, the requester is not barred from filing a new request for *inter partes* reexamination as argued by the petitioner because the estoppel provision of 35 U.S.C. 317(b) to not attach since the reexamination has not been instituted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination (e.g., presenting Palmaz '417 or Schatz in a new light or in combination with other new prior art not considered in a prior examination, which provides a new technical teaching).

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited

documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

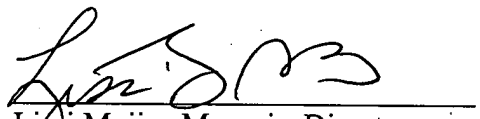
CONCLUSION

1. Given the facts involved in this proceeding, the request for *ex parte* reexamination of claims 1, 3, 4, 8, 9, and 11 of the '154 patent was properly denied by the examiner.

2. Accordingly, the PETITION is DENIED.

3. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.



Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,625	05/03/2007	4763356	75543-011	1812

7590 10/16/2008

EXAMINER	
ART UNIT	PAPER NUMBER

John P. McDonnell
AT&T BELL LABORATORIES
600 Mountain Ave.
Murray Hill, NJ 07974

DATE MAILED: 10/16/2008

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.
90/008,749	07/03/2007	4763356	75543-015	9960

7590 10/16/2008

EXAMINER	

ART UNIT	PAPER NUMBER

John P. McDonnell
AT&T BELL LABORATORIES
600 Mountain Ave.
Murray, NJ 07974

DATE MAILED: 10/16/2008

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

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OCT 16 2008

CENTRAL REEXAMINATION UNIT

John P. McDonnell (For Patent Owner)
AT&T BELL LABORATORIES
600 Mountain Ave.
Murray NJ 07974

Kenneth L. Cage (For Third Party Requester)
McDermott Will & Emery LLP
600 13th Street, NW
Washington, DC 20005-3096

In re Day, Jr. *et alia*
Reexamination Proceeding
Control No. 90/008,625
Request Deposited: May 3, 2007
For: U.S. Patent No. 4,763,356

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

In re Day, Jr. *et alia*
Reexamination Proceeding
Control No. 90/008,749
Request Deposited: July 3, 2007
For: U.S. Patent No. 4,763,356

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. 4,763,356 (hereinafter, the '356 patent), issued to Day, Jr. *et alia*, on August 9, 1988.

2. On May 3, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '356 patent. The reexamination proceeding was assigned Control No. 90/008,625 (hereinafter, the '8625 proceeding).

3. The Reexamination Order was granted in the '8625 proceeding on September 10, 2007.

4. There are currently no amendments in the '8625 proceeding.

5. On July 3, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '356 patent. The reexamination proceeding was assigned Control No. 90/008,749 (hereinafter, the '8749 proceeding).

6. The Reexamination Order was granted in the '8749 proceeding on September 10, 2007.

7. There are currently no amendments in the '8749 proceeding.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8625 and the '8749 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. 90/008,625 and 90/008,749 are MERGED.

2. The reexamination files are being forwarded to the examiner for 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

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.
90/008,629	05/04/2007	6933308		9554

21611 7590 09/05/2007

SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/05/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA CA 92626

(for Patent Owner)

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SEP 05 2007

CENTRAL REEXAMINATION UNIT

Michael D. Harris
KLEINBERG & LERNER, LLP
2049 Century Park East
Suite 1080
Los Angeles, CA 90067

(for Third Party Requester)

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/007,861
Filed: December 28, 2005
For: US Patent No. 6,933,608

In re: Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/008,629
Filed: May 4, 2007
For: US Patent No. 6,933,608

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

BACKGROUND

1. Patent No. 6,933,608 issued on July 10, 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,861 was requested by a third party requester on April 13, 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/007,861 on February 10, 2006.

4. There are currently no amendments proceeding control number 90/007,861.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,629 was requested by a third party requester filed on May 4, 2007.

6. The Reexamination Order was granted in proceeding, control no. 90/008,629 on July 19, 2007.

7. There are currently no amendments proceeding control number 90/008,629.

8. Proceedings control numbers 90/007,861 and 90/008,629 awaits the first Office action on the merits from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/007,861 and 90/008,629 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,861 and 90/008,629 are **MERGED**.

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

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

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

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

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

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

/Reinhart for/

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Joseph W Price
SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA CA 92626

(For Patent Owner)

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FEB 26 2009

CENTRAL REEXAMINATION UNIT

Michael D. Harris
KLEINBERG & LERNER, LLP
2049 Century Park East
Suite 1080
Los Angeles, CA 90067

(for Third Party Requester)

Michael D Harris
SOCAL IP LAW GROUP LLP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE, CA 91362

(For Third Party Requester)

DECISION,
SUA SPONTE
MERGING
REEXAMINATION
PROCEEDINGS
[37 CFR § 1.565(c)]

In re: Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/007,861
Deposited on: 28 December 2005
For: US Patent No. 6,933,608

In re: Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/008,629
Deposited on: 4 May 2007
For: US Patent No. 6,933,608

In re: Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/010,340
Deposited on: 17 November 2008
For: US Patent No. 6,933,608

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

BACKGROUND

1. Patent No. 6,933,608 issued on 10 July 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,861 was requested by a third party requester on 13 April 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/007,861 on 10 February 2006.

4. *Ex Parte* Reexamination Proceeding, control no. 90/008,629 was requested by a third party requester filed on 4 May 2007.

5. The Reexamination Order was granted in proceeding, control no. 90/008,629 on 19 July 2007.

6. Proceedings control numbers 90/007,861 and 90/008,629 were merged on 5 September 2007.

7. There are amendments in the merged proceedings 90/007,861 and 90/008,629.

8. *Ex Parte* Reexamination Proceeding, control no. 90/010,340 was requested by a third party requester on 17 November 2008.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/007,861; 90/008,629 and 90/010,340 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/007,861; 90/008,629 and 90/010,340 are hereby **merged**.

2. The patent owner's representative is required to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

By Mail to: Mail Stop *Ex Parte* Reexam

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

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

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

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

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

/Mark Reinhart/
for

Gregory A. Morse,
Director,
Central Reexamination Unit

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.
90/008,629	05/04/2007	6933608		9554

21611 7590 05/11/2010

SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2010

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

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

Snell & Wilmer LLP (OC)
600 Anton Boulevard
Suite 1400
Costa Mesa, CA 92626

(For patent owner)

Michael D. Harris
SoCal IP Law Group LLP
310 N. Westlake Blvd.
Suite 120
Westlake Village, CA 91362

(For third party requester)

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MAY 11 2010

CENTRAL REEXAMINATION UNIT

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/007,861
Filed: December 28, 2005
For: U.S. Patent No. 6,933,608

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/008,629
Filed: May 4, 2007
For: U.S. Patent No. 6,933,608

In re Hiromi Fujisawa
Ex Parte Reexamination Proceeding
Control No. 90/010,340
Filed: December 10, 2008
For: U.S. Patent No. 6,933,608

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

This is a decision on the March 25, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated merged reexamination ("the March 25, 2010 patent owner petition to revive").[1]

The March 25, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the merged prosecution in this instance, the merged prosecution was "terminated" due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the August 7, 2009 final Office action.

The March 25, 2010 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

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

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*

*

(d) *Terminal disclaimer.*

*

*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

37 CFR 41.33 provides, in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37may be admitted as provided in § 1.116 of this title.

37 CFR 41.37 provides, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing

unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

MPEP 2274 provides, in pertinent part:

I. AMENDMENT

Where the appeal brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the claims of the patent under reexamination in a patentable condition, the amendment may be entered.

*

*

IV. FAILURE TO TIMELY FILE APPEAL BRIEF

Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. ... The reexamination prosecution is then terminated, and a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), the instant merged reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the August 7, 2009 final Office action. Although patent owner filed a Notice of Appeal on December 4, 2009, patent owner failed to follow-up the Notice of Appeal with either (i) an Appeal Brief in accordance with 37 CFR 41.37(a)(1) or (ii) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the merged proceeding in condition for issuance of a reexamination

certificate by making all pending claims patentable, as provided in 37 CFR 41.33(a) and MPEP 2274(I).

Patent owner submitted an Appeal Brief and paid the corresponding fee of $540.00 on March 25, 2010, thereby satisfying item (1).

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the March 25, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the March 25, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 25, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992, for treatment in due course of the March 25, 2010 Appeal Brief.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Erik Kielin, of CRU Art Unit 3992, at (571) 272-1693.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

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.
90/008,630	05/10/2007	5764543	1180.0136R	3691

53184 7590 06/30/2009

i2 TECHNOLOGIES US, INC.
ONE i2 PLACE, 11701 LUNA ROAD
DALLAS, TX 75234

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2009

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

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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i2 Technologies US, Inc. (For Patent Owner)
One i2 Place
11701 Luna Road
Dallas, TX 75234

MAILED

JUN 30 2009

CENTRAL REEXAMINATION UNIT

Paul A. Harrity (For Requester)
Harrity Snyder LLP
11350 Random Hills Road, Suite 600
Fairfax, VA 22030

In re Brian M. Kennedy :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,630 : **GRANTING**
Filed: May 10, 2007 : **PETITION UNDER**
For: U.S. Patent No. 5,764,543 : **37 CFR 1.137(b)**

This is a decision on the June 2, 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 reexamination prosecution ("the June 2, 2009 patent owner petition to revive").[1]

The June 2, 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 June 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 the written statement of interview required under 37 CFR 1.560(b) for the interview of May 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 1.137 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 June 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 statement of the substance of the May 30, 2008 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until June 2, 2009, which was untimely. For the purpose of evaluating whether the June 2, 2009 patent owner petition to revive is a grantable petition, the submission of the statement under 37 CFR 1.560(b) on June 2, 2009, satisfies item (1).

Accordingly, the June 2, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The June 2, 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 processing of the June 2, 2009 Patent Owner's Statement of Interview.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Mary Steelman, of CRU Art Unit 3992, at (571) 272-3704.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,632	05/03/2007	6147995	E2003-701450	2017

37462 7590 07/17/2008

LOWRIE, LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/17/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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LOWRIE, LANDO & ANASTASI, LLP : (For Patent Owner)
Attn: James C. De Vellis, Esq. :
ONE MAIN STREET, SUITE 1100 :
CAMBRIDGE MA 02142 :

MAILED

JUL 17 2008

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP : (For Third Party
(NDQ REEXAMINATION GROUP) : Requester)
Attn: Tracy W. Druce :
1000 LOUISIANA STREET :
FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

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

In re: Dobbins *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/008,632 :
Deposited: 3 May 2007 :
For: US Patent No. 6,147,995 :

This is a decision on the 14 July 2008, "Petition for One-Month Extension of Time Under 37 CFR § 1.550," requesting that the time for responding to the non-final Office action, mailed 24 June 2008 be extended by one month.

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

The petition is Dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the non-final Office action mailed 24 June 2008, which set a one-month shortened statutory deadline 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 by one-month.

The petition is dismissed as incomplete for the reasons given below.

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

Analysis and Findings

On balance, the Patent Owner has not shown "sufficient cause" to grant that the requested time to respond to the Office action be extended by one month. The petition correctly notes that the time for response is the statutory period for response of one month. The Office action contains multiple grounds for rejection and that this is a first request for extension of time.

While this is all true, the patent owner has not shown that there are any extraordinary circumstances which would support "sufficient cause" for extension of time. While the patent owner will review the prosecution history and study the possibility of submitting a declaration under 37 CFR § 1.131 there is no evidence that there is any actual need for additional time to extend the period for response. Reviewing documents from related litigation is all within the normal course of prosecution of reexamination proceedings and there is no support for sufficient cause to extend the period for response. On balance while the patent owner is entitled to an opportunity to present a fair and full argument responsive to the Office action when balanced with the need for special dispatch and a lack of showing of sufficient cause the petition for a one-month extension of time is dismissed as incomplete.

By dismissing the petition for extension of time the patent owner is afforded an additional opportunity to petition for extension of time and present evidence of sufficient cause without the need for an additional petition fee under 37 CFR § 1.17 (g). Absent sufficient cause for extending the period for response the petition for extension of time is hereby dismissed.

The patent owner is invited to provide additional information in the form of a renewed petition for extension of time pursuant to 37 CFR § 1.550 (c) which may be considered to support sufficient cause for extending the period for response by one-month.

The instant petition request is hereby **Dismissed**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 24 June 2008 is **dismissed**.

2. The Office action mailed set a one-month response time for which to respond will end on **24 July 2008**.

3. Future correspondence may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, 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
3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,632	05/03/2007	6147995	E2003-701450	2017

37462 7590 10/30/2008

LOWRIE, LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2008

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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 W. DRUCE
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

OCT 3 0 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008632
PATENT NO. : 6147995
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MAILED

OCT 3 0 2008

CENTRAL REEXAMINATION UNIT

In re Dobbins et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,632 : **DISMISSING**
Filed: May 3, 2007 : **PETITION**
For: U.S. Patent No. 6,147,995 :

This is a decision on the patent owner petition, filed August 26, 2008, denominated "Petition Under 37 CFR § 1.183" requesting waiver of the signature of an unwilling inventor on a declaration under 37 CFR 1.131.

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**.

REVIEW OF FACTS

1. On November 4, 2000, U.S. Patent No. 6,147,995 (the '995 patent) issued from application serial no. 09/387,317 (the '317 application) to Dobbins et al. with 35 claims.

2. The patent lists Cabletron Systems, Inc. (Cabletron) as the assignee by virtue of the fact that the issue fee transmittal (PTO 85B) listed Cabletron as the assignee. However, no assignment to Cabletron was recorded in the USPTO for the '317 application. [1] In fact, the '317 application was assigned from Cabletron to Enterasys Networks, Inc. (Enterasys) on Sept. 29, 2000, after payment of the issue fee but prior to issuance of the '995 patent. This assignment was recorded in the USPTO.

[1] An assignment was recorded for parent application 08/559,738 from the inventors of the '995 patent to Cabletron.

3. A security interest in the entire right of the '995 patent from Enterasys to Wells Fargo Foothills, Inc. and Obsidian, LLC was executed on May 16, 2006, and recorded in the USPTO.

4. On May 3, 2007, a third party requester, Foundry Networks Inc., filed a request for *ex parte* reexamination of claims 1-8, 10-13, 15-17, 19, 20, and 25-31 of the '995 patent, and the resulting reexamination proceeding was assigned control number 90/008,632 (the '8632 proceeding).

5. On June 26, 2007, an order granting the reexamination request was mailed.

6. A non-final Office action was mailed June 24, 2008, in which claims 1, 2,4, 10-13, 15-17, 19, 20, and 25-28 were rejected, and claims 3, 5-8, and 29-31 were confirmed. The Office action set a 1 month period for response.

7. On July 17, 2008, patent owner requested a one month extension of time, which was granted in a decision mailed on July 21, 2008.

8. On Aug. 26, 2008, patent owner filed a response to the Office action, along with a declaration under 37 CFR 1.131 intended to establish date of conception and diligence. A petition, which is the subject of this decision, was filed therewith under 37 CFR 1.183 requesting waiver of the asserted signature requirement of the declaration under 37 CFR 1.131.

9. Also on Aug. 26, 2008, patent owner filed a petition to revive the proceeding, as the response to the Office action was late.

10. The petition to revive the proceeding is being decided by a decision mailed on even date with the present decision.

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, Michael Skubisz, be waived for a declaration under 37 CFR 1.131, which has been submitted with signatures of the other two inventors. 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 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 patent owner has not 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.

The petitioner has not provided evidence of any inability to submit a declaration under 37 CFR 1.131 signed by the assignee of the entire interest in the patent under reexamination. To the contrary, it would appear that patent owner (assignee) patent owner could establish authority to act on the inventor's behalf and (1) execute a declaration under 37 CFR 1.131 and use the declaration of Mr. Dobbins and Mr. Andlauer to support the declaration under 37 CFR 1.131 or (2) legally authorize Mr. Dobbins and Mr. Andlauer to act on patent owner's (the assignee's) behalf in providing the affidavit to establish prior invention and provide a statement of such authorization. See MPEP 324. Accordingly, the petitioner has not shown the present situation to

be one warranting extraordinary relief. Again, see *Cantello v. Rasmussen, supra.* The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

It is noted that if patent owner attempts to submit a declaration, the right of the assignee must be established. In this case, the right of the assignee to take action has not been properly established. A statement under 37 CFR 3.73(b) must be submitted in order to establish that right, including the appropriate documentary evidence showing the chain of title *from the original owner to the current assignee* or statement relating to the evidence and a showing that the person signing has the authority to act on behalf of the assignee. A statement under 37 CFR 3.73(b) was filed, but it does not show a chain of title from the inventors to the current owner. It also does not show the subsequent security interest that has been recorded against the patent. The details of the security interest have not been made of record, so it is not clear as to whether authority must also be granted from the two lien holders in order to establish the right of the assignee to act. The chain of title and ownership obligations must be clarified in order to properly establish the authority of the assignee to act in this proceeding.

Thus, although there appears to be an assignee available to execute the declaration under 37 CFR 1.131 consistent with the provisions of that rule, proper authority to submit such a declaration has not been established.

Additional Discussion:

The petition submits that one inventor is unwilling to sign a declaration under 37 CFR 1.131. When an inventor is unavailable or unwilling to submit an appropriate oath or declaration to establish that invention of subject matter of a rejected claim was prior to the effective date of a reference, a party qualified under 37 CFR 1.42, 1.43, or 1.47 may submit the oath or declaration. The petition states that two inventors are available and have executed a declaration. The petition further states that the other inventor is unwilling to sign and submits as evidence a declaration by a contract employee of the assignee and a copy of one email correspondence between the inventor and that employee. The one limited exchange between the contract employee and the inventor merely shows a general question posed to the inventor indicating that the employee needs help swearing to a declaration. It does not show that diligent effort was expended to obtain the inventor's signature on the specific declaration submitted with the response.

In the case of an inventor refusing to sign a declaration, the requirements analogous to those of 37 CFR 1.47 must be met, including proof of the pertinent facts and the last known address of the non-signing inventor. The email submitted as evidence is not specific evidence that Mr. Skubisz refuses to specifically sign the declaration that establishes invention in accordance with 37 CFR. 1.131. Diligent effort to obtain Mr. Skubisz signature on the declaration has not been shown.

Thus, even if signatures by two of the three inventors were the only avenue to obtain the relief requested, petitioner has not satisfied the requirements under 37 CFR 1.42 or 37 CFR 1.47 required for the granting of the present 37 CFR 1.183 petition to waive the signature requirement of 37 CFR 1.131.

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. 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).

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

October 29, 2008
C:\kiva\kenpet 7\8632 dec 131 no-waiver.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,632	05/03/2007	6147995	E2003-701450	2017

37462 7590 10/30/2008

LOWRIE, LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED

OCT 3 0 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008632
PATENT NO. : 6147995
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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James C. De Vellis (For Patent Owner)
LOWRIE, LANDO & ANASTASI, LLP
Riverfront Office Park
One Main Street, Suite 1100
Cambridge, MA 02142

MAILED

OCT 3 0 2008

CENTRAL REEXAMINATION UNIT

Tracy W. Druce (For Requester)
Novak Druce & Quigg, LLP
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

In re Dobbins et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,632 : **GRANTING**
Filed: May 3, 2007 : **PETITION**
For: U.S. Patent No. 6,147,995 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on August 26, 2008, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

A review of the present petition reveals that it includes, *inter alia*, a response to the outstanding Office action. As such, petitioner has provided the response required by 37 CFR 1.137(b) (item 1). Payment of the requisite unintentional delay fee for a large entity was made (item 2). The petition contains the proper statement for unintentional delay in filing the required response (item 3). The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer (item 4). 37 CFR 1.137(d)(3) .

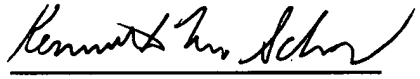
Since the present petition under 37 CFR 1.137(b) includes the requisite response (item 1),[1] the $1540.00 petition fee under 37 CFR 1.17(m) (item 2), and the requisite statement (item 3), the petition will be granted.

CONCLUSION

1. The petition for entry of late papers is **granted.**

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).

3. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster at 571-272-7711.



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

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,633	06/15/2007	5599625	99689-00056	2349

60612 7590 06/26/2009

MCCARTER & ENGLISH, LLP WILMINGTON
BASIL S. KRIKELIS
Renaissance Centre
405 N. King Street, 8th Floor
WILMINGTON, DE 19801

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/26/2009

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JUN 26 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Karen E. Keller
Young, Conaway, Stargatt & Taylor, LLP
1000 West Street, The Brandywine Bldg 17 Fl
Wilmington, DE 19801

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008633
PATENT NO. 5,599,625
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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MCCARTER & ENGLISH, LLP WILMINGTON (For Patent Owner)
BASIL S. KRIKELIS
Renaissance Centre
405 N. King Street, 8th Floor
WILMINGTON DE 19801

Karen E. Keller (For Third Party Requester)
Young, Conaway, Stargatt & Taylor
1000 West Street, The Brandywine Bldg 17th Floor
Wilmington, DE 19801

MAILED

JUN 26 2009

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
Wirth *et al.* : DECISION
Control No.: 90/008,633 : ON
Filed: June 15, 2007 : PETITION
For: U.S. Patent No.: 5,599,625 :

This is a decision on the April 7, 2009 patent owner petition under 37 CFR 1.182 requesting entry of an amendment after issuance of a Notice on Intent to Issue a Reexamination Certificate.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to Deposit account No. 50-3570 in accordance with petitioner's April 7, 2009 authorization.

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

REVIEW OF THE FACTS

1. On February 4, 1997, the Office issued U.S. Patent 5,599,625 (the '625 patent) to Wirth *et al.*

2. On May 3, 2007, a request for *ex parte* reexamination of the '625 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/008,633 (the '8633 proceeding).

3. On May 17, 2007, the Office issued a notice of failure to comply with *ex parte* reexamination request filing requirements and gave the third party requester thirty days to comply.

4. On June 15, 2007, the third party requester submitted a corrected *ex parte* reexamination request for the '625 patent.

5. On June 26, 2007, the Office issued a notice of the filing of the'8633 *ex parte* reexamination with a filing date of June 15, 2007.

6. On August 9, 2007, the Office issued an order granting the'8633 *ex parte* reexamination request.

7. On January 31, 2008, a first Office action on the merits issued rejecting all claims as unpatentable.

8. On March 23 and 24, 2009, patent owner and the examiner of record conducted interviews regarding the need to make corrections to the current claims of record to put them in proper form in accordance with the reexamination rules.

9. Prosecution advanced to the point that the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) on March 30, 2009.

10. On April 6, 2009, patent owner and the examiner of record conducted another interview regarding the correction of formal matters regarding the claims and how to submit the amendment after issuance of the NIRC.

11. On April 7, 2009, patent owner submitted the present petition under 37 CFR 1.182, requesting entry of an amendment after issuance of a Notice on Intent to Issue a Reexamination Certificate to correct formalities, accompanied by the amendment to be entered.

DECISION ON PETITION UNDER 37 CFR 1.182

MPEP 2287.01 states:

> The rules do not provide for an amendment to be filed in a reexamination proceeding after a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has been issued. Note that 37 CFR 1.312 does not apply in a reexamination proceeding. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after the NIRC must be accompanied by a petition under 37 CFR 1.182. The petition must be granted, in order to have the amendment, information disclosure statement, or other paper related to the merits considered. Where an amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding is filed after the NIRC, and the accompanying petition under 37 CFR 1.182 is granted, the examiner will reconsider the case in view of the new information, and if appropriate, will reopen prosecution. See MPEP § 2256 for a detailed discussion of the criteria for obtaining entry and consideration of an information disclosure statement filed after a NIRC.

A telephone conversation was conducted between the examiner of record and Joseph F. Weiss,

Jr., Legal Advisor, regarding the need for the April 7, 2009 amendment. In the conversation, the examiner of record stated that patent owner and the examiner of record conducted interviews on the 23rd and 24th of March regarding the need to submit an amendment to resolve several formal issued related to the format of the claims. Prior to submission of the amendment, the examiner had issued a NIRC. Patent owner then conducted an interview with the examiner of record on April 6, 2009 to discuss entry of the formalities amendment after NIRC. The examiner of record acknowledges that he has reviewed the amendment, that the amendment is in proper form, the amendment addresses and resolves only and all the formal matters previously discussed and, but for the amendment being after NIRC, the amendment is enterable and in accord with special dispatch.

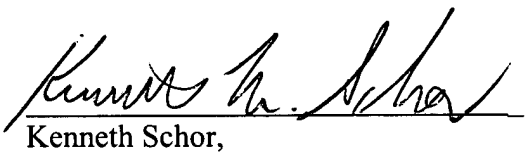
Accordingly, in view of the above and the fact situation presented by the record, the petition is granted.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. Jurisdiction for the '8633 reexamination proceeding is returned to the Central Reexamination Unit (CRU), to address the April 7, 2009 amendment being entered and issue a supplemental NIRC, if appropriate.

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



Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet7
6-23-08

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/15/09

TO SPE OF : ART UNIT 3991
SUBJECT : Request for Certificate of Correction for Appl. No.: 90008633 REEXAM
Patent No.: 5599625

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
Palm Location 7580

Should the changes be made **Valerie Jackson** **Certificates of Correction Branch**

703-756-1573

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: _____

_____

_____

_____

_____ 3991
SPE **Art Unit**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,633	06/15/2007	5599625	99689-00056	2349

60612 7590 02/01/2010

MCCARTER & ENGLISH, LLP WILMINGTON
BASIL S. KRIKELIS
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405 N. King Street, 8th Floor
WILMINGTON, DE 19801

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/01/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Karen E. Keller
Young, Conaway, Stargatt & Taylor, LLP
1000 West Street, The Brandywine Bldg 17 Fl
Wilmington, DE 19801

Date:
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FEB 0 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008633
PATENT NO. : 5599625
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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BASIL S. KRIKELIS
RENAISSANCE CENTRE
405 N. KING STREET, 8TH FLOOR
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FOR PATENT OWNER

KAREN E. KELLER
YOUNG, CONAWAY, STARGATT & TAYLOR
1000 WEST STREET,
THE BRANDYWINE BLDG 17 FI.
WILMINGTON, DE 19801

FOR THIRD PARTY REQUESTER

In re Wirth et al.

Reexamination Proceeding
Control No. : 90/008,633
Filed : June 15, 2007
Patent No. 5,599,625

DECISION ON PATENT OWNER'S PETITION FOR ISSUANCE OF A CORRECTED REEXAMINATION CERTIFICATE

This is a decision addressing Patent Owner's petition under 37 CFR 1.181 for issuance of a corrected reexamination certificate, filed September 11, 2009.

A reexamination certificate was issued in the '633 proceeding on September 1, 2009. Patent Owner correctly points out errors contained in the certificate. Review of the file history shows that a certificate of correction was issued December 15, 2009.

The request for issuance of a new reexamination certificate is DISMISSED as moot.

Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.

Deborah Jones
Supervisory Patent Examiner, Art Unit 3991 KRU

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Henry Kernius (For Patent Owner)
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CANADA

David Nocilly (For Third Party Requester)
Bond, Schoeneck & King, PLLC
One Lincoln Center
Syracuse, NY 13202-1355

In re Ray J. Frise et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,635 : **GRANTING**
Filed: May 10, 2007 : **PETITION UNDER**
For: U.S. Patent No. 6,628,771 : **37 CFR 1.137(b)**

This is a decision on the September 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 September 10, 2009 patent owner petition to revive").[1]

The appropriate petition fee of $810.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

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

The September 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 December 1, 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 $270.00 on June 8, 2009, thereby satisfying item (1).[2] A petition fee of $810.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the September 10, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

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

CONCLUSION

1. The September 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 June 8, 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, Woo Choi, of CRU Art Unit 3992, at (571) 272-4179.

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[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.

L. Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

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(For Patent Owner)

MAILED

JAN 29 2008

CENTRAL REEXAMINATION UNIT

MICHEAL D. LAKE
FACTOR & LAKE, LTD.
1327 W. WASHINGTON BLVD. SUITE 5G/H
CHICAGO, IL 60607

(For Requester)

In re Stillwagon
Reexamination Proceeding
Control No. 90/008,636
Filed: July 9, 2007
For: U.S. Patent No. 5,269,161

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on November 8, 2007 (which was ratified on December 17,2007), styled as "Petition Under 37 CFR § 1.515(c) To Reconsider the Order Denying *Ex Parte* Reexamination," (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 October 5, 2007.

The Petition is GRANTED.

REVIEW OF FACTS

1. U.S. Patent No. 5,269,161 (hereinafter, the '161 patent) issued on December 14, 1993.

2. On October 8, 2004, third party requester, Micheal D. Lake, deposited a request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned Control No. 90/007,242 (hereinafter, the '242 proceeding). Reexamination was granted for all the claims in the '161 patent.

3. On December 19, 2005, an Office action rejected patent claim 26 under 35 U.S.C. 102 based on U.S. Patent No. 3,594,876 and patent claims 1-25 and 29-66 based on numerous other references. The Office action indicated the subject matter of claims 27 and 28, which depend on claim 26, as patentable.

3. On October 17, 2006, a reexamination certificate issued in which claims 27 and 28 were confirmed patentable. Patent claims 1-26 and 29-66 were cancelled.

4. On July 9, 2007[1], the third party requester deposited another request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned Control No. 90/008,636 (hereinafter, the '636 proceeding). The request was based on U.S. Patent No. 3,594,876, three new prior art references, alleged patent owner admissions, and court rulings on claim interpretation.

5. Reexamination was requested for claims 27 and 28 of the '161 patent.

6. A Notice of Reexamination Request Filing Date was issued on July 17, 2007.

7. An order denying the request for reexamination for claims 27 and 28 was issued on October 5, 2007.

8. On November 8, 2007[2], the third party requester filed the Petition under 37 CFR §§ 1.515(c) and 1.181.

9. On December 17, 2007, the third party ratified the Petition.

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[1] The original request was made on May 30, 2007 but a compliant corrected request was not received until July 9, 2007.

[2] The request was timely because it included a certificate of mailing under 37 CFR 1.8, which was dated November 5, 2007, and was ratified on December 17, 2007.

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. The Petitioner did not challenge the examiner's denial of reexamination based on grounds 5-7 set forth in the request, but only challenged the decision regarding grounds 1-4. Specifically, the petitioner advances the following two 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 because the order did not address all the claim limitations of claims 27 and 28 addressed in the request for reexamination.
2. The examiner incorrectly refused to consider alleged patentee's admissions as to claim interpretation in deciding whether to grant the order for reexamination.

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 27 and 28 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 27 and 28 of the '161 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:

As mentioned above, claims 27 and 28 are the current claims in the '161 patent.

In a first Office action, dated December 19, 2005, the examiner rejected patent claim 26 under 35 U.S.C. 102 based on U.S. Patent No. 3,594,876 and patent claims 1-25 and 29-66 based on numerous other references. The examiner also indicated claims 27 and 28, which depend on claim 26, are patentable "...because the cited prior art patents and printed publications fail to teach a latching apparatus, as defined in claim 26, comprising a cinch cam exerting an axial cinching force on a post, and a primary cylindrical cam exerting a primary axial force opposite the axial cinching force, the cinch cam having a force-receiving cam surface and a force-exerting cam surface, the force-receiving cam surface receiving the primary axial force from the primary cylindrical cam and converting the primary axial force into a rotational force which effects rotation of the cinch cam, and the force-exerting surface converting the rotational force into the axial cinching force and transferring the cinching force to a coupling segment of the post."

IV. Analysis of the Request for Reexamination

The Request was denied on October 5, 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 alleged patent owner admissions and the court determination of claim interpretation, the examiner found that such did not raise a substantial new question of patentability. With regard to U.S. Patent No. 3,594,876, the examiner found that this previous considered reference was not presented in a new light, and therefore, do not raise a SNQ. With regard to the newly cited prior art references (e.g., U.S. Patents to Hofer, Tatom, and Poe), the examiner found that these references have cumulative teachings to references already considered in a previous examination, and therefore, did not raise a substantial new question of patentability.

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 three newly cited references that raised a substantial new question of patentability. The Director has reviewed the entire request, and has determined that there is at least one substantial new question of patentability presented by the teachings of U.S. Patent No. 2,978,266 to Poe for reasons set forth

below. Accordingly, the denial of the request for reexamination mailed on October 5, 2007 is hereby withdrawn.

U.S. Patent No. 2,978,266 to Poe: The request states that U.S. Patent No. 2,978,266 to Poe (hereinafter *Poe*) raises a substantial new question of patentability regarding claims 27 and 28 of the '161 patent (see Table D in an appendix to the request).

The *Poe* patent is prior art not cited in the prior prosecution of the '161 patent. As explained in Table D, *Poe* teaches, among other things, a post member 4 including a latching portion 5; a latching assembly 32 defining a passage 33 for accepting the latching portion of the post member and a latch means 31 for effecting a grip on the notched portioned of the latching portion of the post member; a releasing means 23; a cinch cam means 10, 14 for exerting an axial cinching force on the post member; wherein the post member is support by one of the frame elements A and includes a coupling segment 6 and a radial pin 13 and the latching assembly is supported by the other of the frame elements A'; wherein the cinch cam means which appears to include a force-receiving and force-exerting surfaces (e.g., surfaces of element 12); and a primary means 14 for exerting a primary axial force opposite of the cinching force, wherein the cam surfaces converts the axial force into a rotational force (Figures 1-6, col. 2, lines 10-39; col. 2, line 22 to col. 3 line 2). Since this teaching is directly related to subject matter considered as the basis for allowability of the patent claims in the '242 reexamination proceeding, a reasonable examiner would consider evaluation of the *Poe* reference as important in determining the patentability of claims 27 and 28. As such, it is agreed that the *Poe* reference raises a substantial new question of patentability with respect to claims 27 and 28 of the '161 patent.

Because it is agreed that U.S. Patent No. 2,978,266 to Poe raises a SNQ with respect to claims 27 and 28 of the '161 patent, the Petition and Request for Reexamination are GRANTED. None of the other issues presented in the petition are addressed in this decision as it not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination.

CONCLUSION

1. Given the facts involved in this proceeding, the PETITION is GRANTED.

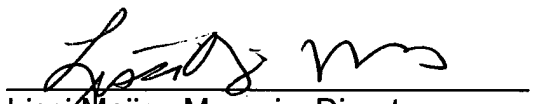
2. Accordingly, the request for *ex parte* reexamination of claims 27 and 28 of the '161 patent is GRANTED.

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 Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.



Lissi Mojica Marquis, Director
Central Reexamination Unit

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(Third Party Requester)

In re Star Lock Systems, Inc.
Ex Parte Reexamination Proceeding
Control No.: 90/008,636
Filed: July 9, 2007
For: U.S. Patent No. 5,269,161

: **DECISION DISMISSING**
: **PETITION TO VACATE**
: **ORDER GRANTING**
: **REEXAMINATION**

This is a decision on the February 19, 2008 patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.181(a)(3) TO VACATE ORDER GRANTING REEXAMINATION." In addition, on March 4, 200, third party requester filed a paper opposing the patent owner's petition which has also been considered.

The petition, the opposition paper and the 90/008,636 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The patent owner's petition is dismissed for the reasons set forth below.

REVIEW SALIENT OF FACTS

1. U.S. Patent No. 5,269,161 (the '161 patent) issued on December 14, 1993

2. On October 8, 2004, a first request for *ex parte* reexamination of the '161 patent was filed by TriTeq Lock & Security, LLC (TriTeq), a third party requester. The request was assigned control number 90/007,242 (the '242 *ex parte* reexamination proceeding) and was accorded a filing date of October 8, 2004.

3. Reexamination was ordered in the '242 *ex parte* reexamination proceeding for claims 1-66, *i.e.*, all of the claims, of the '161 patent, on December 5, 2005.

4. Ultimately, the '242 *ex parte* reexamination proceeding resulted in publication of a reexamination certificate in which the patentability of claims 27 and 28 of the '161 patent was confirmed, and claims 1-26 and 29-66 of the '161 patent were cancelled.

5. On May 5, 2007, papers were deposited requesting *ex parte* reexamination of claims 27 and 28 of the '161 patent by TriTeq (third party requester). The request papers were assigned control number 90/008,636 (the '636 *ex parte* reexamination proceeding).

6. Ultimately, corrected request papers were filed on July 9, 2007, and the '636 *ex parte* reexamination was accorded a filing date of July 9, 2007.

7. On October 5, 2007, reexamination was denied in the '636 *ex parte* reexamination proceeding.

8. On November 8, 2007, third party requester filed a petition under 37 CFR 1.181 to requesting supervisory review of the examiner's refusal to order reexamination. The petition papers included a certificate of mailing [1] dated November 5, 2007, but neither the certificate nor the petition was signed.

9. On December 17, 2007, in response to a telephone conversation with Office personnel, third party requester filed by facsimile transmission "a copy" of the signature page from the November 8, 2007, that was signed. This page also included a certificate of mailing, but the certificate was dated December 17, 2007 and was not signed.

10. On January 29, 2008, a petition decision granting the November 8, 2007 petition was issued by the Director of the Central Reexamination Unit (CRU), reversing the examiner's decision denying reexamination of claims 27 and 28 of the '161 patent and ordering reexamination of claims 27 and 28.

11. Patent owner then filed the present petition on February 19, 2008, seeking to overturn the CRU Director's decision order *ex parte* reexamination, as being an *ultra vires* action on the part of the Office.

12. On March 4, 2008, third party requester filed a paper in opposition to the present patent owner petition.

RELEVANT STATUTES AND EXAMINING PRACTICE

35 U.S.C. § 301 provides:

> Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

35 U.S.C. § 302 provides:

> 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

[1] See: 37 CFR 1.8

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.

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

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. ...

...

(c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable.

37 CFR 1.520 provides, in part:

The Director, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Director or which have been brought to the Director's attention, even though no request for reexamination has been filed in accordance with § 1.510 or § 1.913. The Director may initiate *ex parte* reexamination without a request for reexamination pursuant to § 1.510 or § 1.913. ...

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.

MPEP § 2246(II) provides, in part:

A substantive determination by the Director of the USPTO to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. ...

A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

(A) the reexamination order is not based on prior art patents or printed publications;

(B) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;

(C) reexamination was ordered for the wrong patent;

(D) reexamination was ordered based on a duplicate copy of the request; or

(E) the reexamination order is based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding). ...

When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester ... may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, any such opposition by the third party requester must

be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration. ...

MPEP § 2266.01 provides, in part:

A response by the patent owner will be considered not fully responsive to a non-final Office action where:

(A) a *bona fide* response to an examiner's non-final action is filed;

(B) before the expiration of the permissible response period;

(C) but through an apparent oversight or inadvertence, some point necessary to a full response has been omitted (i.e., appropriate consideration of a matter that the action raised, or compliance with a requirement made by the examiner, has been omitted).

Where patent owner's amendment or response prior to final rejection is not fully responsive to an Office action in a reexamination and meets all of (A) through (C) above, the >prosecution of the< reexamination proceeding should not be terminated; but, rather, a practice similar to that of 37 CFR 1.135(c)(which is directed to applications) may be followed. The examiner may treat a patent owner submission which is not fully responsive to a non-final Office action by:

(A) waiving the deficiencies (if not serious) in the response and acting on the patent owner submission;

(B) accepting the amendment as a response to the non-final Office action but notifying the patent owner (via a new Office action setting a new time period for response) that the omission must be supplied; or

(C) notifying the patent owner that the response must be completed within the remaining period for response to the non-final Office action (or within any extension pursuant to 37 CFR 1.550(c)) to avoid termination of the prosecution of the proceeding under 37 CFR 1.550(d). This third alternative should only be used in the very unusual situation where there is sufficient time remaining in the period for response (including extensions under 37 CFR 1.550(c)), as is discussed below.

Where a patent owner submission responds to the rejections, objections, or requirements in a non-final Office action and is a bona fide attempt to advance the reexamination proceeding to final action, but contains a minor deficiency ... Obviously, this course of action would not be appropriate in instances in which a patent owner submission contains a serious deficiency (e.g., the patent owner submission does not appear to have been filed in response to the non-final Office action).

Where patent owner's submission contains a serious deficiency (*i.e.*, omission) to be dealt with prior to issuing an action on the merits and the period for response has expired, or there is insufficient time remaining to take corrective action before the expiration of the period for response, the patent owner should be notified of the deficiency and what is needed to correct the deficiency, and given a new time period for response (usually 1 month). The patent owner must supply the omission within the new time period for response (or any extensions under 37 CFR 1.550(c) thereof) to avoid termination of the prosecution of the proceeding under 37 CFR 1.550(d). The patent owner may also file a further response as permitted under 37 CFR 1.111. This is analogous to 37 CFR 1.135(c) for an application.

DECISION

I. Patent Owner's Position [2]

Patent owner argues that the CRU Director's January 29, 2008 decision to order reexamination is improper as being an *ultra vires* action. Specifically, patent owner considers such action to have been *ultra vires*, because (a) the third party requester petition filed November 8, 2007, seeking review of the examiner's denial of *ex parte* reexamination was not signed, (b) the signature page filed on December 17, 2007 was not a "true and correct copy" of the unexecuted signature page of the November 8, 2007 petition, and (c) the December 17, 2007 submission was not served on

[2] The discussion that follows is a summary. However, the entirety of patent owner's position has been fully and carefully considered prior to formulation of this decision.

the patent owner. [3] The balance of the patent owner's petition sets forth the litigation history between patent owner and third party requester involving the '161 patent, and otherwise expands on the three asserted defects relied upon to urge that the CRU Director's January 29, 2008 decision was an *ultra vires* action. Based on the three specified defects and the litigation history between the parties, patent owner concludes that "the equities demand denial of requester's petition."

II. Third Party Requester's Position [4]

Third party requester's position is that the actions relied upon by patent owner that relate specifically to the present '636 *ex parte* reexamination proceeding do not rise to the level of making the CRU Director's January 29, 2008 decision an *ultra vires* action. [5] The balance of the opposition paper responds to patent owner's statement of facts, defends the filing of the executed signature paper on December 17, 2007, and argues that the litigation history is not relevant so as to establish equities in favor of patent owner.

III. Analysis and Findings

1. *Ultra Vires* Action Defined

As discussed in MPEP § 2246(II), when the USPTO Director orders reexamination pursuant to a finding that prior patents and/or printed publications establish a substantial new question of patentability (SNQ), the determination is not subject to review by the courts until there has been a final agency decision in the reexamination proceeding. The sole exception is when the order granting reexamination is an *ultra vires* action on the part of the USPTO Director.

An order granting reexamination is considered to be an *ultra vires* action when the USPTO Director lacks authority and discretion to take that action. As explained in MPEP § 2246(II), an *ultra vires* action occurs when an order granting reexamination is based upon consideration of subject matter that the reexamination statute does not permit to be considered to establish an SNQ (*e.g.* a prior public use or sale), or there are no patent claims subject to a reexamination order, or the order was for the wrong patent, or was based upon a duplicate request, or the SNQ determined to exist is not a new SNQ because it only presents a question of patentability that was previously considered in an earlier Office examination of the patent (such as during examination of the application that matured into the patent, a prior reexamination proceeding of the patent, or during an interference proceeding involving the patent). Stated differently, an order granting reexamination is an *ultra vires* action only when it goes beyond the enabling authority conveyed by the reexamination statute, whereby the USPTO Director may assume jurisdiction over an issued United States patent in order to reexamine that patent. The USPTO Director lacks the authority to exercise discretion, if such an exercise of discretion would exceed the authority conveyed by the reexamination statute.

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[3] *See*: Patent owner's "Petition ... to Vacate Order Granting Reexamination," February 19, 2008, page 2, first full paragraph.

[4] The discussion that follows is a summary. However, the entirety of third party requester's position has been fully and carefully considered prior to formulation of this decision.

[5] See: "TriTeq's Opposition to Petition ... To Vacate Order Granting Reexamination," March 4, 2008, page 4.

2. Acceptance Of An Unsigned Paper Not *Ultra Vires*

Patent owner argues that the acceptance of the November 8, 2007 third party requester petition was not subject to ratification, and therefore, acceptance of that paper by the CRU Director renders the January 29, 2008 decision to order *ex parte* reexamination an *ultra vires* action.

It is common Office practice that where a paper filed in the Office is a *bona fide* presentation of a party position, but is incomplete in that it lacks a signature, that such paper may be held to be incomplete in a letter that notifies the party of the defect, and sets a period of time for the party to provide the missing signature. This practice is ubiquitous, and it is clearly within the authority and discretion of the USPTO director that has been delegated to the Technology Centers and the CRU.

As set forth in MPEP § 2266.01, the Office will consider a patent owner submission in an *ex parte* reexamination proceeding, notwithstanding that the submission is in some way defective, provided that the submission is a *bona fide* submission that was submitted prior to the expiration of the period for filing the submission. Such consideration is not outside of the authority given the USPTO Director by the reexamination statute. Pursuant to delegation by of this authority by the USPTO Director, the CRU Director likewise had discretion to consider the third party requester petition for supervisory authority, filed on November 8, 2007, after first having invited (through a USPTO employee) the third party requester to provide the omitted signature on the original petition. It appears that, in the '636 *ex parte* reexamination proceeding, the notice that the November 8, 2007 petition lacked a signature was conveyed to third party requester telephonically. Third party requester thereafter ratified the petition document on December 17, 2007. It also appears that the CRU Director accepted that the December 17, 2007 ratification document also ratified the certificate of mailing, making the filing of the petition on November 8, 2007, timely. Therefore, the action taken on January 29, 2008 by CRU Director was not an *ultra vires* action.

However, it is noted that 37 CFR 1.515(c) sets a one-month period for the filing a petition denying *ex parte* reexamination. As the 37 CFR 1.8 certificate of mailing affixed to the November 8, 2007 petition was not executed, it may be argued that the petition was technically untimely filed with respect to the October 5, 2007 decision denying reexamination. To the extent that patent owner argues that the CRU Director's January 29, 2008 decision granting *ex parte* reexamination was *ultra vires* because the third party requester's petition was not timely filed within the time period set by 37 CFR 1.515(c), the present petition decision hereby extends, *nunc pro tunc*, the one-month time period established by 37 CFR 1.515(c). To the extent that a waiver of the rules might be required, they are herby waived; it is noted that there is no statutory period for filing a 37 CFR 1.515 petition. Thus, the CRU Director's January 29, 2008 decision to grant *ex parte* reexamination in the '636 *ex parte* reexamination proceeding clearly can not be characterized as being an *ultra vires* action, given the acceptance and ratification of the third party requester's November 8, 2007 petition, because such acceptance is now based upon the exercise of discretion to extend the time period, and, to the extent needed, to waive the rules in accordance with 37 CFR 1.183. As noted, *supra*, an *ultra vires* action is an action that is not within the discretion of the USPTO Director.

3. Acceptance of Signature Page Not *Ultra Vires*

Patent owner also argues that the CRU Director's January 29, 2008 decision granting *ex parte* reexamination was an *ultra vires* action because the December 17, 2007 ratification is not "a true and correct copy" of the signature page that originally copied the November 8, 2007 filing.

Patent owner basis this conclusion on the fact that the certificate of mailing on the December 17, 2007 ratification paper is dated December 17, 2007, not November 5, 2007.

This argument is not persuasive. As should be readily apparent, and as explained in third party requester's March 4, 2008 opposition to the present petition, a paper prepared for mailing that includes a certificate of mailing affixed thereto would ordinarily have the date of the certificate indicate the date that the paper is mailed. However, the freshly dated certificate of mailing affixed to the December 17, 2007 ratification paper was not executed. This is unsurprising, since the paper to which it was affixed was transmitted by facsimile transmission, not by first class mail.

Further, it is clear that the substance of the December 17, 2007 ratification paper, *i.e.* the three sentence paragraph and signature block, in fact duplicates the substance of the corresponding page of the November 8, 2007 petition, except that the signature block on the December 17, 2007 ratification paper has been executed.

For these reasons, the acceptance of the December 17, 2007 ratification paper does not demonstrate that the CRU Director's January 29, 2008 decision to order *ex parte* reexamination is an *ultra vires* action. Clearly, acceptance of such ratification paper was well within the discretion of the CRU Director.

4. Acceptance Of Paper Not Served On Patent Owner Not *Ultra Vires*

Patent owner further argues that the acceptance of the December 17, 2007 paper by the CRU Director renders the January 29, 2008 order granting *ex parte* reexamination an *ultra vires* action because the December 17, 2007 paper was not served on patent owner. This too is not persuasive.

While 37 CFR 1.550(f) provides that a document filed by a party must be served on the opposing party, the rule further provides that lack of a certificate of service **may** result in the Office refusing to consider the paper (the choice to refuse consideration or not is discretionary, based on the individual situation). Patent owner relies upon the language of the rule to demonstrate that that the January 29, 2008 order constituted an *ultra vires* action, because it was based upon accepting a paper that had not been served on patent owner. However, acceptance of a paper not served in accordance with the provisions of 37 CFR 1.550(f) is explicitly placed within the authority and discretion of the USPTO Director by rule. In this instance, the patent owner was not prejudiced by the lack of service of the signed ratification. Initially, the patent owner has no statutory right to oppose a petition under 37 CFR 1.515(c); thus, the delayed notification of the filing of the petition did not cause patent owner to lose any response/reply rights. Further, it appears that the substance of the December 17, 2007 paper had previously been served on patent owner, because the substance of the December 17, 2007 paper, (the three sentence paragraph and the signature block), is identical to the November 8, 2007 paper that had been served (that the signature block was now signed is not substance). That existence of a signature on the ratification paper, *per se*, adds nothing of substance to what was contained in the November 8, 2007 petition that had previously been served on patent owner.

Accordingly, the acceptance of the December 17, 2007 ratification paper despite the lack of service of that paper also does not demonstrate that the CRU Director engaged in an *ultra vires* action by accepting the paper.

ADDITIONAL DISCUSSION

Pursuant to 35 U.S.C. § 303(a) and 37 CFR 1.520, *ex parte* reexamination may be ordered at the initiative of the USPTO Director, *sua sponte*, provided that order is based upon a substantial new question of patentability established by prior patents or printed publications. The record of the '636 *ex parte* reexamination proceeding shows that the request has been found to have raised the requisite substantial new question of patentability. Thus, even if the present patent owner petition were to be granted, and action in this reexamination proceeding were to be terminated, the USPTO Director could nevertheless order *ex parte* reexamination based upon the identical substantial new question of patentability. Such a *sua sponte* order would be proper, since the references advanced by the request were not considered in an ordered reexamination proceeding, i.e., were not considered as to the issue of the patentability of the claims (the order is limited to the consideration of whether a substantial new question is raised). Such a *sua sponte* order would be appropriate and desirable, because there is an unresolved substantial new question of patentability as to the claims (see the CRU Director's January 29, 2008 decision to order reexamination), and there is a public interest in resolving the question, i.e., the public is entitled to such resolution. It is, however, not necessary to reach the point of a Director initiated reexamination, since, as pointed out above, the USPTO Director has authority to exercise discretion in this fact situation, which authority is not contrary to the statute.

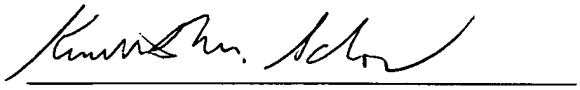
CONCLUSION

1. The patent owner petition filed on February 19, 2008, is dismissed.

2. A copy of this decision will be made of record in the IFW of the '636 *ex parte* reexamination proceeding.

3. Jurisdiction over the '636 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit.

4. Telephone inquiries related to the present decision should be directed to Stephen Marcus 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
March 19, 2008

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JUN 16 2008

CENTRAL REEXAMINATION UNIT

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Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,637 : **DISMISSING**
Filed: May 16, 2007 : **PETITION**
For: U.S. Patent No. 7,012,512 :

This is a decision on the March 31, 2008, third party requester PETITION FOR ENTRY OF LATE PAPERS IN A REEXAMINATION PROCEEDING, requesting late entry of a requester's reply under § 1.535 based on unintentional delay in the instant *ex parte* reexamination proceeding. The third party requester petition is taken as a petition under 37 CFR 1.137(b).

The petition fee of $1540.00 pursuant to 37 CFR 1.17(m) for the petition under 37 CFR 1.137(b) was charged to the third party requester's deposit account, as authorized by the third party requester on page 1 of the instant petition.

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

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

REVIEW OF FACTS

1. U.S. Patent No. 7,012,512 issued on March 16, 2006 (the '512 patent).

2. On May 16, 2007, a request for *ex parte* reexamination of claims 1-21 of the '512 patent was filed by a third party requester, which proceeding was assigned control no. 90/008,637 (the '637 proceeding).

3. Reexamination was ordered in the '637 proceeding on June 26, 2007.

4. On August 20, 2007, patent owner timely filed a patent owner's statement and amendment under 37 CFR 1.530.

5. On March 31, 2008, the third party requester filed a PETITION FOR ENTRY OF LATE PAPERS IN A REEXAMINATION PROCEEDING, requesting late entry of a requester's reply under 37 CFR 1.535 based on unintentional delay in the '637 proceeding.

DECISION

The present petition, taken under 37 CFR 1.137(b) and requesting late entry of a requester's reply under § 1.535 for unintentional delay in the '637 proceeding, has been fully considered.

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 41(a)(7) provides (emphasis added):

> REVIVAL FEES. – On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or 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 (emphasis added):

> 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. § 304 provides (emphasis added):

> 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.

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.
>
> (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.

35 CFR 1.535 provides (in pertinent part):

> 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.

The Manual of Patent Examining Procedure (MPEP) § 2268 provides (in pertinent part):

> The failure to timely file a statement pursuant to 37 CFR 1.530 or a reply pursuant to 37 CFR 1.535, however, would not (under ordinary circumstances) constitute adequate basis to justify a showing of

unavoidable/unintentional delay regardless of the reasons for the failure, since failure to file a statement or reply does not result in a "termination" of the reexamination prosecution, to which 37 CFR 1.137 is directed.

II. DISCUSSION

The Order Granting/Denying Request for *Ex Parte* Reexamination, mailed June 26, 2007, set a two month period from the date of service of any timely filed patent owner's statement for filing an optional requester's reply and noted that no extension of time of this time period is permitted (the two month period is statutory - see 35 U.S.C. § 304). A patent owner's statement under § 1.530 was timely filed and served on August 20, 2007, but no requester's reply under § 1.535 was timely filed in the '637 proceeding.

35 U.S.C. § 305 provides that after the times for filing the statement and reply provided for by § 304 have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of §§ 132 and 133. The relief provision set forth in 35 U.S.C. § 133 for showing unavoidable delay, however, applies only to patent owners and only during the conduct of reexamination proceedings *after the times for filing the patent owner's statement and requester's reply have expired.* Thus, the "unavoidable" relief provision set forth in 35 U.S.C. § 133 is unavailable to the third party requester in the '637 proceeding for late entry of a requester's reply due to unavoidable delay. In addition, 35 U.S.C. § 41(a)(7) provides for "unintentional" relief for "an unintentionally delayed response by the patent owner in any reexamination proceeding." The relief provision set forth in 35 U.S.C. § 41(a)(7) for showing unintentional thus applies only to patent owners and their responses. Therefore, the "unintentional" relief provision set forth in 35 U.S.C. § 41(a)(7) is unavailable to the third party requester in the '637 proceeding for late entry of a requester's reply due to unintentional delay.

Moreover, as set forth in 35 U.S.C. § 304, the filing of a requester's reply is optional; therefore, the non-filing of the requester's reply does not cause termination of the reexamination proceeding. The relief provisions set forth in 37 CFR 1.137 are remedial and apply to *patent owners* in reexamination proceedings where the prosecution of the proceeding been *terminated* (entirely, or as to specific claims). As the '637 proceeding has not been terminated, the relief provision set forth in § 1.137(b) is unavailable. As noted in MPEP § 2268, the failure to timely file a reply pursuant to 37 CFR 1.535 would not constitute adequate basis to justify a showing of unavoidable/unintentional delay regardless of the reasons for the failure, since failure to file a reply does not result in a "termination" of the reexamination prosecution, to which § 1.137 is directed.

Accordingly, third party requester's petition under 37 C.F.R. § 1.137(b), requesting late entry of a requester's reply under § 1.535 in the '637 proceeding, is **dismissed**.

CONCLUSION

1. The third party requester PETITION FOR LATE ENTRY OF PAPERS IN A REEXAMINATION PROCEEDING, taken under 37 CFR 1.137(b), is **dismissed**.

2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit for further examination 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

June 13, 2008
C:\Kiva\kpet-abe\8637_unintentional for accept 3PR reply

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,638	05/15/2007	5501759	1001.1594103	3376

28075 7590 03/02/2010

CROMPTON, SEAGER & TUFTE, LLC
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MINNEAPOLIS, MN 55403-2420

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

WOODCOCK WASHBURN LLP
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2929 ARCH STREET
PHILADELPHIA PA 19104-2891

MAILED

MAR 02 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008638

PATENT NO. 5,501,759

ART UNI 3992

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

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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 02 2010

CENTRAL REEXAMINATION UNIT

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: FOR PATENT OWNER

WOODCOCK WASHBURN LLP
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: FOR THIRD PARTY
: REQUESTER

In re Forman

Reexamination Proceeding
Control No. : 90/008,638
Filed : May 15, 2007
Patent No. 5,501,759

: DECISION ON PATENT
: OWNER'S PETITION UNDER
: 37 CFR 1.181

This is a decision addressing Patent Owner's submission of November 23, 2009 entitled "PETITION TO ENTER DOCUMENTS SUBMITTED IN ACCORDANCE WITH 37 CFR §1.116 IN EX PARTE REEXAMINATION," which is being treated as a petition under 37 CFR 1.181. The petition requests entry of eight evidentiary documents submitted September 16, 2009 as part of a response after final rejection.

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

SUMMARY

Patent Owner's petition is DENIED.

BACKGROUND

1. Patent No. 5,501,759 issued on March 26, 1996.

2. A request for reexamination, assigned Control No. 90/008,638, was filed by a third party Requester on May 15, 2007.

3. Reexamination was ordered in the '638 proceeding on June 29, 2007.

4. A Patent Owner's Statement was filed on August 29, 2007.

5. Requester filed a reply to Patent Owner's statement on October 29, 2007.

6. An Office action on the merits was mailed on September 4, 2008.

7. On November 3, 2008, Patent Owner filed a response to the Office action.

8. On July 17, 2009, the Office mailed a final rejection.

9. On September 16, 2009, Patent Owner filed a response to the final rejection. The response included eight evidentiary documents.

10. On September 24, 2009, the Office mailed an advisory action. The examiner indicated that the evidence submitted after final rejection would not be entered because there was no reason why it was necessary or why it was not earlier presented. The examiner also noted that portions of some documents were illegible or handwritten.

11. On October 26, 2009, Patent Owner filed a second response after final rejection. The response argued that the previously filed documents should be entered and provided a legible copy of one document.

12. On October 29 2009, the Office mailed an advisory action. The examiner again indicated that the evidence submitted after final rejection would not be entered because there was no reason why it was necessary or why it was not earlier presented.

13. On November 11, 2009, Patent Owner filed a notice of appeal.

14. On November 23, 2009, the instant petition was filed.

15. On January 11, 2010, Patent Owner filed an appeal brief.

DECISION

Admission of evidence after a final rejection is governed by 37 CFR 1.116(e), which reads as follows:

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

The documents submitted by Patent Owner include a District Court Order issued in ongoing litigation involving the '759 patent. This Order was submitted as part of Patent Owner's Statement of August 29, 2007. Since it is already part of the record in this proceeding, the petition is moot with regard to the Court Order. The other seven documents are items cited by the Court in support of its decision to deny summary judgment of the '759 patent claims as invalid for obviousness.

Patent Owners are not entitled to have evidence submitted after final rejection considered as a matter of right; any submission after final rejection must be accompanied by a showing as required by 37 CFR 1.116(e). Patent Owner was clearly in possession of the seven newly submitted documents before any Office action on the merits and has not provided any reason why they could not have been presented earlier in this proceeding.

Patent Owner cites *Stratoflex* to show that evidence of secondary considerations "must always" be considered by the examiner, and further argues that the Court documents were submitted because the examiner refused to consider objective evidence of secondary considerations when making the final rejection. This argument is not persuasive. The Court Order is not objective evidence, but a legal conclusion which is not binding on the Office. The standard for a summary judgment of invalidity, as explained at pp. 3-4 of the Court Order, is different from the obviousness standard used in ex parte examination. Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success and solution of a long-felt need, and attorney arguments can not take the place of objective evidence (MPEP 716.01[c]). The *Stratoflex* decision states that evidence of secondary considerations "must always when present be considered." In the final rejection the examiner was not refusing to consider evidence, simply pointing out that Patent Owner had not submitted any evidence to be considered.

It is clear why Patent Owner considers the affidavits and other evidence submitted after final rejection necessary to rebut the examiner's *prima facie* case of obviousness, but there is no good and sufficient reason why this evidence was not earlier presented. The examiner did not make any new ground of rejection in the final rejection, and Patent Owner was in possession of these documents at the time it responded to the first Office action on the merits. Thus Patent Owner's argument is not persuasive.

CONCLUSION

1. Patent Owner's petition filed November 23, 2009 is **DENIED** for the reasons discussed above.

2. This proceeding is returned to the examiner for consideration of Patent Owner's appeal brief.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

GREENBLUM & BERNSTEIN, P.L.C. (For Patent Owner)
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RESTON VA 20191

Andreas Baltazis (For Requester)
Kramer & Amado, P.C,
1725 Duke Street, Suite 240
Alexandria, Va. 22314

In re Ware :
Reexamination Proceeding : DECISION ON
Control No. 90/008,641 : PETITION UNDER
Request Deposited: May 17, 2007 : 37 CFR 1.181
For: U.S. Patent No. 4,707,592 :

The papers filed by requester on August 6, 2007 and August 16, 2007, styled as "Petition Under 37 CFR § 1.181," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, is requesting that the above-identified application be accorded a filing date of May 17, 2007.

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 4,707,592 (hereinafter, the '592 patent) issued on November 17, 1987 from an application filed October 7, 1985.

2. On May 17, 2007, the third party requester deposited a request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned Control No. 90/008,641 (hereinafter, the '641 proceeding).

3. A Notice of Reexamination Request Filing Date was issued on May 22, 2007, which indicated a filing date of May 17, 2007 for the reexamination request.

4. On May 30, 2007, staff of the CRU called the third party requester to inform him that page 12 was missing from the request as it appeared in the image file wrapper (IFW) system. The third party requester faxed the missing page 12 to the CRU staff on the same day.

5. An order granting the request for reexamination for claims 1-4, 10-20 and 22-26 was issued on July 17, 2007.

6. On August 6, 2007, staff of the CRU called the third party requester to let him know that the facsimile transmission of the missing page 12 does not comply with the rules and procedures of the U.S. Patent and Trademark Office (Office), and that a petition under 37 CFR 1.181 with proof that page 12 was included in the original submission of the request of May 17, 2007 was required. The third party requester filed the above-mentioned petition under 37 CFR § 1.181 on the same day.

7. On August 16, 2007, the third party requester filed a supplemental petition under 37 CFR § 1.181 in response to a call from a staff member of the CRU to inform him of the missing evidence needed to make the record clear that the submission of May 17, 2007 included all 33 pages of the request, including page 12.

DECISION

Petitioner argues that page 12 was included with the reexamination request papers deposited on May 17, 2007. As evidence thereof, petitioner submitted a copy of his postcard receipt which acknowledges receipt of a request for reexamination of 33 pages on May 17, 2007, a complete and true copy of the request submitted made on May 17, 2007, and an affidavit by Rusty Belicek, a paralegal for the firm of Kramer & Amado, attesting that he hand delivered a Request for *Ex Parte* Reexamination and Statement, which was 33 pages, along with other documents. Petitioner requests that the request for reexamination be accorded a filing date of May 17, 2007.

Upon review of the record, the evidence is convincing that the reexamination request papers deposited on May 17, 2007, included page 12, which was subsequently misplaced in the Office. Therefore, the reexamination request was complete on filing and entitled to a filing date of May 17, 2007.

In view of the above, the petition is granted. The copy of page 12 submitted with the petition will be used for examination purposes.

The present petition included an authorization to charge a $400.00 petition fee to a credit card. No charge has been made, as a petition under 37 CFR 1.181 does not require such a fee.

CONCLUSION

1. Given the facts involved in this proceeding, the request for *ex parte* reexamination of claims 1-4, 10-20 and 22-26 of the '592 patent should be given a filing date of May 17, 2007.

2. Accordingly, the PETITION is GRANTED.

3. The order dated July 19, 2007 is confirmed, and any time periods set in the order continue to run from the mailing date of the order.

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.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,641	05/17/2007	4,707,592	ADS. 3059.01	3700

7055 7590 06/26/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/26/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Andreas Baltazis

Kramer & Amado, P.C,

1725 Duke Street, Suite 240

Alexandria, Va. 22314

MAILED

JUN 26 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,641*.

PATENT NO. *4,707,592*.

ART UNIT *3992*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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GREENBLUM & BERNSTEIN, P.L.C. : (For Patent Owner)
1950 ROLAND CLARKE PLACE :
RESTON VA 20191 :

MAILED

JUN 26 2008

VOLPE AND KOENIG PC : (For Third Party CENTRAL REEXAMINATION UNIT
Attn: Gerald B. Halt, Jr. : Requester)
30 S 17th St Ste 1600 :
Philadelphia, PA 19103 :

KRAMER & AMADO, P.C. : (For Third Party
Attn: Andreas Baltatzis : Requester)
1725 DUKE STREET :
SUITE 240 :
ALEXANDRIA, VA 22314 :

: 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/

MARK J. REINHART
CRU SPE-AU 3992

for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,642	05/09/2007	6576265	SPV-001RX	3166

22832 7590 06/05/2008

Kirkpatrick & Lockhart Preston Gates Ellis LLP
(FORMERLY KIRKPATRICK & LOCKHART NICHOLSON GRAHAM)
STATE STREET FINANCIAL CENTER
One Lincoln Street
BOSTON, MA 02111-2950

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Kirkpatrick & Lockhart Preston Gates Ellis LLP (For Patent Owner)
State Street Financial Center
One Lincoln Street
Boston, MA 02111-2950

Shlesinger, Arkwright & Garvey LLP (For Third Party Requester)
1420 King Street
Suite 600
Alexandria, VA 22314

MAILED

JUN 05 2008

CENTRAL REEXAMINATION UNIT

In re Spievack :
Reexamination Proceeding :
Control No.: 90/008,642 : **DECISION**
Filed: May 9, 2007 : **ON PETITION**
For: U.S. Patent No.: 6,576,265 : **UNDER 37 CFR 1.182**
:

This is a decision on the May 29, 2008 patent owner petition under 37 CFR 1.182 to extend beyond one (1) hour the duration of the Assignee-initiated Examiner Interview scheduled with the Reexamination Panel on June 11, 2008.

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

The petition is dismissed for the reasons set forth below.

BACKGROUND

1. Patent number 6,576,265 issued June 10, 2003.
2. On May 9, 2007, a request for reexamination, assigned control No. 90/008,642 (the '8642 proceeding), was filed.
3. On July 24, 2007, the Office issued an order granting the '8642 reexamination request.
4. The'8373 proceeding has progressed to the point where a Non-Final action has been issued on April 18, 2008.
5. On May 29, 2008, the instant petition was submitted.

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 2281 states (in part):

The duration of the interview will not exceed one hour, unless the patent owner files a petition under 37 CFR 1.182 showing sufficient cause where more time is needed. In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied, to the extent such is deemed necessary. An hour of time in a structured planned interview should be sufficient to accomplish this, and in those rare instances where it is not, a patent owner may show cause to extend the time. During the interview, the examiner is always free to extend the duration of the interview to discuss issues that the examiner deems appropriate for (further) discussion. Such an extension of the duration of the interview is permitted at the examiner's sole discretion.

DECISION

In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied. In the present case, the submission fails to show sufficient cause as to why more time over the allotted one (1) hour is needed. Although the inventor, Mr. Spievack, is stated to have passed away, assignee has secured an expert in regenerative medicine and tissue graft compositions who is familiar with the prior art and the patent under reexamination to understand the issues raised in the Office action. Further, this expert may accompany the assignee to the interview and act in the same manner as the inventor would have, to address certain rejections raised in the Office action which are asserted to be premised on erroneous understandings of the science underlying the claimed invention and the technology disclosed in the cited prior art.

Based on these facts, the presence of the expert who is well versed in the prior art and the patent under reexamination at the interview would appear to serve in place of not having the actual inventor present. Assignee names the absence of the inventor as the reason for the request of more time during the interview; however, the expert can take the time needed to prepare for the interview, and during the interview, will be available to address the technology in the same manner that the inventor would be available. Thus, assignee has not presented sufficient cause for requiring extra time over the one (1) hour allotted for an interview.

CONCLUSION

1. The petition is dismissed as to the request to extend beyond one (1) hour the duration of the Assignee-initiated Examiner interview scheduled with the Reexamination Panel on June 11, 2008.

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).

3. Telephone inquiries related to this decision should be directed to Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

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

June 4, 2008
C:\kiva\kenpet7\8642 req_more_interview_time.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,642	05/09/2007	6576265	SPV-001RX	3166

22832 7590 06/05/2009

K&L Gates LLP
STATE STREET FINANCIAL CENTER
One Lincoln Street
BOSTON, MA 02111-2950

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2009

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
MICHAEL M. ZADROZNY
SHLESINGER, ARKWRIGHT & GARVEY LLP
1420 KING STREET, SUITE 600
ALEXANDRIA, VA 22314

Date: MAILED

JUN 0 5 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008642
PATENT NO. : 6576265
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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C. Edward Polk, Jr.
K&L Gates LLP
State Street Financial Center
One Lincoln Street
Boston, MA 02111-2950

For Patent Owner

MAILED

JUN 05 2009

CENTRAL REEXAMINATION UNIT

Shlesinger, Arkwright & Garvey LLP
1420 King Street
Suite 600
Alexandria, VA 22314

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,642
Filed: May 9, 2007
For: US Patent No. 6,576,265

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

This is a decision on the petition filed June 2, 2009 to request a two-month extension of time pursuant to 37 CFR 1.550 for filing an Appeal Brief.

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

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

Decision

The Patent Owner requests an extension of time in which to file an Appeal Brief. 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 of time is requested to permit patent owner to file a Request for Continued Reexamination under 37 CFR 1.182 and to permit newly-added counsel time to review and analyze the reexamination file.

Analysis and Findings

Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. The after-final amendment and supporting declaration filed after an interview with the Examiner were not entered and Patent owner believes that the grant of the Request for Continued Reexamination would advance the present proceeding by allowing the Examiner to consider the amendment and Patent Owner to refine the response to at least narrow the issues on appeal to the board. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Patent Owner's showing is adequate to justify the grant of a two-month extension of time in which to file an Appeal Brief. Accordingly, the period of time is extended to August 10, 2009. 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. The Patent Owner's petition for a two-month extension of time in which to file a response to the Office action is **granted**.

2. The Patent Owner's response is due August 10, 2009.

3. Response may be submitted as follows:

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

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

for Deborah Jones

Gregory Morse,
Director, Central Reexamination Unit

United States Patent and Trademark Office

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Alexandria, VA 22313-1450
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C. Edward Polk, Jr.
K&L Gates LLP
State Street Financial Center
One Lincoln Street
Boston, MA 0122-2950

(For Patent Owner)

MAILED

JUL 28 2009

CENTRAL REEXAMINATION UNIT

Michael M. Zadrozny
Shlesinger, Arkwright, & Garvey
1420 King Street, Suite 600
Alexandria, VA 22314

(For Requester)

In re Spievack
Ex Parte Reexamination Proceeding
Control No. 90/008,642
Filed: May 9, 2007
For: U.S. Patent No. 6,576,265 B1

DECISION
GRANTING PETITION
UNDER 1.182

This is a decision on the June 16, 2009 patent owner petition entitled "REQUEST UNDER 37 CFR § 1.182 FOR CONTINUED REEXAMINATION."

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

The petition fee of $400.00 under 37 CFR 1.17(f) has been charged.

The petition is **granted to the extent set forth below**.

BACKGROUND

1. On May 9, 2007, a request for *ex parte* reexamination of all of the claims of U.S. Patent Number 6,576,265 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/008,642 ("the '8642 proceeding").

2. On July 24, 2007 an order granting reexamination of all the claims of the '265 patent was mailed in the '8642 proceeding.

3. On April 18, 2008, a non-final Office action, in which all pending claims were rejected, was mailed in the '8642 proceeding.

4. On June 11, 2008, a first interview was held between patent owner and Office personnel.

5. On June 18, 2008, patent owner submitted a timely response to the outstanding Office action, including amendments and new claims 20-37.

6. On December 11, 2008, a final Office action was mailed, rejecting all of the pending claims.

7. On January 27, 2009, a second interview was held between patent owner and examiners, including a discussion of possible claim language, including amendment of the claim transitional phrases to "close the claim," and an agreement that patent owner will submit an amendment after final Office action.

8. On February 11, 2009, an amendment after final Office action was filed. It included amendments to the text of original patent claims 1-4, 8, and 11, cancellation of claims 9, 10, and 16-37, and a presentation of new claims 38-53. A declaration under 37 CFR 1.132 was also submitted, along with a prior art exhibit.

9. On March 5, 2009, an advisory action was mailed by the Office, stating that the proposed February 11, 2009 response failed to overcome all of the rejections in the final rejection of December 11, 2008 and informing patent owner that the proposed claim amendments would not be entered.

10. On April 10, 2009, a Notice of appeal was filed by patent owner.

11. On June 5, 2009, the Office granted a June 2, 2009 patent owner petition for a one month extension of time, setting the due date for the patent owner's appeal brief at August 10, 2009.

12. On June 16, 2009, patent owner filed the instant petition entitled "REQUEST UNDER 37 CFR § 1.182 FOR CONTINUED REEXAMINATION," concurrently with an amendment, remarks, and evidence submission.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

DECISION

The June 11, 2009 patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of an evidence submission previously denied. 37 CFR 1.182 provides for relief that is not currently provided by an existing rule. In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding **to seek entry of an amendment and/or evidence that was denied entry** after a final rejection in an ex parte reexamination proceeding [emphasis added].

The § 1.182 petition procedure was created to address a need for an amendment or evidence submission, the need for which did not become apparent until the issuance of the final rejection or action closing prosecution. The filing of such a § 1.182 petition is strictly controlled by the Office to further the statutory mandate of 35 U.S.C. § 305 that "[a]ll reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. In keeping with the requirement of special dispatch, a petition under 37 CFR 1.182 for continued reexamination must show how granting the petition would further the prosecution of the reexamination proceeding. Prosecution may be furthered by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate. Furthermore, patent owner should set forth reasons why the need for the submission did not become apparent until the issuance of the final rejection or action closing prosecution.

The examiner conducted an interview with the patent owner on January 27, 2009, and a timely follow up submission including evidence was then filed on February 11, 2009. On March 5, 2009, the Office mailed an advisory action refusing entry of the proposed February 11, 2009 amendment, as not placing the proceeding in better form for appeal by materially simplifying the issues for appeal, and refusing entry of the proposed evidence as not being solely directed to issues that were newly raised by the examiner in the final rejection.

On June 16, 2009, the patent owner timely filed the instant § 1.182 petition. First, at the current stage of the proceedings, no regulation specifically provides for the entry of patent owner's submission to continue rexamination, thereby meeting the "situations not specifically provided for" language in § 1.182. Second, with respect to reasons why the need for the evidence could not have been anticipated earlier, patent owner states that the amendment and evidence was in response to language in the final rejection, and in response to the January 27, 2009 interview with the examiner. *See* Petition at 6. The instant submission includes an amendment intended to address issues, such as the rejections based upon 35 U.S.C. §§ 112 and 305, first raised in the final rejection. In this instance, based on the totality of the circumstances, the patent owner has met the burden of presenting evidence why the need for the submission could not have been anticipated earlier.

---

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

Third, the requirement that the amendment has been previously denied entry is deemed to have been met. The petition was filed after final rejection in an *ex parte* reexamination proceeding to seek entry of an after-final amendment not previously considered, and evidence that was previously denied entry in the March 5, 2009 advisory action. Although the June 16, 2009 amendment has not been denied entry, a similar amendment to the claims was submitted on February 11, 2009, and denied entry on March 5, 2009. While the instant amendment differs in content from the previously unentered amendment, the June 16, 2009 amendment appears to address the same issues as the amendment previously denied entry. These issues were discussed in the February 11, 2009 interview with the examiner, in which the examiner and patent owner discussed possible claim language, including amendment of the claim transitional phrases to "close the claim," and agreed that patent owner will submit an amendment after final Office action. The March 5, 2009 advisory action stated that the previous amendment failed to overcome the art rejections, and would additionally raise issues under 35 U.S.C. §§ 112 and 305, thereby failing to further prosecution. The instant June 16, 2009 submission includes changes to the earlier proposed amendment, including the entry of amendments addressing the art and claim transitional phrases to "close the claim," that are directed towards the examiner's comments in refusing the entry of the earlier proposed amendment. In view of the February 11, 2009 interview and the March 5, 2009 advisory action, the response submitted on June 16, 2009, is found to constitute a *bona fide* attempt to resubmit the earlier amendment that was denied entry, and altered such that entry would further prosecution.

Fourth, the effect of entry of the amendment is determined to be in accordance with conducting the proceeding with special dispatch. In the instant case, a notice of appeal was filed on April 10, 2009, to keep the proceeding pending. While the patent owner has filed a notice of appeal, neither an appeal brief nor an examiner's answer has been filed. Therefore, any delay caused by the submission of the April 10, 2009 notice of appeal is not significant enough to outweigh the benefit to be obtained by consideration of the proffered amendment. Based on the facts in this case, it is found that continuation of examination through entry of the June 16, 2009 amendments and evidence submission would best further prosecution and satisfy the overall needs of special dispatch. Furthermore, the prosecution history shows a pattern of responsiveness on the part of the patent owner through the use of interviews with the examiner in an effort to better define the claims over the applied art. On balance, the entry of the June 16, 2009 amendment would best serve the efficient resolution of the question of patentability arising from the art of record. For these reasons, the § 1.182 petition is deemed to satisfy the requirements set forth in the Notice.

In view of the above, the closing of prosecution rendered via the December 11, 2008 final Office action is withdrawn, and prosecution of the proceeding is reopened to the following extent:

The June 16, 2009 response will be entered by the Central Reexamination Unit, and will then be considered by the examiner. These papers will be treated as a response by patent owner received **after** a first Office action.

CONCLUSION

- The petition is **granted to the extent set forth herein**.
- The prosecution of the present '8642 *ex parte* reexamination proceeding is continued. **No further continuation of the present reexamination proceeding will be granted, absent a showing of extraordinary circumstances.**
- The closing of prosecution rendered via the December 11, 2008 final Office action is hereby withdrawn, and prosecution of the proceeding is reopened.
- The June 16, 2009 response will be entered by the Central Reexamination Unit, and will then be considered by the examiner. These papers will be treated as a response by patent owner received **after** a first Office action.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

July 27, 2009
C:\Kiva\Kenpet7\RCR\

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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PAULEY PETERSEN & ERICKSON
2800 WEST HIGGINS ROAD; SUITE 365
HOFFMAN ESTATES, IL 60169

MAILED

NOV 09 2007

CENTRAL REEXAMINATION UNIT

In re Application of	:	
WILLARD J. WEIBEL	:	
Control No. 90/008,647 (U.S. Patent 7,099,837)	:	DECISION ON PETITION
Filed: MAY 18, 2005	:	TO WITHDRAW
Attorney Docket No. EISA-101-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 05, 2007.

The request is **DENIED**.

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 of the request to withdraw and the expiration date of the time to file a response to the outstanding Office action.

The request cannot be approved because there remain less than 30 (thirty days) between the date of this decision and the expiration of the time given to respond to the Office action mailed on October 12, 2007.

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

Telephone inquiries concerning this decision should be directed to Manuel Saldana (571) 272-7740.

Manuel Saldana

for Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: **ELECTRONIC IMAGING SYSTEMS**
2260 HICKS ROAD, SUITE 405
ROLLING MEADOWS, IL 60008

cc: **KIRK TESKA** (Third Party Requester)
IANDIORIO & TESKA
260 BEAR HILL ROAD
WALTHAM, MA 02451

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on November 05, 2007. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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200 West Adams Street
Chicago, IL 60606

For Patent Owner

Iandorio Teska & Coleman
260 Bear Hill Road
Waltham, MA 02451

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,647
For: U.S. Patent No. 7,099,837

DECISION ON PETITION

This is a decision on the August 17, 2009, "Petition to the Director Under 37 CFR 1.181, 1.182 and 1.183 Requesting Acceptance of Co-Inventor's Previously Filed Requests for Time Extensions, Acceptance of Source 3's Pending Amendment, and Office action Thereon in the Pending Reexamination". The petition will be considered under 37 CFR 1.181.

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 petition seeks to have ratification and entry of three separately filed extensions of time and to have the response filed January 28, 2008 deemed to have been timely filed. A decision granting *nunc pro tunc* the requested extensions of time is being mailed under separate cover and concurrently with this decision. In view of the granting of the requested extensions of time, the response filed January 28, 2008 is deemed to have been timely filed. Accordingly, the instant petition is dismissed as being moot.

Conclusion

1. The patent owner's petition requesting acceptance of the January 28, 2008 response as timely is **dismissed as being moot** in view of the grant of the requested extensions of time.

2. Upon the mailing of this decision, the proceeding will be forwarded to the examiner for consideration of the January 28 and February 21, 2008 responses and issuance of an action.

3. All correspondence relating to this ex parte reexamination should be directed as follows:

By EFS: See 37 CFR 1.8(a)(C)(ii)

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

Gregory Morse, Director
Central Reexamination Unit

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MAILED

APR 11 2008

CENTRAL REEXAMINATION UNIT

William L. Anthony, Jr.
Orrick, Herrington & Sutcliffe (For Third Party Requester)
1000 March Road
Menlo Park, CA 94025

In re Karol Doktor	:	
Ex parte Reexamination Proceeding	:	**DECISION DISMISSING REQUEST**
Control No: 90/008,648	:	**TO VACATE FILING DATE OF AN**
Filing Date: June 11, 2007	:	***EX PARTE* REEXAMINATION**
For: U.S. Patent No.: 5,826,259	:	**PROCEEDING**

This is a decision on the patent owner petition filed on September 14, 2007, entitled "Petition to Vacate the Filing Date Accorded to a Reexamination in Violation of 35 U.S.C. 302."

The patent owner petition papers are before the Office of Patent Legal Administration for consideration.

The patent owner's petition to vacate the filing date of the above identified *ex parte* reexamination is dismissed for failure to submit the requisite fee, as detailed below.

After a review of the facts of this proceeding, this paper also *sua sponte* extends the time period for patent owner to file an optional patent owner statement under 37 CFR 1.530 to expire two months from the date of this decision, in order to address the third party requester's failure to serve the patent owner with corrected reexamination request papers in a timely manner.[1]

BACKGROUND

1. Patent number 5,826,259 (the '259 patent) issued on October 20, 1998, with claims 1-18.

2. On May 9, 2007, a third party, Oracle Corporation, filed a request for *ex parte* reexamination of claims 1-18 that was assigned control no. 90/008,648 (the '8648 proceeding).

[1] The corrected reexamination request papers have now been served on patent owner; see part 10 of the Background section of this decision.

3. The '259 patent is also the subject of a pending merged reissue application 11/152,835 and reexamination proceeding 90/007,707 (requested by Oracle Corporation.) For the merged proceeding, a notice of allowance was mailed on February 20, 2008.

4. A Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements was mailed to the third party requestor on May 29, 2007.

5. On June 8, 2007, the third party requestor filed a corrected request for reexamination by mail and by facsimile transmission.

6. On June 11, 2007, the third party requestor filed a response to the Notice including a letter to CRU Specialist James Matthews, a copy of the Notice, and a substitute form 1449PTO (with the three references absent from the claim chart removed from the form) by mail and by facsimile. No certificate of service was included with the response.

7. A filing date was granted on June 11, 2007 in the Notice of Reexamination Request Filing Date mailed on June 13, 2007.

8. On July 19, 2007, the request for *ex parte* reexamination was granted. A time period for the optional patent owner's statement was set two months from the mail date, and a time period of two months from the date of service of any timely filed patent owner's statement was set for filing a requestor's reply.

9. The present petition was filed on September 14, 2007 requesting that the filing date accorded to this proceeding be vacated because the third party requestor's response did not include a replacement statement and was not served on the patent owner.

10. A certificate of service was filed on September 20, 2007 by the third party requestor certifying that copies of the June 11, 2007 response were served on patent owner's counsel.

DISMISSAL FOR FAILURE TO FILE FEE

I. Pertinent Regulations

§ 1.182 Questions not specifically provided for.

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

§ 1.183 Suspension of rules.

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

II. Decision

The petition was submitted without specifying under which rule relief is requested and without any fee. Patent owner requests that the order granting the request for reexamination be vacated. As there is no specific rule that governs such a request, the request should have been made under 37 CFR 1.182 to address questions not specifically provided for under the rules and/or under 37 CFR 1.183 to request a suspension of the rules.

A petition filed under either 37 CFR 1.182 or 1.183 must be filed with a petition fee in accordance with 37 CFR 1.17(f), which is $400. In view of the failure to submit a fee, the petition cannot be considered and is hereby dismissed.

TIME PERIODS RESET *SUA SPONTE*

The corrected request for reexamination papers filed on June 11, 2007, in response to the May 29, 2007, Notice of Incomplete *Ex Parte* Reexamination Request were adequate to correct the deficiencies noted in the Notice as the substitute information disclosure forms listed only those references detailed in the claim chart in the request. However, the response was not served on the patent owner until after the present petition was filed and after the period for filing the patent owner statement. Under 37 CFR 1.510(b)(5), a certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner as provided for in 37 CFR 1.33(c) is required.

The response filed on June 11, 2007, by the third party requestor that completed the request for reexamination in order to obtain a filing date should have included a certificate of service showing service of all of the request papers on the patent owner. This omission was remedied on September 20, 2007. As this late filing occurred after the time period for the patent owner to file a patent owner statement, the period for filing a statement will be reset to avoid any prejudice to the patent owner by the delay in service. As the response was ultimately served, thus forming a complete reply, it is not in the public's best interest to vacate the filing date or take further corrective action than that taken herein. In this instance, no substantive rights are gained or are lost by retaining the date of deposit as the filing date. On the other hand, the statutory mandate of 35 U.S.C. 305 that all *ex parte* reexamination proceedings "be conducted with special dispatch within the Office" can be furthered by waiving the service requirement of 37 CFR 1.510(b)(5), while extending the time for patent owner to file a statement under 37 CFR 1.530. Since the request has already been served on patent owner, this course of action permits the proceeding to go forth with special dispatch, without the need to reissue the order to reexamine.

Accordingly, the service requirement of 37 CFR 1.510(b)(5) is waived *nunc pro tunc* to the extent that the later service on patent owner will be accepted, while retaining the original filing date.

Further, the time to file a patent owner statement under 37 CFR 1.530 is hereby extended to expire **two months from the mailing date of this decision**. The third party requestor is provided with **two months from the date of service of any patent owner statement** to file a reply in accordance with 37 CFR 1.535, should a statement be filed.

After the expiration of the time periods set herein, the Central Reexamination Unit will commence reexamination in the '8648 proceeding. At that time, the status of the copending merged reissue application 11/152,835 and *ex parte* reexamination proceeding 90/007707 will be evaluated to determine what further action is to be taken.

CONCLUSION

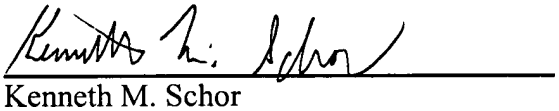
1. The patent owner petition filed on September 14, 2007, is dismissed.

2. The time to file a patent owner statement under 37 CFR 1.530 is hereby extended to expire two months from the mailing date of this decision.

3. If patent owner timely files a statement under 37 CFR 1.530, the third party requester shall have a time period of two months from the date of service of the patent owner statement on requester, in which to file a requestor reply under 37 CFR 1.535.

4. Jurisdiction over the proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for appropriate action after the expiration of the time periods set herein.

5. 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

4-7-08

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.
90/008,648	06/11/2007	5826259	6883/23	4772

32605 7590 07/01/2008

MACPHERSON KWOK CHEN & HEID LLP
2033 GATEWAY PLACE
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SAN JOSE, CA 95110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/01/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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Menlo Park, Ca 94025

MAILED

JUL 0 1 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,648*.

PATENT NO. *5826259*.

ART UNIT *3992*.

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

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

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(For Patent Owner)

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JUL 0 1 2008

CENTRAL REEXAMINATION UNIT

William L. Anthony, Jr.
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1000 March Road
Menlo Park, CA 94025

(For Third Party Requester)

In re Karol Doktor
Ex parte Reexamination Proceeding
Control No: 90/008,648
Filing Date: June 11, 2007
For: U.S. Patent No.: 5,826,259

DECISION DISMISSING REQUEST TO VACATE FILING DATE OF AN *EX PARTE* REEXAMINATION PROCEEDING

This is a decision on the patent owner petition filed on April 25, 2008, entitled "Renewed Petition to Vacate the Filing Date Accorded to a Reexamination in Violation of 35 U.S.C. 302."

The patent owner petition papers are before the Office of Patent Legal Administration for consideration. Although patent owner has again failed to specify under which rule relief is requested, authorization to charge a petition fee to Deposit Account No. 01-0484 has been included. Thus, the petition will be taken under 37 CFR 1.182 and 1.183, and will be addressed.

The patent owner's renewed petition to vacate the filing date of the above identified *ex parte* reexamination is dismissed.

BACKGROUND

1. Patent number 5,826,259 (the '259 patent) issued on October 20, 1998, with claims 1-18.

2. On May 9, 2007, a third party, Oracle Corporation, filed a request for *ex parte* reexamination of claims 1-18 that was assigned control no. 90/008,648 (the '8648 proceeding).

3. The '259 patent is also the subject of a pending merged reissue application 11/152,835 and reexamination proceeding 90/007,707 (requested by Oracle Corporation.) A notice of allowance was mailed on February 20, 2008, and the issue fee was paid March 6, 2008, for the merged proceeding.

4. On May 29, 2007, a Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements (Notice of Failure to Comply) was mailed to the third party requestor, for the '8648 proceeding.

5. On June 8, 2007, the third party requestor filed a corrected request for reexamination by mail and by facsimile transmission.

6. On June 11, 2007, the third party requestor filed a response to the Notice of Failure to Comply including a letter to CRU Specialist James Matthews, a copy of the Notice, and a substitute form 1449 PTO (with the three references absent from the claim chart removed from the form) by mail and by facsimile. No certificate of service was included with the response.

7. A filing date was granted on June 11, 2007 in the Notice of Reexamination Request Filing Date mailed on June 13, 2007.

8. On July 19, 2007, the request for *ex parte* reexamination was granted. A time period for the optional patent owner's statement was set to run two months from the mail date, and a time period of two months from the date of service of any timely filed patent owner's statement was set for filing a requestor's reply.

9. On September 14, 2007, a patent owner petition was filed requesting that the filing date accorded to this proceeding be vacated on the grounds that the third party requestor's response did not include a replacement statement and was not served on the patent owner. The petition did not specify under which rule it was being filed and was not filed with a fee.

10. A certificate of service was filed on September 20, 2007 by the third party requestor certifying that copies of its June 11, 2007 response were served on patent owner's counsel.

11. On April 11, 2008, the September 14, 2007 petition was dismissed for failure to submit the requisite fee for consideration under either 37 CFR 1.182 or 1.183, as the rule under which relief was requested was not specified.

12. On April 25, 2008, patent owner filed a renewed petition, which is the subject of this decision.

13. On May 7, 2008, the third party requester filed a response in opposition to patent owner's renewed petition. The response has been considered in formulating this decision.

14. A patent owner statement was not filed by the due date of June 11, 2008, established in the April 11, 2008, decision on petition.

DECISION

I. Pertinent Regulations

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 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 2246.II. PETITION TO VACATE THE ORDER GRANTING REEXAMINATION (in part)

A substantive determination by the Director of the USPTO to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. See *Joy Mfg. Co. v. Nat'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F. Supp.2d 593 (E.D.Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 35, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's **35 U.S.C. 303** determination entirely to his or her discretion and not subject to judicial review until a final agency decision on the reexamination proceeding has issued). Accordingly, neither the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted. There is no right to petition such a finding after a request for reexamination is granted even if the finding of a substantial new question is based on reasons other than those urged by the requester (or based on less than all the grounds urged by the requester). Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

MPEP 2227 Incomplete Request for *Ex Parte* Reexamination (in part)

OFFICE PROCEDURE WHERE THE REQUEST FAILS TO COMPLY WITH REQUIREMENTS FOR A FILING DATE

A. Discovery of Non-Compliance with Filing Date Requirement(s) Prior to Assigning a Filing Date

1. Notice of Failure to Comply with Reexamination Request Filing Requirement

The Central Reexamination Unit (CRU) Legal Instruments Examiner (LIE) and CRU Paralegal check the request for compliance with the reexamination filing date requirements. If it is determined that the request fails to meet one or more of the filing date requirements (see MPEP § 2214), the person identified as requesting reexamination will be so notified and will be given an opportunity to complete the requirements of the request within a specified time (generally 30 days). Form PTOL-2077, "Notice of Failure to Comply with *Ex Parte* Request Filing Requirements," is used to provide the notification for *ex parte* reexamination. ...

2. Failure to Remedy the Defect(s) in "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements"

> ...If the third party requestor timely responds to the "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements," the CRU LIE and CRU Paralegal will check the request, as supplemented by the response, for correction of all non-compliance items identified in the notice. If any identified non-compliance item has not been corrected, a filing date will not be assigned to the request papers...

II. Findings and Analysis

Patent owner requests that the order granting the request for reexamination be vacated. The arguments in the petition state that the order was improvidently granted because the requestor's response to the Notice of Failure to Comply was inadequate. Patent owner alleges that the response was deficient in three respects - failure to submit a replacement statement under 37 CFR 1.510(b)(1) and (2), facsimile filing the replacement statement, and failure to certify service to the patent owner.

The response was not deficient and the order for reexamination was properly granted for the following reasons. First, the corrected request for reexamination papers filed on June 11, 2007, in response to the May 29, 2007, Notice of Failure to Comply were adequate to correct the deficiencies noted in the Notice, as the substitute information disclosure forms listed only those references detailed in the claim chart in the request. Thus, each cited document in the substitute information disclosure forms is discussed in at least one statement identifying an SNQ and in a corresponding detailed explanation. Page 4 of the Notice of Failure to Comply indicates that the requester may file a paper containing a replacement PTO/SB/08 or its equivalent listing only those patents and publications discussed in a statement identifying an SNQ and the corresponding explanation. Thus, a satisfactory replacement document was filed June 11, 2007.

Second, the replacement pages were submitted by mail through the U.S. Postal Service, with a copy by facsimile transmission. The replacement pages were therefore appropriately filed.

Third, the April 11, 2008, decision on the first patent owner petition fully addressed the late service of the replacement pages. The service requirement of 37 CFR 1.510(b)(5) was waived *nunc pro tunc* to the extent that the later service on patent owner will be accepted, while retaining the original filing date. The Office provided a remedy to the patent owner for the late service of papers by resetting the time period for which a patent owner statement could be filed. Patent owner chose not to avail itself of this remedy and abstained from filing a patent owner statement.

Finally, in the petition the patent owner raises a question as to the propriety of the prior art presented in the request for reexamination, although patent owner does not base the petition on this argument. In particular, the patent owner asserts that the art presented in the reexamination request was submitted by the patent owner and considered by the Examiner, except for the entirety of a German publication, during the merged reexamination proceeding 90/007,707 and reissue application 11/152,835. However, as expressly noted in the order for reexamination, on page 5, paragraph 6, the references to Teorey and Huber cited by the requester were not previously discussed by the examiner nor applied to claims in the prior examination of the patent. Therefore, a substantial new question of patentability is present. The order for reexamination was properly granted.

As a final point, petitioner is referred to *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593. In *Heinl*, 143 F.Supp.2d at 601, the court stated:

> "Under the well established *ultra vires* doctrine, the exhaustion and final agency requirements are excused 'only if plaintiff is able to show that the PTO clearly exceeded its statutory authority'", quoting from *Philip Morris, Inc. v. Block*, 755 F.2d 368, 370 (4th Cir. 1985) (quoting *Mayor and City Council of Baltimore v. Mathews*, 562 F.2d 914, 920 (4th Cir. 1977), vacated on other grounds, 571 F.2d 1273 (4th Cir. 1978).

The court went on to state:

> "Put differently, when an agency acts in 'brazen defiance' of its statutory authorization, courts need not await the conclusions of the underlying proceedings."

After a review of the present record, and based upon the above discussion, it is found that petitioner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office's determination to continue reexamination.

CONCLUSION

1. The patent owner petition filed on April 25, 2008, is dismissed.

2. As no patent owner statement has been filed, jurisdiction over the proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for issuance of an Office action in due course.

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

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

cdd

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OCT - 2 2007

CENTRAL REEXAMINATION UNIT

Jay B. Monahan
eBay, Inc.
2145 Hamilton Avenue
San Jose, CA 95125

(For 3rd Party Requester)

Reexam Control No.: 90/006,956
Filed : March 8, 2004
For U.S. Patent No. : 5,845,265

Reexam Control No.: 90/008,650
Filed : May 15, 2007
For U.S. Patent No. : 5,845,265

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. 90/006,956 was ordered in a decision mailed June 4, 2004. On March 24, 2006 the examiner mailed a non-final Office action. On June 26, 2006 the Office received a response to the non-final Office action. The response was timely by virtue of an extension of time granted in a decision mailed May 18, 2006. The Office has issued no further actions on the merits. No amendments to the claims, specification, drawings have been presented in this proceeding.

Reexamination in application control No. 90/008,650 was ordered in a decision mailed July 27, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. No amendments to the claims, specification, drawings have been presented in this proceeding.

As evidenced by the above facts, reexamination control No. 90/006,956 and reexamination control No. 90/008,650 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

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

Conclusion

Reexamination Control Nos. 90/006,956 and 90/008,650 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

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JAN 16 2009

CENTRAL REEXAMINATION UNIT

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
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(For Patent Owner)

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(For Third Party Requester)

DECISION GRANTING -IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.550(c)]

In re: Thomas G Woolston
Ex Parte Reexamination Proceeding
Control No. 90/006,956
Deposited on: 08 March 2004
For: US Patent No. 5,845,265

In re: Thomas G Woolston
Ex Parte Reexamination Proceeding
Control No. 90/008,650
Deposited on: 15 May 2007
For: US Patent No. 5,845,265

This is a decision on the 14 January 2009, petition for "Request Under 3 7 CFR$ § 1.550 (c) for a One-Month Extension of Time to Reply to a Final Office Action in a Reexamination Proceeding," requesting that the time for responding to the Final Office action, mailed 20 November 2008 be extended by one (1) month.

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

The petition is Granted-in-Part for the reasons set forth below.

Summary of Relevant Facts

1. On 08 March 2004 a third party requester, requested reexamination of US Patent No. 5,845,265.

2. On 04 June 2004 the Order Granting Request for *Ex Parte* Reexamination was mailed to the address of record.

3. On 15 May 2007 a third party requester, requested reexamination of US Patent No. 5,845,265.

4. On 27 July 2007 the Order Granting Request for *Ex Parte* Reexamination was mailed to the address of record.

5. On 02 October 2007 *ex parte* proceeding 90/006,956 was merged with *ex parte* proceeding 90/008,650.

6. A Final rejection was mailed 20 November 2008.

7. On 14 January 2009 a petition was timely filed in the above proceedings.

Decision

The Patent Owner requests an extension of time in which to file a response to the Final Office action mailed 20 November 2008, which set a two-months date for filing a response thereto. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond to the Final Office action be extended by one additional month. Since the petitioner has provided "sufficient cause" for granting in-part an extension of time, the petition is granted-in-part. The petitioner has provided the petition fee set forth in 37 CFR § 1.17(g).

37 CFR § 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

The patent owner petitions the Director of the Central Reexamination Unit for an additional one-month extension of time for which to respond to the outstanding Office action. The petitioner states that the extension of time is sought to enable review of the extensive records from unnamed litigation and unnamed multiple reexamination proceedings. Review of the record of the proceedings seeking this extension of time notes that no additional references were cited in the merged proceedings and that only four (4) claims remain under rejection. Further the petitioner notes the value in an interview but as correctly noted by the petitioner interviews are not considered "sufficient cause" to grant an extension of time.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A fourteen (14) day extension of time is hereby granted.

The petition request is hereby **granted-in-part**.

A **fourteen (14) day** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 20 November 2008 is **granted-in-part**.

2. A **fourteen (14) day** extension of time is hereby granted.

2. The office action mailed set a two-months response time for which to respond with the granting of this extension of time will end on **3 February 2009**.

3. Future correspondence may be submitted as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,650+90/006956	05/15/2007	5845265	2043.566UX6	5364

49845 7590 06/30/2009

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Jay B. Monahan
eBay, Inc.
2145 Hamilton Ave.
San Jose, CA 95125

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,650. + 90/006956

PATENT NO. 5845265.

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

MAILED

JUN 30 2009

CENTRAL REEXAMINATION UNIT

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

Schwegman, Kundberg & Woessner/EBAY (Requester, now Patent Owner)
PO Box 2938
Minneapolis, MN 55402

In re Woolston
Reexamination Proceeding
Control No. 90/006,956
Filed: March 8, 2004
For: U.S. Patent No. 5,845,265

DECISION ON PETITIONS UNDER 37 CFR 1.59

In re Woolston
Reexamination Proceeding
Control No. 90/008,650
Filed: March 8, 2004
For: U.S. Patent No. 5,845,265

This is a decision on the petitions under 37 CFR 1.59(b), filed November 20, 2007 and December 13, 2007, to expunge information from the above identified proceeding.

The petitions are dismissed.

"Materiality" is defined as any information which the examiner considers as being important to a determination of patentability of the claims.

Although the submitted material has been found to not be material to the patentability of the claims, the petition is deficient because the petition does not contain a commitment on the part of petitioner to retain the information to be expunged for the life of any patent with regard to which such information has been submitted, the petition does not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted the information, and the petition does not have a clear statement that the information has not been otherwise been made public.

If Patent Owner timely submits the missing statements, the petitions will be granted.

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

Greg 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.
90/008,651	05/19/2007	5662032	05-14489	1247

7590 10/30/2007

LERNER AND GREENBERG
P.O. BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

10/31/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DANIEL M. CISLO, ESQ.
233 WHILSHIRE BOULEVARD, SUITE 900
SANTA MONICA, CA 90401

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008651
PATENT NO. 5,662,032
ART UNIT 3991

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Cislo & Thomas
233 Wilshire Boulevard, Suite 900
Santa Monica, CA 90401

MAILED

OCT 30 2007

CENTRAL REEXAMINATION UNIT

Reexamination Control No. 90/008,651 : **DECISION**
Filed: May 19, 2007 : **DISMISSING**
Patent No: 5,662,032 : **PETITIONS**
Patentee: Baratta :

This is a decision on petitions dated October 16, 2007 by a third party requestor in reexamination 90/008,651 filed on May 19, 2007. The October 16, 2007 paper first requests access to the abandoned application of De Oliveira, or in the alternative, an Order barring the owner of the patent in reexamination from reliance on the abandoned application (for which access is denied to the third party requestor) to support a § 1.131 affidavit. As the application for which access is sought is abandoned and otherwise not accessible to the public, the petition for access will be treated under § 1.14(h), access in other circumstances. The petition for an Order will be treated as a petition under 37 CFR 1.182.

The petitions are before the Office of Patent Legal Administration for decision.

The petition for access under 37 CFR 1.14(h) is Dismissed.

The petition under 37 CFR 1.182 is Dismissed.

BACKGROUND

A review of the file of the instant reexamination reveals in-part:

- An Order granting *Ex parte* reexamination mailed on July 17, 2007:
  - a third party requestor raised a substantial new question of patentability affecting claims 1-6 of U.S. patent 5,662,032 issued to Baratta; and
  - The substantial new question related to Pursley, D375,024, (based on an application filed May 18, 1995) in combination with Hsu/and or Wang for claims 1-3, and in further view of Rodwick for claims 4-6.
- A Patent Owner's Statement was filed on September 18, 2007:
  - The Owner's statement contained an affidavit under 37 CFR 1.131 attempting to remove Pursley as prior art.

The § 1.131 affidavit relied upon to overcome the May 18, 1995 date of Pursley:

- conception as of May 17, 1995 (affidavit, page 1) (the Patent Owner's Statement itself refers to a July 19, 1994 conception date at page 2), and
- diligent work towards a reduction to practice (affidavit, page 1)

- a constructive reduction to practice by the filing of the now abandoned application 08/412,895 on March 29, 1995 naming De Oliveira as the sole inventor (page 1 of the affidavit, and page 3 of the Owner's Statement), or at least diligence until the filing of the application leading to the patent under reexamination (page 4 of the Patent Owner's Statement).

The Patent Owner's statement, at page 3, states that a copy of application 08/412,895 was ordered (on an unspecified date), but the patent owner was informed that it would not be available from the Patent Office for 4-6 weeks (presumably as the file is not in IFW).

DECISION ON PETITION UNDER 37 CFR 1.14(h)

The instant petition under 37 CFR 1.14(h) seeks access to abandoned patent application 08/412,895, the (sole) inventor thereof being stated to be Rosangela De Oliveira. Petitioner/Requestor, seeks to respond to the patent owner's § 1.131 affidavit, which response is due on November 13, 2007 (Statement of Facts, paragraph 11, attached to the Petition), and requests access to the abandoned application to aid in that response. As the abandoned application is not part of a priority chain in the patent being reexamined, the abandoned application is not available to the public. Petitioner states that without access to the abandoned application, Petitioner as a third party requestor cannot "determine whether the '895 [abandoned] application does in fact disclose the subject matter of the '032 patent" (patent undergoing reexamination). Petition at page 3.

37 CFR 1.14 provides:

> (h) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:
>
> (1) The fee set forth in § 1.17(g); and
>
> (2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

A petition for access by the patent owner Baratta for access to the abandoned application of De Oliveira is not before the Office as part of the reexamination file in support of the § 1.131 affidavit. The patent owner has referred to ordering a copy of the abandoned application (Patent Owner's Statement at page 3), but has not made a copy of the order and any justification it might contain as to why a copy of the abandoned, non-public application of another should be given to the patent owner (such as written consent by De Oliveira). The patent owner has also not presented a copy of the abandoned application obtained from the inventor of the abandoned application inventor De Oliveira, whom he states to be his wife, Patent Owner's Statement, page 3.

Accordingly, any reliance by the patent owner on the abandoned application to support the § 1.131 affidavit would be premature. The examiner reviewing the § 1.131 affidavit would not *sua sponte* utilize the closed Office records of another, De Oliveira, to substantiate for the benefit of another, the patent owner Baratta, the presence of the subject matter of the patent being reexamined in the abandoned application. Thus, Petitioner would not need a copy of the abandoned application and will not be permitted to place himself into a position of obtaining such a copy merely due to an unevaluated claim of priority by the patent owner to an earlier abandoned application by another, which application is not available to the public. Moreover, even as to the patent owner relying on the abandoned application, there would still be a significant issue as to whether the patent owner could convince the examiner that the disclosure of the prior application belonged to the patent owner and not to the inventor named in the abandoned application, particularly if there were an executed § 1.63 declaration by De Oliveira.

Accordingly, the petition for access is Dismissed.

DECISION ON PETITION UNDER 37 CFR 1.182

Petitioner has requested in the alternative, should the petition for access be dismissed, an Order denying the Patent Owner's "claim of due diligence from the abandoned application. " Petition at page 3.

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).

The patent owner is free to utilize any means for overcoming the prior art as is available to the patent owner, such as an affidavit under § 1.131. Whether the patent owner can make the showings required by the affidavit is another matter. The mere fact that Petitioner's premature claim for access (and one that should ultimately be unnecessary as the Patent Owner would need to make the file of record in the reexamination so as to rely on the disclosure therein) to an abandoned application not open to the public has been appropriately dismissed, does not provide sufficient basis to strip the patent owner from any potential basis for overcoming the prior art.

Accordingly, the petition for issuance of an Order pursuant to 37 CFR 1.182 is Dismissed.

FEES

1. The file record reveals that a single petition fee of $130 has been submitted
2. The petition fee set forth in 37 CFR 1.17(g) for the present petition under 37 CFR 1.14(h) is $200, resulting in a deficiency of $70.
3. The petition fee set forth in § 1.17(f) for the present petition under 37 CFR 1.182 is $400, resulting in a deficiency of $400.
4. The total deficiency of $470 ($70, and $400) will be charged to Petitioner's Deposit Account No. 03-2030, in accordance with Petitioner's authorization on page 4 of the petition.

Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
(571) 272-7707

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.
90/008,654	05/21/2007	5861666	8192.002	1248

7590 10/30/2008

EXAMINER	

LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 10/30/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET, 53rd FLOOR
HOUSTON, TX 77002

Date:

MAILED

OCT 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008654
PATENT NO. : 5861666
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

OCT 30 2008

CENTRAL REEXAMINATION UNIT

Daryl K. Neff : (For Patent Owner)
LERNER DAVID LITTENBERG :
KRUMHOLZ & MENTLIK :
600 SOUTH AVENUE WEST :
WESTFIELD NJ 07090 :

Tracy Druce : (For Third Party
NOVAK DRUCE & QUIGG, LLP :
(NDQ REEXAMINATION GROUP) :
1000 LOUISIANA :
WELLS FARGO PLAZA :
53RD FLOOR :
HOUSTON, TX 77002 :

: DECISION
: GRANTING-IN-PART
: PETITION FOR EXTENSION
: OF TIME
: [37 CFR § 1.550(c) and § 1.181]

In re: Bellaar :
Ex Parte Reexamination Proceeding :
Control No. 90/008,654 :
Deposited on: 21 May 2007 :
For: US Patent No. 5, 861,666 :

This is a decision on the 27 October 2008, petition for "Petition to Reset Period of Response and/or for Extension of time to respond," pursuant to 37 CFR § 1.550 (c) and §1.181 requesting that the time for responding to the Office action mailed 30 September 2008, be reset and or extended by one-month.

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

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

Decision

The Patent Owner requests the period be reset and/or an extension of time in which to file a response to the Office action mailed 30 September 2008, which set a one-month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 27 October 2008, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

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

Analysis and Findings

The petitioner petitions under 37 CFR § 1.181 to correct the period for response from one-month to two-months since there is no litigation involving any claim of the '666 patent. The petitioner correctly notes that the record is now clarified as to whether there is not outstanding litigation for which a reduced shortened statutory period for response should be reset. As such, the response period for response to the outstanding Office action should have been set for the two-months shortened statutory period, rather than a period of one-month. Clarification in this matter justifies a period of two-months response and this petition grants the extension of time for response to two-months.

The petitioner further petitions pursuant to 37 CFR § 1.550 (c) for extension of time based upon currently pending reexamination proceedings. Since the period for has been addressed in the clarification of litigation, *supra*, the petition under 37 CFR § 1.550(c) is dismissed as moot.

The petition request is hereby **granted-in-part** 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 30 September 2008 is hereby **granted-in-part**

2. The period for response is extended by one-month.

3. The Patent Owner's response is due **30 November 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, or Eric Keasel at (571) 272-4929 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

Gregory Morse
Director,
Central Reexamination Unit 3999

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

The Hamilton Law Firm PC
8555 W. Belleview Ave.
G21-139
Littleton, CO 80123

(For Patent Owner)

MAILED

JAN 28 2008

CENTRAL REEXAMINATION UNIT

Faegre & Benson LLP
Patent Docketing
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901

(For Patent Owner)

Barry L. Haley
Malin Haley & Di Maggio PA
1936 South Andrews Avenue
Fort Lauderdale, FL 33316

(For 3rd Party Requester)

Abraham Hershkovitz
Hershkovitz and Associates
2845 Duke Street
Alexandria, VA 22314

(For 3rd Party requester)

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

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

DECISION MERGING REEXAMINATION PROCEEDINGS

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

Reexamination in application control No. 90/007,576 was ordered in a decision mailed August 9, 2005. A number of Office actions have been issued and a number of responses have been filed in the instant proceeding. The last paper that has been recorded is an amendment filed by patent owner on September 11, 2007, which amendment is responsive to an Office action mailed July 12, 2007. Claims have been amended and added, and the specification has been amended as well by virtue of amendments filed October 24, 2006, March 20, 2007, and the afore-mentioned amendment filed September 11, 2007.

Reexamination in application control No. 90/008,655 was ordered in a decision mailed June 20, 2007. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines.

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

As noted above, the claims and specification have been amended in the '7,576 reexamination proceedings by virtue of the amendments filed October 24, 2006; March 20, 2007; and September 11, 2007. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in both files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims and specification in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

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

Dual Correspondence

Currently, patent owner appears to be represented by two different representatives. In reexamination proceeding control No. 90/007,576, patent owner is represented by the Hamilton Law Firm per the Power of Attorney papers filed September 13, 2006. In reexamination control No. 90/008,655, patent owner is represented by the law firm of Faegre & Benson, which is the representative of record in the file of the patent undergoing reexamination (i.e., serial number 07/558,651). Under 37 CFR 1.33(a), the Office will not engage in double correspondence with more than one registered attorney or agent except as deemed necessary by the Director. Accordingly, the patent owner is hereby required to notify the Office who his single

representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision.

Conclusion

Reexamination Control Nos. 90/007,576 and 90/008,655 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in both files and to name but a single representative.** Upon receipt of the response, an Office action will issue in due course.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

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.
90/008,662	05/25/2007	7017874	INNOFF 3.5-005 CONTDIVIIA	4687

530 7590 04/30/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/30/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,974	12/21/2007	7017874	INNOFF 3.5-005 CDIIB	4769

530 7590 04/30/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/30/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

Stephan B. Goldman
LERNER, DAVID, LITTENBURG,
KRUMHOLZ & MENTLIK
600 South Avenue West
Westfield, NJ 07090

(for Patent Owner)

MAILED

APR 30 2008

CENTRAL REEXAMINATION UNIT

David R. Bailey
WOODCOCK WASHBURN LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891

Amy E. Allen Hinson
NEXSEN PRUET, LLC
201 West McBee Avenue
Suite 400
Greenville, SC 29603

(for Third Party Requester)

In re Oddsen, Jr.
Ex Parte Reexamination Proceeding
Control No.: 90/008,662
Filed: May 25, 2007
For: U.S. Patent 7,017,874

In re Oddsen, Jr.
Ex Parte Reexamination Proceeding
Control No.: 90/008,974
Filed: December 21, 2007
For: U.S. Patent 7,017,874

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 3900 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 7,017,874 issued March 28, 2006, is the subject of Reexamination Control Nos. 90/008,662 and 90/008,974.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,662 ('8662), was filed May 25, 2007 by David R. Bailey of Woodcock Washburn LLP in Philadelphia, PA. The request urged that a substantial new question of patentability was raised by the teachings of U.S. Patent No. 5,490,652 to Martin, U.S. Patent No. 5,971,268 to Lynch, U.S. Patent No. 4,574,671 to Alessio and a handbook. None of these references were cited in the prosecution of U.S. Patent No. 7,017,874.

3. Reexamination was ordered for '8662 on June 22, 2007.

4. A second request for reexamination, assigned Reexamination Control No. 90/008,974 ('8974), was filed December 21, 2007 by Amy E. Allen Hinson of Nexsen Pruet, LLC in Greenville, SC. The request urged that a substantial new question of patentability was raised by the teachings of U.S. Patent No. 4,220,054 to Kuhlman and U.S. Patent No. 5,490,652 to Martin. Kuhlman was not cited in the prosecution of U.S. Patent No. 7,017,874.

5. Reexamination was ordered for '8974 on February 28, 2008.

DISCUSSION

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

If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* 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 90/008,662 and 90/008,874 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control No. 90/008,662 as:

Reexamination Control Ns. 90/008,662 and 90/008,974

Stephen B. Goldman
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 South Avenue West
Westfield, NJ 07090

A copy of all correspondence from the USPTO will be served on the third party requesters at the address listed in Reexamination Control Nos. 90/008,662 and 90/008,974, respectively as:

David R. Bailey
WOODCOCK WASHBURN LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891; and

Amy E. Allen Hinson
NEXSEN PRUET, LLC
201 West McBee Avenue
Suite 400
Greenville, SC 29603

CONCLUSION

Reexamination Control Nos. 90/008,662 and 90/008,974 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

Lissi M. Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Lerner, David, Littenberg, Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 07090

(For Patent Owner)

David R. Bailey
Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891

(For 3rd Party Requester)

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SEP 04 2008

CENTRAL REEXAMINATION UNIT

Amy E. Allen Hinson
Nexsen Pruet, LLC
201 W. McBee Avenue, Suite 400
Greenville, SC 29603

(For 3rd Party Requester)

Reexam Control No.: 90/008,663
Filed : May 25, 2007
For U.S. Patent No. : 7,066,433

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/009,050
Filed : February 21, 2008
For U.S. Patent No. : 7,066,433

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. 90/008,663 was ordered in a decision mailed July 11, 2007 indicating that claims 1-2, 6-13, 16-20, 22, 24-29, and 32-36 would be reexamined. Prosecution has progressed to the point where an amendment was filed December 21, 2007, amending claims 1, 9, 12, 17-19, 23, 25, and 28, and cancelling claims 16 and 24. No further action has taken place since the filing of the amendment.

Reexamination in application control No. 90/009,050 was ordered in a decision mailed April 9, 2008 indicating that claims 1-2, 6-13, 16-20, 22-29, and 32-36 would be reexamined. Patent

Owner filed a "Waiver of Patent Owner's Statement" on April 28/08.No further action has taken place since the filing of the waiver. Thus, there are no changes to the specification, claims, or drawings in this proceeding.

As evidenced by the above facts, reexamination control No. 90/008,663 and reexamination control No. 90/009,050 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, certain claims have either been amended or cancelled in the '663 reexamination proceeding by virtue of the amendment filed December 21, 2007. No amendment has been filed in the '050 proceeding. Patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-2, 6-13, 17-20, 22-23, 25-29, and 32-36, the only live claims for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,663 and 90/009,050 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this**

decision within which to submit a "housekeeping" amendment placing the same claims in each of the files. Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,665	05/25/2007	6284478	12008.6USR3	3355

23552 7590 11/23/2007

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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.
90/007,913	02/01/2006	6284478	518852800200	5776

21003 7590 11/23/2007

BAKER BOTTS L.L.P.
30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK, NY 10112-4498

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2007

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Mailed :

DDJ

Walter M. Egbert, III
BAKER BOTTS, L.L.P.
30 Rockefeller Plaza
New York, NY 10112

(for Patent Owner)

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

(for Third Party Requester)

In re Heller et al.
Reexamination Proceeding
Control No.: 90/007,913
Filed: February 1, 2006
For: U.S. Patent 6,284,478

In re Heller et al.
Reexamination Proceeding
Control No.: 90/008,665
Filed: May 25, 2007
For: U.S. Patent 6,284,478

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,284,478 issued September 4, 2001, is the subject of Reexamination Control Nos. 90/007,913 and 90/008,665.

2. A first request for Reexamination, assigned Reexamination Control No. 90/007,913 was filed February 1, 2006 by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1-74.

3. Reexamination was ordered for 90/007,913 on February 24, 2006.

4. A first non-final Office action for 90/007,913 was mailed on November 29, 2006.

5. Patent Owner filed a response on February 1, 2007.

6. A second request for Reexamination, assigned Reexamination Control No. 90/008,665, was filed May 25, 2007 by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references in combination with previously cited references regarding claims 1-3, 9, 22-30, 32-35, 39-41, 43-46, 52-59, 61, 64, 66, 67, and 69-74.

7. Reexamination was ordered for 90/008,665 on July 31, 2007.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,913 and 90/008,665 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing of this decision placing identical claims in both files. The paper should be strictly limited to the bare presentation of amendments.** Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the Patent Owner's representative address listed in Reexamination Control Nos. 90/007,913 and 90/008,665 as:

Reexamination Control Ns. 90/007,913 and 90/008,665 as:

Walter M. Egbert, III
BAKER BOTTS, L.L.P.
30 Rockefeller Plaza
New York, NY 10112

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control No. 90/007,913 and 90/008,665 as:

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

CONCLUSION

Reexamination Control Nos. 90/007,913 and 90/008,665 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,667	06/21/2007	6320819	NNYA 04011 D1RX	4093

4372 7590 11/14/2008

EXAMINER	

ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

ART UNIT	PAPER NUMBER

DATE MAILED: 11/14/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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NOV 14 2008

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JOHN J. PATTI

STORM LLP

901 MAIN STREET SUITE 7100

DALLAS TX 75202

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008667

PATENT NO. 6,320,819

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

Sharon Smith
ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON DC 20036

(For Patent Owner)

John J. Patti
STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

(For Third Party Requester)

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NOV 14 2008

CENTRAL REEXAMINATION UNIT

Wen Liu
LIU & LIU
444 S. FLOWER STREET
SUITE 1750
LOS ANGELES, CA 90071

(For Third Party Requester)

DECISION,
SUA SPONTE
MERGING
REEXAMINATION
PROCEEDINGS

In re: Tomita *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,667
Deposited: 15 May 2007
For: US Patent No. 6,320,819

In re: Tomita *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,076
Deposited: 12 march 2008
For: US Patent No 6,320,819

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. 6,320,819 issued on 20 November 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,667 was requested by a third party requester deposited on 15 May 2007.

3. The Reexamination Order was granted in proceeding, control no. 90/008,667 on 3 August 2007

4. There are currently no amendments proceeding control number 90/008,667.

5. *Ex Parte* Reexamination Proceeding, control no. 90/009,076 was requested by a third party requester deposited on 12 March 2008.

6. The Reexamination Order was granted in proceeding, control no. 90/009,076 on 27 May 2008.

7. There are currently no amendments proceeding control number 90/009,076.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,667 and 90/009,076 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 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.

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. 90/008,667 and 90/009,076 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

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

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

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

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

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 or 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 A. Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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CENTRAL REEXAMINATION UNIT

Abraham Hershkovitz
HERSHKOVITZ & ASSOCIATES
2845 Duke Street
Alexandria, VA 22314

(For Patent Owner)

Arthur J. Steiner
Ditthavong, Mori & Steiner, P.C.
918 Prince Street
Alexandria, VA 22314

(For Third Party Requester)

In re Terry L. Geer
Reexamination Proceeding
Control No.: 90/008,671
Filed: May 31, 2007
For: U.S. Patent No.: 5,583,759

DECISION ON PETITION UNDER 37 CFR 1.182/1.183

This is a decision on the December 20, 2007 patent owner petition under 37 CFR 1.182, and alternatively under 37 CFR 1.183, 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 20, 2007, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,583,759 issued on December 10, 1996.
2. A request for reexamination, assigned control No. 90/008,671 (the '8671 proceeding), was filed on May 31, 2007, by a third party requester.
3. On June 22, 2007, the Office issued an order granting the '8671 reexamination request.
4. The'8671 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on November 19, 2007.
5. On December 20, 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.)

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 made a factual accounting to explain why the information is being submitted so late. And, the patent owner has not provided a discussion of the substance of the information, explaining 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 only makes the general statement that the information being submitted came to light in recent months as litigation documents were received. This is not a factual accounting in accordance with MPEP 2256 guidance. A factual accounting would include the presentation of when the patent owner became aware of the information and an explanation as to why it could not be submitted earlier, e.g. the patent owner did not become aware of the information until after an NIRC was issued. Based upon the statement by patent owner that awareness of the information was in "recent months" it is reasonable to conclude patent owner's awareness arose prior to issuance of the NIRC. The patent owner makes no factual accounting of the events between the time of the information came to their attention and the filing of the December 20, 2007 IDS. However, patent owner does state that due to the voluminous nature of the information no efforts were made to determine relevancy of the information. Therefore, it is unclear as to why there would have been any delay whatsoever in the submission of the information once received, since patent owner did not take any time to discern the content. Accordingly, patent owner has failed to satisfy the requirements for submission of a post NIRC IDS in accordance with MPEP 2256 item (A).

In regard to explaining the relevance of the submitted information (B), the patent owner has expressly stated on the record in the petition that "Patent Owner is not aware of any specific relevance of any documents cited herein." Accordingly, patent owner has failed to satisfy the requirements for submission of a post NIRC IDS in accordance with MPEP 2256 item (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 November 19, 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.

As to the aspect of the petition under 37 CFR 1.183, that regulation 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.

The procedure set forth in MPEP 2256 is grounded on 35 U.S.C. 305 which states that "[a]ll reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office." Consideration of the submitted IDS information in this instance without a description of information submitted, as it relates to the claims, and without an explanation of why the information could not be submitted sooner, runs counter to 35 U.S.C. 305; and 37 CFR 1.183 precludes waiver of a "requirement of the statutes." In addition, petitioner has given no reason why petitioner cannot simply file a new reexamination proceeding to obtain consideration of the information submitted, and also, why petitioner cannot go through the information and determine which references are relevant and why.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on December 20, 2007.

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

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

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

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

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2-5-08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,680	06/01/2007	7085729	1180.0663R	2293

53184 7590 10/09/2009

i2 TECHNOLOGIES US, INC.
11701 LUNA ROAD
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2009

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
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FAIRFAX, VA 22030

Date:
MAILED
OCT 09 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008680
PATENT NO. : 7085729
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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(Patent Owner)

MAILED

OCT 09 2009

Paul A. Harrity
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11350 Random Hills Road, Suite 600
Fairfax, VA 22030

(Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re Kennedy *et al.*
Reexamination Proceeding
Control No.: 90/008,680
Filed: June 1, 2007
For: U.S. Patent No.: 7,085,729

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

This is a decision on the April 13, 2009 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this 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 13, 2009, has not been entered for consideration by the examiner.

FEE

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. 50-0777 in accordance with petitioner's authorization in the April 13, 2009 petition.

BACKGROUND

1. On August 1, 2006, the Office issued U.S. Patent No. 7,085,729, to Kennedy *et al* (the '729 patent).
2. On June 1, 2007, a third party requester filed a request for *ex parte* reexamination of the '729 patent. The request was assigned reexamination control number 90/008,680 (the '8680 proceeding).
3. On July 13, 2007, the Office issued an order granting reexamination for the '8680 reexamination request.

4. Prosecution progressed to the point where, on March 30, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '8680 proceeding.

5. On April 10, 2009, the '8680 proceeding was designated 452 status as entering the print cycle.

6. On April 13, 2009, patent owner filed the instant petition accompanied by an IDS, which patent owner requests the Office to consider.

7. The '8680 reexamination proceeding is in the final phase of the publication process for printing the reexamination certificate (*i.e.* 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.)

MPEP 2256

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present 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 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the reexamination proceeding, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. Nor has patent owner filed an amendment to the claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable. To the contrary, patent owner merely states that the items of information are all being submitted in light of the facts and decision of *Larson Mfg. Co. of S.D. v. Aluminart Products Ltd.*, 559 F.3d 1317 (Fed. Cir. 2009). Moreover, the patent owner does not provide a discussion of the substance of any of the items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

Furthermore, there is no factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. Presumably, patent owner was aware of the existence of the items of information now being submitted, but chose not to do so until the issuance of the *Larson* decision by the Court of Appeals for the Federal District Court in March 2009. Therefore, a factual accounting as to why the information was not submitted that covers the time period from when patent owner first discovered the information until submission is needed. Accordingly, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after a NIRC has been mailed and the proceeding has entered the printing cycle.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." It is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory provision for special dispatch, and such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is explicitly set forth in the MPEP, as set forth above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on March 30, 2009, and the proceeding has now entered the final stages of the publication process, *i.e.* the print cycle, as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the

requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure explain why it could not have been submitted earlier, the failure to identify a question of patentability of the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the 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. The proceeding will 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).

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.

In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on April 13, 2009.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic file 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.
90/008,689	08/20/2007	6,317,631	2206-017RE	5484

54042 7590 12/12/2007

WOLF, BLOCK, SHORR AND SOLIS-COHEN LLP
250 PARK AVENUE
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2007

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CENTRAL REEXAMINATION UNIT

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In re Shlomo Ben-Haim et al.)
Reexamination Proceeding) **DECISION DISMISSING**
Control No. 90/008,689) **PATENT OWNER PETITION**
Filed: August 20, 2007) **FOR ENTRY OF CDS**
For: U.S. Patent No. 6,317,631)

This is a decision on the November 20, 2007 patent owner petition under 37 CFR 1.183 requesting a waiver of 37 CFR 1.2, to allow patent owner to provide the copies of references on a disk to fulfill the submission requirement of 37 CFR 1.98(a)(2). The petition is also being taken as a request to waive 37 CFR 1.52(e).

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

The petition is dismissed for the reasons set forth below.

PERTINENT REGULATIONS AND EXAMINATION PRACTICE

37 CFR § 1.52(e) states:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

(I) A computer program listing (see 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).

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

37 CFR 1.98 (a) provides:

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

...

(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 1.183 (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]

The Legal Framework For EFS-Web, as of July 2007, provides:

I. Introduction - Scope of Document

This Legal Framework provides guidance on the background statutes, regulations and policies that support the Electronic Filing System - Web (EFS-Web) project. The document is provided as a reference for applicants, parties in reexamination proceedings, attorneys, and agents, as well as their staffs using the system.

III. EFS-Web

The EFS-Web interface is a streamlined approach to eFiling. EFS-Web integrates well with the current workflow for most inventors (applicants), reexamination parties, law firms, and corporations and other business entities. EFS-Web collects minimal data elements on screen. Needed patent information, however, is collected on form fillable PDF, or user created PDF files attached to the submission.

...

IV. Relevant Statutes and Rules

35 USC 111 - filing a patent application
35 USC 302, 311 - filing a request for reexamination
37 CFR 1.52 - form of an application/reexamination
37 CFR 1.4 - signatures
37 CFR 1.6 - receipt of correspondence

XXII. May a reissue application or a request for reexamination, and follow on papers be submitted via EFS-Web?

Yes, the Summer 2007 update to EFS-Web permits a user to electronically submit a reissue application under 35 USC 251 and follow-on papers, a request for ex parte reexamination under 35 USC 302 and follow-on papers, or a request for inter partes reexamination under 35 USC 311 and follow-on papers. In reexamination, both the reexamination requester and the patent owner may file via EFS-Web.

ANALYSIS

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. [1] None of the information proposed to be filed on CD-ROM falls into any of the categories listed in 37 CFR 1.52(e)(1). (In addition, the files are presumably not ASCII data files as required by 37 CFR 1.52(e)(3)(i)). Accordingly, these files may 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 would be deemed an "extraordinary" situation where "justice requires" that the rules be waived to permit entry of a CD-ROM containing copies of references into the record of the reexamination proceeding.

As a basis for seeking relief, patent owner relies upon the burden on the Office of scanning a voluminous amount of paper. However, as of the date of the present decision, patent owner may now submit the documents in question utilizing the electronic EFS-Web filing system. Filings that utilize the EFS-Web system will become part of an electronic Image File Wrapper (IFW), which stores the filings as electronic image files, not as paper documents. Therefore, there is no longer a cost or storage burden on the Office with respect to documents filed, when the EFS-Web electronic filing system is utitlized. It is also to be noted that documents so filed are available to the patent owner, and the patent owner may therefore elect to utilize such storage, and/or storage on CD or other electronic medium, to reduce the burdens of storage and costs on patent owner. Therefore, patent owner has not demonstrated an entitlement to relief under 37 CFR 1.183. Accordingly, no waiver of the rule is appropriate.

CONCLUSION

1. The petition is dismissed.

2. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit.

3. Inquiries with respect to this decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

---

[1] Patent owner proposes submission of a disk. It is not clear whether this is intended to mean a compact disc (CD) in compliance with 37 CFR 1.52(e), or whether patent owner is requesting waiver of the required format as well. For the balance of this decision it will be presumed that patent owner is requesting to file on a medium approved under 37 CFR 1.52(e).

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

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UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 06 2007

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

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

(For Third Party Requester)

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

(For Third Party Requester)

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

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

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

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

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

REVIEW OF RELEVANT FACTS

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

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

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

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

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

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

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

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

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

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

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

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

DECISION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte*

reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '7577, '7691, and '8690 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, the claims have been amended in the '7577 and '7691 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,577, 90/007,691, and 90/008,690 are **merged**.

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

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

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

Eric Keasel For

ERIC S. KEASEL
CRU SPE-AU 3992

Lissi Mojica Marquis
Director, Central Reexamination Unit

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United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

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

PATENT NO. 5,982,921.

ART UNIT 3992.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,690	07/20/2007	5,982,921	586852800200	4179

32588 7590 03/04/2009

APPLIED MATERIALS, INC.
P. O. BOX 450A
SANTA CLARA, CA 95052

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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In re Alumot *et alia*
Reexamination Proceeding
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Request Deposited: June 3, 2005
For: U.S. Patent No. 5,982,921

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

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

: DECISION DISMISSING
: PETITION FOR EXTENSION
: OF TIME
: UNDER 37 CFR 1.550

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the February 25, 2009, "REQUEST FOR EXTENSION OF TIME FOR RESPONSE PURSUANT TO 37 C.F.R 1.550" requesting that the time to submit a Patent Owner Appeal Brief be extended two months.

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

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

REVIEW OF RELEVANT FACTS

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

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

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

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

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

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

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

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

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

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

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

12. The '7577, '7691, and '8690 proceedings were merged on December 6, 2007.

13. A non-final rejection was mailed on February 7, 2008.

14. An amendment was timely filed on April 7, 2008.

15. A final rejection was mailed on August 5, 2008.

16. An after-final response was filed on August 13, 2008.

17. An advisory action was mailed on November 10, 2008.

18. A Notice of Appeal, a second after-final response, and the present petition were filed on January 5, 2009.

19. An advisory action was mailed on February 19, 2009 withdrawing 35 USC 305 rejections of claims 41-45, 47-49, 63-65 as well as other rejections.

20. On February 25, 2009, the present petition was filed.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner Appeal Brief. The present petition for extension of time was timely filed on February 25, 2009.

37 CFR §1.550(c) states:

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

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

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

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

Analysis and Findings

Initially, it noted that Patent Owner states "[n]o fee is believed to be due". However, 37 CFR §1.550(c) clearly states

> Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g).

An authorization to charge Deposit Account No. 06-1050 is given in the petition. Accordingly, the required fee has been applied to said Deposit Account No.

The petition lacks a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and why, in spite of the action taken thus far, the requested additional time is needed.

The present petition notes that a petition filed January 5, 2009 has not yet been decided as of the filing date of the present petition. Petitioner attention is directed to 37 CFR 1.181(f), which states, in part, "[t]he mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings."

CONCLUSION

1. Petitioner's request is **dismissed**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

By Mail to: Mail Stop *Ex Parte* Reexam
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United States Patent & Trademark Office
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Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

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

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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.
90/008,690	07/20/2007	5,982,921	586852800200	4179

32588 7590 03/04/2009

APPLIED MATERIALS, INC.
P. O. BOX 450A
SANTA CLARA, CA 95052

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2009

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

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MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

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

PATENT NO. 5,982,921.

ART UNIT 3992.

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

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

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

: DECISION DISMISSING
: PETITION TO
: WITHDRAW FINALITY
: UNDER 37 CFR 1.181

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the January 5, 2009, "PETITION UNDER 37 C.F.R §1.181 TO WITHDRAW FINALITY OF OFFICE ACTION".

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

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

REVIEW OF RELEVANT FACTS

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

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

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

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

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

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

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

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

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

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

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

12. The '7577, '7691, and '8690 proceedings were merged on December 6, 2007.

13. A non-final rejection was mailed on February 7, 2008.

14. An amendment was timely filed on April 7, 2008.

15. A final rejection was mailed on August 5, 2008.

16. An after-final response was filed on August 13, 2008.

17. An advisory action was mailed on November 10, 2008.

18. A Notice of Appeal, a second after-final response, and the present petition were filed on January 5, 2009.

19. An advisory action was mailed on February 19, 2009 withdrawing 35 USC 305 rejections of claims 41-45, 47-49, 63-65 as well as other rejections.

20. On March 4, 2009, the office mailed a PTO-90C indicating that the 35 USC 305 rejections of claims 34-36, 46, and 56-58 were withdrawn.

DECISION

Patent Owner argues that the presence of a 35 USC 305 rejection of claims 34-36, 41-49, 56-58, and 63-65 in the office action mailed August 5, 2008 were not necessitated by the most current amendment. So, the office action can not properly be made final. In the advisory action mailed February 19, 2009 and the letter mailed March 4, 2009, all of the rejections in question (as well as others) have been withdrawn. It is noted that the rejection of claim 47 is withdrawn in the advisory action as indicated by claim 47 being indicated as patentable and/or confirmed in box 6 of the advisory. Since the underlying basis for the requested relief no longer exists, the petition is dismissed as moot and the office action mailed August 5, 2008 remains a final rejection.

CONCLUSION

1. Petitioner's request is **dismissed as moot**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

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

Eric Keasel For

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 15 2008

CENTRAL REEXAMINATION UNIT

Niels Haun
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FOR PATENT OWNER

Susan G. L. Glovsky
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FOR THIRD PARTY REQUESTER

In re Louis C. Argenta et al.
Reexamination Proceeding
Control No. 90/008,692
Filed: June 11, 2007
For: U.S. Patent No. 5,645,081

DECISION DISMISSING PATENT OWNER PETITION FOR ENTRY OF CDS

This is a decision on the December 26, 2007 patent owner petition under 37 CFR 1.183 requesting suspension of the rules, to allow patent owner to submit the copies of references on CD-ROM to fulfill the submission requirement of 37 CFR 1.98(a)(2). The petition is also being taken as a request to waive 37 CFR 1.52(e).

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

The petition is dismissed for the reasons set forth below.

PERTINENT REGULATIONS AND EXAMINATION PRACTICE

37 CFR § 1.52(e) states:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> > (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:
> >
> > > (I) A computer program listing (see 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).

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(I) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

37 CFR 1.98 (a) provides:

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

...

(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 1.183 (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 1.555 (b) provides:

> (b) Under this section, information is material to patentability in a reexamination roceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and
>
> > (1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or
> >
> > (2) It refutes, or is inconsistent with, a position the patent owner takes in:
> > (i) Opposing an argument of unpatentability relied on by the Office, or
> > (ii) Asserting an argument of patentability.
>
> A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

ANALYSIS

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. None of the information presently proposed to be filed on CD-ROM falls into any of the categories listed in 37 CFR 1.52(e)(1). Accordingly,the submission of files to the Office on a compact disk as proposed is prohibited, absent a waiver of the rule.

Petitioner contends that the present situation should be deemed an "extraordinary" situation where "justice requires" that the rules be waived to permit entry of a CD-ROM containing copies of references into the record of the reexamination proceeding. In support of this position, petitioner states (a) that the submitted CDs comply with the relevant portions of 37 CFR 1.52, (b) that patent owner would like to disclose information accumulated during the 10 years since the patent has issued, (c) that the time to be expended for submission of this information by means of EFS-Web is estimated to exceed 13 hours, and finally, (d) that petitioner has experienced system problems in uploading information via EFS-Web in a related case.

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, patent owner requests a waiver of the rules governing submission of documents to the Office based upon the difficulties petitioner has encountered in filing the documents electronically.

The fact that petitioner has experienced problems with EFS-Web is not persuasive. Patent Owner may submit the documents on paper. Office systems as currently configured do not have the capability of directly uploading files from a CD into the IFW system. If the Office were to accept the six CDs, the burden would be shifted on to the Office to print out all the documents contained in the CDs to then scan

them into the IFW, *along with the logistics of insuring that each document is accurate and complete and that all documents are properly included.* In addition, a review of the CDs reveals that, contrary to petitioner's assertions, the CDs are not in compliance with the relevant portions of rule 52 as petitioner alleges; rather, the files are in PDF format and are thus not ASCII data files as required by 37 CFR 1.52(e)(3)(I).

It is to be noted that the duty to disclose under 37 CFR 1.555 is limited to "information material to patentability" as defined in 37 CFR 555(b), which specifically excludes material which is "cumulative to information of record or being made of record." Patent Owner is urged to review the materials and to limit the submission to documents that are material to patentability. As it now stands, patent owner appears to be submitting a bulk of "information accumulated over 10 years," without any indication of whether the information is material to examination. Thus, the granting of the petition could potentially create a situation in which the Office aided in submission of irrelevant prior art, thereby hindering justice by overly burdening the record with material which could interfere with the examiner's ability to effectively examine the claims at issue, and would delay the examination of the proceeding contrary to the mandate for "special dispatch" in examination of 35 U.S.C. 305.

For the reasons stated above, patent owner has not demonstrated an entitlement to relief under 37 CFR 1.183. Accordingly, no waiver of the rule is appropriate.

In the event that petitioner files one set of documents in compliance with the rules in one case and an Information Disclosure Statement (IDS) with the identical documents is filed in a related case, petitioner may wish to consider filing a petition under 37 CFR 1.183 requesting waiver of the formal submission requirements of an IDS under 37 CFR 1.555 and 1.98 and transfer of copies of the documents to the related case.

CONCLUSION

1. The petition is dismissed.

2. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit.

3. Inquiries with respect to this decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

Kenneth M. Schor

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

c:\Kiva\kenids\decisions\8692_CD_no_waiver_to_accept.wpd
1-11-08

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Alexandria, VA 22313-1450
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Dann, Dorfman, Herrell & Skillman
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(For Patent Owner)

MAILED

JAN 2 1 2009

CENTRAL REEXAMINATION UNIT

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

(For 3rd Party Requester)
90/008,692

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(For 3rd Party Requester)
90/010,186

Reexam Control No.: 90/008,692
Filed : June 11, 2007
For U.S. Patent No. : 5,645,081

Reexam Control No.: 90/010,186
Filed : June 3, 2008
For U.S. Patent No. : 5,645,081

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. 90/008,692 was ordered in a decision mailed September 4, 2007 indicating that claims 1-6, 8, 11, 13-14, 16-17, 30, 39-44, 46, 49, 54-59, 61, and 64 would be reexamined. A non-final Office action was mailed February 28, 2008. Patent Owner filed a response on April 28, 2008. Since then, a number of Information Disclosure Statements and Notifications of Concurrent Proceedings have been filed. There are no amendments to the claims, specification or drawings in this reexamination proceeding.

Reexamination in application control No. 90/010,186 was ordered in a decision mailed August 28, 2008 indicating that claims 1-82, all of the claims in the patent, would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. A number of Information Disclosure Statements and Notifications of Concurrent Proceedings have been filed. There are no amendments to the claims specification or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/008,692 and reexamination control No. 90/010,186 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 1-82, 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 requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,692 and 90/010,186 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 01/16/2008

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/16/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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FOR PATENT OWNER

Susan G. L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, Massachusetts 01742

FOR THIRD PARTY REQUESTER

MAILED

JAN 16 2008

CENTRAL REEXAMINATION UNIT

In re Louis C. Argenta et al.
Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

DECISION DISMISSING PATENT OWNER PETITION FOR ENTRY OF CDS

This is a decision on the January 7, 2008 patent owner petition under 37 CFR 1.183 requesting suspension of the rules, to allow patent owner to submit the copies of references on CD-ROM to fulfill the submission requirement of 37 CFR 1.98(a)(2). The petition is also being taken as a request to waive 37 CFR 1.52(e).

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

The petition is dismissed for the reasons set forth below.

PERTINENT REGULATIONS AND EXAMINATION PRACTICE

37 CFR § 1.52(e) states:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> > (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

(I) A computer program listing (see 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).

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(I) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

37 CFR 1.98 (a) provides:

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

...

(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 1.183 (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 1.555 (b) provides:

(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:
(i) Opposing an argument of unpatentability relied on by the Office, or
(ii) Asserting an argument of patentability.

A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

ANALYSIS

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. None of the information presently proposed to be filed on CD-ROM falls into any of the categories listed in 37 CFR 1.52(e)(1). Accordingly, the submission of files to the Office on a compact disk as proposed is prohibited, absent a waiver of the rule.

Petitioner contends that the present situation should be deemed an "extraordinary" situation where "justice requires" that the rules be waived to permit entry of a CD-ROM containing copies of references into the record of the reexamination proceeding. In support of this position, petitioner states (a) that the submitted CDs comply with the relevant portions of 37 CFR 1.52, (b) that patent owner would like to disclose information "struck-through" by the examiner "during the 6-year period of examination", (c) that the time to be expended for submission of this information by means of EFS-Web is estimated to exceed 9 hours, and finally, (d) that petitioner has experienced system problems in uploading information via EFS-Web in a related case.

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, patent owner requests a waiver of the rules governing

submission of documents to the Office based upon the difficulties petitioner has encountered in filing the documents electronically.

The fact that petitioner has experienced problems with EFS-Web is not persuasive. Patent Owner may submit the documents on paper. Office systems as currently configured do not have the capability of directly uploading files from a CD into the IFW system. If the Office were to accept the four CDs, the burden would be shifted on to the Office to print out all the documents contained in the CDs to then scan them into the IFW, *along with the logistics of insuring that each document is accurate and complete and that all documents are properly included.* In addition, a review of the CDs reveals that, contrary to petitioner's assertions, the CDs are not in compliance with the relevant portions of rule 52 as petitioner alleges; rather, the files are in PDF format and are thus not ASCII data files as required by 37 CFR 1.52(e)(3)(i).

It is to be noted.that the duty to disclose under 37 CFR 1.555 is limited to "information material to patentability" as defined in 37 CFR 555(b), which specifically excludes material which is "cumulative to information of record or being made of record." Patent Owner is urged to review the materials and to limit the submission to documents that are material to patentability. Patent owner appears to be submitting a bulk of information submitted "during the 6-year period over which the instant application was prosecuted" that applicant contends the examiner improperly struck-through and failed to consider, without any indication of whether the information is material to examination. The fact that applicant allowed the patent to issue without petitioning for the consideration of these documents is an indication that these documents were not considered, *by applicant*, to be material to patentability. Thus, the granting of the petition could potentially create a situation in which the Office aided in submission of irrelevant prior art, thereby hindering justice by overly burdening the record with documents which could interfere with the examiner's ability to effectively examine the claims at issue, and would delay the examination of the proceeding contrary to the mandate for "special dispatch" in examination of 35 U.S.C. 305.

For the reasons stated above, patent owner has not demonstrated an entitlement to relief under 37 CFR 1.183. Accordingly, no waiver of the rule is appropriate.

In the event that petitioner files one set of documents in compliance with the rules in one case and an Information Disclosure Statement (IDS) with the identical documents is filed in a related case, petitioner may wish to consider filing a petition under 37 CFR 1.183 requesting waiver of the formal submission requirements of an IDS under 37 CFR 1.555 and 1.98 and transfer of copies of the documents to the related case.

CONCLUSION

1. The petition is dismissed.

2. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit.

3. 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

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1-15-08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 10/14/2008

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2008

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

Susan G.L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road, P.O. Box 9133
Concord, MA 01742

Date:
MAILED
OCT 14 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 10/14/2008

DANN, DORFMAN, HERRELL & SKILLMAN
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2008

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

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IRVINE, CA 92614

Date:

MAILED

OCT 14 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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CENTRAL REEXAMINATION UNIT

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SABING H. LEE
KNOBBE MARTENS OLSON & BEAR L.L.P
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(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

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 RELEVANT FACTS

1. U.S. Patent No. 7,216,651 (the '651 patent) issued to Argenta *et al.* on May 15, 2007.

2. A request for *ex parte* reexamination of claims 1-13, 16-42, 44-51, 54-93, 95-98, 100-103, 105-109 and 111-125 of the '651 patent was filed on October 5, 2007, by third party requester

Susan G. L. Glovsky, and the request was assigned control number 90/008,693 (the '8693 *ex parte* proceeding).

3. On November 26, 2007, *ex parte* reexamination was ordered for claims 1-13, 16-42, 44-51, 54-93, 95-98, 100-103, 105-109 and 111-125 of the '651 patent based on the examiner's determination that the October 5, 2007 request raised a substantial new question of patentability affecting these claims.

4. On February 28, 2008, a non-final Office action was mailed in the '8693 *ex parte* proceeding, rejecting claims 1-13, 16-42, 44-51, 54-93, 95-98, 100-103, 105-109 and 111-125 of the '651 patent.

5. On April 28, 2008, patent owner filed a response to the February 28, 2008 Office action, requesting reconsideration of the rejections of the claims and proposing an amendment to claim 54.

6. A request for *inter partes* reexamination of claims 1-125 of the '651 patent was filed on May 30, 2008, by third party requester Sabing H. Lee, in which BlueSky Medical Group, Inc. and Smith & Nephew, Inc. were identified as the real parties in interest, and the request was assigned control number 95/001,048 (the '1048 *inter partes* proceeding).

7. On June 3, 2008, an examiner interview was conducted at the Office with the patent owner in the '8693 *ex parte* proceeding.

8. On August 4, 2008, *inter partes* reexamination was ordered for claims 1-125 of the '651 patent based on the examiner's determination that the May 30, 2008 request raised a substantial new question of patentability affecting these claims.

9. There has been no further Office action in the '1048 *inter partes* proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '8693 *ex parte* proceeding expired after January 26, 2008. [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 '1048 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.

[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 the parties.

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.

In accordance with 37 CFR 1.989(a), the 90/008,693 and 95/001,048 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

1. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since an amendment to claim 54 has been proposed in the '8693 *ex parte* proceeding, the claims are not currently the same in both files and a "housekeeping amendment" is needed to place the same amendment in both proceedings.

2. Patent owner is required to submit an appropriate "housekeeping amendment" within one month of this decision placing the same amendment in both files. The paper should be strictly limited to the bare presentation of the amendment. 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.

3. 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 claim 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]

---

[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 housekeeping 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.

4. In the event that the required housekeeping amendment (to place identical amendments in all (both) files) is not timely submitted, 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.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

It is noted that reexamination was ordered for claims 1-13, 16-42, 44-51, 54-93, 95-98, 100-103, 105-109 and 111-125 of the '651 patent in the '8693 *ex parte* proceeding, while reexamination was ordered for claims 1-125 of the '651 patent in the '1048 *inter partes* proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-125 of the '651 patent.

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

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

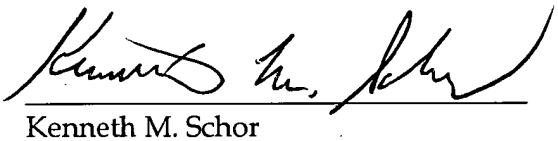
1. *Inter partes* Reexamination Control No. 95/001,048 and *ex parte* Reexamination Control No. 90/008,693 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

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 amendment in both files 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 amendment in both files, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the housekeeping amendment.

5. 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

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.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 06/30/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Susan G.L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road, P.O. Box 9133
Concord, MA 01742

Date:

MAILED

JUN 30 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
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.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 06/30/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
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PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2009

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Alexandria, VA 22313-1450
www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KNOBBE MARTENS
OLSON & BEAR LLP
2040 MAIN STREET 14TH FLOOR
IRVINE, CA 92614

Date:
MAILED
JUN 30 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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DONALD R. PIPER, JR. (For Patent Owner)
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PHILADELPHIA, PA 19103

MAILED

JUN 30 2009

CENTRAL REEXAMINATION UNIT

SUSAN G.L. GLOVSKY (For *Ex Parte* Requester)
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. OFFICE BOX 9133
CONCORD, MA 01742

SABING H. LEE (For *Inter Partes* Requester)
KNOBBE, MARTENS & OLSON & BEAR, LLP
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IRVINE, CA 92614

Ex Parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

DECISION DISMISSING PETITION

This is a decision addressing *inter partes* third party requester's May 12, 2009 petition paper entitled "THIRD PARTY REQUESTOR'S PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(B) REQUIREMENT."

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

DISCUSSION

On May 12, 2009, *inter partes* third party requester (hereinafter "requester") filed "THIRD PARTY COMMENTS ADDRESSING ISSUES RAISED BY THE FEBRUARY 12, 2009 OFFICE ACTION AND THE APRIL 13, 2009 PATENT OWNER'S REPLY" with accompanying exhibits and declarations. Concurrently, on May 12, 2009, requester filed the instant petition, requesting "the PTO pursuant to 37 C.F.R. § 1.183 to accept and consider all pages of the concurrently filed Comments with accompanying exhibits and declarations" only

"to the extent that the PTO may determine that Third Party Requestor has exceeded the 50-page limit set forth in 37 C.F.R. § 1.943(b)."[1]

Facially, *inter partes* requester's May 12, 2009 comments appear compliant with respect to the 50-page limit of 37 CFR 1.943(b), and currently there are no official notices of non-compliance from the Office of record in the instant merged reexamination proceeding, which would be in need of waiver.[2] The necessity of requester's request for relief is conditioned on the Office first determining that requester's May 12, 2009 comments in fact exceed the 50-page limit of 37 CFR 1.943(b), because of considerations not facially apparent. Accordingly, because requester's request for waiver of the 50-page limit of 37 CFR 1.943(b) is premature at this time, the petition is **dismissed**.

The petition to waive 37 CFR 1.943(b) is subject to renewal, if a determination is made that would cause such relief to become necessary; however, such renewed petition would not hold in abeyance any time periods for response that may be running against the parties in the instant merged reexamination proceeding.

FEES

The petition fee of $400 for the petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to *inter partes* requester's credit card on May 13, 2009. In the event requester files a renewed petition, no additional fee need be submitted.

CONCLUSION

1. *Inter partes* requester's May 12, 2009 petition under 37 CFR 1.183 to waive the page limit requirement of 37 CFR 1.943(b) is **dismissed** as premature.

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

3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

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

Kenpet7\IP\length 6-29-09

[1] *See* petition at page 1.

[2] *Inter partes* requester's May 12, 2009 comments are 47 pages long, which facially appears to be in compliance with the rule. Moreover, *inter partes* requester states on page 1 of the petition, "The exhibits included with the Comments, including the supporting declarations, contain only factual information and do not include arguments." Thus, it does not facially appear that pages of the attached exhibits, including supporting declarations, would be subject to the page limit requirements of 37 CFR 1.943 pursuant to MPEP 2667(I)(A)(2), though the Central Reexamination Unit may subsequently determine to the contrary.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693 · 95/001,048	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 09/09/2009

EXAMINER

DANN, DORFMAN, HERRELL & SKILLMAN
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SUITE 2400
PHILADELPHIA, PA 19103-2307

ART UNIT	PAPER NUMBER

DATE MAILED: 09/09/2009

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530 Virginia Road, P.O. Box 9133
Concord, MA 01742

Date: MAILED

SEP 09 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693 ; 95/001,048
PATENT NO. : 7216651
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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DONALD R. PIPER, JR.
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(For Patent Owner)

MAILED

SEP 09 2009

CENTRAL REEXAMINATION UNIT

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(For *Ex Parte* Requester)

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KNOBBE, MARTENS & OLSON & BEAR, LLP
2040 MAIN ST. 14 FLOOR
IRVINE, CA 92614

(For *Inter Partes* Requester)

Ex Parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

DECISION DISMISSING PETITION

This is a decision on *inter partes* third party requester's August 24, 2009 petition paper entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" (hereinafter "petition under 37 CFR 1.183").

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration for consideration. The petition fee of $400 for the petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to *inter partes* third party requester's credit card on August 25, 2009, as authorized on page one of the petition under 37 CFR 1.183.

The petition under 37 CFR 1.183 is dismissed, for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,216,651 (the '651 patent) issued on May 15, 2007.

2. On October 5, 2007, a request for *ex parte* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 90/008,693 (the '8693 proceeding).

3. On November 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8693 proceeding.

4. On May 30, 2008, a request for *inter partes* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,048 (the '1048 proceeding).

5. On August 4, 2008, the Office issued an order granting *inter partes* reexamination in the '1048 proceeding.

6. On October 14, 2008, the Office mailed a decision merging the '8693 *ex parte* and '1048 *inter partes* reexamination proceedings ("the merged proceeding").

7. Prosecution in the merged proceeding progressed to the point where, on July 22, 2009, the Office mailed an Action Closing Prosecution ("ACP").

8. On August 21, 2009, patent owner filed a "STATEMENT UNDER 37 CFR 1.951(a)" in the merged proceeding.

9. On August 24, 2009, *inter partes* third party requester (hereinafter "requester") filed the instant "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" ("petition under 37 CFR 1.183") in the merged proceeding.

10. Concurrently on August 24, 2009, requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" ("petition under 37 CFR 1.181") in the merged proceeding.

DISCUSSION

37 CFR 1.181 provides (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 1.183 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).

On August 24, 2009, requester filed a petition under 37 CFR 1.181, asserting that the ACP, mailed on July 22, 2009, "does not present a clear record for appeal."[1] Concurrently, on August 24, 2009, requester filed the instant petition under 37 CFR 1.183 requesting entry and consideration of the petition under 37 CFR 1.181.[2] 37 CFR 1.181(a) provides that "[p]etition may be taken to the Director: (1) From any action or requirement of any examiner ... in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court." Thus, suspension or waiver of the rules pursuant to 37 CFR 1.183 is unnecessary to obtain consideration of a petition under 37 CFR 1.181, as 37 CFR 1.181 applies to any party challenging any action of any examiner in a reexamination proceeding not subject to appeal. In this instance, requester is challenging an action of the examiner (*i.e.*, in the issued ACP) in a merged reexamination proceeding not subject to appeal.

Because requester's August 24, 2009 petition under 37 CFR 1.183, requesting entry and consideration of the concurrently filed petition under 37 CFR 1.181, is unnecessary, the petition is **dismissed**. Requester is reminded that the mere filing of a petition will not stay any period for reply that may be running in the proceeding.[3]

CONCLUSION

1. *Inter partes* requester's August 24, 2009 "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" to waive the rules for entry and consideration of the concurrently filed "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" is **dismissed** as unnecessary.

---

[1] *See* petition under 37 CFR 1.183 at page 1 (stating, "Specifically, the ACP is ambiguous whether the Examiner entered the Petitioner's Proposed Further Grounds of Rejection but declined to adopt those Proposed Grounds for rejection, or whether the Examiner refused to enter the Proposed Grounds. ").

[2] *See* id.

[3] 37 CFR 1.181(f). The time period for filing responsive comments under 37 CFR 1.951(b) is still running against requester and will expire on September 21, 2009.

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

3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

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

Kenpet7/IP
9-9-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 11/18/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Susan G.L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road, P.O. Box 9133
Concord, MA 01742

Date: MAILED

NOV 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
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.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 11/18/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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NOV 18 2009
CENTRAL REEXAMINATION UNIT

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Ex Parte Reexamination Proceeding :
Control No. 90/008,693 :
Filed: October 5, 2007 :
For: U.S. Patent No. 7,216,651 : **DECISION ON**
: **PETITION**
Inter Partes Reexamination Proceeding : **UNDER 37 CFR 1.181**
Control No. 95/001,048 :
Filed: May 30, 2008 :
For: U.S. Patent No. 7,216,651

This is a decision on *inter partes* third party requester's August 24, 2009 petition paper entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" (hereinafter "petition").

The petition under 37 CFR 1.181 is before the Director of the Central Reexamination Unit for consideration as to whether the Action Closing Prosecution, mailed on July 22, 2009, is proper.

The petition under 37 CFR 1.181 is granted, for the reasons set forth herein, to the extent that the third party requester comments, dated May 12, 2009, does not comply with 37 CFR 1.947 and 1.948, and therefore, should not have been entered into the record and considered by the examiner in the Action Closing Prosecution.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,216,651 (the '651 patent) issued on May 15, 2007.

2. On October 5, 2007, a request for *ex parte* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 90/008,693 (the '8693 proceeding).

3. On November 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8693 proceeding.

4. On May 30, 2008, a request for *inter partes* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,048 (the '1048 proceeding).

5. On August 4, 2008, the Office issued an order granting *inter partes* reexamination in the '1048 proceeding.

6. On October 14, 2008, the Office mailed a decision merging the '8693 *ex parte* and '1048 *inter partes* reexamination proceedings ("the merged proceeding").

7. Prosecution in the merged proceeding progressed to the point where, on July 22, 2009, the Office mailed an Action Closing Prosecution ("ACP").

8. On August 21, 2009, patent owner filed a "STATEMENT UNDER 37 CFR 1.951(a)" in the merged proceeding.

9. On August 24, 2009, *inter partes* third party requester (hereinafter "requester") filed the instant "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" ("petition under 37 CFR 1.183") in the merged proceeding.

10. Concurrently on August 24, 2009, requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" ("petition under 37 CFR 1.181") in the merged proceeding.

11. On September 21, 2009, third party requester filed a paper titled "THIRD PARTY COMMENTS UNDER 37 C.F.R. § 1.951(b) ADDRESSING ISSUES RAISED BY THE JULY 22, 2009 ACTION CLOSING PROSECUTION AND THE AUGUST 21, 2009 PATENT OWNER'S STATEMENT".

DISCUSSION

The third party requester (petitioner) states that the requester is seeking the director's review under 37 CFR 1.181 of the examiner's treatment of the new proposed rejections introduced in the third party requester's comments dated May 12, 2009. The petitioner contends the new proposed rejections should given full consideration by the examiner because:

(1) there is no requirement to establish a substantial new question of patentability for the new proposed rejections;

(2) the comments dated May 12, 2009 did discuss the pertinency of each reference applied in the new proposed rejections;

(3) the explanation of the new proposed rejection provided at least one basis for combining the references and a statement of why the claims would have been obvious; and
(4) if the comments dated May 12, 2009 were improper, the third party requester should have been notified and given 15 days to rectify and refile the comments.

See pages 4-5 of the petition.

Legal Authority Citations:

37 CFR 1.181 states, in part:

(a) Petition may be taken to the Director:

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

(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 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948 states, in part:

(a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
(1) which is necessary to rebut a finding of fact by the examiner;
(2) which is necessary to rebut a response of the patent owner; or
(3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2666.05 states, in part:

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is

necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

Analysis:

Turning to the facts in this merged proceeding, the new proposed rejections were not included in the request for reexamination and are based on references, newly cited in the comments of May 12, 2009. Instead, these proposed rejections were not mentioned until the third party requester comments submitted after the first Office action on the merits. See, e.g., pages 32-33 of the May 12, 2009 comments.

37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. 37 CFR 1.948(a)(2) and MPEP 2666.05

only permits a third party requester to introduce new proposed rejections if necessitated by the patent owner's amendment to the claims. See MPEP 2666.05.

The new proposed rejections in the comments of May 12, 2009 were not caused by the patent owner amendment in the paper of April 13, 2009 because the patent owner did not make any amendments to the claims. Therefore, the comments dated May 12, 2009 improperly included new proposed rejections and did not have a right of entry under 37 CFR 1.947 and 1.948. In the Action Closing Prosecution (ACP), the examiner correctly stated that the new proposed rejections are not entitled to consideration. See pages 11-12 in the ACP, mailed July 22, 2009. However, under the facts present in this proceeding, the ACP is improperly issued because it treated the entire third party requester's comments dated May 12, 2009 on the merits, including the new proposed rejections. See page 13 of the Office Action in which the examiner stated that the primary references in the proposed rejection fail to teach certain claim limitations. Therefore, the record indicates that the examiner did give consideration to some extent to the improperly raised new proposed rejections.

Accordingly, the petition is granted to the extent that the comments dated May 12, 2009 will be closed and returned to the third party requester. As the paper has been entered into the electronic Image File Wrapper (IFW) record, the paper will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record. The present decision will, however, be made of record in the merged reexamination proceeding. See also MPEP 2267.

The third party requester is given fifteen (15) days from the mailing date of this decision to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

In addition, the ACP, mailed July 22, 2009, is hereby vacated.

Accordingly, the patent owner's response, dated August 21, 2009, to the July 22, 2009 ACP, and the third party requester's comments filed September 21, 2009, directed to patent owner's response of August 21, 2009, are moot due to the vacatur of the ACP. The papers will be closed in the record pending resolution of compliance with 37 CFR 1.947 and 1.948 for the third party comments and the issuance of a new Office action, at which point it will be determined which papers will be opened. This decision will remain of record.

CONCLUSION

1. The August 24, 2009, the third party requester petition under 37 CFR 1.181 seeking the Director's review of the July 22, 2009 ACP is **granted to the extent of finding** that the ACP may have incorrectly considered improperly raised new proposed rejection and is being vacated.

2. The third party requester comments, dated May 12, 2009, are improper papers and are being expunged from the record, as indicated above. The third party requester has fifteen (15) days from the mailing date of this decision to rectify and refile the comments.

3. The examiner will issue a new Office action, as appropriate, after the filing of any rectified third party comments filed.

4. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 12/22/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 12/22/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2009

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
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Date:
MAILED

DEC 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
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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2040 MAIN STREET 14TH FLOOR
IRVINE, CA 92614

Date:

MAILED

DEC 22 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

DEC 22 2009

CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

Ex Parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on *inter partes* third party requester's December 3, 2009 petition paper entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181(a)(3)" (hereinafter "petition"), which is requesting reconsideration of the decision mailed on November 18, 2009.

The petition under 37 CFR 1.181 is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for reconsideration of the November 18, 2009 decision.

The request for reconsideration petition under 37 CFR 1.181 is denied, for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,216,651 (the '651 patent) issued on May 15, 2007.

2. On October 5, 2007, a request for *ex parte* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 90/008,693 (the '8693 proceeding).

3. On November 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8693 proceeding.

4. On May 30, 2008, a request for *inter partes* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,048 (the '1048 proceeding).

5. On August 4, 2008, the Office issued an order granting *inter partes* reexamination in the '1048 proceeding.

6. On October 14, 2008, the Office mailed a decision merging the '8693 *ex parte* and '1048 *inter partes* reexamination proceedings ("the merged proceeding").

7. Prosecution in the merged proceeding progressed to the point where, on July 22, 2009, the Office mailed an Action Closing Prosecution ("ACP").

8. On August 21, 2009, patent owner filed a "STATEMENT UNDER 37 CFR 1.951(a)" in the merged proceeding.

9. On August 24, 2009, *inter partes* third party requester (hereinafter "requester") filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" ("petition under 37 CFR 1.183") in the merged proceeding.

10. Concurrently on August 24, 2009, requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" ("petition under 37 CFR 1.181") in the merged proceeding.

11. On November 18, 2009, a decision granting the petition under 37 CFR 1.181 to the extent that the requester was given fifteen days to correct their comments was mailed. The decision also vacated the ACP.

12. On December 3, 2009, the requester filed corrected comments and a petition requesting reconsideration of the November 18, 2009 decision.

DISCUSSION

The third party requester (petitioner) states that the requester is seeking the director's review under 37 CFR 1.181 of November 18, 2009 decision ("decision"). The petitioner contends the decision improperly applied the requirements of 37 CFR 1.947 and 1.948 because:

(1) Petitioner was permitted to submit new proposed rejections if the newly cited prior art satisfied the requirements of any one of 37 CFR 1.948(a)(1), (2), or (3);

(2) The new proposed rejections based on the Solovev references were properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(2);
(3) The new proposed rejections based on the Bagautidinov II reference was properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(1); and
(4) All of the new proposed rejections were properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(3).

See pages 4-5 of the petition.

Legal Authority Citations:

37 CFR 1.181 states, in part:

(a) Petition may be taken to the Director:

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

(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 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948 states, in part:

(a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
(1) which is necessary to rebut a finding of fact by the examiner;
(2) which is necessary to rebut a response of the patent owner; or
(3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2666.05 states, in part:

> Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.
>
> **As to item (A) above, 37 CFR 1.948(a)(1)** permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. **However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester.** Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.
>
> As to item (B) above, **37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.**
>
> As to item (C) above, prior art submitted under **37 CFR 1.948(a)(3)** must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission **must also include a discussion of the pertinency of each reference to the patentability of at least one claim**.
>
> As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.
>
> Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

Analysis:

Turning to the facts in this merged proceeding, the new proposed rejections were not included in the request for reexamination and are based on references, newly cited in the comments of May 12, 2009. These proposed rejections were first mentioned in the third party requester comments submitted after the first Office action on the merits. See, e.g., pages 32-33 of the May 12, 2009 comments.

37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. 37 CFR 1.948(a)(2) and MPEP 2666.05 only permits a third party requester to introduce new proposed rejections if necessitated by the patent owner's amendment to the claims. See MPEP 2666.05.

The new proposed rejections in the comments of May 12, 2009 were not caused by the patent owner amendment in the paper of April 13, 2009 because the patent owner did not make any amendments to the claims. Therefore, the comments dated May 12, 2009 improperly included newly proposed rejections, and therefore, did not have a right of entry under 37 CFR 1.947 and 1.948. In the Action Closing Prosecution (ACP), the examiner correctly stated that the newly proposed rejections are not entitled to consideration. See pages 11-12 in the ACP, mailed July 22, 2009. However, under the facts present in this proceeding, the ACP was determined to be improperly issued because it treated the third party requester's comments dated May 12, 2009 on the merits, including some consideration of the newly proposed rejections. See page 13 of the Office Action in which the examiner stated that the primary references in the newly proposed rejection fail to teach certain claim limitations. Therefore, the record indicates that the examiner did give consideration to some extent to the improperly raised newly proposed rejections.

In summary, the November 18, 2009 decision determined that the May 12, 2009 comments were improper papers because the papers raised new grounds of rejection, which were not authorized by 37 CFR 1.947 and 1.948. Accordingly, the decision granted the August 24, 2009 petition to the extent that the third party requester was given fifteen (15) days to rectify and file replacement comments. The decision also stated that as the May 12, 2009 comments have been entered into the electronic Image File Wrapper (IFW) record, the comments will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record.

On December 3, 2009, the third party requester filed replacement comments and a petition requesting reconsideration of the November 18, 2009 decision. This reconsideration petition raises four issues, each will be addressed below.

(1) Petitioner was permitted to submit new proposed rejections if the newly cited prior art satisfied the requirements of any one of 37 CFR 1.948(a)(1), (2), or (3)

Petitioner argues that new proposed rejections are authorized under each subsection of 37 CFR 1.948(a). See page 5 of the petition. Specifically, petitioner points to the following statement in MPEP 2666.05, subsection II, for support of their position that each subsection of 37 CFR 1.948(a)(1)-(3) authorizes newly proposed rejections:

"As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617..."

However, when MPEP 2666.05, subsection II, is read as a whole, it is clear that only 37 CFR 1.948(a)(2) authorizes the third party requester to provide newly proposed rejections when the newly proposed rejections are necessitated by an amendment to the claims. See the bolded text in the text above-quoted from MPEP 2666.05, subsection II. Specifically, MPEP 2666.05 states that 37 CFR 1.948(a)(2) permits newly proposed rejections only if necessitated by patent owner's amendments. In contrast, 37 CFR 1.948(a)(1) and (3)

permit a statement of relevancy to the examiner's interpretation/finding, or the patentability of at least one claim, respectively. To allow newly proposed rejections under each of 37 CFR 1.948(a)(1), (2), and (3) would allow the introduction of new issues of patentability in response to every examiner's finding, every patent owner's amendment, and every discovery of new art. Such would result in an unwieldy proceeding, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch. Therefore, the statements in MPEP 2666.05 that only permit newly proposed rejections under 37 CFR 1.948(a)(2) are wholly consistent with the spirit and letter of 35 U.S.C. 314(c).

(2) The new proposed rejections based on the Solovev references were properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(2)

Petitioner states that the newly proposed rejections based on the Solovev references were made in accordance with the requirements of 37 CFR 1.947 and 1.948(a)(2) because the Solovev references rebut the patent owner's position that it is not obvious to modify Jeter to use foam. See pages 6-7 of the petition.

As explained above, MPEP 2666.05 clearly states that "... 37 CFR 1.948(a)(2) **permits** the requester to provide **a new proposed rejection**, where such new proposed rejection is **necessitated by patent owner's amendment of the claims.**" (Emphasis added). The record is clear that patent owner did not amend the claims. Furthermore, patent owner's arguments regarding the obviousness of modifying the Jeter reference does not, by itself, authorize newly proposed rejections under 37 CFR 1.948(a)(2) for the same reasons as an examiner's finding of patentability does not authorize newly proposed rejections under 37 CFR 1.948(a)(1). See MPEP 2666.05, which states for 37 CFR 1.948(a)(1), that:

> **".... a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester). does NOT permit the requester to then cite new art to replace the art originally advanced by requester.** Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch." (Emphasis added).

Therefore, while 37 CFR 1.947 and 1.948(a)(2) may authorize[1] the citation of the Solovev references to rebut the position taken by the patent owner in April 13, 2009 response, MPEP 2666.05 is clear that 37 CFR 1.947 and 1.948(a)(2) do not authorize newly presented proposed rejections, which are not necessitated by an amendment to the patent claims.

[1] The examiner will make the determination of whether the citation of the Solovev references comply with 37 CFR 1.947 and 1.948 in the next Office action.

(3) The new proposed rejections based on the Bagautidinov II reference was properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(1)

Petitioner states that the newly proposed rejections based on the Bagautidinov II reference were made in accordance with the requirements of 37 CFR 1.947 and 1.948(a)(1) because the Bagautidinov II reference rebuts the examiner's finding that Bagautidinov does not maintain negative pressure on a wound. See page 7 of the petition.

As explained above, MPEP 2666.05 clearly states for 37 CFR 1.948(a)(1), that:

> **".... a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester.** Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch." (Emphasis added).

Petitioner states that the newly presented proposed rejections based on Bagautidinov II are not "replacement" proposed rejections. The record, however, does not support this statement by the petitioner. In other words, the record is clear that the third party requester is presenting newly proposed rejections based on the newly cited Bagautidinov II reference in response to the examiner's finding in the first Office action. This exact situation is addressed in MPEP 2666.05, subsection II, which is quoted above. Therefore, while 37 CFR 1.947 and 1.948(a)(1) may authorize[2] the citation of the Bagautidinov II reference to rebut the position taken by the examiner in the first Office action, MPEP 2666.05 is clear that 37 CFR 1.947 and 1.948(a)(1) do not authorize newly presented proposed rejections to rebut a finding by the examiner. In other words, the comments must be limited to how Bagautidinov II rebuts the examiner's finding in the first Office action, in accordance with the requirements of 37 CFR 1.947 and 1.948(a)(1), to support the original proposed rejection based on Bagautidinov.

(4) All of the new proposed rejections were properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(3)

Petitioner states that the newly proposed rejections were made in accordance with the requirements of 37 CFR 1.947 and 1.948(a)(3) because all the references satisfy the requirements of 37 CFR 1.948(a)(3). See pages 7-8 of the petition. Petitioner points to statements made in the Federal Register publication of the institution of 37 CFR 1.948(a)(3) to support their position. In addition, petitioner argues that the requirements of 37 CFR 1.948(a)(3) trumps any more restrictive requirements of 37 CFR 1.947.

---

[2] The examiner will make the determination of whether the citation of the Bagautidinov II reference complies with 37 CFR 1.947 and 1.948 in the next Office action.

As explained above, MPEP 2666.05 clearly states the requirements for 37 CFR 1.948(a)(3) "... include a discussion of the pertinency of each reference to the patentability of at least one claim." MPEP 2666.05 does not state that newly presented rejections based on newly cited art under 37 CFR 1.948(a)(3) is permitted. As explained above, only 37 CFR 1.948(a)(2) authorizes newly presented proposed rejection that are necessitated by a patent owner's amendment of the claims. Therefore, while 37 CFR 1.947 and 1.948(a)(3) may authorize[3] the citation of the references and permit an explanation of the relevancy of the references to at least one patent claim, MPEP 2666.05 is clear that 37 CFR 1.947 and 1.948(a)(3) do not authorize newly presented proposed rejections upon meeting the requirements of 37 CFR 1.948(a)(3). The comments from the Federal Register notice are not persuasive because the notice does not explicitly authorize newly presented proposed rejections, and do not make any explicit statements inconsistent with MPEP 2666.05. In regard to petitioner's argument that 37 CFR 1.948(a)(3) must control 37 CFR 1.947 to the extent that there is any conflict, this argument is not fully understood as there does not appear to be any conflict between 37 CFR 1.948(a)(3) and 1.947. In conclusion, petitioner's arguments pertaining to 37 CFR 1.48(a)(3) are not persuasive in light of the clear statutory requirement of special dispatch and the guidance provided in MPEP 2666.05.

For all the reasons discussed above, the petition for reconsideration is **denied**.

In summary:

- The May 12, 2009 third party comments is closed and expunged from the record;
- The ACP, mailed July 22, 2009, is vacated; and
- The patent owner's response, dated August 21, 2009, to the July 22, 2009 ACP is moot due to the vacatur of the ACP.

The papers will be closed in the record pending resolution of compliance with 37 CFR 1.947 and 1.948 for the third party comments dated December 3, 2009 and the issuance of a new Office action, at which point it will be determined which papers will be opened. This decision will remain of record.

REQUESTER'S RECOURSE

The third party requester has the following possible courses of action if the third party requester desires to bring the newly presented proposed rejections before the Office:

1. Initiate an *ex parte* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references by filing a new and complete request for *ex parte* reexamination. This decision is without prejudice to the right of the requester to file a new request for reexamination. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.
2. Initiate an *inter partes* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references by filing a new and complete request for *inter partes*

[3] The examiner will make the determination of whether the citation of the references comply with 37 CFR 1.947 and 1.948 in the next Office action.

reexamination, if a showing can be made that the newly cited art was unavailable at the time of filing the request in this proceeding, in accordance with the requirements of 35 U.S.C. 317(b) and 37 CFR 1.907. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

3. File a petition under 35 U.S.C. 317(a) to authorize the filing of a new *inter partes* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references. If granted, the request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

CONCLUSION

1. The third party requester petition under 37 CFR 1.181 seeking the Director's review of the November 18, 2009 decision is **denied**.

2. The third party requester comments, dated May 12, 2009, are improper papers and are expunged from the record, as indicated in the November 19, 2009 decision. This decision makes no determination as to whether the third party requester's replacement comments, dated December 3, 2009, comply with 37 CFR 1.947 and 1.948.

3. The proceedings will be forwarded to the examiner, who will issue a new Office action, as appropriate, in due course. The examiner will determine if the replacement comments, dated December 3, 2009, fully comply with the requirements of 37 CFR 1.947 and 1.948. If the December 3, 2009 comments fail to comply with 37 CFR 1.947 and 1.948, the examiner shall state that such comments are improper papers and that the comments will be expunged from the record in the new Office action. No additional time will be given to file replacement comments.

4. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Andy Kashnikow, at (571) 272-4361, or in his absence, to Gregory Morse, Director of the CRU, at (571) 272-3838.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 06/30/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2010

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Date:

MAILED

JUN 30 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
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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JUN 3 0 2010

CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

Ex Parte Reexamination Proceeding :
Control No. 90/008,693 :
Filed: October 5, 2007 :
For: U.S. Patent No. 7,216,651 : **DECISION**
: **DISMISSING**
Inter Partes Reexamination Proceeding : **PETITION**
Control No. 95/001,048 :
Filed: May 30, 2008 :
For: U.S. Patent No. 7,216,651

This is a decision on *inter partes* requester's December 3, 2009 petition paper entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" (hereinafter "petition under 37 CFR 1.183").

The petition is before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was processed on December 4, 2009.

The petition is **dismissed**, for the reasons set forth herein.

BACKGROUND

1. United States Patent Number 7,216,651 (the '651 patent) issued on May 15, 2007.

2. On October 5, 2007, a request for *ex parte* reexamination of the '651 patent was filed by a first third party requester and assigned Reexamination Control No. 90/008,693 (the '8693 proceeding).

3. On November 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8693 proceeding.

4. On May 30, 2008, a request for *inter partes* reexamination of the '651 patent was filed by a second third party requester and assigned Reexamination Control No. 95/001,048 (the '1048 proceeding).

5. On August 4, 2008, the Office issued an order granting *inter partes* reexamination in the '1048 proceeding.

6. On October 14, 2008, the Office mailed a decision merging the '8693 *ex parte* and '1048 *inter partes* reexamination proceedings ("the merged proceeding").

7. On February 12, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On April 13, 2009, patent owner filed a response to the February 12, 2009 Office action. In the response, patent owner did not amend the claims subject to reexamination.

9. On May 12, 2009, *inter partes* requester filed "THIRD PARTY COMMENTS ADDRESSING ISSUES RAISED BY THE FEBRUARY 12, 2009 OFFICE ACTION AND THE APRIL 13, 2009 PATENT OWNER'S REPLY" ("the May 12, 2009 comments submission"), presenting new proposed rejections based on newly submitted prior art.

10. On July 22, 2009, the Office mailed an Action Closing Prosecution ("ACP").

11. On August 21, 2009, patent owner filed a "STATEMENT UNDER 37 CFR 1.951(a)," responsive to the July 22, 2009 ACP.

12. On August 24, 2009, *inter partes* requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" ("the August 24, 2009 petition under 37 CFR 1.181"), seeking the Director's review of the July 22, 2009 ACP.

13. On September 21, 2009, *inter partes* requester filed "THIRD PARTY COMMENTS UNDER 37 C.F.R. § 1.951(b) ADDRESSING ISSUES RAISED BY THE JULY 22, 2009 ACTION CLOSING PROSECUTION AND THE AUGUST 21, 2009 PATENT OWNER'S STATEMENT" ("the September 21, 2009 comments submission").

14. On November 18, 2009, the Office mailed a decision granting the August 24, 2009 petition under 37 CFR 1.181 seeking the Director's review of the July 22, 2009 ACP "to the extent of finding that the ACP may have incorrectly considered improperly raised new proposed rejection and is being vacated."[1] The Office closed and expunged the requester's May 12, 2009 comments submission from the record of the merged proceeding, and set a time period of 15 days for *inter partes* requester to submit corrected comments.

15. On December 3, 2009, *inter partes* requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181(a)(3)" ("the December 3, 2009 petition under 37 CFR 1.181"), requesting reconsideration of the November 18, 2009 decision.

16. Concurrently, on December 3, 2009, *inter partes* requester filed the instant "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" ("the petition under 37 CFR 1.183").

17. Also on December 3, 2009, *inter partes* requester filed a paper entitled "REFILED THIRD PARTY COMMENTS ADDRESSING ISSUES RAISED BY THE FEBRUARY 12, 2009 OFFICE ACTION AND THE APRIL 13, 2009 PATENT OWNER'S REPLY."

18. On December 22, 2009, the Office mailed a decision denying the December 3, 2009 petition under 37 CFR 1.181.

19. On January 15, 2010, the Office mailed an ACP, confirming all of the claims subject to reexamination (*i.e.*, claims 1-125). In the ACP, the examiner stated that patent owner's April 13, 2009 response has been entered and made of record, and that requester's December 3, 2009 comments has been entered and made of record.[2]

20. On March 12, 2010, the Office mailed a Right of Appeal Notice ("RAN").

21. On April 12, 2010, *inter partes* requester filed a Notice of Appeal.

22. On June 14, 2010, *inter partes* requester filed an appeal brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

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[1] November 18, 2009 decision at page 6.
[2] January 15, 2010 ACP at page 2.

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. 947 provides, in pertinent part:

> 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.

37 CFR 1. 948 provides, in pertinent part:

> (a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
> (1) which is necessary to rebut a finding of fact by the examiner;
> (2) which is necessary to rebut a response of the patent owner; or
> (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

DECISION

In the December 3, 2009 petition under 37 CFR 1.183, *inter partes* requester (hereinafter "requester") requests waiver of 37 CFR §§ 1.947 and/or 1.948 to permit entry and consideration of its May 12, 2009 comments submission. The December 3, 2009 petition under 37 CFR 1.183 was filed concurrently with a petition under 37 CFR 1.181, requesting reconsideration of the Office's November 18, 2009 decision.

The November 18, 2009 decision granted the requester's August 24, 2009 petition under 37 CFR 1.181, seeking review of the July 22, 2009 ACP, to the extent of vacating the July 22, 2009 ACP. The November 18, 2009 decision also found requester's May 12, 2009 comments submission improper for introducing new proposed grounds of rejection based on newly submitted prior art. In particular, the Office found that "[t]he new proposed rejections in the comments of May 12, 2009 were not caused by the patent owner amendment in the paper of April 13, 2009 because the patent owner did not make any amendments to the claims. Therefore, the comments dated May 12, 2009 improperly included new proposed rejections and did not have a right of entry under 37 CFR 1.947 and 1.948."[3] The Office closed and expunged requester's May 12, 2009 comments submission from the record of the merged proceeding.

Subsequently, in the December 22, 2009 decision, the Office denied requester's December 3, 2009 petition under 37 CFR 1.181, requesting reconsideration of the Office's November 18, 2009 decision. In the December 22, 2009 decision, the Office reaffirmed its position that requester's May 12, 2009 comments submission improperly included new proposed rejections not necessitated by an amendment to the patent claims and, therefore, did not have a right of entry under 37 CFR 1.947 and 1.948.[4]

In the present petition under 37 CFR 1.183, requester asserts that "based on the Office's present reading of 37 C.F.R. §§ 1.947 and 1.948 that new proposed rejections can only be made if caused by the patent owner's amendment to the claims, Petitioner petitions for suspension of 37 C.F.R. § 1.947 and/or § 1.948 to permit entry and consideration of the Comments filed May 12, 2009." [5] In support of waiver of the rules, requester submits the following arguments:

(1) The MPEP explicitly provides for new proposed rejections under any one of 37 CFR 1.948(a)(1), (a)(2) or (a)(3);
(2) 37 CFR 1.948(a)(3) requires an explanation of the pertinency of the new art to the reexamined claims and all of the new proposed rejections in the May 12, 2009 comments submission were submitted to explain the pertinency of the new art to the patentability of at least one claim; and
(3) Purported inconsistencies between 37 CFR 1.947, 1.948 and MPEP 2666.05 provides good cause to suspend the rules and allow entry of the new proposed rejections. [6]

Further in support of waiver of the rules, requester asserts in the petition under 37 CFR 1.183:

> [A]llowing the entry and consideration of the New Proposed Rejections in the current proceeding will conserve the resources of the parties and the Office by obviating the need for the Petitioner to request a separate reexamination proceeding based on the New Art. As noted above, obviating the need for additional reexamination proceedings is an express policy goal of the Release Notes accompanying the implementation of the inter partes reexamination proceedings. 65 Fed. Reg. at 76,767. Allowing the entry of the New Proposed

[3] November 18, 2009 decision at page 5.
[4] December 22, 2009 decision at pages 5-8.
[5] The petition under 37 CFR 1.183 at page 4.
[6] *See*, the petition under 37 CFR 1.183 at pages 4-6 for requester's detailed discussion of these arguments.

> Rejections will also present a consolidated record for appeal and hasten the resolution of the parties' dispute, thus promoting the interests of justice. [7]

Analysis and Findings

1. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of a rule.

Addressing the instant petition under 37 CFR 1.183, 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, the December 20, 2009 decision explicitly identified several alternative avenues for obtaining the relief sought by requester in the instant petition under 37 CFR 1.183. In particular, the December 22, 2009 decision set forth the following three alternative avenues if requester desires to bring the newly presented proposed rejections before the Office:

1. Initiate an *ex parte* reexamination of: the '651 patent based on the newly cited Solovev and Bagautidinov II references by filing a new and complete request for *ex parte* reexamination. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

2. Initiate an *inter partes* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references by filing a new and complete request for *inter partes* reexamination, if a showing can be made that the newly cited art was unavailable at the time of filing the request in this proceeding, in accordance with the requirements of 35 U.S.C. 317(b) and 37 CFR 1.907. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

3. File a petition under 35 U.S.C. 317(a) to authorize the filing of a new *inter partes* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references. If granted, the request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination. [8]

Moreover, requester could have sought reconsideration of the December 22, 2009 decision, denying requester's December 3, 2009 petition under 37 CFR 1.181, but no such petition requesting reconsideration of the December 22, 2009 decision was timely filed by requester.

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[7] The petition under 37 CFR 1.183 at page 6.
[8] December 22, 2009 decision at pages 8-9.

2. Even if 37 CFR 1.948 is shown to be satisfied or waived, such would not necessarily permit requester to propose a new ground of rejection based on additional art, as 37 CFR 1.947 must be satisfied in order for requester to be permitted to propose a new ground of rejection. And, 37 CFR 1.947 cannot be waived to the extent that it promulgates a requirement of the statute – in this instance, 35 U.S.C. 314(b)(2).

35 U.S.C. 314(b)(2) limits the content of requester's comments to "addressing issues raised by the action of the Office or the patent owner's response thereto." When new prior art is necessary to rebut a finding of fact by the examiner or a patent owner response, then a proposed new ground of rejection is limited to modification of the existing rejection by adding the new art that provides the rebuttal as per 37 CFR 1.948(a) or (b). An entirely new proposed new ground of rejection, however, is not permitted by 35 U.S.C. 314(b)(2), as such would not address "issues raised by the action of the Office or the patent owner's response," but rather would be adding a new rejection as a substitute for the originally proposed rejection.

If the proposed new ground of rejection is not limited to a rebuttal pursuant to 37 CFR 1.948(a) or (b), then there can be no 37 CFR 1.183 relief, because introduction of the proposed rejection in the reexamination proceeding is barred by 35 U.S.C. 314(b)(2) as not addressing "issues raised by the action of the Office or the patent owner's response," and the statute cannot be waived. If, on the other hand, the proposed new ground of rejection is limited to a rebuttal as per 37 CFR 1.948(a) or (b), then there is no need for 37 CFR 1.183 relief, since the proposed new ground of rejection has an entry right.

In this instance, requester's December 3, 2009 37 CFR 1.181 petition requested reconsideration of the November 18, 2009 decision finding that the proposed new ground of rejection lacked an entry right. The December 3, 2009 reconsideration petition was denied on December 22, 2009. The denial is a finding that the entry of the proposed new ground of rejection is barred by 35 U.S.C. 314(b)(2), as discussed above. Requester's remedy was to file a petition under 37 CFR 1.181(a)(3) for review of the denial decision by a higher official by January 22, 2009 (see 37 CFR 1.181(f), 2nd sentence). Requester did not do so. Thus, the finding that the proposed new ground of rejection is barred by 35 U.S.C. 314(b)(2) remains in place, and cannot be waived.

3. For the foregoing reasons, the instant petition under 37 CFR 1.183, requesting waiver of the rules for entry of requester's May 12, 2009 comments submission, **is dismissed**.

CONCLUSION

1. The *inter partes* requester's December 3, 2009 petition under 37 CFR 1.183 is **dismissed**.

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

3. Any inquiry concerning the instant decision should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

6-29-10
Kenpet8/IP

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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	

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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

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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.
90/008,528	03/14/2007	5679977		7588

7590 02/12/2008

EXAMINER	

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ART UNIT	PAPER NUMBER

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

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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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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Alexandria, VA 22313-1450
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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. 90/008,484	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
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 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

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

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

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.
90/008,484	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.

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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

TRACY DRUCE
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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.
90/008,528	03/14/2007	5679977		7588

7590 03/03/2010

LERNER, DAVID, LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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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 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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P.O. Box 1450
Alexandria, VA 22313-1450
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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.
90/008,695	06/11/2007	5679977		5843

7590 03/11/2010

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/11/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

NOVAK DRUCE & QUIGG LLP

(NDQ REEXAMINATION GROUP)

1000 LOUSIANIA STREET, FIFTY-THIRD FLOOR

HOUSTON, TX 77002

MAILED

MAR 11 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,695*.

PATENT NO. *5679977*.

ART UNIT *3992*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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
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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
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.
90/008,695	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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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)).

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 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

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

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

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

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Commissioner for Patents
United States Patents and Trademark Office
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

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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United States Patent and Trademark Office
P.O. Box 1450
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APR 13 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 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

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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

LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090-1497

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,485	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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

TRACY DRUCE
NOVAK DRUCE & QUIGG, LLP
1000 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)).

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
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. : 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
Control No. 90/008,485
Request Deposited: February 9, 2007
For: U.S. Patent No. 6,133,627

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: 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
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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CENTRAL REEXAMINATION UNIT

Marcus J. Millet
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Sanjeet K. Dutta
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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

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United States Patent and Trademark Office
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JAN 15 2008

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FOR PATENT OWNER

Susan G. L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, Massachusetts 01742

FOR THIRD PARTY REQUESTER

In re Louis C. Argenta et al.
Reexamination Proceeding
Control No. 90/008,697
Filed: October 5, 2007
For: U.S. Patent No. 5,636,643

DECISION DISMISSING PATENT OWNER PETITION FOR ENTRY OF CDS

This is a decision on the December 26, 2007 patent owner petition under 37 CFR 1.183 requesting suspension of the rules, to allow patent owner to submit the copies of references on CD-ROM to fulfill the submission requirement of 37 CFR 1.98(a)(2). The petition is also being taken as a request to waive 37 CFR 1.52(e).

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

The petition is dismissed for the reasons set forth below.

PERTINENT REGULATIONS AND EXAMINATION PRACTICE

37 CFR § 1.52(e) states:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> > (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:
> >
> > > (I) A computer program listing (see 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).

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(I) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

37 CFR 1.98 (a) provides:

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

...

(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 1.183 (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 1.555 (b) provides:

(b) Under this section, information is material to patentability in a reexamination roceeding when it is not cumulative to information of record or being made of record in the reexamination

proceeding, and

> (1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or
>
> (2) It refutes, or is inconsistent with, a position the patent owner takes in:
> (i) Opposing an argument of unpatentability relied on by the Office, or
> (ii) Asserting an argument of patentability.
>
> A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

ANALYSIS

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. None of the information presently proposed to be filed on CD-ROM falls into any of the categories listed in 37 CFR 1.52(e)(1). Accordingly,the submission of files to the Office on a compact disk as proposed is prohibited, absent a waiver of the rule.

Petitioner contends that the present situation should be deemed an "extraordinary" situation where "justice requires" that the rules be waived to permit entry of a CD-ROM containing copies of references into the record of the reexamination proceeding. In support of this position, petitioner states (a) that the submitted CDs comply with the relevant portions of 37 CFR 1.52, (b) that patent owner would like to disclose information accumulated during the 10 years since the patent has issued, (c) that the time to be expended for submission of this information by means of EFS-Web is estimated to exceed 13 hours, and finally, (d) that petitioner has experienced system problems in uploading information via EFS-Web in a related case.

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, patent owner requests a waiver of the rules governing submission of documents to the Office based upon the difficulties petitioner has encountered in filing the documents electronically.

The fact that petitioner has experienced problems with EFS-Web is not persuasive. Patent Owner may submit the documents on paper. Office systems as currently configured do not have the capability of directly uploading files from a CD into the IFW system. If the Office were to accept the seven CDs, the burden would be shifted on to the Office to print out all the documents contained in the CDs to then scan them into the IFW, *along with the logistics of insuring that each document is accurate and complete and that all documents are properly included.* In addition, a review of the CDs reveals that, contrary to petitioner's assertions, the CDs are not in compliance with the relevant portions of rule 52 as petitioner alleges; rather, the files are in PDF format and are thus not ASCII data files as required by 37 CFR 1.52(e)(3)(I).

It is to be noted that the duty to disclose under 37 CFR 1.555 is limited to "information material to patentability" as defined in 37 CFR 555(b), which specifically excludes material which is "cumulative to information of record or being made of record." Patent Owner is urged to review the materials and to limit the submission to documents that are material to patentability. As it now stands, patent owner appears to be submitting a bulk of "information accumulated over 10 years," without any indication of whether the information is material to examination. Thus, the granting of the petition could potentially create a situation in which the Office aided in submission of irrelevant prior art, thereby hindering justice by overly burdening the record with material which could interfere with the examiner's ability to effectively examine the claims at issue, and would delay the examination of the proceeding contrary to the mandate for "special dispatch" in examination of 35 U.S.C. 305.

For the reasons stated above, patent owner has not demonstrated an entitlement to relief under 37 CFR 1.183. Accordingly, no waiver of the rule is appropriate.

In the event that petitioner files one set of documents in compliance with the rules in one case and an Information Disclosure Statement (IDS) with the identical documents is filed in a related case, petitioner may wish to consider filing a petition under 37 CFR 1.183 requesting waiver of the formal submission requirements of an IDS under 37 CFR 1.555 and 1.98 and transfer of copies of the documents to the related case.

CONCLUSION

1. The petition is dismissed.

2. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit.

3. 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

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1-11-08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,700	05/31/2007	6181497		4369

1923 7590 05/08/2009

MCDERMOTT, WILL & EMERY LLP
Attn: IP Department
227 WEST MONROE STREET
SUITE 4400
CHICAGO, IL 60606-5096

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/08/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DLA PIPER US LLP C/O JOHN D. KINTON
401 B. STREET
SUITE 1700
SAN DIEGO, CA 92101-4297

Date: MAILED

MAY 0 8 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008700
PATENT NO. : 6181497
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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McDermott Will & Emery LLP
Attn: IP Department
227 West Monroe Street
Suite 4400
Chicago, IL 60606-5096

(For Patent Owner)

MAILED

MAY 0 8 2009

CENTRAL REEXAMINATION UNIT

John D. Kinton
DLA Piper US LLP
401 B Street, Suite 1700
San Diego, CA 92101-4297

(For Third Party Requester)

In re Daniel James Malone, Sr.
Ex Parte Reexamination Proceeding
Control No. 90/008,700
Filed: May 31, 2007
For: U.S. Patent No. 6,181,497

: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b) AND**
: **DISMISSING PETITION**
: **FOR EXTENSION OF TIME**

This is a decision on: (i) the April 23, 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 prosecution ("the April 23, 2009 petition to revive")[1]; and (ii) the April 23, 2009 patent owner petition for one month extension of time ("the April 23, 2009 petition for extension of time").

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the April 23, 2009 petition to revive has been paid. Patent owner also paid a fee of $130.00 for the April 23, 2009 petition for extension of time.

The April 23, 2009 petition to revive and the April 23, 2009 petition for extension of time are before the Office of Patent Legal Administration (OPLA) for consideration.

The April 23, 2009 petition to revive is **granted**.

The April 23, 2009 petition for extension of time is **dismissed**.

[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 January 30, 2009.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

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

37 CFR 1.137 provides, in pertinent part:

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

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

37 CFR 1.550 provides, in pertinent part:

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

(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 Response To Final Office Action on April 23, 2009. The primary examiner for the instant reexamination proceeding has confirmed that the April 23, 2009 response includes an amendment that cancels all the rejected claims, 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 23, 2009 petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the April 23, 2009 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

---

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

The Petition for Extension of Time is Dismissed

In the April 23, 2009 petition for extension of time, patent owner requests that the time for responding to the January 30, 2009 final Office action be extended for one month, therefore setting a due date of April 30, 2009. However, 37 CFR 1.550(c) specifically provides that any request for an extension of time in an *ex parte* reexamination proceeding "must be filed on or before the day on which action by the patent owner is due."[3] The January 30, 2009 final Office action sets a 2-month shortened statutory period for response; therefore, the April 23, 2009 petition for extension of time is untimely.

It is also pointed out that the Office is not authorized to grant relief in a petition under 37 CFR 1.550(c) in a terminated reexamination prosecution.

Accordingly, the April 23, 2009 petition for extension of time is **dismissed**.

CONCLUSION

1. The April 23, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. The April 23, 2009 patent owner petition for one month extension of time is **dismissed**.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for further processing in view of the April 23, 2009 Response To Final Office Action.

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Colin LaRose, of CRU Art Unit 3992, at (571) 272-7423.

5. 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] 37 CFR 1.550(c) also provides that any request for extension in an *ex parte* reexamination proceeding must be accompanied by the petition fee set forth in § 1.17(g), which is currently $200.00. Patent owner enclosed a check for only $130.00 to cover the fee for the April 23, 2009 petition for extension of time.

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.
90/008,711	10/05/2007	7198046	0101-P00636US9	7278

110 7590 01/17/2008

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/17/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Susan L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Rd., P.O. Box 9133
Concord, MA 01742

Date:

MAILED

JAN 17 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008711
PATENT NO. : 7198046
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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Niels Haun
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1601 Market Street
Suite 2400
Philadelphia, Pennsylvania 19103-2307

FOR PATENT OWNER

MAILED

JAN 17 2008

CENTRAL REEXAMINATION UNIT

Susan G. L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, Massachusetts 01742

FOR THIRD PARTY REQUESTER

In re Louis C. Argenta et al.
Reexamination Proceeding
Control No. 90/008,711
Filed: October 5, 2007
For: U.S. Patent No. 7,198,046

DECISION DISMISSING PATENT OWNER PETITION FOR ENTRY OF CDS

This is a decision on the January 7, 2008 patent owner petition under 37 CFR 1.183 requesting suspension of the rules, to allow patent owner to submit the copies of references on CD-ROM to fulfill the submission requirement of 37 CFR 1.98(a)(2). The petition is also being taken as a request to waive 37 CFR 1.52(e).

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

The petition is dismissed for the reasons set forth below.

PERTINENT REGULATIONS AND EXAMINATION PRACTICE

37 CFR § 1.52(e) states:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> > (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

(I) A computer program listing (see 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).

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(I) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

37 CFR 1.98 (a) provides:

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

...

(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 1.183 (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 1.555 (b) provides:

(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:
(i) Opposing an argument of unpatentability relied on by the Office, or
(ii) Asserting an argument of patentability.

A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

ANALYSIS

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. None of the information presently proposed to be filed on CD-ROM falls into any of the categories listed in 37 CFR 1.52(e)(1). Accordingly, the submission of files to the Office on a compact disk as proposed is prohibited, absent a waiver of the rule.

Petitioner contends that the present situation should be deemed an "extraordinary" situation where "justice requires" that the rules be waived to permit entry of a CD-ROM containing copies of references into the record of the reexamination proceeding. In support of this position, petitioner states (a) that the submitted CDs comply with the relevant portions of 37 CFR 1.52, (b) that patent owner would like to disclose information "struck-through" by the examiner "during the 6-year period of examination", (c) that the time to be expended for submission of this information by means of EFS-Web is estimated to exceed 9 hours, and finally, (d) that petitioner has experienced system problems in uploading information via EFS-Web in a related case.

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, patent owner requests a waiver of the rules governing

submission of documents to the Office based upon the difficulties petitioner has encountered in filing the documents electronically.

The fact that petitioner has experienced problems with EFS-Web is not persuasive. Patent Owner may submit the documents on paper. Office systems as currently configured do not have the capability of directly uploading files from a CD into the IFW system. If the Office were to accept the four CDs, the burden would be shifted on to the Office to print out all the documents contained in the CDs to then scan them into the IFW, *along with the logistics of insuring that each document is accurate and complete and that all documents are properly included.* In addition, a review of the CDs reveals that, contrary to petitioner's assertions, the CDs are not in compliance with the relevant portions of rule 52 as petitioner alleges; rather, the files are in PDF format and are thus not ASCII data files as required by 37 CFR 1.52(e)(3)(i).

It is to be noted that the duty to disclose under 37 CFR 1.555 is limited to "information material to patentability" as defined in 37 CFR 555(b), which specifically excludes material which is "cumulative to information of record or being made of record." Patent Owner is urged to review the materials and to limit the submission to documents that are material to patentability. Patent owner appears to be submitting a bulk of information submitted "during the 6-year period over which the instant application was prosecuted" that applicant contends the examiner improperly struck-through and failed to consider, without any indication of whether the information is material to examination. The fact that applicant allowed the patent to issue without petitioning for the consideration of these documents is an indication that these documents were not considered, *by applicant*, to be material to patentability. Thus, the granting of the petition could potentially create a situation in which the Office aided in submission of irrelevant prior art, thereby hindering justice by overly burdening the record with documents which could interfere with the examiner's ability to effectively examine the claims at issue, and would delay the examination of the proceeding contrary to the mandate for "special dispatch" in examination of 35 U.S.C. 305.

For the reasons stated above, patent owner has not demonstrated an entitlement to relief under 37 CFR 1.183. Accordingly, no waiver of the rule is appropriate.

In the event that petitioner files one set of documents in compliance with the rules in one case and an Information Disclosure Statement (IDS) with the identical documents is filed in a related case, petitioner may wish to consider filing a petition under 37 CFR 1.183 requesting waiver of the formal submission requirements of an IDS under 37 CFR 1.555 and 1.98 and transfer of copies of the documents to the related case.

CONCLUSION

1. The petition is dismissed.

2. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit.

3. 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\8711_CD_no_waiver_to_accept.wpd
1-15-08

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Heller et al.
Reexamination Proceeding
Control No.: 90/007,914
Filed: February 1, 2006
For: U.S. Patent 6,329,161

In re Heller et al.
Reexamination Proceeding
Control No.: 90/008,713
Filed: July 25, 2007
For: U.S. Patent 6,329,161

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,329,161, issued December 11, 2001, is the subject of Reexamination Control Nos. 90/007,914 and 90/008,713.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,914 ('7914), was filed February 1, 2006 by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1 - 10, 16 - 20, 22, 25 - 43, 47, and 48.

3. Reexamination was ordered for '7914 on February 28, 2006.

4. A first Office action for '7914 was mailed December 15, 2006.

5. Patent owner filed a response on March 1, 2007.

6. A second request for re-examination, assigned Reexamination Control No. 90/008,713, was filed July 25, 2007 by Peng Chen of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references in combination with previously cited references regarding claims 1 - 48.

7. Reexamination was ordered for 90/008,713 on October 18, 2007.

8. Patent Owner filed a "Waiver of Patent Owner's Statement under 37 CFR §1.530" on November 18, 2007.

DISCUSSION

Under 37 C.F.R. §1.565(c):

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. §1.565(c), the 90/007,914 and 90/008,713 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since the claims in both files are not the same, the Patent Owner is given one month to to file a "Housekeeping" amendment in order to make the claims the same in each file (identical amendments to be placed in both files) See MPEP §2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,914 and 90/008,713 as:

Walter M. Egbert, III
BAKER & BOTTS, L.L.P.
30 Rockefeller Plaza
New York, NY 10112

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,914 and 90/008,713 as:

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

CONCLUSION

Reexamination Control Nos. 90/007,914 and 90/008,713 are merged. The Patent Owner is given **one month** from the date of the mailing of this decision to merge in order to file amendments in both cases making the claims identical. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course after the Patent Owner has filed the "Housekeeping" amendment.

for Lissi M. Marquis, Director
Central Reexamination Unit

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.
90/008,717	06/19/2007	6,439,389 B1	024643-00010	6844

4372 7590 05/05/2008

EXAMINER	

ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Arent Fox LLP
1050 Connecticut Avenue, N. W.
Suite 400
Washington, DC 20036

(For Patent Owner)

MAILED
MAY 05 2008
CENTRAL REEXAMINATION UNIT

R. Joseph Trojan
Trojan Law Offices
9250 Wilshire Blvd, Suite 325
Beverly Hills, CA 90212

(For Requester)

In re: Mogil
Reexamination Proceeding
Control No. 90/008,717
Request Deposited: June 19, 2007
For: U.S. Patent No. 6,237,776

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

This is a decision on the April 8, 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 two months.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,439,389 (hereinafter, the '389 patent), issued to Mogil, on August 27, 2002.

2. On June 19, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '389 patent. The reexamination proceeding was assigned Control No. 90/008,717 (hereinafter, the '8717 proceeding).

3. The reexamination order was granted in the '8717 proceeding on August 3, 2007.

4. A non-final rejection was mailed on November 19, 2007 setting a one-month shortened statutory period (SSP) for response as litigation was stayed for purposes of this proceeding.

5. Patent Owner timely filed a response on December 19, 2007.

6. A final rejection was mailed on March 17, 2008 setting a one-month shortened statutory period (SSP) for response as litigation was stayed for purposes of this proceeding.

7. A petition for extension of time was filed on April 8, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the final office action mailed March 17, 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 8, 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 that "Mr. Mogil is currently overseas on business, and will not be able to contribute to preparation of a response to the Office Action before his return on the weekend of April 21, 2008". 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 one month 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.

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8704

(For Patent Owner)

MAILED

APR 24 2009

CENTRAL REEXAMINATION UNIT

Lori A Gordon
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Ave., NW
Washington, DC 20005

(For Patent Owner,
Courtesy Copy Only)

David L. McCombs
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party
Requester)

DECISION
GRANTING
PETITION FOR
EXTENSION
OF TIME
37 CFR § 1.550(c) and
§ 1.181

In re: Richard A Belgard
Ex Parte Reexamination Proceeding
Control No. 90/008,722
Deposited on: 15 June 2007
For: US Patent No. 5,895,503

This is a decision on the 15 April 2009, "Petition Under 37 CFR § 1.183 to Waive the Provisions for Response to Office Action of 37 CFR § 1.515(c)" requesting that the time for responding to the non-final Office action mailed 31 March 2009, be extended by thirty (30) days. The petition was timely filed with the petition fee. The petition title while filed pursuant to 37 CFR § 1.183 and § 1.515(c) will be addressed under 37 CFR § 1.181 and § 1.550(c) since these are the sections under

which petitions for extensions of time are addressed by the USPTO for reexamination proceedings.

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 20 April 1999 US Patent No. 5,895,503 was granted to Richard A Belgard.

2. On 15 June 2007 a request for *ex parte* reexamination was submitted by a third party requester.

3. On 16 August 2007 the Order was granted for *ex parte* reexamination.

4. On 31 March 2009 a non-Final Office action was mailed to the patent owner's address of record.

5. On 15 April 2009 the instant petition was submitted.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 31 March 2009, which set a two (2) months 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 15 April 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an

argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

37 CFR § 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

...

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double Correspondence with the patent owner or owners and the patent owner 's attorney or agent, or with more than one attorney or agent, will not be undertaken.

MPEP 2222 Address of Patent Owner (in-part)

If the patent owner desires that a different attorney or agent receive correspondence, then a new power of attorney must be filed. See MPEP § 324 for establishing an assignee's right to take action when submitting a power of attorney.

Submissions to the Office to change the correspondence address or power of attorney in the record of the patent should be addressed as follows:

Where a request for ex parte reexamination has been filed :

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

ANALYSIS AND FINDINGS

The patent owner's representative to extend the period for response by adding thirty (30) days 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 non-final rejection mailed 31 March 2009. The patent owner submitted a timely filed petition with the appropriate fee.

The petition dated 15 April 2009 articulates there has been a change in the patent owner as well as a change in counsel. While there is no indication in this proceeding that the counsel for the patent owner has changed, a courtesy copy of this decision will be mailed to the address of the petitioner. Given the extensive amount of documentation to be considered by the new assignee of the instant patent and this proceeding as well as the confusion over who is representing the patent owner, on balance, the events identified by the petitioner seem to demonstrate "sufficient cause" to grant a thirty (30) days extension of time.

The petition request to extend the response time by thirty (30) days is hereby granted.

The patent owner is reminded of the requirements of MPEP § 2222 which state in part:

> Further, 37 CFR § 10.23(c)(8) requires a practitioner to "timely notify the Office of an inability to notify a client or former client of correspondence received from the Office" (Emphasis added.) As the language of this requirement clearly indicates, the duty to notify the Office is a consequence, not of any attorney-client relationship, but rather arises by virtue of the practitioner's status as a registered patent attorney or agent. If the patent owner desires that a different attorney or agent receive correspondence, then a new power of attorney must be filed. See MPEP § 324 for establishing an assignee's right to take action when submitting a power of attorney. (emphasis added)

In light of the reasons for granting the extension of time, the patent owner should note the requirements involved in changes in correspondence address and/or representation.

CONCLUSION

1. The patent owner's petition for extension of thirty (30) days time in which to file a response to the Office action dated 31 March 2009 is hereby **granted**

2. The period for response is extended by thirty (30) days.

3. The Patent Owner's response is due **31 May 2009.**

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

By Mail to: Mail Stop *Ex Parte* Reexam

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/008,724	06/19/2007	6237776	R07-06-4638	7939

7590 05/05/2008

EXAMINER	

MURAT, OZGU, ARENT, FOX,, KINTNER, PLOTKIN & KAHN PLLC
1050 Connecticut Ave.
Suite 600
Washington, DC 20036-5339

ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Arent Fox LLP
1050 Connecticut Avenue, N. W.
Suite 400
Washington, DC 20036

(For Patent Owner)

MAILED

MAY 05 2008

CENTRAL REEXAMINATION UNIT

R. Joseph Trojan
Trojan Law Offices
9250 Wilshire Blvd, Suite 325
Beverly Hills, CA 90212

(For Requester)

In re: Mogil
Reexamination Proceeding
Control No. 90/008,724
Request Deposited: June 19, 2007
For: U.S. Patent No. 6,237,776

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

This is a decision on the April 8, 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 two months.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,237,776 (hereinafter, the '776 patent), issued to Mogil, on May 29, 2001.

2. On June 19, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '776 patent. The reexamination proceeding was assigned Control No: 90/008,724 (hereinafter, the '8724 proceeding).

3. The reexamination order was granted in the '8724 proceeding on August 3, 2007.

4. A non-final rejection was mailed on November 19, 2007 setting a one-month shortened statutory period (SSP) for response as litigation was stayed for purposes of this proceeding.

5. Patent Owner timely filed a response on December 19, 2007.

6. A final rejection was mailed on March 17, 2008 setting a one-month shortened statutory period (SSP) for response as litigation was stayed for purposes of this proceeding.

7. A petition for extension of time was filed on April 8, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the final office action mailed March 17, 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 8, 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 that "Mr. Mogil is currently overseas on business, and will not be able to contribute to preparation of a response to the Office Action before his return on the weekend of April 21, 2008". 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 one month 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.

Eric Keasel For

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

MAILED

NOV 04 2009

CENTRAL REEXAMINATION UNIT

In re Application of :
VASEL ET AL. :
Control No. 90/008,731 (US PAT 7,194,960) : DECISION ON PETITION
Filed: June 27, 2007 : TO WITHDRAW
Attorney Docket No. 86905 7304 : 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 02, 2009.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Thomas F. Lebens on behalf of all attorneys of record who are associated with customer No. 22242.

All attorneys/agents associated with the Customer Number 22242 have been withdrawn.

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

The correspondence address of record has been changed and the new correspondence address is the first copied address indicated below.

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

Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: PEPPERBALL TECHNOLOGIES, INC.
6142 NANCY RIDGE DRIVE, SUITE 101
SAN DIEGO, CA 92121

cc: RONALD GORSCHE (Third Party Requester)
BROWNSTEIN HYATT FARBER SCHRECK, PC
410 SEVENTEENTH STREET
SUITE 2200
DENVER, CO 80202

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on November 02, 2009. There is no indication it was served on the Third Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,733	07/06/2007	7096937		4746

23720 7590 07/07/2008

WILLIAMS, MORGAN & AMERSON
10333 RICHMOND, SUITE 1100
HOUSTON, TX 77042

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Williams, Morgan & Amerson
10333 Richmond, Suite 1100
Houston, TX 77042

(For Patent Owner)

MAILED

JUL 07 2008

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/008,733
Filed : July 6, 2007
For U.S. Patent No. : 7,096,937

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/009,064
Filed : February 29, 2008
For U.S. Patent No. : 7,096,937

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. 90/008,733 was ordered in a decision mailed September 5, 2007 indicating that claim 1 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. Information Disclosure Statements were filed on October 4, 2007, November 1, 2007 and November 2, 2007. There are no amendments to the claims specification or drawings in this reexamination proceeding. No further action has taken place in this reexamination proceeding.

Reexamination in application control No. 90/009,064 was ordered in a decision mailed April 14, 2008 indicating that claims 2-24 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. There are no amendments to the claims specification or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/008,733 and reexamination control No. 90/009,064 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 1-24, 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. 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. 90/008,733 and 90/009,064 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Gregory Morse, Director
Central Reexamination Unit

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.
90/008,734	07/06/2007	7069988		4756

23720 7590 07/07/2008

WILLIAMS, MORGAN & AMERSON
10333 RICHMOND, SUITE 1100
HOUSTON, TX 77042

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Williams, Morgan & Amerson
10333 Richmond, Suite 1100
Houston, TX 77042

(For Patent Owner)

MAILED

JUL 07 2008

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/008,734
Filed : July 6, 2007
For U.S. Patent No. : 7,069,988

DECISION MERGING REEXAMINATION PROCEEDINGS

Reexam Control No.: 90/009,063
Filed : February 29, 2008
For U.S. Patent No. : 7,069,988

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. 90/008,734 was ordered in a decision mailed September 5, 2007 indicating that claims 1, 6, 11-13, 16, and 17 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. Information Disclosure Statements were filed on October 4, 2007, November 1, 2007 and November 2, 2007. There are no amendments to the claims specification or drawings in this reexamination proceeding. No further action has taken place in this reexamination proceeding.

Reexamination in application control No. 90/009,063 was ordered in a decision mailed April 14, 2008 indicating that claims 2-5, 7-9, 14 and 15 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. There are no amendments to the claims specification or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/008,734 and reexamination control No. 90/009,063 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 1-9, and 11-17, 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. 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. 90/008,734 and 90/009,063 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Gregory Morse, Director
Central Reexamination Unit

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.
90/008,737	07/12/2007	5825449	01450.0023.000000	6736

30827 7590 02/13/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,221	07/17/2008	5,825,449	1160-01-REX-SM	9018

7590 02/13/2009

FINNEGAN,HENDERSON,FARABOW,GARRETT & DUNNER, L.L.P
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

MAILED

FEB 13 2009

CENTRAL REEXAMINATION UNIT

HOWREY LLP - EAST
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH, VA 22042-2924

(For Third Party Requester)

KLEIN, O'NEILL & SINGH, LLP
43 CORPORATE PARK, SUITE 204
IRVINE, CA 92606
ATTN: SCOTT LORAS MURRAY

(For Third Party Requester)

In re Shin
Reexamination Proceeding
Control No. 90/008,737
Request Deposited: July 10, 2007
For: U.S. Patent No. 5,825,449

In re Shin
Reexamination Proceeding
Control No. 90/010,221
Request Deposited: July 16, 2008
For: U.S. Patent No. 5,825,449

: 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. 5,825,449 (hereinafter, the '449 patent), issued to Shin, on October 20, 1998.

2. On July 10, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '449 patent. The reexamination proceeding was assigned Control No. 90/008,737 (hereinafter, the '8737 proceeding).

3. The Reexamination Order was granted in the '8737 proceeding on October 15, 2007.

4. On July 16, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '449 patent. The reexamination proceeding was assigned Control No. 90/010,221 (hereinafter, the '10221 proceeding).

5. The Reexamination Order was granted in the '10221 proceeding on October 10, 2008.

6. A non-final office action was mailed in the '8737 proceeding on December 22, 2008 setting a 2-month period for response.

7. There are currently no amendments in either proceeding.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8737 and the '10221 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. 90/008,737 and 90/010,221 are MERGED.

2. The period for response to the non-final office action of the '8737 remains running. A response to the action in the merged proceeding, as outlined above, is due on or before February 23, 2009 (February 22 is a Sunday).

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, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,221	07/17/2008	5,825,449	1160-01-REX-SM	9018

7590 07/14/2009

EXAMINER	

FINNEGAN,HENDERSON,FARABOW,GARRETT & DUNNER, L.L.P
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

ART UNIT	PAPER NUMBER

DATE MAILED: 07/14/2009

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

Copied from 90010221 on 07/15/2009

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
SCOTT LORAS MURRAY
KLEIN,O'NEILL & SINGH, LLP
43 CORPORATE PARK, SUITE 204
IRVINE, CA 92606

Date:
MAILED
JUL 14 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010221
PATENT NO. : 5825449
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)).

Copied from 90010221 on 07/15/2009

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

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(for patent owner)

MAILED

JUL 14 2009

CENTRAL REEXAMINATION UNIT

HOWREY LLP - EAST
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH, VA 22042-2924

(for requester)

Klein, O'Neill & Singh, LLP
43 Corporate Park, Suite 204
Irvine, CA 92606

(for requester)

In re Reexamination of USP 5825449
Cont. Nos.: 90/008,737 and 90/010,221
Filed: July 10, 2007 and July 16, 2008
For: **LIQUID CRYSTAL DISPLAY DEVICE AND METHOD OF MANUFACTURING THE SAME**

DECISION ON PETITIONS UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed March 16, 2009 and May 14, 2009, to expunge information from the above identified merged reexamination proceedings.

The petitions are granted.

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

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

Copied from 90010221 on 07/15/2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,221	07/17/2008	5,825,449	1160-01-REX-SM	9018

7590 07/14/2009

EXAMINER	

FINNEGAN,HENDERSON,FARABOW,GARRETT & DUNNER, L.L.P
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

ART UNIT	PAPER NUMBER

DATE MAILED: 07/14/2009

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

Copied from 90010221 on 07/15/2009

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

SCOTT LORAS MURRAY
KLEIN,O'NEILL & SINGH, LLP
43 CORPORATE PARK, SUITE 204
IRVINE, CA 92606

Date:

MAILED

JUL 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010221
PATENT NO. : 5825449
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)).

Copied from 90010221 on 07/15/2009

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

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(for patent owner)

MAILED
JUL 14 2009
CENTRAL REEXAMINATION UNIT

HOWREY LLP - EAST
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH, VA 22042-2924

(for requester)

Klein, O'Neill & Singh, LLP
43 Corporate Park, Suite 204
Irvine, CA 92606

(for requester)

In re Reexamination of USP 5825449
Cont. Nos.: 90/008,737 and 90/010,221
Filed: July 10, 2007 and July 16, 2008
For: **LIQUID CRYSTAL DISPLAY DEVICE AND METHOD OF MANUFACTURING THE SAME**

DECISION ON PETITIONS UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed March 16, 2009 and May 14, 2009, to expunge information from the above identified merged reexamination proceedings.

The petitions are granted.

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

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

Copied from 90010221 on 07/15/2009

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

The expunged material has been removed from the official file and is being returned to petitioner (patent owner). A copy of this decision (without the expunged material) is being sent to both requesters and will be entered in the file.

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

Gregory Morse
Director, Central Reexamination Unit

Copied from 90010221 on 07/15/2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,740	07/12/2007	4,383,272	75543-017	8621

7590 11/18/2008

EXAMINER	

S.E. HOLLANDER
BELL TELEPHONE LABS. INC.
600 MOUNTAIN AVE.
MURRAY HILL, NJ 07974

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,789	08/06/2007	4,383,272	75543-019	5033

530 7590 11/18/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2008

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

McDERMOTT WILL &EMERY LLP
KENNETH L. CAGE
600 13th STREET, N.W.
WASHINGTON, DC 20005-3096

Date:

MAILED

NOV 18 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008789
PATENT NO. : 4383272
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

NOV 18 2008

CENTRAL REEXAMINATION UNIT

S. E. HOLLANDER
BELL TELEPHONE LABS. INC.
600 MOUNTAIN AVE.
MURRAY HILL NJ 07974

(For Patent Owner)

Kenneth L. Cage
McDermott Will & Emery LLP
600 13th Street, NW
Washington, DC 20005-3096

(For Third Party Requester)

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

(courtesy copy)

In re Netravali *et alia*
Reexamination Proceeding
Control No. 90/008,740
Request Deposited: July 12, 2007
For: U.S. Patent No. 4,383,272

In re Netravali *et alia*
Reexamination Proceeding
Control No. 90/008,789
Request Deposited: August 6, 2007
For: U.S. Patent No. 4,838,272

: 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. 4,838,272 (hereinafter, the '272 patent), issued to Netravali *et alia*, on May 10, 1983.

2. On July 12, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '272 patent. The reexamination proceeding was assigned Control No. 90/008,740 (hereinafter, the '8740 proceeding).

3. The Reexamination Order was granted in the '8740 proceeding on August 16, 2007.

4. There are currently no amendments in the '8740 proceeding.

5. On August 6, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '272 patent. The reexamination proceeding was assigned Control No. 90/008,789 (hereinafter, the '8789 proceeding).

6. The Reexamination Order was granted in the '8789 proceeding on September 1, 2007.

7. There are currently no amendments in the '8789 proceeding.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8740 and the '8789 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. It should be noted that the patent has expired so no amendments are permitted.

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. 90/008,740 and 90/008,789 are MERGED.

2. The reexamination files are being forwarded to the examiner for 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

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

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

(For Patent Owner)

RECEIVED
MAY 02 2008
CENTRAL REEXAMINATION UNIT

Jeremy S. Pitcock
KASOWITZ, BENSON, TORRES &
FRIEDMAN LLP
1633 Broadway
23rd Floor
New York, NY 10019

(For Third Party Requester)

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

In re: Shaw *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,744
Deposited on: 20 September 2007
For: US Patent No.: 4,859,016

In re: Shaw *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,941
Deposited on: 28 November 2007
For: US Patent No.: 4,859,016

This is a decision on the 23 April 2008, petition for "Request for Extension Under 37 CFR § 1.550 (c)" requesting that the time for responding to the Office action mailed 11 April 2008, be extended by two-months.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 11 April 2008, which set a one month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 23 April 2008, together with an electronic fee transmittal for the $200.00 petition fee as is required by 37 CFR 1.515(c) and 37 CFR 1.17 (g).

37 CFR 1.550 (c) states:

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

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

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

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is insufficient to justify an extension of time. While it is true that there may have been 118 proposed prior art combinations, the actual rejection of the patent claims is far less in number and thus could reasonably be addressed in the reduced statutory time period. The time period is a balance between the needs of the Patent Owner and the need for special dispatch. In these circumstances there are insufficient grounds to support an extension of time. The request for two-months extension of time is dismissed.

The petition request is hereby **Granted.**

Conclusion

1. The patent owner's petition for extension of two-months time in which to file a response to the Office action dated 11 April 2008 is hereby **dismissed.**

2. Patent owner is invited to file a renewed petition for extension of time, without additional fee, to address the deficiencies noted above, in order to appropriately establish "sufficient cause" for granting the extension of time. Any such renewed petition would be directed to the Central Reexamination Unit.

3. The Patent Owner's response is due **11 May 2008**.

4. Response may be submitted as follows:

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

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

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

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

MARK J. REINHART
CRU SPE-AU 3992

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,746	08/02/2007	5938197		9909

23552 7590 02/25/2009

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date:

MAILED

FEB 2 5 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008746
PATENT NO. : 5938197
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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FEB 25 2009

CENTRAL REEXAMINATION UNIT

In re Application of 5938197
Appl. No.: 90/008,746
Filed: August 02, 2007
For: Random Number Generator For Game Playing

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed February 8, 2008 , to expunge information from the above identified application.

The petition is dismissed.

Petitioner requests that a document entitled "Deposition Transcript of Kurt Benson dated January 17, 2006, Michael Bowling v. Hasbro, Inc., Civil Action No. 05-229S", filed December 31, 2007, be expunged from the record.

The petition is deficient because: the petition does not contain a clear statement that the information requested to be expunged is either: (1) a trade secret, proprietary, and/or subject to a protective order; or (2) was unintentionally submitted and 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. The petition lacks the second statement.

A renewed petition that includes the omitted statement indicated above should be filed shortly after the mailing of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) (i.e., in time to be addressed before the reexamination proceeding enters the reexamination process), or any material then in the file will remain therein and be open to the public in accordance with 37 C.F.R. 1.14.

Andres Kashnikow,
SPE AU 3993
(571) 272-4361

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.
90/008,746	08/02/2007	5938197	12206.0004USRX	9909

23552 7590 04/01/2009

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2009

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

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008746
PATENT NO. : 5938197
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Application of 5938197
Appl. No.: 90/008,746
Filed: August 02, 2007
For: Random Number Generator for Game Playing

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the renewed petition under 37 CFR 1.59(b), filed March 25, 2009, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled "Deposition Transcript of Kurt Benson dated January 17, 2006, Michael Bowling v. Hasbro, Inc., Civil Action No. 05-229-S", filed December 31, 2007 as part of an Information Disclosure Statement, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

As the material to be expunged has been scanned into the electronic Image File Wrapper (IFW) of the proceeding, it cannot be physically returned. Therefore, the scanned copy of the material in question is being expunged by closing the document in the IFW file of the present proceeding and marked as "not public". It will not constitute part of the present reexamination proceeding.

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.
90/008,749	07/03/2007	4763356	75543-015	9960

7590 10/16/2008

John P. McDonnell
AT&T BELL LABORATORIES
600 Mountain Ave.
Murray, NJ 07974

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/16/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,625	05/03/2007	4763356	75543-011	1812

7590 10/16/2008

John P. McDonnell
AT&T BELL LABORATORIES
600 Mountain Ave.
Murray Hill, NJ 07974

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/16/2008

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

MAILED

OCT 16 2008

CENTRAL REEXAMINATION UNIT

John P. McDonnell
AT&T BELL LABORATORIES
600 Mountain Ave.
Murray NJ 07974

(For Patent Owner)

Kenneth L. Cage
McDermott Will & Emery LLP
600 13th Street, NW
Washington, DC 20005-3096

(For Third Party Requester)

In re Day, Jr. *et alia*
Reexamination Proceeding
Control No. 90/008,625
Request Deposited: May 3, 2007
For: U.S. Patent No. 4,763,356

In re Day, Jr. *et alia*
Reexamination Proceeding
Control No. 90/008,749
Request Deposited: July 3, 2007
For: U.S. Patent No. 4,763,356

: 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. 4,763,356 (hereinafter, the '356 patent), issued to Day, Jr. *et alia*, on August 9, 1988.

2. On May 3, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '356 patent. The reexamination proceeding was assigned Control No. 90/008,625 (hereinafter, the '8625 proceeding).

3. The Reexamination Order was granted in the '8625 proceeding on September 10, 2007.

4. There are currently no amendments in the '8625 proceeding.

5. On July 3, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '356 patent. The reexamination proceeding was assigned Control No. 90/008,749 (hereinafter, the '8749 proceeding).

6. The Reexamination Order was granted in the '8749 proceeding on September 10, 2007.

7. There are currently no amendments in the '8749 proceeding.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8625 and the '8749 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. 90/008,625 and 90/008,749 are MERGED.

2. The reexamination files are being forwarded to the examiner for 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

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.
90/008,751	06/29/2007	6846477		2036

23913 7590 07/02/2008

PFIZER INC
Steve T. Zelson
150 EAST 42ND STREET
5TH FLOOR - STOP 49
NEW YORK, NY 10017-5612

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JUDY JARECKI-BLACK, PH.D, J.D.
MERIAL LIMITED
3239 SATELITTLE BLVD
DULUTCH, GA 30096-4640

Date: MAILED

JUL 0 2 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008751
PATENT NO. : 6846477
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

Peter Bernstein
400 Garden City Plaza
Suite 300
Garden City, NY 11530

(For Patent Owner)

MAILED

JUL 02 2008

CENTRAL REEXAMINATION UNIT

Judy Jarecki-Black, Ph.D., J.D.
Merial Limited
3239 Satelittle Boulevard
Dulutch, GA 30096-4640

(For Third Party Requester)

In re Reexamination Proceedings :
Keich et al. : DECISION GRANTING PETITION
Control No. 90/008,751 :
Filed: June 29, 2007 :
Attorney Docket No. 14288REX (PC11858A) :

This is a decision on the petition under 37 CFR 1.137(a) filed by the patent owner on June 25, 2008, for entry of late papers based upon unavoidable delay.

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

37 CFR 1.137(a) states:

> (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(l); (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

A review of the present petition reveals that it includes, *inter alia*, a response to the outstanding Office action, to serve as the response required by 37 CFR 1.137(a) (item 1). It further includes payment of the requisite unavoidable delay fee for a non-small entity was made (item 2). The petition further contains the proper statement for unavoidable 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)

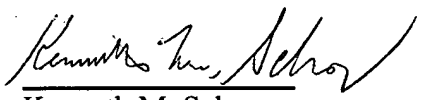
Accordingly, the present petition under 37 CFR 1.137(a) includes the requisite response (item 1), the $510.00 petition fee under 37 CFR 1.17(l) (item 2), and the requisite statement (item 3).

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. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor at 571-272-7710.



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

7-1-08

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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PFIZER INC
MARY J HOSLEY
150 EAST 42ND STREET
MS: 150/02/E112
NEW YORK, NY 10017-5612

: FOR PATENT OWNER

MAILED

JAN 19 2010

CENTRAL REEXAMINATION UNIT

JUDY JARECKI-BLACK, PH.D., J.D.
MERIAL LIMITED
3239 SATELLITE BLVD.
DULUTH, GEORGIA 30096-4640

: FOR THIRD PARTY REQUESTER

In re Keich et al.

Reexamination Proceeding
Control No. : 90/008,751
Filed : June 29, 2007
Patent No. 6,846,477

: DECISION ON PATENT OWNER'S PETITION UNDER 37 CFR 1.181

This is a decision addressing Patent Owner's petition under 37 CFR 1.181, filed November 16, 2009. The petition requests entry of the declaration under 37 CFR 1.132 of Dr. Dennis Foss, filed November 2, 2009.

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

SUMMARY

Patent Owner's petition is DENIED.

BACKGROUND

1. Patent No. 6,846,477 issued on January 25, 2005.

2. A request for reexamination, assigned Control No. 90/008,751, was filed by a third party Requester on June 29, 2007.

3. Reexamination was ordered in the '751 proceeding on September 20, 2007.

4. An Office action on the merits was mailed on January 8, 2008.

5. On June 20, June 25 and August 15 2008, Patent Owner filed replies to the Office action by the examiner.

6. On October 8, 2008, the Office mailed a final rejection.

7. On January 8, 2009, Patent Owner filed a response to the final rejection.

8. On January 21, 2009, the Office mailed an advisory action.

9. On February 6, 2009, Patent Owner filed a second response after final rejection.

10. On February 7, Patent Owner filed a notice of appeal.

11. On March 5, 2009, the Office mailed an advisory action.

12. On May 4, 2009, Patent Owner filed a third response after final rejection.

13. On May 7, 2009, Patent Owner filed an appeal brief.

14. Prosecution was reopened and the Office mailed a final rejection on July 17, 2009.

15. On September 16, 2009, Patent Owner filed a response to the final rejection, including claim amendments and a declaration under 37 CFR 1.132 by Dr. Dennis Foss.

16. On September 29, 2009, the Office mailed an advisory action and on October 7, 2009 a supplemental advisory action was mailed. The examiner indicated that the amendments would be entered and that the Foss declaration had been considered, but did not overcome the rejections of record.

17. On November 2, 2009, Patent Owner filed another response after final rejection which included a supplemental declaration under 37 CFR 1.132 by Dr. Dennis Foss.

18. On November 12, 2009, the Office mailed an advisory action. The examiner indicated that the response and declaration would not be entered because they would not overcome the rejections of record and because Patent Owner had not provided any reason why the declaration was not presented with the previous response.

19. On November 16, 2009, the instant petition was filed.

DECISION

Admission of evidence after a final rejection is governed by 37 CFR 1.116(e), which reads as follows:

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

Patent Owner's lengthy arguments are mostly directed to the merits of the rejections made by the examiner. Since these issues are subject to appeal and are not decided by petition, they will not be discussed here.

Patent Owners are not entitled to have evidence submitted after final rejection considered as a matter of right; any submission after final rejection must be accompanied by a showing as required by 37 CFR 1.116(e). It is noted that a first declaration from Foss has already been entered after the final rejection (entered September 29, 2009). Patent Owner has not provided any reason why the second Foss declaration could not have been presented earlier in this proceeding. The second Foss declaration and accompanying remarks filed November 2, 2009 have each been reviewed. Neither document offers any reason why the evidence in the second Foss declaration could not have been presented in the first declaration filed September 16, 2009.

Patent Owner argues (petition, p. 7 and p. 10) that the second Foss declaration is necessary because the advisory action did not provide a detailed rebuttal to the first Foss declaration. While it is clear why Patent Owner considers the second declaration necessary, there is still no good and sufficient reason why this evidence was not presented in the first declaration. Thus Patent Owner's argument is not persuasive.

CONCLUSION

1. Patent Owner's petition filed November 16, 2009 is **DENIED** for the reasons discussed above.

2. Patent Owner's appeal brief is due January 17, 2010.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director

MAILED

FEB 04 2010

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

PFIZER INC
150 East 42nd Street
MS: 150/02/E112
New York, NY 10017-5612

for Patent Owner

Judy Jarecki-Black, Ph.D., J.D.
MERIAL LIMITED
3239 Satellite Blvd.
Duluth, Georgia 30096-4640

for Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,751
Filed: June 29, 2007
For: US Patent No. 6,846,477

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

This is a decision on the petitions filed November 18, 2009 and December 15, 2009 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing an Appeal Brief.

The petitions are before the Director of the Central Reexamination Unit for consideration.

The petitions are dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file an Appeal Brief from the currently applicable date of January 17, 2010 to February 17, 2010 pursuant to the Notice of Appeal filed November 17, 2009. 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

Patent Owner requests that the due date for the Appeal Brief be deferred pending the outcome of the petition under 37 CFR 1.181, filed November 16, 2009, to request entry of papers filed November 2, 2009.

Analysis and Findings

In the interview held March 25, 2009, patent owner discussed the after-final amendment of February 6, 2009 and proposed a supplemental amendment to be entered so that the claims would concisely limit and focus the issues that will be present on appeal. Patent owner was informed at the interview that this would

result in reinstating the previous rejections and that the subsequent Office action would be Final. Patent owner filed the request for reconsideration and an after-final amendment and IDS on May 4, 2009. This amendment was entered and a Final rejection was mailed July 17, 2009. Patent owner submitted another amendment and request for reconsideration on September 24, 2009 which was entered. The advisory mailed on September 29, 2009 clearly indicated the status of the claims and referred Patent owner to the Final action for a discussion of the maintained rejections. A supplemental after-final amendment was submitted November 11, 2009 which was not entered. The Notice of Appeal was timely filed on November 17, 2009 and the Appeal Brief was timely filed on January 19, 2010. In view of the fact that the Appeal Brief was filed within the time period for response, these petitions are dismissed as moot.

Conclusion

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

2. 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/
Deborah Jones, SPE
Central Reexamination Unit 3991

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,751	06/29/2007	6846477		2036

23913 7590 03/23/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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(For Patent Owner)

MAILED

MAR 23 2010

CENTRAL REEXAMINATION UNIT

Judy Jarecki-Black
MERIAL LIMITED
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(For Requester)

In re Keich *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/008,751
Filed: June 29, 2007
For: U.S. Patent No. 6,846,477 B2

DECISION
DISMISSING PETITION
UNDER § 1.182

This is a decision on the February 26, 2010 patent owner petition entitled "PETITION UNDER § 1.182 REQUESTING CONTINUED REEXAMINATION."

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

The petition fee under 37 C.F.R. § 1.17(f) of $400 has been submitted.

The petition is **dismissed**.

BACKGROUND

- On June 29, 2007, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,751 ("the '8751 proceeding").

- Reexamination of claims 1-4, 6-12, and 14-17 was ordered in an Office decision issued on September 20, 2007.

- On January 8, 2008, a nonfinal Office action was issued that included rejections based upon WO 94/07531 (Bhogal '531).

- On August 15, 2008, patent owner submitted claim amendments and remarks in response to the nonfinal Office action, and in particular, to the rejection over Bhogal '531.

- On October 8, 2008, the Office mailed a final Office action in which the rejections over Bhogal '531 were withdrawn, as stated on page 5 of that action, in view of the August 15, 2008 amendment to claim 1 in which the phrases "consisting essentially of administering a single dose of vaccination" and "wherein said animal is not derived from a *M. hyopneumoniae* vaccinated animal" were added.

- On January 21, 2009, the Office mailed an advisory Office action denying entry of after-final claim amendments submitted on January 8, 2009, as raising new issues, as being noncompliant with § 1.530(f), and as proposing to amend a claim not subject to reexamination.

- On February 6, 2009, patent owner submitted a supplemental (second) amendment after final rejection, and on February 7, 2009, patent owner filed a Notice of Appeal.

- On March 5, 2009, an advisory Office action was mailed refusing entry of the February 6, 2009 patent owner supplemental amendment. The advisory action stated that "the proposed amendment to claim 1 would re-raise prior art rejections over Bhogal et al," and that other new issues would be raised through entry of the amendment, which would not overcome the prior art rejection of record.

- On March 25, 2009, an interview was held between the patent owner's representative and Office staff. Patent owner's statement summarizing the interview was filed on April 7, 2009, and stated on page 1 that the proposed amendment would "concisely limit and focus the issues that will be present on appeal, in order to facilitate review by the Board or a Court, and that thus, on this basis, the amendments should be entered of record for further consideration."

- On May 4, 2009, patent owner submitted a (third) after-final submission - a request for reconsideration, in which the "wherein said animal is not derived from a *M. hyopneumoniae* vaccinated animal" language was removed from claim 1.

- On May 7, 2009, patent owner timely submitted an Appeal Brief.

- On July 17, 2009, the Office mailed a final Office action, withdrawing the previous final Office action of October 8, 2008, and rejecting all of the claims under reexamination, including rejections over Bhogal '531.

- On September 16, 2009, patent owner submitted a (fourth) after-final submission [1] including claim amendments, a declaration by Dr. Foss, and an Information Disclosure Statement.

- On September 29, 2009, the Office issued an advisory action entering the proposed amendment and declaration by Dr. Foss, and maintaining certain rejections set forth in

[1] The first after-final submission with respect to the July 17, 2009 final Office action.

the final Office action of July 17, 2009. A further advisory Office action, issued on October 7, 2009, clarified that the Foss declaration was considered, but was insufficient to overcome the art rejections.

- On November 2, 2009, patent owner filed a (fifth) after-final submission, including a second declaration by Dr. Foss, and an Information Disclosure Statement.

- On November 12, 2009, the Office issued an advisory action refusing entry of the November 2, 2009 response, including the second Foss declaration, as the declaration was stated not to overcome the art rejections of record, and as the patent owner "has not provided a sufficient reason why the declaration is necessary and was not presented with the After final amendment filed on 9/16/09."

- On November 16, 2009, patent owner filed a petition under 37 C.F.R. § 1.181," requesting entry of the evidence submission and remarks filed on November 2, 2009.

- On November 17, 2009, patent owner filed a notice of appeal; patent owner filed a request for oral hearing on November 18, 2009.

- On January 19, 2010, patent owner filed an appeal brief.

- Also on January 19, 2010, the Office mailed a decision denying patent owner's petition under § 1.181, as lacking a good and sufficient reason why the second declaration was not earlier presented.

- On February 26, 2010, patent owner filed the instant petition entitled " PETITION UNDER § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of the declaration and remarks filed on November 2, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[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.

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. The petition should therefore clearly discuss the manner in which the entry of the submission would so act such that continued prosecution is warranted. Following the same rationale, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final rejection or action closing prosecution. Thus, a petition for continuation of the reexamination prosecution should explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution (i.e., before issuance of the final rejection).

In this instance, patent owner's response includes a submission directed towards the entry of the November 2, 2009 submission including a second Foss declaration and accompanying papers and remarks, as described in patent owner's instant petition. This declaration was denied entry in the advisory Office action of November 12, 2009, and the examiner's decision was upheld in the § 1.181 petition decision of January 19, 2010. These papers and declaration are alleged at pages 5-6 of the petition to focus and narrow the issues for appeal by supplying additional references that "directly cast doubt upon" the basis of the rejections of the claims over Bhogal, and patent owner seeks entry of this evidence "to address any further rejections and/or rebuttals."

Patent owner's response is not persuasive as to the reasons why the instant November 2, 2009 evidence submission warrants reopening of prosecution. The evidence submission consists of a second Foss declaration, which repeats points from the first Foss declaration submitted September 16, 2009, and states that additional references submitted with the declaration "cast doubt on the predictability of vaccination success." Foss declaration at 2. Since the first Foss declaration was entered by the Office on September 29, 2009, the second Foss declaration does not advance prosecution merely through its repetition of points already of evidence in the proceeding. With respect to the listed references, the declarant merely summarizes or quotes

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

certain sections of the documents. While these sections may be asserted to "cast doubt on the predictability of vaccination success," the petition fails to clearly explain how these additional references would advance the reexamination proceeding; e.g., through a specific argument of secondary considerations of nonobviousness or some other argument traversing a rejection. The petition states that petitioner seeks entry of this evidence "to address any further rejections and/or rebuttals." Petition at 5. However, as prosecution has closed, the final rejection of the Office action of July 17, 2009 stands as the final rejection of the claims. Therefore, entry of an affidavit to address "future rejections and/or rebuttals," in this situation is not a persuasive reason to reopen prosecution.

Furthermore, patent owner's response is not persuasive as to the reasons why such an evidence submission addressing this issue is necessary and could not have been presented earlier. To the contrary, this issue has been raised by the Office in the first Office action of January 8, 2008, argued in patent owner's response of June 20, 2008, and addressed by evidence filed by patent owner on September 16, 2009.

Patent owner was first presented with the Office position that Bhogal teaches a single dose vaccination of 3-10 day old piglets in the first Office action of January 8, 2008. Applicant thus had the opportunity to file a responsive declaration and any other contrary documents at that time. Patent owner, at that time, presented arguments addressing this issue and an amendment on August 15, 2008. However, patent owner failed to submit any evidence under § 1.132, despite the clear notice at MPEP 2272 that a patent owner should identify and develop all issues prior to the final Office action, including the presentation of evidence under § 1.132.

The Office again placed patent owner on notice of its position on the single dose vaccination issue in an advisory Office action issued on March 5, 2009. The March 5, 2009 advisory Office action, stated that entry of an amendment deleting "wherein said animal is not derived from a *M. hyopneumoniae* vaccinated animal" language from claim 1 would "re-raise prior art rejections over Bhogal et al." Therefore at March 5, 2009, patent owner was on notice to, and again had the opportunity to, present any declaration or contrary documents addressing that issue in patent owner's next-filed submission. Patent owner did not, however, file any evidence in its next-filed submission of May 4, 2009. At that point, the Office reopened prosecution to enter the amendment filed by patent owner, and the Office issued a new final Office action on July 17, 2009.

The Office subsequently entered an after-final evidence submission addressing this specific issue. Patent owner filed an evidence submission (first Foss declaration) on September 16, 2009, addressing the issue of single dose vaccination of 3-10 day old piglets. This after-final evidence submission was entered and fully considered by the Office as noted in the advisory Office actions mailed on September 29, 2009, and on October 7, 2009. Patent owner then, on November 2, 2009, filed the evidence submission (second Foss declaration) at issue in the present petition. In this evidence submission, the question of single dose vaccination of 3-10 day old piglets is again addressed. This issue was raised in the case in the first Office action of January 8, 2008, argued in patent owner's response of June 20, 2008, and addressed by evidence filed on September 16, 2009. Patent owner has therefore had a full and fair opportunity to provide evidence supporting his position.

Patent owner's petition presents additional arguments in support of the instant petition set forth on pages 1-4. These arguments address either previous action taken by the examiner, or the merits of the rejection. The former (pages 1-3) are properly addressed by a petition under §1.181, and the latter (pages 3-4) are properly addressed through the appeal process. To the extent that these arguments are made to support a contention that patent owner could not have presented the instant submission at an earlier date, the facts of the proceeding, as discussed above, do not support such a contention.

Patent owner has had numerous opportunities to present the November 2, 2009 evidence submission and failed to do so earlier. Neither patent owner, nor the file history, provides reasons why the contents of the November 2, 2009 submission could not have been presented at an earlier date, or explains the manner in which entry of the submission would advance the proceedings such that reopening of prosecution is warranted at this stage of the proceeding. The resolution of the substantial new question of patentability is this proceeding has previously been delayed for reopening of prosecution to enter an after-final amendment submitted by patent owner to place the proceeding in better condition for appeal. In view of these facts, reopening of the prosecution to consider this evidence submission at this stage in the proceedings would validate the unnecessary delay (by patent owner) in presenting the instant evidence submission in this proceeding contrary to the requirement of "special dispatch within the Office."

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

March 22, 2010
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UNITED STATES PATENT AND TRADEMARK OFFICE

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FALLS CHURCH, VA 22042-2924

Date:

MAILED

MAY 14 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008752
PATENT NO. : 5657317
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.
90/008,752	07/06/2007	5657317		2038

7590 05/14/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/14/2008

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MAILED

MAY 14 2008

CENTRAL REEXAMINATION UNIT

In re Ronald L. Mahany et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,752 : **DISMISSING**
Filed: July 6, 2007 : **PETITION**
For: U.S. Patent No. 5,657,317 :

This is a decision on the patent owner petition, filed April 7, 2008, denominated "Petition of Patent Owner Under 37 CFR § 1.183 Requesting That It Be Allowed to Submit the Declaration of the Patent Owner, Including the Declarations of Guy West & Steven Koenck."

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

The petition fee required under 37 CFR 1.17(f) has been charged to deposit account no. 13-0017, as authorized on page 5 of the petition.

The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is **dismissed**.

REVIEW OF FACTS

1. On August 12, 1997, U.S. Patent No. 5,657,317 (the '317 patent) issued to Mahany et al. and was assigned to Norand Corporation. Norand Corporation subsequently merged with Intermec Technologies Corporation, which assigned the patent rights to Intermec IP Corp. The present owner, Broadcom Corporation, acquired the patent rights via an assignment from Intermec IP Corp. recorded on Feb. 2, 2003.

2. On July 6, 2007, the third party requester filed a request for *ex parte* reexamination of claims 1, 6, 9, and 12 of the '317 patent, and the resulting reexamination proceeding was assigned control number 90/008,752 (the '8752 proceeding).

3. On August 13, 2007, an order granting the reexamination request was mailed.

4. A non-final Office action was mailed February 7, 2008, in which claims 1, 6, 9, and 12 were rejected. The Office action set a 1 month period for response.

5. On March 6, 2008, patent owner requested a one month extension of time, which was granted in a decision mailed on March 7, 2008.

6. On April 7, 2008, patent owner filed a response to the Office action, along with three declarations intended to establish date of conception and diligence. The declarations include a declaration by patent owner under 37 CFR 1.131, a declaration by one of the inventors Guy West, and a declaration by a former employee, Steven Koenck, of the prior assignee, Norand. The subject petition was filed therewith under 37 CFR 1.183 requesting permission to waive the signature requirement for the three declarations.

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 § 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.

37 CFR § 1.42 When the inventor is dead.

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

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).

DECISION

I. Petition Under 37 CFR 1.183 To Accept the Patent Owner Declaration Under 37 CFR 1.131

The petitioner requests the Office to accept the declaration by the patent owner offered under 37 CFR 1.131 to establish conception and diligence. 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, patent owner may pursue an alternative avenue that complies with the rules to obtain the requested relief.

37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination*. . . may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). 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 the case here. Moreover, 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 patent owner declaration submitted April 7, 2008, is signed by Noel B. Whitley, the Senior Director, Intellectual Property of Broadcom Corporation, who according to USPTO assignment records is the current owner of the '317 patent. However, the right of the assignee to take action has not been established. A statement under 37 CFR 3.73(b) must be submitted in order to establish that right including the appropriate documentary evidence or statement relating to the evidence and a showing that the person signing has the authority to act on behalf of the assignee.

Thus, although there appears to be an assignee available to execute the declaration under 37 CFR 1.131 consistent with the provisions of that rule, the authority to submit such a declaration has not been established. Therefore, while the petition to waive the rule is not required to accept a declaration by the patent owner, the patent owner declaration submitted with the petition is not acceptable as the right for the assignee to act on behalf of the inventors has not yet been properly established. Accordingly, the petition is dismissed.

II. Petition Under 37 CFR 1.183 To Waive the Signatures of the Two Unavailable Inventors on Declaration of Guy West

The petition submits that only one inventor is available to sign a declaration under 37 CFR 1.131. When the inventor(s) is unavailable to submit an appropriate oath or declaration to

establish invention of subject matter of a rejected claim prior to the effective date of a reference, a party qualified under 37 CFR 1.42, 1.43, or 1.47 may submit the oath or declaration. The petition states that one inventor is available and has executed a declaration (see the Declaration of Guy West). The petition further states that one inventor is deceased, with a copy of an obituary submitted to support that assertion, and that the other inventor is unwilling to sign the declaration, with a copy of an email submitted to support that assertion.

In the case of the death of an inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, in accordance with 37 CFR 1.42. A copy of an obituary does not satisfy the requirements of 37 CFR 1.42.

In the case of an inventor refusing to sign a declaration, the requirements of 37 CFR 1.47 must be met, including proof of the pertinent facts and the last known address of the non-signing inventor. The email submitted as evidence is not specific evidence that Mr. Bunte refuses to sign a declaration that establishes invention in accordance with 37 CFR. 1.131.

The petition has not satisfied the requirements under 37 CFR 1.42 or 37 CFR 1.47 required for the granting of the present 37 CFR 1.183 petition to waive the signature requirement of 37 CFR 1.131. Moreover, the petitioner has not provided evidence of any inability to submit a declaration under 37 CFR 1.131 signed by the assignee of the entire interest in the patent under reexamination. To the contrary, it would appear that patent owner (assignee) patent owner could establish authority to act on the inventor's behalf and (1) execute a declaration under 37 CFR 1.131 and use the declaration of Mr. West and Mr. Koenck to support the declaration under 37 CFR 1.131 or (2) legally authorize Mr. West to act on patent owner's (the assignee's) behalf in providing the affidavit to establish prior invention and provide a statement of such authorization. Accordingly, the petitioner has not shown the present situation to be one warranting extraordinary relief. Again, see *Cantello v. Rasmussen, supra.*

Accordingly, this aspect of the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

CONCLUSION

1. For the reasons set forth above, the petition under 37 CFR 1.183 to waive 37 CFR 1.131 as to its requirement for signature of an oath or declaration is **dismissed**.

2. This decision does not address the merits of the patent owner's response or the substance of the declarations, which would be determinations within the jurisdiction of the examiner of record.

3. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).

4. Any inquiry concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729, or in his absence, to the undersigned at (571) 272-7710.

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

May 12, 2008
C:\kiva\kenpet 7\ 8752 dec.131.no-waiver.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,753	07/16/2007	6415749	7883P058R	2968

8791 7590 11/19/2008

EXAMINER	

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

ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2008

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
JOHN J. PENNY JR.
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON MA 02205

Date:
MAILED

NOV 19 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008753
PATENT NO. : 6415749
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP (For Patent Owner)
1279 Oakmead Parkway
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John J. Penny, Jr. (For Third Party Requester)
EDWARDS ANGELL PALMER & DODGE LLP
P.O. Box 55874
Boston, MA 02205

MAILED

NOV 19 2008

CENTRAL REEXAMINATION UNIT

In re Sturman et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No.: 90/008,753 : **DISMISSING AND**
Filed: July 16, 2007 : **EXPUNGING PETITION**
For: U.S. Patent No. 6,415,749 :

This is a decision on the October 2, 2008 third party requester petition titled "PETITION UNDER 37 CFR § 1.182."

The third party requester petition paper is before the Office of Patent Legal Administration.

The petition is dismissed.

The third party requester petition paper is an improper paper. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the present reexamination proceeding.[1]

REVIEW OF FACTS

1. U.S. Patent No. 6,415,749 ("the '749 patent") issued to Sturman et al. on July 9, 2002.

2. On July 16, 2007, a request for *ex parte* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 90/008,753 ("the '8753 proceeding").

3. On September 24, 2007, an order granting *ex parte* reexamination in the '8753 proceeding was mailed.

4. On September 18, 2008, a first Office action on the merits was mailed.

[1] *See* MPEP 2267.

5. On October 2, 2008, the third party requester filed the present petition paper titled "PETITION UNDER 37 CFR § 1.182," which is the subject of this decision.

6. Also on October 2, 2008, a non-final Office action was mailed. The October 2, 2008 non-final Office action states at page 2 that the September 18, 2008 Office action is vacated in order to correct the omission of the rejection of claim 4.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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

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

35 U.S.C. § 304 provides:

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

37 CFR 1.183 provides:

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

DECISION

The October 2, 2008 third party requester petition paper filed under 37 CFR 1.182 is being treated as a petition under 37 CFR 1.183 to suspend the rules. However, the rules cannot be waived/suspended to provide the third party requester the right to file a paper at the present stage in the '8753 proceeding. Waiver/suspension of the rules to permit the third party requester submission via the petition is not justified in view of the legislation and implementing rules which make reexamination under 35 U.S.C. §§ 302 - 307 an *ex parte* proceeding. *See Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the Federal Circuit stated (paragraph bridging pages 1868 & 1869):

> If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination. See 35 U.S.C. § 305 **("[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination**"). Thus, a reexamination is conducted *ex parte* after it is instituted. See *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1 , 5-6 n.6 (Fed. Cir.), *cert.* denied, 474 U.S. 828 (1985)." [Emphasis added in bold].

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

On its face, the third party requester's October 2, 2008 petition paper was filed after the statutory statement and reply period ended in the '8753 proceeding. The statutory statement and reply period ended in the '8753 proceeding when the patent owner did not file a statement in response to the September 24, 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 2, 2008 petition paper, and the petition is **dismissed**.

CONCLUSION

1. The petition is dismissed.

2. The petition paper filed by the third party requester on October 2, 2008, is being expunged as not having an entry right. This will be carried out by closing the petition paper

(document) in the IFW of the '8753 proceeding and marking the paper "closed" and "non-public."

3. No copy of the petition papers will be maintained of record in the IFW for the '8753 proceeding, or elsewhere in the Office.

4. A copy of this decision will be made of record in the reexamination file.

5. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

November 18, 2008
C:\kiva\kimpropa\3PR\8753 improper 1.183 pet for 3PR participation-dismiss.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,757	07/18/2007	RE37807		3714

7590 07/08/2008

EXAMINER	
ART UNIT	PAPER NUMBER

CATERPILLAR INC
INTELLECTUAL PROPERTY DEPT.
AB6490
100 N.E. ADAMS
PEORIA, IL 61629-6490

DATE MAILED: 07/08/2008

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

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Roland McAndrews
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001

(For Patent Owner)

In re Reexamination Proceedings
Shinogle et al.
Control No. 90/008757
Filed: July 18, 2007

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on June 24, 2008, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

A review of the present petition reveals that it includes, *inter alia*, a reply to the outstanding Office action. As such, petitioner has provided the response required by 37 CFR 1.137(b) (item 1). Payment of the requisite unintentional delay fee for a large entity was made (item 2). The petition contains the proper statement for unintentional delay in filing the required response (item 3). The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer (item 4). 37 CFR 1.137(d)(3) .

Since the present petition under 37 CFR 1.137(b) includes the requisite response (item 1), the $1540.00 petition fee under 37 CFR 1.17(m) (item 2), and the requisite statement (item 3), the petition will be granted.

CONCLUSION

1. The petition for entry of late papers is **granted.**

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).

3. Telephone inquiries with regard to this decision should be directed to the undersigned t 571-272-7710.

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

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CENTRAL REEXAMINATION UNIT

Leonard Mitchard
Nixon & Vandehye
901 North Glebe Road, 11th Floor
Arlington VA, 22203

(for Patent Owner)

Judy Jarecki-Black, PhD, J.D.
Merial Limited
3239 Satellite Blvd.
Duluth, Georgia, 30096-4640

(for Third Party Requeste)

In re Donachie
Reexamination Proceeding
Control No.: 90/008,762
Filed: July 5, 2007
For: U.S. Patent 5,587,166

In re Donachie
Reexamination Proceeding
Control No.: 90/007,964
Filed: March 8, 2006
For: U.S. Patent 5,587,166

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 5,587,166 (the '166 patent) issued December 24, 1996 and is the subject of Reexamination Control Nos. 90/007,964 and 90/008,762.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,964, was filed March 8, 2006 by Judy Jarecki-Black of Merial Limited in Duluth, Georgia. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed invention or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/007,964 on April 5, 2006.

4. A first non-final Office action was issued on December 22, 2006.

5. Patent Owner filed a response on May 22, 2007.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,762, was filed July 5, 2007 by Judy Jarecki-Black of Merial Limited in Duluth, Georgia. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed invention or are so close as to establish a case of obviousness.

7. Reexamination was ordered for 90/008,762 on September 29, 2007.

81. No Office action has been issued in the later reexamination proceeding.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,964 and 90/008,762 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,964 and 90/008,762 as:

Leonard Mitchard
Nixon & Vandehye
901 North Glebe Road, 11th Floor
Arlington VA 22203

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in both Reexamination Control No. 90/006,946 and 90/007,987as:

Judy Jarecki-Black
Merial Limited
3239 Satellite Blvd.
Duluth Georgia 30096-4640

CONCLUSION

Reexamination Control Nos. 90/006,946 and 90/007,987 are merged. **Since there has been no amendment to the specification or claims, the requirement to submit a "housekeeping amendment" is waived.** An Office action will issue in due course.

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

for Lissi M. Marquis, Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Leonard Mitchard
Nixon & Vandehye
901 North Glebe Road, 11th Floor
Arlington VA, 22203

(for Patent Owner)

Judy Jarecki-Black, PhD, J.D.
Merial Limited
3239 Satellite Blvd.
Duluth, Georgia, 30096-4640

(for Third Party Requeste)

In re Donachie
Reexamination Proceeding
Control No.: 90/008,762
Filed: July 5, 2007
For: U.S. Patent 5,587,166

In re Donachie
Reexamination Proceeding
Control No.: 90/007,964
Filed: March 8, 2006
For: U.S. Patent 5,587,166

CORRECTED
DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 5,587,166 (the '166 patent) issued December 24, 1996 and is the subject of Reexamination Control Nos. 90/007,964 and 90/008,762.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,964, was filed March 8, 2006 by Judy Jarecki-Black of Merial Limited in Duluth, Georgia. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed invention or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/007,964 on April 5, 2006.

4. A first non-final Office action was issued on December 22, 2006.

5. Patent Owner filed a response on May 22, 2007.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,762, was filed July 5, 2007 by Judy Jarecki-Black of Merial Limited in Duluth, Georgia. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed invention or are so close as to establish a case of obviousness.

7. Reexamination was ordered for 90/008,762 on September 29, 2007.

81. No Office action has been issued in the later reexamination proceeding.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,964 and 90/008,762 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,964 and 90/008,762 as:

Leonard Mitchard
Nixon & Vandehye
901 North Glebe Road, 11th Floor
Arlington VA,22203

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in both Reexamination Control No. 90/008,762 and 90/007,964as:

Judy Jarecki-Black
Merial Limited
3239 Satellite Blvd.
Duluth Georgia 30096-4640

CONCLUSION

Reexamination Control Nos. 90/008,762 and 90/007,964 are merged. **Since there has been no amendment to the specification or claims, the requirement to submit a "housekeeping amendment" is waived.** An Office action will issue in due course.

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

for Lissi M. Marquis, Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Robert A. Miller
Patent & Licensing Department
NALCO Chemical Company
One Nalco Center
Naperville, IL 60563-1198

(For Patent Owner)

Timothy Keister, CWT
ProChemTech
P. O. Box 214
Brockway, PA 15824

(For Requester)

Attachment: September 29, 2008 patent owner petition under 37 CFR 1.137(b)

In re Dallmier et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,766
Filed: September 6, 2007
For: U.S. Patent No. 5,795,487

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

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 under 37 CFR 1.137(b)").

The September 29, 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. 14-0105, as authorized on page 2 of the September 29, 2008 patent owner petition.

SUMMARY

The September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

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

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 304 provides, in pertinent part:

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.

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 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) . . . A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional . . .

*

*

(d) *Terminal Disclaimer.*

*

*

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

37 CFR 1.530 provides, in pertinent part:

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

(c) . . . Where the reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the ex parte reexamination requester in accordance with § 1.248.

37 CFR 1.550 provides, in pertinent part (emphasis added):

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

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

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

*

*

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

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for ex parte reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

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 2266.03 provides, in pertinent part:

Any paper filed with the Office, i.e., any submission made, in a third party requested reexamination by either the patent owner or the third party requester, must be served on every other party in the reexamination proceeding.

As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper. It is required that the name and address of the party served, and the method of service be set forth in the certificate of service. Further, a copy of the certificate of service must be attached with the copy of the paper that is served on the other party.

Any paper for which proof of service is required, which is filed without proof of service, may be denied consideration.

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 September 29, 2008 Patent Owner Petition Must Be Accompanied by Proof of Service

The September 29, 2008 patent owner petition under 37 CFR 1.137(b) was not accompanied by a certificate of service certifying that the September 29, 2008 patent owner petition under 37 CFR 1.137(b) was served on the third party requester, as required by 37 CFR 1.550(f) and 37 CFR 1.248. Where a request for reexamination is filed by a third party requester, as is the case here, **any paper** filed in the reexamination proceeding by either the patent owner or by the third party requester, such as a petition under 37 CFR 1.137(b), a patent owner response to an Office action, or a patent owner statement under 37 CFR 1.530(b), **must be served on the other party or the paper may be denied consideration. As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper.** See MPEP 2266.03.[1]

While the September 29, 2008 patent owner petition under 37 CFR 1.137(b) may be denied consideration for failure to attach a certificate of service, the Office, in the interest of fulfilling its statutory requirement for conducting reexamination proceedings with special dispatch,[2] is exercising its option to consider the present petition and to perfect service on the third party requester by mailing a copy of the September 29, 2008 patent owner petition under 37 CFR 1.137(b) to the third party requester as an attachment to this decision.

The parties are cautioned that, in the future, the Office may refuse consideration of any paper, including any petition, filed by either party in this reexamination proceeding without proper proof of service

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[1] Note that a certificate of service is NOT a certificate of mailing or transmission. Compare MPEP 2220 and 2266.03, which discusses a certificate of service, with MPEP 512, which discusses a certificate of mailing or transmission.

[2] See 35 U.S.C. 305.

The Response Required by 37 CFR 1.137(b) Must Respond to the Outstanding Office Action

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response[3] 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 pursuant to 37 CFR 1.137(b) 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. The patent owner has not, however, satisfied item (1), because the patent owner has not provided a proper response to the outstanding Office action.[4]

To fulfill the reply requirement of 37 CFR 1.137(b)(1), the patent owner points to the "response to the granting of the request for *ex parte* reexam" (i.e., the September 15, 2008 paper entitled "Patent Owner Statement").[5] As indicated in the September 23, 2008 Notice of Intent to Issue a Reexamination Certificate, however, prosecution was terminated under 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.111, to the ***first Office action mailed on June 13, 2008***.

The September 15, 2008 paper entitled "Patent Owner Statement" cannot be construed as a response to the June 13, 2008 first Office action because the patent owner statement fails to specifically address any of the rejections applied in the Office action. For example, the September 15, 2008 "Patent Owner Statement" fails to specifically address the rejection of claim 13 under 35 U.S.C. 102(b), or, in the alternative, under 35 U.S.C. 103(a) over Golton alone, and the rejection of claim 14 under 35 U.S.C. 103(a) over Golton alone.

In addition, the September 15, 2008 paper entitled "Patent Owner Statement" fails to include a certificate of service pursuant to 37 CFR 1.550(f) and 37 CFR 1.248, certifying that a copy of the September 15, 2008 paper entitled "Patent Owner Statement" was served on the third party requester.[6]

---

[3] 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).

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

[5] The patent owner is not required to file a patent owner statement in response to an order granting reexamination. Consequently, a reexamination proceeding cannot be terminated for failure to timely file a patent owner statement. See 35 U.S.C. 304, which provides, in pertinent part: "[the patent owner] ***may*** file a statement on such question . . . ***If*** the patent owner files such a statement . . ." (emphasis added). See also 37 CFR 1.530(b). Furthermore, any patent owner statement in response to the order was required to be filed with the time period set in the order mailed on November 30, 2007, i.e., within two months from the mail date of the order. A patent owner statement, therefore, was due on or before January 30, 2008. If no patent owner statement, or a petition under 37 CFR 1.550(c) for an extension of time to file the patent owner statement, is received within the time period set in the order granting reexamination (as is the case here), a first Office action is issued. See, generally, MPEP 2249 and 2260. In this case, the June 13, 2008 first Office action is the outstanding Office action to which a response must be filed in order to revive the proceeding.

[6] Again see MPEP 2266.03. Any paper by either party, including a patent owner response to an Office action, that is filed in a reexamination proceeding in which the request was filed by a third party requester, as is the case here, must be accompanied by a certificate of service. Note that even if the September 15, 2008 "Patent Owner

Accordingly, the September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

Any renewed petition to revive under 37 CFR 1.137(b) filed in response to this decision must be accompanied by a response to the June 13, 2008 first Office action, and a certificate of service indicating that the renewed petition and the response to the June 13, 2008 first Office action, as well as any additional attachments appropriately identified in the certificate of service, were served on the third party requester. See 37 CFR 1.550(f) and 37 CFR 1.248. See also MPEP 2266.03.

CONCLUSION

- The September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

- Any renewed petition to revive under 37 CFR 1.137(b) filed pursuant to this decision must be mailed 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.

- Any renewed petition to revive under 37 CFR 1.137(b) filed pursuant to this decision must be accompanied by a response to the June 13, 2008 first Office action, and a certificate of service certifying that the renewed petition and the response to the June 13, 2008 first Office action as well as any additional attachments appropriately identified in the certificate of service, were served on the third party requester.

- Jurisdiction over this reexamination proceeding is being retained by the Office of Patent Legal Administration pending a response to this decision, or the expiration of time to respond to this decision.

- All correspondence relating to this petition in this *ex parte* reexamination proceeding should be directed to:

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

  By Mail To: Mail Stop "*Ex Parte* Reexam"
  ATTN: Central Reexamination Unit
  Commissioner for Patents
  P. O. Box 1450
  Alexandria VA 22313-1450

Statement" were **timely filed as a patent owner statement** under 37 CFR 1.530(b) **in response to the** November 30, 2007 **order granting reexamination**, i.e., on or before January 30, 2008, this paper may still be refused consideration under 37 CFR 1.530(c) and 37 CFR 1.550(f) for failure to attach a certificate of service.

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

- Any inquiry concerning the **examination** of this reexamination proceeding should be directed to the primary examiner, Jerry Johnson, of CRU Art Unit 3991, at (571) 272-1448.

- 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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SEP 29 2008

CENTRAL FAX CENTER

PTO/SB/64 (08-08)
Approved for use through 08/30/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional): 5244 A

First named inventor: Anthony W. Dallmier

Application No.: 90/008,766 Art Unit: 3991

Filed: 09/05/2007 Examiner: Jerry D. Johnson

Title: PROCESS TO MANUFACTURE STABILIZED ALKALI OR ALKALINE EARTH METAL HYOBROMITE AND USES THEREOF IN WATER TREATMENT TO CONTROL MICROBIAL FOULING.

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

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

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☑ Other than small entity – fee $ 1540.00 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of response to the granting of the request for ex parte reexam (identify type of reply):

☑ has been filed previously on 09/15/08.
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____
☐ has been paid previously on _____.
☐ is enclosed herewith.

10/01/2008 RBELL1 00000001 140185 90008766
01 FC:1453 1540.00 DA

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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SEP 29 2008

CENTRAL REEXAMINATION UNIT

PTO/SB/64 (08-08)
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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.

3. Terminal disclaimer with disclaimer fee

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

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Signature	09/29/08 Date
William Maheras Typed or printed name	54,873 Registration Number, if applicable
1601 West Delhi Road Address	(630) 305-2029 Telephone Number
Naperville, IL 60563 Address	

Enclosures:
- ☐ Fee Payment
- ☐ Reply
- ☐ Terminal Disclaimer Form
- ☐ Additional sheets containing statements establishing unintentional delay
- ☑ Other: AUTHORIZATION TO PAY ANY NECESSARY FEES FROM DEPOSIT ACCT. 14-0105

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- ☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
- ☑ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at ~~(571) 273-8300.~~ (571)273-9900.

09/29/08 Date	Robert T. Faedtke Signature
	Robert Faedtke Typed or printed name of person signing certificate

PAGE 2/2 * RCVD AT 9/29/2008 4:13:29 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/8 * DNIS:2739900 * CSID:6303052906 * DURATION (mm-ss):00-46

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JAN 26 2009

CENTRAL REEXAMINATION UNIT

Robert A. Miller (For Patent Owner)
Patent & Licensing Department
NALCO Chemical Company
One Nalco Center
Naperville, IL 60563-1198

Timothy Keister, CWT (For Requester)
ProChemTech
PO Box 214
Brockway, PA 15824

In re Reexamination Proceedings :
Dallimer et al. :
Control No. 90/008766 : DECISION
Filed: September 6, 2007 : GRANTING
For: U.S. Patent 5,795,487 : PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b) filed by the patent owner on December 26, 2008, for entry of late papers based upon unintentional delay.

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

The petition is **granted.**

BACKGROUND AND FACTS

1. On November 4, 1997, United States Patent Number 5,683,654 (the '654 patent) issued.

2. On September 6, 2007, a third party requester filed a request for *ex parte* reexamination of the '654 patent, assigned Reexamination Control No. 90/008,766 (the '8766 proceeding).

3. On November 30, 2007, the Office issued an order granting *ex parte* reexamination in the '8766 proceeding.

4. On June 13, 2008, the Office issued a first Office action on the merits (FOAM) in the '8766 proceeding, noting a Patent Owner's Statement was not filed.

5. On September 15, 2008, the patent owner filed a paper.

6. On September 23, 2008, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC).

7. On September 29, 2008, the patent owner filed a petition under 37 CFR 1.137(b) to revive the '8766 prosecution for entry of late papers.

8. On November 28, 2008, the Office issued a decision dismissing the patent owner petition to revive as incomplete and gave patent owner thirty (30) days to renew the petition in complete form.

9. On December 26, 2008, the patent owner timely submitted the present renewed petition under 37 CFR 1.137(b) to revive.

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 petition reveals that it includes correspondence denoted as Response to Office Action in *Ex Parte* Reexamination submitted December 26, 2008. As such, Petitioner has provided the response required by 37 CFR 1.137(b) (item 1). Payment of the requisite unintentional delay fee for other than small entity was previously charged on October 1, 2008 (item 2). The petition contains the proper statement for unintentional delay in filing the required response (item 3). The petition does not require a terminal disclaimer (item 4), as the present proceeding is a reexamination proceeding. See 37 CFR 1.137(d)(3).

Accordingly, the petition under 37 CFR 1.137(b) includes the requisite items – the response (item 1), the $1540.00 petition fee under 37 CFR 1.17(m) (item 2), and the requisite statement (item 3).

Furthermore, the renewed petition for revival filed on December 26, 2008 is timely filed within the thirty day time period for response set by the dismissal of the original petition for revival issued by the Office on November 28, 2008.

CONCLUSION

1. The petition for entry of late papers is **granted.**

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

3. Any further communication as to the merits of the reexamination proceeding should be directed to examiner Jerry D. Johnson in the CRU, who can be reached at (571) 272-1448.

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

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

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

Williams, Morgan & Amerson
10333 Richmond, Suite 1100
Houston, TX 77042

(For Patent Owner)

Reexam Control No.: 90/008,768
Filed : July 6, 2007
For U.S. Patent No. : 6,655,455

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/009,060
Filed : May 6, 2008
For U.S. Patent No. : 6,655,455

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CENTRAL REEXAMINATION UNIT

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/008,768 was ordered in a decision mailed September 5, 2007 indicating that claim 1 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. Information Disclosure Statements were filed on October 14, 2007, November 1, 2007 and November 2, 2007. There are no amendments to the claims specification or drawings in this reexamination proceeding. No further action has taken place in this reexamination proceeding.

Reexamination in application control No. 90/009,060 was ordered in a decision mailed June 20, 2008 indicating that claims 2, 6, and 23 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. There are no amendments to the claims specification or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/008,768 and reexamination control No. 90/009,060 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, 2, 6, and 23 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. 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. 90/008,768 and 90/009,060 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Gregory Morse, Director
Central Reexamination Unit

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Guido Modiano
Via Mera Vigil 16
Milan, 20123
Italy

(For Patent Owner)

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MAR 11 2008

CENTRAL REEXAMINATION UNIT

Cantor Colburn, LLP
55 Griffin Road South
Bloomfield, CT 06002

(For Patent Owner)

Edwards Angell Palmer & Dodge LLP
P.O. Box 55874
Boston, MA 02205

(For 3rd Party Requester)

Reexam Control No.: 90/008,773
Filed : July 25, 2007
For U.S. Patent No. : 5,743,390

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,796
Filed : July 30, 2007
For U.S. Patent No. : 5,743,390

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

Reexamination in application control No. 90/008,773 was ordered in a decision mailed October 19, 2007. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/008,796 was ordered in a decision mailed October 26, 2007. A patent owner's statement was filed December 6, 2007. The statement did not include an amendment to the specification, drawings or claims.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines.

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

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

Conduct of Proceedings

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

Dual Correspondence

Currently, patent owner appears to be represented by three different representatives. In reexamination proceeding control No. 90/008,773, patent owner is represented by Guido Mogliano, whose correspondence address is that of record in the patent, and per 37 CFR 1.33(c) is the address that must be used in these proceedings. In reexamination control No. 90/008,796, patent owner is represented by the law firm of Cantor Coburn, LLP. Further, the patent owner's statement filed in reexamination Control No. 90/008,796 was filed by a member of the law firm of Cardinal Law Group presumably under the auspices of 37 CFR 1.34. Under 37 CFR 1.33(a), the Office will not engage in correspondence with more than one registered attorney or agent except as deemed necessary by the Director. Accordingly, the patent owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision. Failure to do so will result in the changing of the correspondence address in reexamination control No. 90/008,796 to that of Mr. Mogliano, per 37 CFR 1.33(c).

Conclusion

Reexamination Control Nos. 90/008,773 and 90/008,796 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to name but a single representative**. Upon receipt of the response, an Office action will issue in due course.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

cc: Cardinal Law Group
Suite 2000
1603 Orrington Avenue
Evanston, IL 60201

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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Guido Modiano
Via Mera Vigil 16
Milan, 20123
Italy

(For Patent Owner)

MAILED

MAR 17 2008

CENTRAL REEXAMINATION UNIT

Cantor Colburn, LLP
55 Griffin Road South
Bloomfield, CT 06002

(For Patent Owner)

Edwards Angell Palmer & Dodge LLP
P.O. Box 55874
Boston, MA 02205

(For 3rd Party Requester)

Reexam Control No.: 90/008,773
Filed : July 25, 2007
For U.S. Patent No. : 5,743,390

CORRECTED
DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,796
Filed : July 30, 2007
For U.S. Patent No. : 5,743,390

This is a corrected decision merging the above noted reexamination proceedings. The above noted reexamination proceedings were merged in a decision mailed March 11, 2008. The decision indicated that in reexamination control No. 90/008,796 a patent owner's statement had been filed December 6, 2007. Further, it indicated that the patent owner's statement had been filed by a member of the law firm of Cardinal Law Group, the filing of which created confusion as to who the real representative for patent owner is. Upon further review of the file, it was noticed that the December 6, 2007 paper was entered into the 90/008,796 file by mistake. As the paper in question does not belong in 90/008,796, it has been removed therefrom and it is clear that the law firm of Cardinal Law Group has nothing to do with the instant reexamination proceedings. In view of the above the merger mailed March 11, 2008 is modified as follows.

Reexamination in application control No. 90/008,773 was ordered in a decision mailed October 19, 2007. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/008,796 was ordered in a decision mailed October 26, 2007. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines.

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

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

Conduct of Proceedings

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

Dual Correspondence

Currently, patent owner appears to be represented by two different representatives. In reexamination proceeding control No. 90/008,773, patent owner is represented by Guido Mogliano, whose correspondence address is that of record in the patent, and per 37 CFR 1.33(c) is the address that must be used in these proceedings. In reexamination control No. 90/008,796, patent owner is represented by the law firm of Cantor Coburn, LLP as that is the entity that filed the request, allegedly on behalf of patent owner. Under 37 CFR 1.33(a), the Office will not engage in correspondence with more than one registered attorney or agent except as deemed necessary by the Director. Accordingly, the patent owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision. Failure to do so will result in the changing of the correspondence address in reexamination control No. 90/008,796 to that of Mr. Mogliano, per 37 CFR 1.33(c).

Conclusion

Reexamination Control Nos. 90/008,773 and 90/008,796 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to name but a single representative.** Upon receipt of the response, an Office action will issue in due course.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

cc: Cardinal Law Group
Suite 2000
1603 Orrington Avenue
Evanston, IL 60201

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
WOLF, BLOCK, SCHORR, AND SOLIS-COHEN LLP
250 PARK AVENUE
NEW YORK, NY 10177

Date:
MAILED
MAY 16 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008774
PATENT NO. : 6482520
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.
90/008,774	07/24/2007	6482520		9522

23456 7590 05/16/2008

WADDEY & PATTERSON, P.C.
1600 DIVISION STREET, SUITE 500
NASHVILLE, TN 37203

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/16/2008

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

WADDEY & PATTERSON, P.C. (For Patent Owner)
1600 DIVISION STREET, SUITE 500
NASHVILLE TN 37203

WOLF, BLOCK, SCHORR AND SOLIS-COHEN LLP (For Third Party Requester)
250 PARK AVENUE
NEW YORK, NY 10177

MAILED

MAY 16 2008

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
J. W. Tzeng :
Control No. 90/008,774 : DECISION GRANTING PETITION
Filed: July 24, 2007 :
U.S. Patent No. 6,482,520 :
Attorney Docket No. V0287 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on April 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 (Response To Office Action In *Ex Parte* Reexamination (Response) - 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. 23-0035 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the Response filed April 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, Stephen Stein, in CRU Art Unit 3991, who can be reached at 571-272-1544.

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

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

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.
90/008,775	07/30/2007	4935184	X32441	9943

20995 7590 08/30/2008

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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AUG 29 2008

CENTRAL REEXAMINATION UNIT

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(for Patent Owner)

Edward W. Callan
No. 705 PMB 452
3830 Valley Centre Drive
San Diego, CA 92130

(for Patent Owner)

Arnold Turk, Esq.
Greenblum & Bernstein PLC
1950 Roland Clarke Place
Reston, VA 20191

(for Third Party Requester)

In re Sorensen
Reexamination Proceeding
Control No.: 90/008,775
Filed: Julyl 30, 2007
For: U.S. Patent 4,935,184

Pavan Agarwal
Foley & Lardner LLP
3000 K Street, NW, Suite 500
Washington, DC 20007

(for Third Party Requester)

In re Sorensen
Reexamination Proceeding
Control No.: 90/008,976
Filed: December 21, 2007
For: U.S. Patent 4,935,184

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 4,935,184, issued June 19, 1990, is the subject of Reexamination Control Nos. 90/008,775 and 90/008,976.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,775, was filed July 30, 2007 by Arnold Turk of Greenblum & Bernstein in Reston VA. The request urged that a substantial new question of patentability was raised by the newly cited references which either inherently or expressly disclose the subject matter of the present claims.

3. Reexamination was ordered for 90/008,775 (the '8775 reexam) on October 11, 2007.

4. No Patent Owner statement has been received and no Office action has issued.

5. A second request for re-examination, assigned Reexamination Control No. 90,008,976, was filed December 21, 2007 by Pavan Agarwal of Foley & Lardner in Washington, DC. The request urged that a substantial new question of patentability was raised by the newly cited references which are directed to the subject matter of the present claims.

6. Reexamination was ordered for 90/008,976 (the '8976 reexam) on February 21, 2008.

7. No Patent Owner statement or Office action has issued in the '8976 reexam.

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 90/008,775 and 90/008,976 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/008,775 as:

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/008,976 as:

Edward W. Callan
No. 705 PMB 452
3830 Valley Centre Drive
San Diego, CA 92130

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/008,775 as:

Arnold Turk, Esq.
Greenblum & Bernstein PLC
1950 Roland Clarke Place
Reston, VA 20191

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/008,976 as:

Pavan Agarwal
Foley & lardner LLP
3000 K Street, NW, Suite 500
Washington, DC 20007

CONCLUSION

Reexamination Control Nos. 90/008,775 and 90/008,976 are merged. **Since there have been no amendments made in these proceedings, the requirement for 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 Deborah Jones
Gregory Morse, Director
Central Reexamination Unit

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MAY 27 2010

CENTRAL REEXAMINATION UNIT

Knobbe Martens Olson & Bear LLP
2040 Main Street
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Edward W. Callan
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Reston, VA 20191

(For Third Party Requester)

In re Sorensen
Reexamination Proceeding
Control No.: 90/008,775
Filed: July 30, 2007
For: U.S. Patent 4,935,184

Pavan Agarwal
Foley & Lardner LLP
3000 K Street, NW, Suite 500
Washington, DC 20007

(For Third Party Requester)

In re Sorensen
Reexamination Proceeding
Control No.: 90/008,976
Filed: December 21, 2007
For: U.S. Patent 4,935,184

DECISION ON PETITION
UNDER 1.181(f)

This is a decision on the petition filed April 12, 2010 for relief from the Ex Parte Reexamination Advisory Action mailed on March 5, 2010 in which a declaration of Stephen Petrie, Ph.D. entitled "Supplemental Declaration of Stephen Petrie, Ph.D. After Final Office Action" was denied entry.

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

The petition is dismissed for the reasons set forth below.

Review of Facts

On July 30, 2007 a first request for re-examination of USPN 4,935,184 was filed and assigned control number 90/008,775.

On October 11, 2007, re-examination was ordered on 90/008,775 ('8775).

On December 21, 2007, a second request for re-examination of USPN 4,935,184 was filed and assigned control number 90/008,976.

On February 21, 2008, re-examination was ordered on 90/008,976 ('8976).

On August 29, 2008, the proceedings were merged.

On October 31, 2008, a non-final Office action issued in the merged proceeding.

On January 2, 2008, a timely response to the non-final action was submitted.

On August 21, 2009, a second non-final Office action issued in the merged proceeding.

On October 21, 2009, a timely response to the non-final action was submitted.

On January 8, 2010, a Final Office action was mailed rejecting claims 1, 2, 4, and 6-10. A shortened statutory period for response to this action was set to expire one month from this mail date.

On February 8, 2010, a timely response to the Final Office was submitted. The response included a declaration by David O. Kazmer, Ph.D.

On February 16, 2010, Patent Owner filed a supplemental response with a declaration by Stephen Petrie Ph.D. There was no explanation regarding why this was necessary or why it could not have been submitted earlier. Further, there was no request for an extension of time in which to file this paper.

On March 5, 2010, an Advisory action was mailed in response to the submission of February 8, 2010, indicating the declaration of Dr. Kazmer was entered but not persuasive.

On March 5, 2010, an additional Advisory action was mailed in response to the submission of February 16, 2010, indicating the declaration of Dr. Petrie would not be entered primarily because patent owner failed to show good and sufficient reasons why it was necessary and why it was not earlier presented.

On April 8, 2010, patent owner filed an amended declaration of Dr.Petrie, a declaration of inventor Sorenson, and the present petition requesting entry of the original Petrie declaration and the two concurrently submitted declarations.

Decision

37 CFR 1.116 provides, in part:

> (b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, ..., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
>
> (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
>
> (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
>
> (e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 CFR 1.550(a) provides:

> All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116 and will result in the issuance of an *ex parte* reexamination certificate under § 1.570.

MPEP 2271 provides, in part:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...

It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

Analysis and Findings

The present petition requests entry of original supplemental Petrie declaration filed on February 16, 2010 and the amended Petrie declaration and the Sorensen declaration, filed with the petition. Petitioner states the amended declaration is directed to the same issues and arguments presented in the response to the second non-final Office action. Further, it does not expand the scope of the claims and places the proceeding in better condition for appeal. Petitioner asserts the declaration could not have been presented earlier because patent owner did not fully understand the substance of some of the Examiner's concerns in the claim rejections.

In the non-final Office action mailed August 21, 2009, the examiner provided a definition of "laminated walls" in response to patent owner's definition and arguments. This position was reiterated in the final Office action mailed January 8, 2010. Patent owner has had ample opportunity to rebut this position by, e.g., providing declaratory evidence or argument. The declaration of Dr. Kazmer, filed after the final Office action, was entered, considered and not found convincing regarding this issue. As stated by petitioner, the amended Petrie declaration is directed to the same issue and arguments presented in the response to the second non-final Office action. In light of the requirement for "special dispatch" the declaration should have been provided earlier rather than after an Advisory action.

Patent owner has not provided persuasive reasons why the amended Petrie declaration, the original supplemental Petrie declaration or the Sorensen declaration could not have been filed earlier. Patent owner's assertions that the examiner's reasoning for the modified construction of "laminated walls" in the non-final rejection of August 21, 2009 is not deemed as a good and sufficient reason why this declaration was not earlier presented because, as explained above, the record does not support any material change in claim interpretation in the rejections in the final Office action. Specifically, the examiner's definition of "laminated walls" was essentially repeated in the rejections in the final Office action. The new reasoning to which petitioner refers to is merely the examiner's response to arguments set forth in patent owner's responses filed on October 21, 2009 and November 25, 2009. To emphasize, the examiner was addressing arguments made by the patent owner in the final Office action and did not modify or alter the grounds of rejection. Therefore, it can be seen that the original supplemental Petrie declaration filed on February 16, 2010 and the amended Petrie declaration and the Sorensen declaration, filed with the petition, address issues first raised in the non-final Office action that was mailed on August 21, 2009. Accordingly, petitioner has presented no persuasive reasoning why the need for the declarations addressing issues raised in the August 21, 2009 non-final Office action could not have been anticipated earlier.

In this case, patent owner failed to submit this evidence (original supplemental Petrie declaration filed on February 16, 2010 and the amended Petrie declaration and the Sorensen declaration, filed with the petition) at the earliest possible point, despite the clear notice in MPEP 2272 that

evidence submission should be filed before final action and despite the statutory mandate for special dispatch in reexamination. As such, the petition fails for want of a persuasive explanation of why the patent owner did not consider and explore the need for this new evidence earlier in the prosecution of the present reexamination merged proceeding, which would have led to an earlier submission of the evidence to advance the need for special dispatch in reexamination.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's responses, including original supplemental Petrie declaration filed on February 16, 2010 and the amended Petrie declaration and the Sorensen declaration, filed with the petition, are not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above, the petition under 37 CFR 1.181 is dismissed.

Conclusion

1. The Patent Owner's petition for entry of the supplemental declaration of Stephen Petrie, Ph.D., filed February 16, 2010 and the amended Petrie declaration and the Sorensen declaration, filed with the petition, is dismissed.

2. The Patent Owner's Appeal Brief is due June 8, 2010.

3. Response may be submitted as follows:

By EFS: See 37 CFR 1.8(a)(C)(ii)

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

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

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

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

Gregory 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.
90/008,775	07/30/2007	4935184	SRDT.006RX	9943

20995 7590 06/01/2010

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Arnold Turk, Esq.
Greenblum & Bernstein P. L. C.
1950 Roland Clarke Place
Reston VA 20191

Date:

MAILED

JUN 01 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008775
PATENT NO. : 4935184
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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Knobbe Martens Olson & Bear LLP
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(For Patent Owner)

Arnold Turk, Esq.
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1950 Roland Clarke Place
Reston, VA 20191

(For Third Party Requester)

MAILED

JUN 01 2010

CENTRAL REEXAMINATION UNIT

In re Sorensen
Reexamination Proceeding
Control No.: 90/008,775
Filed: July 30, 2007
For: U.S. Patent 4,935,184

Pavan Agarwal
Foley & Lardner LLP
3000 K Street, NW, Suite 500
Washington, DC 20007

(For Third Party Requester)

In re Sorensen
Reexamination Proceeding
Control No.: 90/008,976
Filed: December 21, 2007
For: U.S. Patent 4,935,184

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

This is a decision on the petition filed May 13, 2010 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing an Appeal Brief.

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

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

Decision

The Patent Owner requests an extension of time in which to file an Appeal Brief that is currently due on June 8, 2010. 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 Patent Owner is awaiting the decision on a Petition to Director under 37 CFR 1.181, filed on April 8, 2010 which seeks relief from the advisory action mailed on March 5, 2010 and entry of several declarations. Patent Owner contends that entry (or non-entry) of these documents will impact the arguments that can be presented in the appeal brief. Patent Owner has also pointed out that the court has stayed litigation pending the outcome of the reexamination proceeding.
An extension of one month is requested to provide Patent Owner with a fair opportunity to prepare an adequate appeal brief.

Analysis and Findings

While patent owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period, when balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Patent Owner's showing is not adequate to justify the grant of a one-month extension of time in which to file an appeal brief. Accordingly, the period of time for filing the Appeal Brief is extended for two weeks and is due on June 22, 2010.

Conclusion

1. The Patent Owner's petition for extension of time in which to file an Appeal Brief is granted for **two (2) weeks.**

2. The Patent Owner's response is due June 22, 2010.

3. Response may be submitted as follows:

By EFS: See 37 CFR 1.8(a)(C)(ii)

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/,
SPE Art Unit 3991
Central Reexamination Unit

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(For Third Party Requester)

In re Sorensen
Reexamination Proceeding
Control No.: 90/008,775
Filed: July 30, 2007
For: U.S. Patent 4,935,184

Pavan Agarwal
Foley & Lardner LLP
3000 K Street, NW, Suite 500
Washington, DC 20007

(For Third Party Requester)

In re Sorensen
Reexamination Proceeding
Control No.: 90/008,976
Filed: December 21, 2007
For: U.S. Patent 4,935,184

DECISION DISMISSING
UNDER 1.181(a)(1)

This is a decision on the petition filed April 8, 2010 for expedited consideration of the petition under 37 CFR 1.181(f), concurrently filed, requesting relief from the Ex Parte Reexamination Advisory Action mailed on March 5, 2010 in which a declaration of Stephen Petrie, Ph.D. entitled "Supplemental Declaration of Stephen Petrie, Ph.D. After Final Office Action" was denied entry.

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

The petition is dismissed for the reasons set forth below.

Analysis and Findings

On May 27, 2010, a decision on the petition under 37 CFR 1.181(f) was mailed rendering the instant petition moot.

Conclusion

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/,
SPE, Art Unit 3991
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.
90/008,778	08/29/2007	6854698	INNOFF 3.5-005 CONT	9804

530 7590 09/12/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2008

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

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GREENVILLE, SC 29603

Date:
MAILED

SEP 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008778
PATENT NO. : 6854698
ART UNIT : 3900

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

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

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SEP 12 2008

CENTRAL REEXAMINATION UNIT

Lerner, David, Littenberg, Krumholz
& Mentlik
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Westfield, New Jersey 07090

(For Patent Owner)

Nexsen Pruet, LLC.
P.O. Box 10648
Greenville, SC 29603

(For Third Party Requester)

In re Innovative Office Products, Inc.
Ex Parte Reexamination Proceeding
Control No.: 90/008,778
Filed: August 29, 2007
For: U.S. Patent No.: 6,854,698 B2

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

This is a decision on the August 28, 2008 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.182 TO REOPEN REEXAMINATION AND CONSIDER ADDITONAL MATERIALS."

The petition and the 90/008,778 *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. 12-1095 as authorized in the patent owner's petition.

BACKRGROUND

1. Patent number 6,854,698 B2 ("the '698 patent") issued on May 19, 1998.

2. A request for *ex parte* reexamination of the '698 patent was deposited on August 29, 2007, by a third party requester, and it was assigned control No. 90/008,778 (the '778 reexamination proceeding).

3. A filing date for the '778 reexamination proceeding was not accorded for the reasons set forth in the "Notice of Failure to Comply With *Ex Parte* Reexamination Request Filing Requirements (37 CFR 1.510(c))" was mailed on August 14, 2007.

4. A response to the August 14, 2007 Notice was filed on August 29, 2007, and the '778 reexamination proceeding was accorded a filing date of August 29, 2007.

5. An *Order Granting Ex Parte Reexamination* in the '778 reexamination proceeding was mailed on August 19, 2007, in which reexamination was ordered for claims 1-34, (*i.e.*, all of the claims) of the '698 patent.

6. The proceeding progressed to the point where, on August 4, 2008, the Office mailed a *Notice of Intent to Issue Ex Parte Reexamination Certificate* (NIRC), in which the patentability of claims 1-34 was confirmed.

7. On August 15, 2008, the '778 reexamination proceeding was forwarded to the Office of Patent Publication for entry into the printing cycle to print and publish the Reexamination Certificate.

8. On August 28, 2008, patent owner filed papers the present petition, and also filed a letter addressed to the Office of Patent Publication informing that Office that the petition had been filed.

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 the '698 patent claims, prosecution was ultimately closed by the mailing of an NIRC on August 4, 2008. It appears from the present petition that patent owner has recently received certain information "that relates to other reexaminations currently pending for certain family members of the '698 patent. [1] Patent owner has submitted this information concurrently with the filing of the present petition, and requests consideration of the submitted information, notwithstanding that prosecution in the '778 reexamination proceeding has been terminated by the issue and mailing of the NIRC on August 4, 2008. [2] It is the apparent position of patent owner that patent owner did not have a "full opportunity to submit" the information, because it was first mailed to patent owner on July 19, 2008, less than two weeks prior to the mailing of the NIRC in the present '778 reexamination proceeding, and patent owner wishes to submit the information out of an abundance of caution, even though the examiner in the other reexamination proceedings is also the examiner in the '778 reexamination proceeding. [3] Patent owner points out that the information has been submitted within three months from the date of its receipt. [4]

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[1] "Petition Under 37 C.F.R. § 1.182 ..." filed August 28, 2008, at pages 1-2. The proceedings are reexamination control number 90/008,771, (the '771 reexamination proceeding), deposited on July 19, 2007 and accorded a filing date of August 13, 2007 and reexamination control number 90/008,735, (the '735 reexamination proceeding), deposited on July 3, 2007 and accorded a filing date of July 25, 2007.

[2] Id., at page 2.

[3] Id., at pages 2-3.

[4] Id., at page 2. It is noted that "the information" in question consists of Office actions in reexamination control numbers 90/008,771 and 90/008,735, but not the prior art on which the Office actions are based.

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 printing 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. For the reasons discussed below, it is clear that patent owner has not satisfied the requirements for an adequate showing in the present petition.

Although patent owner has attempted to address the issue of why the information now being cited to the Office was not earlier furnished to the Office, patent owner does not adequately explain why that information could not have been earlier cited to the Office. The information in possession of the patent owner as a result of the July 19, 2008 mailing of an Office Action in the '771 reexamination proceeding and the July 28, 2008 mailing of an Office action in the '735 reexamination proceeding was not cited to the Office in the present '778 reexamination proceeding until patent owner filed the present petition on August 28, 2008. On August 15, 2008, the '778 reexamination proceeding was forwarded to the Office of Patent Publication for printing and publication of the Reexamination Certificate. Patent owner has not stated the date of counsel's receipt of these Office actions, and has not established why this information of the Office actions could not have been furnished to the Office at a time earlier than August 15, 2008.

Aside from the above point, it is noted that the records of the '771 and '735 reexamination proceedings reveal that the information (*i.e.*, prior patents and printed publications) upon which the reexamination order and first action on claim patentability were based in those reexamination proceedings was present in the files of those proceedings not later than October, 2007, and had been served on patent owner in each of the '771 and '735 reexamination proceedings. Those prior patents and or printed publications, which patent owner has now submitted in the '778 reexamination proceeding, must, perforce, either be information material to patentability of the claims at issue in the '778 reexamination proceeding, or information that is not material to the patentability of those claims. [5] Patent owner has not discussed, in the present petition, any steps taken by patent owner to analyze this information (from the other proceedings) in order to determine whether some or all of this information was/is material to the patentability of claims being reexamined in the '778 reexamination proceeding as defined in 37 CFR 1.555. It would appear that, to the extent that the documents cited in the '771 and '735 reexamination proceedings are now being cited in the '778 reexamination proceeding because

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[5] 37 CFR 1.555(b) provides that:

Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

patent owner considers them to be material to claim patentability in the present '778 proceeding, patent owner could readily have cited such information to the Office in the '778 reexamination proceeding long prior to the mailing of the NIRC in the '778 reexamination proceeding, and long prior to the entry of the '778 reexamination proceeding into the publication cycle on August 15, 2008, because patent owner was in possession of this information not later than October, 2007. [6] Obviously, if the information is not regarded by patent owner as being material to claim patentability, the information should not have been cited at all and is not needed now.

In addition to the above discussion, even assuming, *arguendo*, that patent owner could not have cited this information to the Office prior to the issuance and mailing of the NIRC and prior to the '778 reexamination proceeding entering the printing cycle, the citation of this information to the Office concurrently with the present petition has not been accompanied by the requisite unequivocal statement as to why the submitted information renders one or more of the claim subject to reexamination unpatentable, an amendment to such claim(s), and an explanation as to how the amendment causes such claim(s) 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. Patent owner has not satisfied this requirement with respect to information cited in the present '778 reexamination proceeding after the proceeding has entered into the printing cycle.

For all of the foregoing reasons, patent owner is not considered to have established entitlement to the relief requested in the present petition.

If patent owner believes that any information submitted with this petition raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, and patent owner desires to have the information in question considered on the record by the Office, patent owner is entitled to 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 '698 patent, as revised by the Reexamination Certificate that will conclude the 'present '778 reexamination proceeding upon its publication. Provided that any newly filed request for reexamination of the '698 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 '698 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. [7] Patent owner would then have the opportunity to obtain consideration of information that has not discussed and considered on the record in the present '778 reexamination proceeding.

CONCLUSION

1. The patent owner petition is dismissed.

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[6] See MPEP §§ 2206 and 2280, which clearly indicate that patent owner may submit a prior art citation at any time during a reexamination proceeding, subject to the qualification in MPEP § 2256 quoted, *supra*.

[7] 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. The information furnished by patent owner will be made of record in the file of the '778 reexamination proceeding, but will not be considered. [8]

3. Jurisdiction of the '778 *ex parte* reexamination proceeding is returned to the Office of Patent Publication to continuing processing of the proceeding to publication of the Reexamination Certificate.

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 10, 2008

[8] With respect to the treatment of information cited by patent owner subsequent to an order granting reexamination, see MPEP § 2206.

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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Reexam Control No.: 90/007,627
Filed : July 13, 2005
For U.S. Patent No. : 4,739,762

Reexam Control No.: 90/008,780
Filed : July 26, 2007
For U.S. Patent No. : 4,739,762

Reexam Control No.: 90/008,797
Filed : August 9, 2007
For U.S. Patent No. : 4,739,762

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

Reexamination in application control No. 90/007,627 was ordered in a decision on petition mailed February 27, 2007. The decision ordered reexamination of claims 16, 23, 44, 51 and 54. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,780 was ordered in a decision mailed October 22, 2007 indicating that claims 23, 51 and 54 will be reexamined. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,797 was ordered in a decision mailed October 23, 2007 indicating that claims 1-12, 14-23 and 25-43, will be reexamined. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,627, reexamination control No. 90/008,780 and reexamination control No. 90/008,790 are currently pending. Since the order to reexamine has been mailed in all three reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-12, 14-23, 25-44, 51 and 54, will be reexamined. Claims 45-50, 52, 53, and 55-59 will not be reexamined as none of the above-identified requests requested reexamination of these claims. All papers mailed by the Office will take the form of a single action that jointly applies to each of the three reexamination proceedings. All papers issued by the Office will contain the identifying data for each of the three proceedings, and each action will be entered into each of the three files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the two third party requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,627; 90/008,780 and 90/008,797 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Andres Kashnikow

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,785	11/09/2007	6230146	ARIBP015REX	3897

21912 7590 01/29/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/29/2008

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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WASHINGTON, DC 20004

Date: MAILED

JAN 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008785
PATENT NO. : 6230146
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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VAN PELT, YI & JAMES LLP
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CUPERTINO, CA 95014

(For Patent Owner)

MAILED

JAN 29 2008

CENTRAL REEXAMINATION UNIT

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WASHINGTON, DC 20004

(For Requester)

In re *Alaia et al.*
Reexamination Proceeding
Control No. 90/008,785
Filed: November 9, 2007
For: U.S. Patent No. 6,230,146

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on January 10, 2008, styled as "Petition 37 CFR Sections 1.181 and 1,515(c) for Review of Order Denying Request for *Ex Parte* Reexamination," 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 December 12, 2007. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,230,146 (hereinafter, the '146 patent) issued on May 8, 2001.

2. On July 30, 2007, a third party requester deposited a request for *ex parte* reexamination of the '146 patent, and the resulting reexamination proceeding was assigned Control No. 90/008,785 (hereinafter, the '785 proceeding).

3. On October 10, 2007, a "Decision *Sua Sponte* Vacating *Ex Parte* Reexamination Filing Date" was mailed due to noncompliance with the filing date requirements of 37 CFR 1.510.

4. On November 9, 2007, the third party requester deposited a corrected request for *ex parte* reexamination for claims 1-43, and the resulting reexamination proceeding was assigned a filing date of November 9, 2007

5. A Notice of Reexamination Request Filing Date was issued on December 4, 2007.

6. An order denying the request for reexamination for claims 1-43 was issued on December 12, 2007.

6. On January 10, 2008, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges one ground for which petitioner feels the examiner erred in not finding that substantial new question of patentability exists. The petitioner states that the examiner erred in determining that none of the references suggest the claim limitation of "extension of the second closing time based on a prior extension of a first closing time." Specifically, the petitioner advances that the document by Hugh C. Hildesley, entitled "The Complete Guide to Buying and Selling at Auction" (hereinafter "Buying and Selling at Auction") teaches such a claim limitation.

In support of their showing under the above-mentioned ground, the petitioner states that Buying and Selling at Auction expressly teaches the following:

1. Overtime extensions to early lots can adversely affect the allotted time for later lots;
2. An extension to an early lot thus requires the auctioneer to "calculate" what should happen with later lots; and
3. If an earlier closing time is extended so as to deprive a later lot of its minimum increment, then the closing time of the later lot should be extended.

Petitioner's arguments hinge on establishing that Buying and Selling at Auction creates a substantial new question of patentability by teaching the extension of the second closing time based on prior extension of a first closing time, in combination with other references.[1]

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-43 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 1-43 of the '146 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier

---

[1] Each SNQ is based on at least the combination of FCC Congress Report in view of Buying and Selling at Auction and Racing Gear. Petitioner has only requested review of the order based upon the teachings of the Buying and Selling at Auction reference and has stated that they agree with much of the analysis done in the Order Denying Reexamination mailed December 12, 2007 (see page 1 of the petition).

examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[2] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 states that:

> No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.
>
> The decision denying the request will then indicate, for each patent and printed publication cited in the request, why the citation is:

---

[2] Public Law 96-517, enacted on December 12, 1980.

(A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;

(B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);

(C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or

(D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

The examiner should also, in the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

A. The request fails to raise a substantial new question of patentability regarding Buying and Selling at Auction (in combination with other references) that is different from patentability issues raised in the prosecution of application number 09/252,790, which issued as the '146 patent.

The request for reexamination, dated November 9, 2007, stated that the following substantial new questions of patentability (SNQ) exist under 35 U.S.C. 103 as to:

A. Claims 1-5, 10-14, and 19 of the '146 patent by the FCC Congress Report, Buying and Selling at Auction, and Racing Gear.
B. Claims 6-8 and 15-17 of the '146 patent by the FCC Congress Report, Buying and Selling at Auction, Racing Gear and the Second Report.
C. Claims 9 and 18 of the '146 patent by the FCC Congress Report, Buying and Selling at Auction, Racing Gear, the Second Report and Auction Design Enhancements.
D. Claims 20, 22, 24-28, 30, 32-36, 38, and 40-43 of the '146 patent by the FCC Congress Report, Buying and Selling at Auction, Racing Gear and Porter.
E. Claims 21,29 and 37 of the '146 patent by the FCC Congress Report, Buying and Selling at Auction, Racing Gear, the Second Report and Porter
F. Claims 23, 31 and 39 of the '146 by the FCC Congress Report, Buying and Selling at Auction, Racing Gear, Porter and the Proposed Rulemaking Manual.
G. Claims 20, 22, 24-28, 30, 32-36, 38, and 40-43 of the '146 patent by the FCC Congress Report, Buying and Selling at Auction and Racing Gear.
H. Claims 6 and 15 of the '146. patent by the FCC Congress Report, Buying and Selling at Auction and Racing Gear.

As previously mentioned, the petitioner has only advanced that the examiner erred in determining that Buying and Selling at Auction does not teach the claim limitations of determining whether to extend a second closing time in response to the extension of a first closing time and maintaining a predetermined, minimum time interval between the closing times of the two lots. See page 2 of the petition. The Director has undertaken a *de novo* review of this issue.

As previously stated, Buying and Selling at Auction must present a new technical teaching (e.g, new information) not previously considered in the previous examination in order to establish a substantial new question of patentability. Alternatively, Buying and Selling at Auction must present the teachings of prior art teachings already considered "in a new light" in order to raise a substantial new question of patentability. Buying and Selling at Auction was not considered in the prosecution of the application, which issued as the '146 patent. Buying and Selling at Auction, however, fails to provide any new teachings, or provide any "new light" to the prior art teachings already considered, as presented in the request for reexamination dated November 9, 2007. In the request, the Buying and Selling at Auction is described as showing the claim limitations pertaining to extension of a later (e.g., second) lot based on extension of an earlier (e.g., first) lot. For example, in the request, dated November 9, 2007, on page 20, Buying and Selling at Auction is cited for the teaching that an auctioneer will extend the closing time of a lost when bidding is heavy. The request states that this requires that the closing time of the subsequent lots be shortened to complete the entire auction at the set time. Accordingly, "it would have been obvious to one of ordinary skill in the art to extend the closing time of the subsequent lots if necessary to ensure a minimum time for a lot, but otherwise to allow the closing time of a lot to be shortened so that the overall auction can be completed by the scheduled ending time." In the petition, the petitioner further explains that Buying and Selling at Auction teaches that the auctioneer must make a determination about varying closing times of later lots in response to the extended closing of earlier lots from the teaching that the auctioneer must calculate when a lot will appear, must give an item a fair chance to be bid upon, and must maintain a steady pace of the auction (see pages 2-3 of the instant petition). The petitioner advances that Buying and Selling at Auction explicitly teaches maintaining a predetermined, minimum time interval of at least 30 seconds for each bidding time. Petitioner states that Buying and Selling at Auction explicitly teaches the following:

1. Overtime extensions to early lots can adversely affect the allotted time for later lots;
2. An extension to an early lot thus requires the auctioneer to "calculate" what should happen with later lots; and
3. If an earlier closing time is extended so as to deprive a later lot of its minimum increment, then the closing time of the later lot should be extended.

The evidence and explanation, as set forth in the request dated November 9, 2007 and as supplemented by the instant petition, simply does not support ordering a request for reexamination. Buying and Selling at Auction does not present a new technical teaching or sufficient evidence to present the prior art teachings already considered in a new light, or provides any new teaching that was not already considered in a previous examination. Despite the statements from petitioner that Buying and Selling at Auction teaches all the above-

mentioned methods/devices for extension of a subsequent lot closing time based on extension of an earlier lot closing time, Buying and Selling at Auction fails to contain such teachings. The reference only discloses that:

- "Two lots per minute is about as fast an auctioneer can reasonably go while still giving each lot its fair chance"
- "The lot-per-minute rate will vary according to the amount of interest displayed in a particular item"
- "It helps when an auctioneer maintains a steady pace but varies it occasionally to prevent boredom in the room"

See page 185 of Buying and Selling at Auction. These teachings, however, do not present any new technical teaching (or new information) than the teachings of Fisher (as explained in the order denying reexamination mailed December 12, 2007) or the teaching of Fisher in view of an article by Sairamesh et al., entitled "Economic Framework for Pricing and Charging Digital Libraries," both of which were applied in a rejection against the claims in the previous prosecution of the application that issued as the '146 patent. In addition, Buying and Selling at Auction does not present any of the previous considered prior art teachings in a new light. Like Buying and Selling at Auction, the Fisher and Sairamesh et al. references supply general teachings concerning the timing of when a lot closes pertaining to amount of bidding that is occurring. See page 3 of the Final Office action dated September 12, 2000. Like Buying and Selling at Auction, these references fail to provide teachings that the second lot is extended when it is determined that the extension of the first lot fails to provide a predetermined minimum time for the second lot. Therefore, upon *de novo* review, it is determined that there is a substantial likelihood that a reasonable examiner would not consider the combined teachings of Buying and Selling at Auction with the other cited references important in deciding whether or not the claims are patentable.

Accordingly, Buying and Selling at Auction does not present any new technical teaching that was not present and considered in a previous examination. Petitioner's argument that Buying and Selling at Auction raises an SNQ because it teaches the claim limitations pertaining to extension of a later lot based on the extension of an earlier lot is unpersuasive. There is simply no evidence of record to support petitioner's position. In accordance with the legislative history of legislation concerning reexamination, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ, that the art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. Accordingly, as Buying and Selling at Auction in combination with the cited references, does not provide a new light or new information to the teachings of prior art already considered, a request for reexamination cannot be granted.

This policy is consistent with the legislative history as discussed above. Petitioner can still avail themselves of the *ex parte* reexamination proceeding, if petitioner can formulate a request that

brings forth some new technological information that was not consider in a previous examination.

As explained in the order denying reexamination, in accordance with MPEP 2242, "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.

REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '146 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination (which new request includes the missing information identified above). The third party requester should file all evidence, with a new and complete request for reexamination, which supports the third party requester's position that Buying and Selling at Auction provides a new teaching or presents a new light to the teachings of other prior art references. This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted.

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

CONCLUSION

1. Given the facts involved in this proceeding, the request for *ex parte* reexamination of claims 1-43 of the '146 patent was properly denied by the examiner.

2. Accordingly, the PETITION is DENIED.

3. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,789	08/06/2007	4,383,272	75543-019	5033

530 7590 11/18/2008

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,740	07/12/2007	4,383,272	75543-017	8621

7590 11/18/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2008

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NOV 18 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008789
PATENT NO. : 4383272
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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NOV 18 2008

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

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KRUMHOLZ & MENTLIK
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WESTFIELD NJ 07090

(courtesy copy)

In re Netravali *et alia*
Reexamination Proceeding
Control No. 90/008,740
Request Deposited: July 12, 2007
For: U.S. Patent No. 4,383,272

In re Netravali *et alia*
Reexamination Proceeding
Control No. 90/008,789
Request Deposited: August 6, 2007
For: U.S. Patent No. 4,838,272

: 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. 4,838,272 (hereinafter, the '272 patent), issued to Netravali *et alia*, on May 10, 1983.

2. On July 12, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '272 patent. The reexamination proceeding was assigned Control No. 90/008,740 (hereinafter, the '8740 proceeding).

3. The Reexamination Order was granted in the '8740 proceeding on August 16, 2007.

4. There are currently no amendments in the '8740 proceeding.

5. On August 6, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '272 patent. The reexamination proceeding was assigned Control No. 90/008,789 (hereinafter, the '8789 proceeding).

6. The Reexamination Order was granted in the '8789 proceeding on September 1, 2007.

7. There are currently no amendments in the '8789 proceeding.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8740 and the '8789 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. It should be noted that the patent has expired so no amendments are permitted.

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. 90/008,740 and 90/008,789 are MERGED.

2. The reexamination files are being forwarded to the examiner for 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

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

MAR 11 2008

CENTRAL REEXAMINATION UNIT

Cantor Colburn, LLP
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(For Patent Owner)

Edwards Angell Palmer & Dodge LLP
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Boston, MA 02205

(For 3rd Party Requester)

Reexam Control No.: 90/008,773
Filed : July 25, 2007
For U.S. Patent No. : 5,743,390

Reexam Control No.: 90/008,796
Filed : July 30, 2007
For U.S. Patent No. : 5,743,390

DECISION MERGING REEXAMINATION PROCEEDINGS

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

Reexamination in application control No. 90/008,773 was ordered in a decision mailed October 19, 2007. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/008,796 was ordered in a decision mailed October 26, 2007. A patent owner's statement was filed December 6, 2007. The statement did not include an amendment to the specification, drawings or claims.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines.

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

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

Conduct of Proceedings

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

Dual Correspondence

Currently, patent owner appears to be represented by three different representatives. In reexamination proceeding control No. 90/008,773, patent owner is represented by Guido Mogliano, whose correspondence address is that of record in the patent, and per 37 CFR 1.33(c) is the address that must be used in these proceedings. In reexamination control No. 90/008,796, patent owner is represented by the law firm of Cantor Coburn, LLP. Further, the patent owner's statement filed in reexamination Control No. 90/008,796 was filed by a member of the law firm of Cardinal Law Group presumably under the auspices of 37 CFR 1.34. Under 37 CFR 1.33(a), the Office will not engage in correspondence with more than one registered attorney or agent except as deemed necessary by the Director. Accordingly, the patent owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision. Failure to do so will result in the changing of the correspondence address in reexamination control No. 90/008,796 to that of Mr. Mogliano, per 37 CFR 1.33(c).

Conclusion

Reexamination Control Nos. 90/008,773 and 90/008,796 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to name but a single representative**. Upon receipt of the response, an Office action will issue in due course.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

cc: Cardinal Law Group
Suite 2000
1603 Orrington Avenue
Evanston, IL 60201

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

Guido Modiano
Via Mera Vigil 16
Milan, 20123
Italy

(For Patent Owner)

MAILED

MAR 17 2008

CENTRAL REEXAMINATION UNIT

Cantor Colburn, LLP
55 Griffin Road South
Bloomfield, CT 06002

(For Patent Owner)

Edwards Angell Palmer & Dodge LLP
P.O. Box 55874
Boston, MA 02205

(For 3rd Party Requester)

Reexam Control No.: 90/008,773
Filed : July 25, 2007
For U.S. Patent No. : 5,743,390

CORRECTED
DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,796
Filed : July 30, 2007
For U.S. Patent No. : 5,743,390

This is a corrected decision merging the above noted reexamination proceedings. The above noted reexamination proceedings were merged in a decision mailed March 11, 2008. The decision indicated that in reexamination control No. 90/008,796 a patent owner's statement had been filed December 6, 2007. Further, it indicated that the patent owner's statement had been filed by a member of the law firm of Cardinal Law Group, the filing of which created confusion as to who the real representative for patent owner is. Upon further review of the file, it was noticed that the December 6, 2007 paper was entered into the 90/008,796 file by mistake. As the paper in question does not belong in 90/008,796, it has been removed therefrom and it is clear that the law firm of Cardinal Law Group has nothing to do with the instant reexamination proceedings. In view of the above the merger mailed March 11, 2008 is modified as follows.

Reexamination in application control No. 90/008,773 was ordered in a decision mailed October 19, 2007. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/008,796 was ordered in a decision mailed October 26, 2007. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines.

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

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

Conduct of Proceedings

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

Dual Correspondence

Currently, patent owner appears to be represented by two different representatives. In reexamination proceeding control No. 90/008,773, patent owner is represented by Guido Mogliano, whose correspondence address is that of record in the patent, and per 37 CFR 1.33(c) is the address that must be used in these proceedings. In reexamination control No. 90/008,796, patent owner is represented by the law firm of Cantor Coburn, LLP as that is the entity that filed the request, allegedly on behalf of patent owner. Under 37 CFR 1.33(a), the Office will not engage in correspondence with more than one registered attorney or agent except as deemed necessary by the Director. Accordingly, the patent owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision. Failure to do so will result in the changing of the correspondence address in reexamination control No. 90/008,796 to that of Mr. Mogliano, per 37 CFR 1.33(c).

Conclusion

Reexamination Control Nos. 90/008,773 and 90/008,796 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to name but a single representative.** Upon receipt of the response, an Office action will issue in due course.

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

Lissi Mojica Marquis, Director
Central Reexamination Unit

cc: Cardinal Law Group
Suite 2000
1603 Orrington Avenue
Evanston, IL 60201

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

Wood, Phillips, Katz, Clark, Mortimer
500 W. Madison Street
Suite 3800
Chicago, IL 60661

(For Patent Owner)

MAILED

MAR 3 1 2008

CENTRAL REEXAMINATION UNIT

Kenneth L. Cage
McDermott, Will & Emery LLP
600 13th Street, N.W.
Washington, DC 20005

(For 3rd Party Requester)

Walter Steinkraus
Vidas, Arrett & Steinkraus
6640 Shady Oak Road, Suite 400
Eden Prairie, MN 55344

(For 3rd Party Requester)

Reexam Control No.: 90/007,627
Filed : July 13, 2005
For U.S. Patent No. : 4,739,762

Reexam Control No.: 90/008,780
Filed : July 26, 2007
For U.S. Patent No. : 4,739,762

Reexam Control No.: 90/008,797
Filed : August 9, 2007
For U.S. Patent No. : 4,739,762

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

Reexamination in application control No. 90/007,627 was ordered in a decision on petition mailed February 27, 2007. The decision ordered reexamination of claims 16, 23, 44, 51 and 54. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,780 was ordered in a decision mailed October 22, 2007 indicating that claims 23, 51 and 54 will be reexamined. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,797 was ordered in a decision mailed October 23, 2007 indicating that claims 1-12, 14-23 and 25-43, will be reexamined. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,627, reexamination control No. 90/008,780 and reexamination control No. 90/008,790 are currently pending. Since the order to reexamine has been mailed in all three reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-12, 14-23, 25-44, 51 and 54, will be reexamined. Claims 45-50, 52, 53, and 55-59 will not be reexamined as none of the above-identified requests requested reexamination of these claims. All papers mailed by the Office will take the form of a single action that jointly applies to each of the three reexamination proceedings. All papers issued by the Office will contain the identifying data for each of the three proceedings, and each action will be entered into each of the three files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the two third party requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,627; 90/008,780 and 90/008,797 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Andres Kashnikow

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.
90/008,798	08/09/2007	7,252,141 B1	8698.002.REX000	8696

77176 7590 08/28/2008

Novak, Druce & Quigg LLP
1300 I Street, N.W.
Suite 1000, West Tower
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/28/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STEVEN ARTERBERRY
SCHWEGMAN, LUNDBERG, WOESSNER P.A.
P.O. BOX 2938
MINNEAPOLIS,MN 55402

Date:
MAILED
AUG 28 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008798
PATENT NO. : 7252141
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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AUG 28 2008

CENTRAL REEXAMINATION UNIT

NOVAK, DRUCE & QUIGG LLP
1300 I STREET, N.W.
SUITE 1000, WEST TOWER
WASHINGTON, DC 20005

(For Patent Owner)

(For Third Party Requester)

SCHWEGMAN, LUNDBERG &
WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.550(c)]

In re: Intelisano
Ex Parte Reexamination Proceeding
Control No. 90/008,798
Deposited on: 9 August 2007
For: US Patent No. 7,252,141

This is a decision on the 27 June 2008 , petition for "Petition for One Month Extension of Time," requesting that the time for responding to the Office action mailed 27 June 2008 be extended by one-month.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 27 June 2008, which set a two month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 5 June 2008, together with the $200.00 petition fee required by 37 CFR § 1.515(c) and § 1.17(g).

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

37 CFR § 1.550 (c) states:

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

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

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

Analysis and Findings

The Office must weigh the decision to grant additional time to respond based upon the balance of providing the patent owner a fair opportunity to present an argument with the need for special dispatch. The patent owner has presented a statement that numerous attempts were made to schedule an interview with the examiner. That the examiner was unavailable on 25 August 2008 and accordingly the patent owner's representatives were unable to meet with the examiner before 27 August 2008. On balance, it should first be noted that examiner's interviews are not considered to be sufficient cause and justification for additional time. With due consideration of the examiner's unavailability, the petition request is hereby granted-in-part. The patent owner is hereby granted an additional two weeks to respond to the Office action dated 27 June 2008.

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

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 27 June 2008 is **granted-in-part**.

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

3. The Patent Owner's response is due **10 September 2008**.

4. Response may be submitted as follows:

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner at (571) 272-1611, Art Unit 3992 or Andres Kashnikow, Supervisory Patent Examiner at (571) 272-4361, Art Unit 3993 in the Central Reexamination Unit.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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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.
90/008,798	08/09/2007	7,252,141 B1	8698.002.REX000	8696

77176 7590 09/02/2008

Novak, Druce & Quigg LLP
1300 I Street, N.W.
Suite 1000, West Tower
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/02/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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
STEVEN ARTERBERRY
SCHWEGMAN, LUNDBERG, WOESSNER P.A.
P.O. BOX 2938
MINNEAPOLIS,MN 55402

Date:
MAILED

SEP 0 2 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008798
PATENT NO. : 7252141
ART UNIT : 3900

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UNITED STATES PATENT AND TRADEMARK OFFICE

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NOVAK, DRUCE & QUIGG LLP
1300 I STREET, N.W.
SUITE 1000, WEST TOWER
WASHINGTON, DC 20005

(For Patent Owner)

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SEP 02 2008

CENTRAL REEXAMINATION UNIT

SCHWEGMAN, LUNDBERG &
WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.550(c)]

In re: Intelisano
Ex Parte Reexamination Proceeding
Control No. 90/008,798
Deposited on: 9 August 2007
For: US Patent No. 7,252,141

This is a decision on the 27 June 2008 , petition for "Petition for One Month Extension of Time," requesting that the time for responding to the Office action mailed 27 June 2008 be extended by one-month.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 27 June 2008, which set a two month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 5 June 2008, together with the $200.00 petition fee required by 37 CFR § 1.515(c) and § 1.17(g).

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

37 CFR § 1.550 (c) states:

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

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

Analysis and Findings

The Office must weigh the decision to grant additional time to respond based upon the balance of providing the patent owner a fair opportunity to present an argument with the need for special dispatch. The patent owner has presented a statement that numerous attempts were made to schedule an interview with the examiner. That the examiner was unavailable on 25 August 2008 and accordingly the patent owner's representatives were unable to meet with the examiner before 27 August 2008. On balance, it should first be noted that examiner's interviews are not considered to be sufficient cause and justification for additional time. With due consideration of the examiner's unavailability, the petition request is hereby granted-in-part. The patent owner is hereby granted an additional two weeks to respond to the Office action dated 27 June 2008.

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

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 27 June 2008 is **granted-in-part**.

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

3. The Patent Owner's response is due **10 September 2008**.

4. Response may be submitted as follows:

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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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner at (571) 272-1611, Art Unit 3992 or Andres Kashnikow, Supervisory Patent Examiner at (571) 272-4361, Art Unit 3993 in the Central Reexamination Unit.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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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.
90/008,807	08/01/2007	5404505		5300

22913 7590 02/12/2008

WORKMAN NYDEGGER
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2008

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

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,282	10/05/2006	5404505	060900-5021US	5471

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.

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www.uspto.gov

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.

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Greenblum & Bernstein, P.L.C.
Attn: Bruce H. Stoner
1950 Roland Clarke Place
Reston, VA 20191

Date:

MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008282
PATENT NO. : 5404505
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Steven B. Samuels
WOODCOCK WASHBURN LLP
2929 Arch Street 12th Floor, Cira Centre
Philadelphia, PA. 19104-2891

Date:

MAILED
FEB 12 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008807
PATENT NO. : 5404505
ART UNIT : 3900

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

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

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FEB 12 2008

CENTRAL REEXAMINATION UNIT

Morgan, Lewis & Brockius, LLP (For Patent Owner)
2 Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306

Greenblum & Bernstein, PLC (For Third Party Requester)
Attn: Bruce Stoner
1950 Roland Clarke Place
Reston, VA 20191

Steven B. Samuels (For Third Party Requester)
Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th floor
Philadelphia, PA 19104-2891

In re Levinson
Reexamination Proceeding
Control No. 90/008,282
Request Deposited: October 5, 2006
For: U.S. Patent No. 5,404,505

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,807	08/01/2007	5404505	060900-5024US	5300

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
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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

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Dickstein Shapiro LLP
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Washington, DC 20006-5403

(For Patent Owner)

MAILED

JAN 29 2008

CENTRAL REEXAMINATION UNIT

Jon L. Roberts
Roberts Mardula & Wertheim, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191

(For 3rd Party Requester)

Reexam Control No.: 90/008,088
Filed : July 12, 2006
For U.S. Patent No. : 6,112,772

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,808
Filed : August 17, 2007
For U.S. Patent No. : 6,112,772

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

Reexamination in application control No. 90/008,088 was ordered in a decision mailed September 22, 2006. Prosecution proceeded to the mailing of a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) on February 24, 2007. The NIRC indicated that claims 1-7, all of the claims in the patent, were confirmed. A decision vacating the NIRC was mailed January 28, 2008. There were no amendments made to the claims, specification and/or drawings in this proceeding.

Reexamination in application control No. 90/008,808 was ordered in a decision mailed October 13, 2007 indicating that claims 1-7 will be reexamined. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/008,088 and reexamination control No. 90/008,808 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-7, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,088 and 90/008,808 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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The Firm of Hueschen and Sage
Seventh Floor, Kalamazoo Building
107 West Michigan Avenue
Kalamazoo, MI 49007

(For Patent Owner)

MAILED

MAR 06 2008

CENTRAL REEXAMINATION UNIT

THOMAS J. KOWALSKI
FROMMER LAWRENCE & HAUG LLP
745 FIFTH AVE.
NEW YORK, NY 10151

(For Third Party Requester)

In re Sandusky et al.
Reexamination Proceeding
Control No. 90/008,811
Request Deposited: August 23, 2007
For: U.S. Patent No. 7,037,543

: DECISION *RE*
: PETITION ON
: REEXAMINATION
: FILING DATE
: REQUIREMENTS

This is a decision addressing the December 19, 2007 third party requester paper filed in response to the Office's November 19, 2007, a "Decision *Sua Sponte* Vacating *Ex Parte* Reexamination Filing Date." The third party requester filed a replacement request, which was over 600 pages long. As part of the replacement request, the requester "petitioned" that if the corrected request was "... not deemed a sufficient response to the Decision [November 19, 2007 Decision] or is deemed to raise any new defect that Requestor be permitted to cure such or that such be waived or deemed immaterial or cured...". See pages 2-8 of the replacement request. A conditional petition under 37 CFR 1.181, 1.182, and 1.183 is found on pages 2-8 of the replacement request is dismissed. Accordingly, the replacement request is taken to provide a petition under 37 CFR 1.181, 37 CFR 1.182, and CFR 1.183.

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

The petition under 37 CFR 1.181, 37 CFR 1.182, and CFR 1.183 is dismissed.

In addition, the processing of the present *inter partes* reexamination request papers assigned Control No. 90/008,811 is terminated.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,037,543 (hereinafter, the '543 patent), issued to Sandusky et al. on May 2, 2006.

2. On August 23, 2007, a third party deposited a request for *ex parte* reexamination of claims 1-3, 7-25 and 29-39 of the '543 patent. The reexamination proceeding was assigned Control No. 90/008,811 (hereinafter, the '8811 proceeding).

3. On September 26, 2007, a "Notice of *Ex parte* Reexamination Request Filing Date" was mailed for the '8811 proceeding. The notice assigned a filing date of August 23, 2007 to the request for reexamination.

4. On November 19, 2007, a "Decision *Sua Sponte* Vacating *Ex Parte* Reexamination Filing Date" was mailed.

5. On December 19, 2007, the third party requester filed a six hundred and fifty four page replacement request. Page 2 of this replacement request contains language which may be considered a petition under 37 CFR 1.183 for waiver of the filing date requirements. Page 3 makes reference to granting relief 37 CFR 1.181, 37 CFR 1.182, and CFR 1.183.

6. On February 26, 2008, a "Notice of Termination of Preprocessing of *Ex Parte* Reexamination Request" was mailed.

DECISION

37 CFR 1.181 provides:

> (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.

37 CFR 1.182 provides:

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

37 CFR 1.183

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

In response to the aspect of the petition that the Office should *sua sponte* order a reexamination proceeding for the '204 patent, the Director of the USPTO will not normally consider requests to order reexamination at the Director's initiative received from members of the public. If a member of the public desires reexamination of a patent, a request and fee should be filed in accordance with 37 CFR 1.510. It is further noted that a decision to order reexamination at the Director's initiative is rare. Only in compelling circumstances, after a review of all the facts concerning the patent, would such a decision be made. See MPEP 2239.

In response to the remaining aspects of the petition, the filing of multiple petitions in a single paper, this practice does not comply with 37 CFR 1.4(c) and must be avoided in the future.

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.

Accordingly, each and every petition must be filed as separate papers from a response to the merits and from other petitions to avoid confusion and delay, and the present petition must be dismissed.

As additional grounds for dismissal: The "petitions" on pages 2-8 of the replacement request fail to satisfy the requirements of 37 CFR 1.181, 1.182, and/or 1.183. The petitions include no specific facts or evidence to show what point or points should be reviewed (under 37 CFR 1.181), and no showing that justice requires waiver of the rules in an extraordinary situation (under 37 CFR 1.183). To the extent that the present petition requests waiver of the rules, the petition must show (1) that the present situation is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). The petition has not shown that either condition exists in this case. The petition has not demonstrated that the failure to comply with the reexamination filing date requirements is caused by "extraordinary circumstances, such that "justice requires" waiver of the requirements. Waiver is not intended to be routine and the situation must rise to the level of an "extraordinary situation" that would justify waiver under 37 CFR 1.183. See e.g., *Issidorides v. Ley*, 4 USPQ 2d 1861 (Comm. of Patents 1987)("It is not the policy of the Patent and Trademark Office, however, to routinely waive rules), citing, *Myers v. Feigelman*, 455 F.2d 596, 172 USPQ 580, 584 (CCPA 1972)("the rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183")).

THIRD PARTY REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '543 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination, (which new request includes the missing information identified in the November 19, 2007 "Decision *Sua Sponte* Vacating *Ex Parte* Reexamination Filing Date"). The present decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted.

CONCLUSION

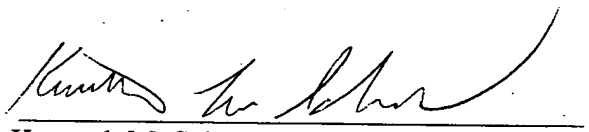
1. The petition under 37 CFR 1.181, 37 CFR 1.182, and CFR 1.183 is dismissed.

2. Processing of the present *inter partes* reexamination request papers assigned Control No. 90/008,811 is terminated.

3. A refund of the $8,800 reexamination filing fee will be made to requester in due course.

4. Jurisdiction over the vacated *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit, where the proceeding will be processed to mark its file history papers "closed" and "non-public," and for the determination of compliance with § 1.501 for adding the papers to the file for the '204 patent in due course.

5. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Lissi Marquis, Director of the Central Reexamination Unit, at (571) 272-1596, or in their absence to the undersigned at (571) 272-7710.



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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,813	11/14/2007	7105898	740756-3101	7257

22204 7590 01/22/2009

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/22/2009

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 Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Anthony J Canning
NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON DC 20004-2128

(For Patent Owner)

MAILED

JAN 22 2009

CENTRAL REEXAMINATION UNIT

DECISION DISMISSING
PETITION UNDER
37 CFR § 1.59 (b) TO
EXPUNGE INFORMATION

In re: Miyazaki *et alia*
Ex Parte Reexamination Proceeding
Control Number 90/008,813
Deposited on: 14 November 2007
For U.S. Patent No. 7,105,898

This is a decision on the 25 August 2008, Patent Owner requested petition titled "Petition to Expunge Material Under 37 CFR § 1.59(b)."

This petition considers under 37 CFR 1.59 (b) a request to expunge materials submitted by the Patent Owner with the Information Disclosure Statement (IDS) filed 5 August 2008.

The petition was filed in a timely manner with the authorization for the appropriate fee from a deposit account pursuant to 37 CFR § 1.17 (g).

The petition is hereby dismissed as moot.

REVIEW OF RELEVENT FACTS

1. US Patent No 7,105,898 was granted on 12 September 2006.

2. On 14 November 2007 the patent owner requested *ex parte* reexamination of US Patent No. 7,105,898 which is identified under control no. 90/008,813.

3. The Order was granted for reexamination on 10 December 2007.

4. An Information Disclosure Statement was filed on 5 August 2008.

5. The patent owner filed the instant Petition to Expunge on 25 August 2008

CITATION OF APPROPRIATE PROCEDURE

37 CFR § 1.59 (in-part)
Expungement of information or copy of papers in application file.
(a)
(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.
(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

DECISION

The petitioner requests that the documents submitted on 5 August 2008 be expunged from the *ex parte* proceeding. The petition authorizes the appropriate fee pursuant to 37 CFR § 1.59(b) and § 1.17 (g). It is noted that the examiner in charge of the proceeding considered the Information Disclosure Statement as indicated in the initialed and signed PTO form 1449 dated 23 September 2008. Since the Information Disclosure Statement has already been considered by the examiner in charge of the proceeding, the petition to expunge is considered to be moot.

CONCLUSION

1. The petition to expunge documents submitted by the patent owner on 5 August 2008 is hereby **dismissed as moot**.

2. The proceeding is hereby returned to the examiner in charge of the file for further action.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

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

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

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

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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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DEC 13 2007

CENTRAL REEXAMINATION UNIT

L. Grant Foster (For Patent Owner)
HOLLAND & HART LLP
60 East South Temple
Suite 2000
Salt Lake City, UT 84111-1031

David B. Cupar (For Third Party Requester)
600 Superior Avenue, E.
Suite 2100
Cleveland, OH 44114-2653

In re Dickson	:	
Ex parte Reexamination Proceeding	:	
Control No. 90/008,814	:	
Filed: August 13, 2007	:	
For: U.S. Patent No. 6,979,117	:	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
In re Dickson	:	
Inter partes Reexamination Proceeding	:	
Control No. 95/000,228	:	
Filed: February 12, 2007	:	
For: U.S. Patent No. 6,979,117	:	

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

REVIEW OF FACTS

1. On December 27, 2005, United States Patent Number 6,979,117 (the '117 patent) issued.

2. On February 12, 2007, a request for *inter parte* reexamination of the '117 patent, assigned Reexamination Control No. 95/000,228 (the '228 proceeding), was filed by David Cupar on behalf of third party requester, Vita-Mix Corp.

3. On May 7, 2007, an order granting *inter partes* reexamination issued, accompanied by an action on the merits for the '228 proceeding

4. On July 6, 2007, patent owner responded to the May 7, 2007 Office Action. No amendments were submitted by patent owner.

5. On August 6, 2007, third party requester submitted comments after patent owner's July 6, 2007 response.

6. On August 13, 2007 a request for *ex parte* reexamination of the '117 patent, assigned Reexamination Control No. 90/008,814 (the '8814 proceeding), was filed by David Cupar on behalf of Vita-Mix Corp.

7. An order granting *ex parte* reexamination was mailed for the '8814 proceeding on November 9, 2007.

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 '228 proceeding) is an *inter partes* proceeding. The *inter partes* proceeding is still pending, and has not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989 (a), the 95/000,228 and 90/008,814 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester 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. And, that third party has full *inter partes* reexamination participation rights.

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 the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim

should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,228 and *ex parte* Reexamination Control No. 90/008,814 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759, or, in her absence, to the undersigned, at 571-272-7710.

Kenneth M. Schor

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

December 12, 2007
C:\kiva\petmerger\Reexreex\95_0228+8814_EP-IP-Merge_cls-same EP-3PR-is-IP-3PR.doc_

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David B. Cupar, Esq.

McDONALD HOPKINS LLC

600 Superior Avenue, E., Suite 2100

Cleveland, OH 44114-2653

MAILED

MAR 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,814*.

PATENT NO. *6979117*.

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

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.
90/008,814	08/13/2007	6979117	46264.0047	7484

57600 7590 03/23/2009

HOLLAND & HART LLP
60 E. South Temple, Suite 2000
P.O. Box 11583
Salt Lake City, UT 84110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

L. Grant Foster (For Patent Owner)
HOLLAND & HART LLP
60 East South Temple
Suite 2000
Salt Lake City, UT 84111-1031

David B. Cupar (For Third Party Requester)
600 Superior Avenue, E.
Suite 2100
Cleveland, OH 44114-2653

MAILED

MAR 23 2009

CENTRAL REEXAMINATION UNIT

In re Dickson :
Ex parte Reexamination Proceeding :
Control No. 90/009,113 :
Filed: April 17, 2005 :
For: U.S. Patent No. 6,979,117 :
:
In re Dickson : **DECISION, *SUA SPONTE*,**
Ex parte Reexamination Proceeding : **TO MERGE**
Control No. 90/008,814 : **REEXAMINATION**
Filed: August 13, 2007 : **PROCEEDINGS**
For: U.S. Patent No. 6,979,117 :
:
In re Dickson :
Inter partes Reexamination Proceeding :
Control No. 95/000,228 :
Filed: February 12, 2007 :
For: U.S. Patent No. 6,979,117 :

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

REVIEW OF FACTS

1. On December 27, 2005, United States Patent Number 6,979,117 (the '117 patent) issued.

2. On February 12, 2007, a request for *inter partes* reexamination of the '117 patent, assigned Reexamination Control No. 95/000,228 (the '228 proceeding), was filed by David Cupar on behalf of third party requester, Vita-Mix Corp.

3. On May 7, 2007, an order granting *inter partes* reexamination issued, accompanied by an action on the merits for the '228 proceeding

4. On July 6, 2007, patent owner responded to the May 7, 2007 Office Action. No amendments were submitted by patent owner.

5. On August 6, 2007, third party requester submitted comments after patent owner's July 6, 2007 response.

6. On August 13, 2007, a first request for *ex parte* reexamination of the '117 patent, assigned Reexamination Control No. 90/008,814 (the '8814 proceeding), was filed by David Cupar on behalf of Vita-Mix Corp.

7. On November 9, 2007, the Office issued an order granting *ex parte* reexamination for the '8814 proceeding.

8. On December 13, 2007, the Office issued a decision *sua sponte* merging the '228 and the '8814 proceedings.

9. On April 17, 2008 a second request for *ex parte* reexamination of the '117 patent, assigned Reexamination Control No. 90/009,113 (the '9113 proceeding), was filed by David Cupar on behalf of Vita-Mix Corp.

10. On May 23, 2008, the Office issued an order granting *ex parte* reexamination for the '9113 proceeding.

11. A patent owner's statement under 37 CFR 1.530 has not been received in the '9113 reexamination proceeding, and the time for same has expired.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. One of the proceedings (the '228 proceeding) is an *inter partes* proceeding. The *inter partes* proceeding is currently part of a merged proceeding with an *ex parte* reexamination proceeding, the '8814 proceeding (the previously merged proceeding). The previously merged proceeding is still pending, and has not been terminated. Further, a patent owner's statement under 37 CFR 1.530 has not been received in the '9113 reexamination proceeding, and the time for same has expired. Therefore, consideration of further merger with the '9113 proceeding pursuant to 37 CFR 1.989 is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the previously merged proceeding, consisting of the 95/000,228 and 90/008,814 proceedings, and the 90/009,113 reexamination proceedings, are now merged. The new tri-merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files *throughout the tri-merged proceeding*. As the claims are the same in all files, a "housekeeping amendment" is NOT needed.

III. CONDUCT OF TRI-MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with merged proceeding that includes an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the tri-merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the 90/009,113 *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the two *ex parte* reexaminations were requested by the same third party that requested the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the tri-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 and the third party requester will contain the identifying data for all 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 triplicate, each bearing a signature and identifying data for all 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

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at:

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

Patent owner and requester are reminded that every paper filed in the tri-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 set forth above.

C. Amendments:

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

Upon return of the present tri-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. 95/000,228 and *ex parte* reexamination Control Nos. 90/008,814 and 90/009,113 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the tri-merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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

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JASON J. YOUNG
3001 W BIG BEAVER ROAD
SUITE 624
TROY, MI 48084-3109

MAILED
OCT 30 2007
CENTRAL REEXAMINATION UNIT

In re Application of :
PETER S. WILENS :
Control No. 90/008,817 (U.S. Patent 5,779,566) : DECISION ON PETITION
Filed: August 09, 2007 : TO WITHDRAW
Attorney Docket No. PRW-004 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 29, 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 Thomas N. Young on behalf of all attorneys of record. Applicant is reminded that there is no attorney of record at this time. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Manuel Saldana at 571-272-7740.

Manuel Saldana

for Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: **PETER S. WILENS**
2331 Cheswick
Troy, MI 48084

cc: **TOLER SCHAFFER, LLP** (Third Party Requester)
ATTN: Jeffrey G. Toler
8500 Bluffstone Cove, Suite A201
Austin, TX 78759

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on October 29, 2006. There is no indication it was served on 3rd Party Requester.

PTO/SB/83 (01-06)
Approved for use through 12/31/2006. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	90008817
Filing Date	August 9, 2007
First Named Inventor	Peter S. Wilens
Art Unit	3993
Examiner Name	Jimmy G. Foster
Attorney Docket Number	PRW-004

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

Please withdraw me as attorney or agent for the above identified patent application, and

☑ all the attorneys/agents of record.

☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or

☐ the attorneys/agents associated with Customer Number [ ]

NOTE: This box can only be checked when the power of attorney of record in the application is to all the practitioners associated with a customer number.

The reasons for this request are:
The client has engaged another attorney.

CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☐ Change the correspondence address and direct all future correspondence to:

☐ The address associated with Customer Number: [ ]

OR

☑ Firm or Individual Name	Peter S. Wilens				
Address	2331 Cheswick				
City	Troy	State	Michigan	Zip	48084
Country	United States				
Telephone	248-649-4860	Email			

Signature			
Name	Thomas N. Young	Registration No.	20985
Date	October 29, 2007	Telephone No.	(248) 649-3333

NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-600-PTO-9199 and select option 2.

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 08 2008

CENTRAL REEXAMINATION UNIT

Commissioner for Patents
United States Patent and Trademark Office
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CENTRAL REEXAMINATION UNIT

McAndrews Held & Malloy, LTD
500 West Madison Street
Suite 3400
Chicago, IL 60661

(For Patent Owner)

Howrey LLP
c/o IP Docketing Department
2941 Fairview Park Drive, Suite 200
Falls Church, VA 22042-2924

(For Third-Party Requester)

In re: Koenck *et al*
Reexamination Proceeding
Control No. 90/008,819
Corrected Request Deposited: October 18, 2007
For: U.S. Patent No. 6,714,983

: DECISION
: REFUSING ENTRY
: OF REPLY TO OPPOSITION
:
:

This is a decision on the April 21, 2008 patent owner supplemental petition, which has been filed after the third party requester opposition petition filed on April 21, 2008.

The supplemental petition is before the Office of Patent Legal Administration.

The supplemental petition paper is an improper paper, and is refused entry into the record, without consideration on the merits, for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,714,983 (hereinafter, the '983 patent), issued to Koenck *et al*, on March 30, 2004.

2. On January 9, 2007, the USPTO issued a certificate of correction of the '983 patent.

3. On August 24, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '983 patent. Reexamination of claims 1, 4, 8, 9, and 11 was requested, and requester asserted substantial new questions of patentability (SNQs) for those claims. The request was assigned Control No. 90/008,819 (hereinafter, the '8819 proceeding).

4. On September 21, 2007, a Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements was mailed in the '8819 proceeding.

5. On October 18, 2007, the third party requester filed a "REPLACEMENT STATEMENT AND EXPLANATION UNDER 37 C.F.R. 1.510(b)(1) AND (b)(2)." The '8819 proceeding was assigned the filing date of October 18, 2007.

6. On December 14, 2007, the Office granted the request for *ex parte* reexamination of claims 1, 4, 8, 9, and 11 of the '983, ordering reexamination of those claims.

7. On April 7, 2008, the patent owner filed a petition under 37 CFR 1.182 to vacate the reexamination order and refusing to grant any further requests by requester Qualcomm.

8. On April 21, 2008, third party requester Qualcomm filed a petition opposing the April 7, 2008 patent owner petition.

9. On April 21, 2008, patent owner filed the present supplemental petition.

DECISION

The patent owner's supplemental petition in response to an opposition is an unauthorized paper in the present *inter partes* reexamination proceeding because it is not provided for in the reexamination statute, regulations, or practice.

In this instance, patent owner's original petition effectively includes a request that the December 14, 2007 order for reexamination be vacated, as being an *ultra vires* reexamination order on the part of the Office, since a filing date should not have been granted based on the October 18, 2007 supplemental third party request paper (and thus, there was no proceeding upon which to grant reexamination. The last sentence of MPEP 2246 II provides:

> "The filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester."

Accordingly, the patent owner's April 21, 2008 supplemental petition is an improper paper, and will not be considered.

It is to be noted that, after an opposition to a patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not), any further paper in opposition/rebuttal/response to the third party opposition paper is improper and will not be considered. There is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. (See, 35 U.S.C. 305.) There is no indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple

iterations of input in petitionable matters was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

As the patent owner's April 21, 2008 supplemental petition paper is an improper submission, it will not be made of record in the reexamination file. The paper is being "returned" to the patent owner. Since the reply paper was scanned into the Image File Wrapper (IFW) for the proceeding prior to discovery that it lacked an entry right, the "return" will take the form of closing the reply paper document in the IFW file of the '8819 reexamination proceeding from public view and marking the document as "not public." The present decision will be made of record in the reexamination file.

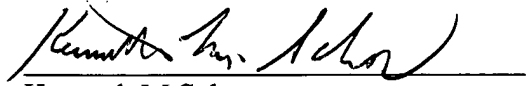
CONCLUSION

1. Patent owner's April 21, 2008 supplemental petition paper is an improper paper; it will not be considered, and it will be removed from the record. Since this paper has previously been incorporated into the IFW, it will be closed from public view and marked "non-public" in the IFW record of the present reexamination proceeding, to thereby expunge the paper.

2. No copy of the aforementioned April 21, 2008 patent owner paper will be maintained in the reexamination file, or elsewhere in the Office.

3. A copy of this decision will be made of record in the reexamination file.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611, 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
Office of the Deputy Commissioner
for Patent Examination Policy

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CENTRAL REEXAMINATION UNIT

McAndrews Held & Malloy, LTD (For Patent Owner)
500 West Madison Street
Suite 3400
Chicago, IL 60661

Howrey LLP (For Third-Party Requester)
c/o IP Docketing Department
2941 Fairview Park Drive, Suite 200
Falls Church, VA 22042-2924

In re: Koenck *et al* : DECISION
Reexamination Proceeding : GRANTING-IN-PART
Control No. 90/008,819 : PETITION UNDER
Corrected Request Deposited: October 18, 2007 : 37 CFR 1.182
For: U.S. Patent No. 6,714,983 :

This is a decision on the April 7, 2008, "PETITION OF PATENT OWNER UNDER 37 CFR 1.182 REQUESTING THE REEXAMINATION ORDER BE VACATED DUE TO A DEFECTIVE REQUEST FOR REEEXAMINATION" requesting "vacating the instant Reexamination Order and refusing to grant any further requests by Qualcomm." A third party requester opposition petition was filed on April 21, 2008.

The petition is before the Office of Patent Legal Administration for consideration. The petition is considered pursuant to 37 CFR 1.182. The petition was accompanied by an authorization to charge the fee required by 37 CFR 1.17(f) to Deposit Account 13-0017 and said fee has been applied.

The petition as to the aspect of vacating the instant reexamination order is **granted** for the reasons set forth below.

The petition as to the aspect of refusing to grant any further requests by Qualcomm is **dismissed** for the reasons set forth below.

The third party requester opposition petition is dismissed as being moot.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,714,983 (hereinafter, the '983 patent), issued to Koenck *et alia*, on March 30, 2004.

2. On January 9, 2007, the USPTO issued a certificate of correction of the '983 patent.

3. On August 24, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '983 patent. Reexamination of claims 1, 4, 8, 9, and 11 was requested, and requester asserted substantial new questions of patentability (SNQs) for those claims. The request was assigned Control No. 90/008,819 (hereinafter, the '8819 proceeding).

4. On September 21, 2007, a Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements was mailed in the '8819 proceeding.

5. On October 18, 2007, the third party requester filed a "REPLACEMENT STATEMENT AND EXPLANATION UNDER 37 C.F.R. 1.510(b)(1) AND (b)(2)." The '8819 proceeding was assigned the filing date of October 18, 2007.

6. On December 14, 2007, the Office granted the request for *ex parte* reexamination of claims 1, 4, 8, 9, and 11 of the '983.

7. On April 7, 2008, the patent owner filed the present petition under 37 CFR 1.182 to vacate the reexamination order and refusing to grant any further requests by requester Qualcomm.

8. On April 21, 2008, third party requester Qualcomm filed a petition opposing the April 7, 2008 patent owner petition.

9. On April 21, 2008, patent owner filed a supplemental petition, which will be treated by a separate decision.

DECISION

A. The filing date issue:

Pursuant to 37 CFR 1.510(b), any request for *ex parte* 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.

(4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office."

Petitioner correctly points out that the copy of the patent in the request for reexamination was not accompanied by the certificate of correction dated January 9, 2007. Therefore, the filing date requirement set forth in 37 CFR 1.510(b)(4) has not been complied with by requester.

Accordingly, the filing date (October 18, 2007) assigned to the request papers for *ex parte* reexamination proceeding Control No. 90/008,819 is hereby vacated for failure of the request papers to comply with the filing date requirements for an *ex parte* reexamination proceeding, as set forth in 37 CFR 1.510(b)(4).

Consequently, the order granting reexamination mailed December 14, 2007 is hereby vacated.

Thus, petitioner's requested relief of vacating the present reexamination order is **granted**.

The Certificate of Correction is of record in the USPTO in the '983 patent. A copy of the Certificate of Correction is now inserted into the '8819 proceeding, *sua sponte,* thereby making the request complete. The new filing date for the '8819 proceeding is assigned as of the mail date of the present decision.

The order granting reexamination in the '8819 proceeding is being re-mailed, with a date as of the mail date of the present decision, as an attachment to this decision.

Pursuant to 37 CFR 1.510(b):

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

Therefore, patent owner has two months from the date of the re-mailed order granting the request for reexamination to file a patent owner statement under 37 CFR 1.530. In a reexamination proceeding, patent owner may waive the right under 37 CFR 1.530 to file a patent owner Statement. The document must contain a statement that patent owner waives the right under 37 CFR 1.530 to file a patent owner statement, and, if the request for reexamination was made by a third party requester, must include proof of service in the manner provided by 37 CFR 1.248 - see 37 CFR 1.550(f). If such a waiver of right is desired by patent owner, the patent owner may consider using the following statement in a document waiving the right to file a patent owner statement:

"Patent owner waives the right under 37 C.F.R. 1.530 to file a patent owner statement."

Nothing in the third party requester opposition petition filed on April 21, 2008 addresses this resolution of the matter, which is deemed to provide equitable relief, to resolve the issues in an expeditious manner, and to further the "special dispatch" mandate of 35 U.S.C. § 305.

B. The certificate of correction:

It is noted that the present petition does not request any relief regarding the presence of the certificate of correction in the '983 patent. Therefore, the present decision does not address any of the comments in the petition regarding how or why the certificate of correction was filed or issued. If desired, the patent owner may consider filing, **in the '983 patent** (not in this reexamination proceeding), a separate petition to vacate the Certificate of Correction, with the Office of Petitions.

C. The request for refusal of further reexamination requests:

Further, the petition, on page 6, line 4, requests further relief in the form of "refusing to grant any further requests by Qualcomm." Initially, the relief being requested is not from/for any action or inaction in the present proceeding, and is thus inappropriately requested. In addition, the set of "any further requests" is an unbounded set – a request could be made on any basis; thus, the requested relief is ill defined. Furthermore, there does not appear to be any underlying basis for such requested relief, nor is it explained how the situation in the present proceeding can warrant sanctions to "any further requests." Accordingly, the petition as to the aspect of requesting the office to refuse to grant any further requests by Qualcomm is **dismissed**.

CONCLUSION

1. Petitioner's requested relief of vacating the present reexamination order is **granted**.

2. **The filing date** assigned to the request papers for *ex parte* reexamination proceeding Control No. 90/008,819 is hereby **vacated** for failure of the request papers to comply with the filing date requirements for an *ex parte* reexamination proceeding, as set forth in 37 CFR 1.510(b)(4).

3. **The order granting reexamination** mailed December 14, 2007 is hereby **vacated**.

4. A **copy of the Certificate of Correction is inserted** into the '8819 proceeding *sua sponte* thereby making the **request complete**.

5. A new **filing date** for the '8819 proceeding is **assigned** as of the mail date of the present decision.

6. The **order granting reexamination** in the '8819 proceeding is **re-mailed**, as an attachment to this decision, and the order mail date is that of the present decision.

7. The petition as to the aspect of requesting the office to refuse to grant any further requests by Qualcomm is **dismissed**.

8. The patent owner has two months from the date of the re-mailed order granting the request for reexamination to file a patent owner statement under 37 CFR 1.530. If the patent owner files a statement in a timely manner, the third-party requester has two months from the date of service to reply.

9. 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

10. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611, or in their absence, to Legal Advisors Stephen Marcus at (571) 272-7743, or Pinchus M. Laufer at (571) 272-7726.

/Kenneth M. Schor/

Kenneth M Schor
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.
90/008,823	08/27/2007	5,763,831	1001.169	1891

54434 7590 02/19/2010

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/19/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILLIAM F. PRENDERGAST
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

Date:
MAILED

FEB 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008823
PATENT NO. : 5763831
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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FEB 19 2010

CENTRAL REEXAMINATION UNIT

Kenneth C. Booth
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Tempe AZ 85281

(For Patent Owner)

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

(For Third Party Requester)

In re: Shotey *et alia*
Ex parte Reexamination Proceeding
Control No. 90/008,823
Deposited on: 27 August 2007
For: US Patent No. 5,763,831

DECISION
DENYING
PETITION
37 CFR §§ 1.181 and 1.182

This is a decision on the 20 January 2010, "Petition Pursuant to 37 CFR §§ 1.181 and 1.182" requesting that the action dated 22 December 2009 indicate that a conference took place.

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

The petition is denied since a conference did in fact take place.

DISCUSSION

The Patent Owner requests the office action dated 22 December 2009 be re-mailed with evidence of a panel conference. The action dated 22 December 2009 does in fact indicate that a conference took place. The petition does include the certificate of service.

Further the petition seeks relief under both 37 CFR § 1.181 and 1.182. Pursuant to 37 CFR § 1.4(c) each distinct inquiry must be contained in a separate paper. While this petition could be dismissed in it's entirety under 37 CFR § 1.4(c), the part of this petition seeking relief under 37 CFR § 1.181 will be addressed and the part under 37 CFR § 1.182 will not be addressed. Should the petitioner seek further relief under 37 CFR § 1.182, the petition must file under a separate paper for consideration.

CITATION OF RELEVANT AUTHORITY

37 CFR § 1.4(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 § 2271 FINAL OFFICE ACTION (in-part)

I. PANEL REVIEW CONFERENCE
After an examiner has determined that the reexamination proceeding is ready for final rejection, the examiner will formulate a draft preliminary decision to issue a final rejection, the preliminary decision setting forth which claims to reject, the grounds of rejection, which claims to allow/confirm and reasons for allowance/confirmation. The examiner will then inform his/her Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS) of his/her intent to issue the final rejection. The CRU SPE/TC QAS will convene a panel review conference, and the conference members will review the patentability of the claim(s) pursuant to MPEP § 2271.01. If the conference confirms the examiner's preliminary decision to reject and/or allow the claims, the proposed final rejection shall be issued and signed by the examiner, with the two other conferees initialing the action (as "conferee") to indicate their presence in the conference. If the conference does not confirm the examiner's preliminary decision, the examiner will reevaluate and issue an appropriate Office action.

MPEP § 2271.01 (in-part)

IV. CONSEQUENCES OF FAILURE TO HOLD CONFERENCE
Should the examiner issue an Office action without panel review, the patent owner or the third party requester who wishes to object must promptly file a paper alerting the Office of this fact. (The failure to provide panel review would be noted by the parties where there are no conferees' initials at the end of the Office action.) Any

challenge of the failure to hold a panel review conference must be made within two weeks of receipt of the Office action issued, or the challenge will not be considered. In no event will the failure to hold a panel review conference, by itself, be grounds for vacating any Office decision(s) or action(s) and "restarting" the reexamination proceeding.

ANALYSIS AND FINDINGS

The patent owner seeks to have the Office action dated 22 December 2009 re-mailed with indication of a Panel Review Conference. Review of the Final action mailed 22 December 2009 indicated the signature of primary examiner Albert Gagliardi, the e-signature of Erik Kielin and the longhand signature of Supervisory Patent Examiner Eric Keasel. All of the requirements for indicating that a panel conference took place is met on the signature page 55 in the Office action dated 22 December 2009.

It should be noted pursuant to MPEP § 2271.01 (IV) that the any challenge of the failure to hold a panel review conference must be made within two weeks of receipt of the Office action issued, or the challenge will not be considered. The instant petition was not timely filed. Further, "[i]n no event will the failure to hold a panel review conference, by itself, be grounds for vacating any Office decision(s) or action(s) and "restarting" the reexamination proceeding.

The petition seeks relief under both 37 CFR § 1.181 and 1.182. Pursuant to 37 CFR § 1.4(c) each distinct inquiry must be contained in a separate paper. The part of this petition seeking relief under 37 CFR § 1.181 is addressed and the part under 37 CFR § 1.182 is be addressed. Should the petitioner seek further relief under 37 CFR § 1.182, the petition must file under a separate paper for consideration.

The petition is denied since a conference did indeed take place.

To seek relief under 37 CFR § 1.182 a separate petition must be filed.

CONCLUSION

1. The patent owner's petition re-mailing the Office action dated 22 December 2009 to indicate a panel conference convened is hereby **denied.**

2. The proceeding is returned to the examiner for further disposition.

3. Other response may be submitted as follows:

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

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, 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.

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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Thompson Hine L.L.P.
Intellectual Property Group
P.O. Box 8801
Dayton, OH 45401-8801

For Patent Owner

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CENTRAL REEXAMINATION UNIT

Douglas R. Hansom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway, Suite 1002
Arlington, VA 22202

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,824
Filed: October 3, 2007
For: U.S. Patent No. 7,229,417

DECISION ON PETITION
FOR WITHDRAWING NIRC
UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on August 10, 2009. The petition is entitled "PETITION UNDER 37 C.F.R. §1.181 TO WITHDRAW NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION CERTIFICATE AND IN ALTERNATIVE PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b)", and is a request to the Director of the Central Reexamination unit to exercise his authority to withdraw the Notice of Intent to Issue *Ex parte* Reexamination Certificate (NIRC) mailed July 22, 2009, and to have the amendment after final filed July 24, 2009 considered. In the same paper, the patent owner also filed an alternative petition under 37 CFR 1.137(b) requesting the revival of the instant reexamination proceeding. This alternative petition will not be addressed for reasons discussed below.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated August 10, 2009 is **denied** with respect to the withdrawal of the NIRC mailed July 22, 2009 and consideration of the amendment after final filed July 24, 2009.

Review of Relevant Facts

1. On June 12, 2007, U.S. Patent No. 7,229,417 issued to Seth A. Foerster et al.
2. On October 3, 2007, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/008,824.
3. An Order granting reexamination in control No. 90/008,824 was mailed November 20, 2007.
4. On March 7, 2008, a non-final Office action was mailed.
5. A response was received from the patent owner on May 7, 2008. The response failed to comply with the requirements of 37 CFR 1.530 (d) and (f) in that a new

claim was presented but was not underlined as is specifically required by 37 CFR 1.530(d)(2).

6. On May 15, 2008, a supplemental amendment was filed at the request of the Office presenting the new claim in the proper format.
7. An interview was held with patent owner's representative on October 9, 2008.
8. On October 23, 2008, patent owner filed a Statement of the Interview.
9. Another non-final Office action was mailed on November 6, 2008.
10. On January 6, 2009, a response was received from patent owner. This response also failed to comply with the requirements of 37 CFR 1.530 (d) and (f) in that the claims did not include the appropriate markings to show subject matter that has been added relative to the text appearing in the patent undergoing reexamination.
11. A final Office action was mailed on March 10, 2009. The action included a section (first paragraph of the "Detailed Action") that informed patent owner that: (1) there were defects in the amendment filed January 6, 2009; (2) in order to proceed with "special dispatch", specific requirements of 37 CFR 1.530 were "*sua sponte*" waived; (3) the January 6, 2009 amendment was ***provisionally accepted for examination purposes***; and (4) the waiver was **not** to be taken as guidance as to any future waiver of the rules. (Bold emphasis added.) The action also included, as the last page thereof, the waiver signed by Mr. Kenneth Schor, the Senior Legal Advisor of the Office of Patent Legal Administration. The waiver again indicated that: (1) the improper amendment of January 6, 2009 was being provisionally accepted for examination purposes in order to further the statutory requirement of 35 U.S.C. 305 that "All proceedings under this section...will be conducted with special dispatch within the Office."; (2) patent owner was given two months to re-submit the January 6, 2009 amendment in a form that complies with 37 CFR 1.530; (3) the period for complying with the corrected amendment requirement run concurrently but separately from the period for response to the Office action; and, (4) if "**patent owner fails to timely correct the informality, the amendment will be held not to be an appropriate response, prosecution of the present reexamination proceeding will be terminated, and a reexamination will issue, 37 CFR 1.550(d)**". (Emphasis in original text.)
12. On April 23, 2009, patent owner requested a one-month extension of time.
13. On April 27, 2009, a decision granting the extension of time request was mailed.
14. A second request for a one-month extension of time was filed June 3, 2009.
15. On June 5, 2009, the second one-month extension of time request was granted.
16. A response to the final Office action was received July 8, 2009. The response was not accompanied by an amendment curing the defects of the January 6, 2009 amendment, nor was a separate paper filed doing so.
17. A Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) was mailed July 22, 2009.
18. Another amendment in response to the final Office action mailed March 10, 2009, and the NIRC mailed July 22, 2009, was filed July 24, 2009[1].
19. On August 10, 2009, the instant petition was filed.

---

[1] A separate decision treating this post-NIRC submission is being mailed on the same date as this decision.

Decision

The patent owner (petitioner) submits that the NIRC issued prematurely without consideration of the patent owner's amendment after final, and as such the NIRC should be withdrawn and the amendment after final filed July 24, 2009 entered in place of the July 8, 2009 amendment.

In support of the request, petitioner makes reference to section 2272 of the MPEP, quoting that **"any timely first response to a final rejection (even an informal response or even a response that is not signed) will automatically result in the extension of the shortened statutory period for an additional month."** (Petitioner's emphasis.) Petitioner indicates that the timely filing of the July 8, 2009 amendment automatically extended the deadline for response to August 10, 2009 and therefore, the amendment of July 24, 2009 was timely and should be considered. Petitioner notes that there is nothing in section 2272 of the MPEP restricting the patent owner's submissions to the final Office action during that interim month extension.

Petitioner states that the July 8, 2009 response to the final Office action was not unreasonable and, in fact, appears to comply with 37 CFR 1.530. Petitioner alleges that the final Office action mailed March 10, 2009, "clearly set forth an **unconditional waiver** of the informalities under §1.530". (Petitioner's emphasis.) Further, petitioner asserts that it was not unreasonable for the patent owner to construe the final Office action as entering the proposed amendments to claims 1, 8, 15, and 21 presented in the amendment filed January 9, 2009. As petitioner considers the July 8, 2009 response to be a bona fide attempt to respond to the substantive issues presented in the final Office action, the provisions of section 2272 of the MPEP alluded to hereinbefore should apply and an automatic extension of time granted. Petitioner also directs the Office to the request for the withdrawal of the NIRC presented in the amendment of July 24, 2009 as well as the request to extend the waiver of the requirements of 37 CFR 1.530 (d)(2), (f)(2), and (i) set forth in the final Office action of March 10, 2009, in view of the fourth paragraph at page 4 of the amendment filed July 24, 2009. Patent owner submits that the requested extension of the waiver of 37 CFR 1.530 should be granted in the interest of justice, as failure to do so would seem to undermine the purpose for which the waiver was originally granted and undermine the purpose of the extension procedure under MPEP 2272. As a final point, petitioner seems to be under the impression that the waiver signed by Ken Schor[2] links the time period for responding to the re-submission of the corrected amendment complying with 37 CFR 1.530 with the time period for responding to the final rejection.

Patent owner's reliance on the 'automatic extension of time" discussed in section 2272 of the MPEP is noted but not applicable in the present situation. The final Office action mailed March 10, 2009 is clear and unequivocal in its dealings with the improper amendment filed January 9, 2009 and consistent with the mandates of 35 U.S.C. 305 that

[2] Mr. Schor, as Senior Legal Advisor of the Office of Legal Patent Administration under the Office of the Deputy Commissioner for Patent Examination Policy, has been granted the authority to sign decisions involving the waiving of rules.

all reexamination proceedings under this section be conducted with special dispatch within the Office. As a preliminary observation, it is noted that patent owner's first amendment in this reexamination proceeding filed March 7, 2008 failed to comply with the requirements of 37 CFR 1.530. In that instance, as a result of a courtesy call from the Office, a corrected amendment was filed. The second amendment in this proceeding filed January 9, 2009 once again failed to comply with the requirements of 37 CFR 1.530. In this instance, the examiner **provisionally** accepted the amendment for examination purposes[3], and the waiver signed by Mr. Schor also stated that the improper amendment of January 9, 2009 is **provisionally** accepted for examination purposes. This clearly does not suggest that the waiver was an "unconditional waiver" as advanced by petitioner. Further, the examiner cautioned patent owner that the waiver was not to be taken as guidance as to any future waiver of the rules. The waiver signed by Mr. Schor clearly states that **"the time period for filing the corrected amendment is separate from the time period to the Office action."** (Emphasis in original.) Finally, the waiver stated that if **"patent owner fails to timely correct this informality, the amendment will be held not to be an appropriate response, prosecution of the present reexamination proceeding will be terminated, and a reexamination certificate will issue, 37 CFR 1.550(d)."** (Again, emphasis in original.)

As the first amendment after final rejection filed July 8, 2009, did not include nor was it accompanied by an amendment curing the noted informalities of the January 9, 2009 amendment, as stated in the waiver, the amendment of January 9, 2009, was held to be an improper amendment, prosecution of the present reexamination proceedings terminated and a NIRC issued. Accordingly, the request to withdraw the NIRC and to have the amendment filed July 24, 2009 deemed timely and considered by the examiner is **denied**. Having failed to comply with the waiver requirement, no further consideration was given to the July 8, 2009 amendment, and therefore, the "automatic extension of time" provisions set forth in section 2272 of the MPEP was not an available option.

Alternative Petition under 37 CFR 1.137(b)

As to the alternative relief requested under 37 CFR 1.137(b), only the petition under 37 CFR 1.181 is before the Central reexamination unit, and is addressed by this decision. The petition under 37 CFR 1.137(b) must be filed as a separate paper for proper consideration by the Office, and is not addressed in this decision.

37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States 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.

Because petitions filed under 37 CFR 1.137(b) dealing with reexaminations are handled by the Office of Patent Legal Administration (see MPEP 2268) while petitions under 37

[3] See penultimate paragraph on the page marked as page of the final Office action mailed March 10, 2009.

CFR 1.181 are decided by the Central reexamination Unit, the patent owner must submit the petition under 37 CFR 1.137(b) in a separate paper to avoid confusion and delay.

Conclusion

The petition under 37 CFR 1.181 to withdraw the NIRC mailed July 22, 2009, and to deem the amendment of July 24, 2009 timely and have it considered by the examiner is **denied**.

Patent owner is advised that a petition under 37 CFR 1.137(b) requesting the withdrawal of the NIRC and accepting as timely the amendment filed July 24, 2009 must be filed as a separate paper.

Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,824	10/03/2007	7229417	END-0448USREX1	2049

27805 7590 10/09/2009

THOMPSON HINE L.L.P.
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Date:
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008824
PATENT NO. : 7229417
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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Welsh & Flaxman LLC
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(For Patent Owner)

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OCT 09 2009

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(Courtesy Copy)

In re Seth A. Foerster et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,824
Filed: October 3, 2007
For: U.S. Patent No. 7,229,417

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

This is a decision on the September 8, 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 September 8, 2009 patent owner petition to revive").

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 September 8, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The September 8, 2009 patent owner petition to revive is **granted**.

The July 22, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

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

37 CFR 1.137 provides, in pertinent part:

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

*

(d) *Terminal disclaimer.*

*

*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

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

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

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent

to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Patent owner submitted a Notice of Appeal and paid the corresponding fee of $540.00 on August 10, 2009, thereby satisfying item (1).[1] A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the September 8, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the September 8, 2009 patent owner petition to revive is **granted**.

The July 22, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

PATENT OWNER'S CORRESPONDENCE ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 7,229,417 patent file is that of Welsh & Flaxman LLC, 2000 Duke Street, Suite 100, Alexandria, VA 22314.

As a courtesy, this decision is being mailed to the address of Thompson Hine L.L.P., Intellectual Property Group, P.O. Box 8801, Dayton, OH 45401-8801, in view of the August 4, 2009 Power of Attorney and August 5, 2009 Notice of Acceptance of Power of Attorney present in the file of the '8824 reexamination proceeding.

---

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

The address of Welsh & Flaxman LLC, 2000 Duke Street, Suite 100, Alexandria, VA 22314, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '417 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The September 8, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. The July 22, 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, Art Unit 3993, for further processing in view of the August 10, 2009 Notice of Appeal.

4. 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).

5. The address of Welsh & Flaxman LLC, 2000 Duke Street, Suite 100, Alexandria, VA 22314, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '417 patent file is made in accordance with 37 CFR 1.33(c).

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jeanne Clark, of CRU Art Unit 3993, at (571) 272-7714.

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

L. Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,824	10/03/2007	7229417	END-0448USREX1	2049

27805 7590 12/04/2009

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ART UNIT	PAPER NUMBER

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Date: MAILED

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008824
PATENT NO. : 7229417
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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Suite 1002
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(For Third Party Requester)

In re Seth A. Foerster et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,824
Filed: October 3, 2007
For: U.S. Patent No. 7,229,417

: **DECISION**
: **ON**
: **PETITIONS**

This is a decision addressing the October 27, 2009 patent owner petition under 37 CFR 1.182 requesting continued reexamination and the November 10, 2009 patent owner petition under 37 CFR 1.182 requesting withdrawal of the October 27, 2009 petition.

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

For the reasons set forth below, the October 27, 2009 petition is dismissed as withdrawn and has not been considered on its merits. The November 10, 2009 petition is granted.

FEES

The petition fee of $400 set forth in 37 CFR 1.17(f) for the October 27, 2009 petition under 37 CFR 1.182 was transmitted by EFS-Web on October 27, 2009.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the November 10, 2009 petition under 37 CFR 1.182 is hereby waived, as the petition is a request to withdraw the previous petition.[1]

REVIEW OF RELEVANT FACTS

1. On June 12, 2007, U.S. Patent No. 7,229,417 issued to Seth A. Foerster et al.

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

2. On October 3, 2007, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/008,824.

3. On November 20, 2007, an order granting reexamination was mailed.

4. On March 7, 2008, a non-final Office action was mailed.

5. Prosecution progressed to the point where, on March 10, 2009, a final Office action was mailed.

6. On April 23, 2009, patent owner filed a petition requesting a one-month extension of time to file a response to the March 10, 2009 final Office action.

7. On April 27, 2009, the Office mailed a decision granting the one-month extension of time to file a response to the final Office action.

8. On June 3, 2009, patent owner filed a petition to request a second one-month extension of time to file a response to the March 10, 2009 final Office action.

9. On June 5, 2009, the Office mailed a decision granting the second one-month extension of time to file a response to the March 10, 2009 final Office action.

10. On July 8, 2009, patent owner filed a response to the final Office action, the response being accompanied by declarations.

11. On July 22, 2009, a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) was mailed. The Notice stated that the amendment filed on July 8, 2009 did not comply with 37 CFR 1.530.

12. On July 24, 2009, patent owner filed a substitute response after final Office action to correct the defects of the July 8, 2009 amendment indicated in the NIRC.

13. On September 8, 2009, patent owner filed a petition entitled "PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b)."

14. On October 9, 2009, the Office mailed a decision granting the September 8, 2009 petition under 37 CFR 1.137(b).

15. On October 27, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

16. On November 10, 2009, patent owner filed a petition entitled "REQUEST TO WITHDRAW PETITION UNDER 37 C.F.R. §1.182 FOR CONTINUED REEXAMINATION."

17. On November 13, 2009, the Office mailed an advisory action stating that the declarations filed after a final action would not be entered, pursuant to 37 CFR 1.116(e), because

patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence was necessary and was not earlier presented.

18. On November 24, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.181 FOR ENTRY OF AFFIDAVIT SUBMITTED AFTER FINAL ACTION."

DECISION

In the October 27, 2009 petition, patent owner requested that the Office continue the prosecution of the above-captioned reexamination proceeding to provide consideration of the amendment after final and accompanying declarations filed on July 24, 2009 in response to the March 10, 2009 final Office action.

In the November 10, 2009 petition, patent owner requested that the Office withdraw from consideration the petition under 37 CFR 1.182 to request for continued prosecution of the above-captioned reexamination proceeding in light of the fact that the patent owner's response to the final Office action of March 10, 2009 was not yet considered, and therefore the petition under 37 CFR 1.182 to request for continued reexamination appeared to be premature. It is noted that the November 10, 2009 petition does not give the date of the petition under 37 CFR 1.182 that is requested to be withdrawn. Since there is only one petition under 37 CFR 1.182 requesting continued reexamination of record in the present proceeding and it was filed on October 27, 2009, the petition under 37 CFR 1.182 referred to in the November 10, 2009 petition is taken to be the October 27, 2009 petition.

It is noted that subsequent to the filing of the November 10, 2009 petition, the Office mailed an advisory action on November 13, 2009, stating that the affidavit filed after a final action would not be entered, pursuant to 37 CFR 1.116(e), because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence was necessary and was not earlier presented. In response to the advisory action, patent owner, on November 24, 2009, filed a petition entitled "PETITION UNDER 37 C.F.R. §1.181 FOR ENTRY OF AFFIDAVIT SUBMITTED AFTER FINAL ACTION."

Since the petition under 37 CFR 1.181 to request entry of the amendment and declarations filed on November 24, 2009 has not yet been decided, the amendment and declarations filed on July 24, 2009 cannot be considered to have been denied entry after a final rejection in an *ex parte* reexamination proceeding, for the purpose of filing a petition under 37 CFR 1.182 to request for continued reexamination. Accordingly, the October 27, 2009 petition to request for continued reexamination filed to seek entry of the July 24, 2009 amendment and declarations filed after a final Office action would be premature.

In light of the patent owner request that the Office withdraw from consideration the October 27, 2009 request for continued prosecution of the present reexamination proceeding, the October 27, 2009 petition is hereby dismissed as withdrawn. The November 10, 2009 petition for withdrawal of the October 27, 2009 petition accordingly is granted.

CONCLUSION

1. The October 27, 2009 petition under 37 CFR 1.182 is dismissed as withdrawn.

2. The November 10, 2009 petition under 37 CFR 1.182 is granted.

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

4. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet7/RCR
12-3-09

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EXAMINER	
ART UNIT	PAPER NUMBER

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Date:

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CENTRAL REEXAMINATION UNIT

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In re Foerster et al.
Reexamination Proceeding
Control No.: 90/008,824
Filed: October 3, 2007
For: U.S. Patent No.: 7,229,417

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on November 24, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181 FOR ENTRY OF AFFIDAVIT SUBMITTED AFTER FINAL REJECTION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and enter the affidavit of William A. Bernie (hereinafter "the Bernie affidavit") filed on July 24, 2009.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated November 24, 2009 is denied with respect to entry of the Bernie affidavit filed on July 24, 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,229,417 (hereinafter, the '417 patent) issued on June 12, 2007.

2. A request for *ex parte* reexamination, assigned control No. 90/008,824 (hereinafter, the '824 proceeding), was filed by a third party requester on October 3, 2007. Reexamination was requested for claims 1, 5, 8, 12, 15 and 20. Reexamination was NOT requested for claims 2-4, 6, 7, 9-11, 13, 14 and 16-19.

3. *Ex parte* reexamination was ordered for the '824 proceeding on November 20, 2007 for claims 1, 5, 8, 12, 15 and 20.

4. On March 7, 2008, a non-final Office action, which rejected claims 1, 5, 8, 12, 15 and 20 based upon obviousness over U.S. Patent No. 4,832,686 to Anderson or obviousness over Anderson in view of U.S. Patent No. 4,863,470 to Carter, was mailed in the '824 reexamination proceeding.

5. On May 15, 2008, the patent owner filed a response and amendment of claims 1, 8 and 15 and submitted newly filed claim 21.

6. On October 9, 2008, an interview was held wherein the examiner agreed with withdraw the outstanding rejections.

7. On November 6, 2008, the Office issued a second, non-final Office action setting forth new grounds of rejection rejecting claims 1, 5, 8, 12, 15, 20 and 21 based upon obviousness over U.S. Patent No. 5,388,588 to Nabai et al. in view of Anderson and further in view of an article entitled "Air as Ultrasound Contrast Marker for Accurate Determination of Needle Placement," authored by Dr. Timothy G. Lee and Dr. John Q. Knochel, Radiology, Vol. 143 No. 3, published in June 1982, pages 787-88.

8. On January 6, 2009, the patent owner filed a response and amendment of claim 1, 8, 15 and 21.

9. On March 10, 2009, the Office issued a Final rejection Office action, which addressed the patent owner's response of January 6, 2009. The Office action rejected claims 1, 5, 15, 20 and 21 based upon obviousness over U.S. Patent No. 5,388,588 to Nabai et al. in view of Anderson and further in view of an article entitled "Air as Ultrasound Contrast Mraker for Accurate Determination of Needle Placement," authored by Dr. Timothy G. Lee and Dr. John Q. Knochel, Radiology, Vol. 143 No. 3, published in June 1982, pages 787-88. The Office action also rejected claims 8 and 12 based upon obviousness over an article

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12. On July 8, 2009, patent owner filed a response and an affidavit by William A. Bernie.

13. On July 22, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate. The Notice stated that the July 8, 2009 response did not include an amendment in compliance with 37 CFR 1.530, which was required in the Final Office action mailed March 10, 2009. The March 10, 2009 Office action required that patent owner submit an amendment in compliance with 37 CFR 1.530 and indicated that if the patent owner failed to timely correct the informality, the amendments, dated January 6, 2009, would be held to be an improper response, prosecution of the present reexamination proceedings would be terminated, and a reexamination certificate would issue.

14. On July 24, 2009, patent owner filed another response correcting the claim amendments submitted in the January 6, 2009 response and an affidavit by William A. Bernie.

15. On August 10, 2009, patent owner filed a Notice of Appeal and a paper entitled "Petition Under 37 CFR 1.181 to Withdraw Notice of Intent to Issue Ex Parte Reexamination Certificate And in the Alternative, Petition to Revive Under 37 CFR 1.137(b)".

16. On September 3, 2009, the Office mailed a "Decision Regarding a Post-NIRC Submission" indicating that the response filed July 24, 2009 would not be entered. On even date, the Office mailed a decision denying the Petition under 37 CFR 1.181.

17. On September 9, 2009, patent owner filed a Petition to Revive under 37 CFR 1.137(b).

18. On October 9, 2009, the Office mailed a decision granting the petition filed under 37 CFR 1.137(b). The decision directed patent owner to file an appeal brief by December 9, 2009.

19. On November 11, 2009, patent owner filed a response after final rejection.

20. On November 13, 2009, the Office mailed an advisory action refusing entry of the affidavit by William A. Bernie filed July 24, 2009.

21. On November 24, 2009, patent owner filed the instant petition requesting entry of the affidavit by William A. Bernie.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding not to enter the affidavit of William A. Bernie, filed July 24, 2009, because the affidavit was submitted in response to two new arguments presented by the Office in the Final Office action dated March 10, 2009. As such, petitioner contends that the Bernie affidavit is necessary and could not have been earlier presented. Specifically, petitioner argues that in the Final Office action mailed March 10, 2009, the Office materially modified the rejection by 1) alleging that the claimed method (with the exception of claim 8) "is not restricted to a biopsy method that does not involve a skin biopsy" and 2) alleging that the use of IL-2 in the Anderson reference "is not required and that the IL-2 may not be included in the implant if it was not desired." See page 2 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the Bernie affidavit filed July 24, 2009, the director finds there are no good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings 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 March 10, 2009 sets forth essentially 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 November 6, 2008, claims 1, 5, 15, 20 and 21 were again rejected based on obviousness over Nabai in view of Anderson and further in view of Lee. Based upon an amendment to claim 8 in the response filed January 6, 2009, claims 8 and 12 were rejected based on obviousness over Lee in view of Nabai and Anderson. The examiner then addressed arguments presented in the January 6, 2009 response by the patent owner,

including the arguments based upon a biopsy method involving skin biopsy and the use of IL-2 in Anderson. See pages 11-13 of the Final Office action mailed March 10, 2009.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the Bernie affidavit filed July 24, 2009 should not be entered. The patent owner had an opportunity to enter the Bernie affidavit following the non-final Office action of November 6, 2008. As aptly pointed out by the examiner in the advisory action mailed November 13, 2009, patent owner has not presented any reasons why the declaration was not earlier presented. In the petition, patent owner alleges that the examiner "materially modified" the rejection. To the contrary, the examiner set forth the *exact* same rejection as in the non-final Office action of November 6, 2008. The "material modification" to which petitioner refers is merely the examiner's response to arguments set forth in patent owner's response filed January 6, 2009. To reiterate, the examiner is addressing arguments made by the patent owner, not modifying or altering the grounds of rejection.

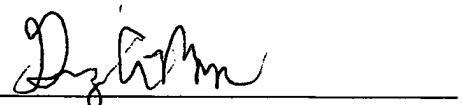
For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not enter the Bernie affidavit of July 24, 2009.

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 entry of the Bernie affidavit dated July 24, 2009 is denied.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,824	10/03/2007	7229417	END-0448USREX1	2049

27805 7590 02/02/2010

THOMPSON HINE L.L.P.
Intellectual Property Group
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DAYTON, OH 45401-8801

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Douglas R. Hanscom
JONES, TULLAR & COOPER
2001 Jefferson Davis Highway, Suite 1002
Arlington, VA 22202

Date: MAILED

FEB 0 2 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008824
PATENT NO. : 7229417
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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Thompson Hine L.L.P.
Intellectual Property Group
P.O. Box 8801
Dayton, OH 45401-8801

(For Patent Owner)

MAILED

FEB 0 2 2010

CENTRAL REEXAMINATION UNIT

Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

(For Third Party Requester)

In re Seth A. Foerster et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,824
Filed: October 3, 2007
For: U.S. Patent No. 7,229,417

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

This is a decision on the December 17, 2009 patent owner petition entitled "SECOND PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

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

FEES

The requisite petition fee for a petition under 37 CFR 1.182 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee was electronically submitted on December 17, 2009.

REVIEW OF RELEVANT FACTS

1. On June 12, 2007, U.S. Patent No. 7,229,417 issued to Seth A. Foerster et al.

2. On October 3, 2007, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/008,824.

3. On November 20, 2007, an order granting reexamination was mailed.

4. On March 7, 2008, a non-final Office action was mailed.

5. Proceeding progressed to the point where, on March 10, 2009, a final Office action was mailed.

6. On April 23, 2009, patent owner filed a petition requesting a one-month extension of time to file a response to the March 10, 2009 final Office action.

7. On April 27, 2009, the Office mailed a decision granting the one-month extension of time to file a response to the final Office action.

8. On June 3, 2009, patent owner filed a petition to request a second one-month extension of time to file a response to the March 10, 2009 final Office action.

9. On June 5, 2009, the Office mailed a decision granting the second one-month extension of time to file a response to the March 10, 2009 final Office action.

10. On July 8, 2009, patent owner filed a response to the final Office action, the response being accompanied by declarations.

11. On July 22, 2009, a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) was mailed. The Notice stated that the July 8, 2009 amendment filed did not comply with 37 CFR 1.530.

12. On July 24, 2009, patent owner filed a substitute response after final Office action to correct the defects of the July 8, 2009 amendment indicated in the NIRC.

13. On September 8, 2009, patent owner filed a petition entitled "PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b)."

14. On October 9, 2009, the Office mailed a decision granting the September 8, 2009 petition under 37 CFR 1.137(b).

15. On October 27, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

16. On November 10, 2009, patent owner filed a petition entitled "REQUEST TO WITHDRAW PETITION UNDER 37 C.F.R. §1.182 FOR CONTINUED REEXAMINATION."

17. On November 13, 2009, the Office mailed an advisory action stating that the declarations filed after a final action would not be entered, pursuant to 37 CFR 1.116(e), because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence was necessary and was not earlier presented.

18. On November 24, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.181 FOR ENTRY OF AFFIDAVIT SUBMITTED AFTER FINAL ACTION."

19. On November 24, 2009, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.550(c) for filing an appeal brief.

20. On December 4, 2009, the Office mailed a decision dismissing the October 27, 2009 petition under 37 CFR 1.182 as withdrawn and granting the November 10, 2009 petition under 37 CFR 1.182 to withdraw petition.

21. On December 7, 2009, the Office mailed a decision denying the November 24, 2009 petition under 37 CFR 1.181.

22. On December 7, 2009, the Office mailed a decision granting a one-month extension of time to file an appeal brief.

23. On December 17, 2009, patent owner filed the present petition entitled "SECOND PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

24. On January 8, 2010, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.181(a)(3) FOR REVIEW OF THE DIRECTOR OF THE CENTRAL REEXAMINATION UNIT'S DENIAL OF ENTRY OF AMENDMENTS AND AFFIDAVITS SUBMITTED AFTER FINAL ACTION."

25. On January 11, 2010, patent owner filed an appeal brief.

26. On January 22, 2010, the Office mailed a Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in *Ex Parte* Reexamination.

DECISION

I. A PETITION UNDER 37 CFR 1.182 WILL NOT BE GRANTED WHERE ANOTHER RULE APPLIES

37 CFR 1.182 provides:

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

In the present petition under 37 CFR 1.182, it is requested that the Office grant continued reexamination of the above-captioned *ex partes* reexamination proceeding and enter the amendment after final and accompanying declaration filed on July 24, 2009.

Patent owner has subsequently filed a petition under 37 CFR 1.181 on January 8, 2010 to also seek entry of the July 24, 2009 papers.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein

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

that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding.

In this instance, the patent owner has subsequently pursued alternative relief via a 37 CFR 1.181 petition for entry of the July 24, 2009 papers.[2] Since the subsequently filed January 10, 2010 petition under 37 CFR 1.181 to request entry of the amendment and declarations has not yet been decided, the §1.182 petition is premature – if the §1.181 petition should be granted, then relief will be "specifically provided for in the regulations," i.e., under §1.181. Since the present § 1.182 petition is premature, it is dismissed as such. Stated another way, the relief requested in the petition under 37 CFR 1.182 would be moot, should relief be granted under 37 CFR 1.181. Since the entry of the July 24. 2009 submissions is currently in the process of being addressed through 37 CFR 1.181, consideration of this situation under 37 CFR 1.182 would be premature. Patent owner retains the option of seasonably filing a renewed petition under 37 CFR 1.182, if at some future date relief has not been granted under 37 CFR 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.182. When no further petitions under 37 CFR 1.181 are filed by patent owner, patent owner may renew the present petition under 37 CFR 1.182.

In view of the above, the petition under 37 CFR 1.182 is **dismissed** as premature.

CONCLUSION

1. The patent owner petition under 37 CFR 1.182 for continued reexamination filed on December 17, 2009 is **dismissed** as being premature.

2 .Jurisdiction for the instant *ex partes* reexamination proceeding is being transferred to the Office of Petitions for consideration of the January 8, 2010 patent owner petition filed under 37 CFR 1.181.

3. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

[2] The January 8, 2010 petition under 37 CFR 1.181 requests the Director to exercise his supervisory authority under 37 CFR 1.183(a)(3) and overturn the decision of the Director of the Central Reexamination Unit (CRU) dated December 7, 2009, which denied entry of the amendment after final filed July 24, 2009 and accompanying affidavits.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER

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(For Patent Owner)

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FEB 05 2010

CENTRAL REEXAMINATION UNIT

Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway, Suite 1002
Arlington, VA 22202

(For Requester)

In re Foerster et al.
Reexamination Proceeding
Control No.: 90/008,824
Filed: October 3, 2007
For: U.S. Patent No.: 7,229,417

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on January 8, 2010. The petition is entitled "PETITION UNDER 37 CFR § 1.181(a)(3) FOR REVIEW OF THE DIRECTOR OF THE CENTRAL REEXAMINATION UNIT'S DENIAL OF ENTRY OF AMENDMENTS AND AFFIDAVITS SUBMITTED AFTER FINAL ACTION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and enter the affidavit of William A. Bernie (hereinafter "the Bernie affidavit") filed on July 24, 2009.

The petition under 37 CFR 1.181 is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for reconsideration of the December 7, 2009 decision.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated January 8, 2010 is denied with respect to entry of the Bernie affidavit filed on July 24, 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,229,417 (hereinafter, the '417 patent) issued on June 12, 2007.

2. A request for *ex parte* reexamination, assigned control No. 90/008,824 (hereinafter, the '824 proceeding), was filed by a third party requester on October 3, 2007. Reexamination was requested for claims 1, 5, 8, 12, 15 and 20. Reexamination was NOT requested for claims 2-4, 6, 7, 9-11, 13, 14 and 16-19.

3. *Ex parte* reexamination was ordered for the '824 proceeding on November 20, 2007 for claims 1, 5, 8, 12, 15 and 20.

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13. On July 22, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate. The Notice stated that the July 8, 2009 response did not include an amendment in compliance with 37 CFR 1.530, which was required in the Final Office action mailed March 10, 2009. The March 10, 2009 Office action required that patent owner submit an amendment in compliance with 37 CFR 1.530 and indicated that if the patent owner failed to timely correct the informality, the amendments, dated January 6, 2009, would be held to be an improper response, prosecution of the present reexamination proceedings would be terminated, and a reexamination certificate would issue.

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21. On November 24, 2009, patent owner filed a petition under 37 CFR 1.181 requesting entry of the affidavit by William A. Bernie.

22. On December 7, 2009, the petition filed November 24, 2009 was denied.

23. On January 8, 2010, patent owner filed the instant petition.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding not to enter the affidavit of William A. Bernie, filed July 24, 2009, because the affidavit was submitted in response to two new arguments presented by the Office in the Final Office action dated March 10, 2009. As such, petitioner contends that the Bernie affidavit is necessary and could not have been earlier presented. Specifically, petitioner argues that in the Final Office action mailed March 10, 2009, the Office materially modified the rejection by 1) alleging that the claimed method (with the exception of claim 8) "is not restricted to a biopsy method that does not involve a skin biopsy" and 2) alleging that the use of IL-2 in the Anderson reference "is not required and that the IL-2 may not be included in the implant if it was not desired." See page 2 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the Bernie affidavit filed July 24, 2009, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection and for consideration of after final responses. See MPEP 2272.

Turning to the facts in this proceeding, the Final rejection of March 10, 2009 sets forth essentially 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 November 6, 2008, claims 1, 5, 15, 20 and 21

were again rejected based on obviousness over Nabai in view of Anderson and further in view of Lee. Based upon an amendment to claim 8 in the response filed January 6, 2009, claims 8 and 12 were rejected based on obviousness over Lee in view of Nabai and Anderson. The examiner then addressed arguments presented in the January 6, 2009 response by the patent owner, including the arguments based upon a biopsy method involving skin biopsy and the use of IL-2 in Anderson. See pages 11-13 of the Final Office action mailed March 10, 2009.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the Bernie affidavit filed July 24, 2009 should not be entered. The patent owner had an opportunity to enter the Bernie affidavit following the non-final Office action of November 6, 2008. As aptly pointed out by the examiner in the advisory action mailed November 13, 2009, patent owner has not presented any reasons why the declaration was not earlier presented. In the petition, patent owner alleges that the examiner "materially modified" the rejection. To the contrary, the examiner set forth the *exact* same rejection as in the non-final Office action of November 6, 2008. The "material modification" to which petitioner refers is merely the examiner's response to arguments set forth in patent owner's response filed January 6, 2009. To reiterate, the examiner is addressing arguments made by the patent owner, not modifying or altering 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 her discretion in deciding to not enter the Bernie affidavit of July 24, 2009.

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 seeking the Director's review of the December 7, 1009 decision is denied.

2. Patent owner is advised that the petition under 37 CFR 1.182 requesting continuing reexamination, filed December 17, 2009, will be decided in due course.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to Gregory Morse, Director of the CRU, at (571) 272-3838.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,824	10/03/2007	7229417	END-0448USREX1	2049

27805 7590 04/30/2010

THOMPSON HINE L.L.P.
Intellectual Property Group
P.O. BOX 8801
DAYTON, OH 45401-8801

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/30/2010

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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MAILED

Date: APR 30 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Douglas R. Hanscom
JONES, TULLAR & COOPER
2001 Jefferson Davis Highway, Suite 1002
Arlington, VA 22202

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008824
PATENT NO. : 7229417
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Thompson Hine L.L.P.
Intellectual Property Group
P.O. Box 8801
Dayton, OH 45401-8801

(For Patent Owner)

MAILED
APR 30 2010
CENTRAL REEXAMINATION UNIT

Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

(For Third Party Requester)

In re Seth A. Foerster et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,824
Filed: October 3, 2007
For: U.S. Patent No. 7,229,417

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

This is a decision on the February 24, 2010 patent owner petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

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

FEES

The requisite petition fee for a petition under 37 CFR 1.182 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee was electronically submitted on December 17, 2009 for the original petition under 37 CFR 1.182. A fee is not required for the present renewed petition.

BACKGROUND

1. On June 12, 2007, the Office issued U.S. Patent No. 7,229,417 (the '417 patent) to Foerster et al.

2. On October 3, 2007, a request for *ex parte* reexamination of the '417 patent was filed by a third party requester. The resulting reexamination proceeding was assigned reexamination control No. 90/008,824 (hereinafter '8824).

3. On November 20, 2007, the Office issued an order granting the '8824 reexamination request.

4. On March 7, 2008, a first Office action of the merits issued, rejecting claims 1, 5, 8, 12, 15 and 20. Reexamination was not requested for claims 2-4, 6, 7, 9-11, 13, 14 and 16-19.

5. On May 15, 2008, patent owner filed a response amending claims 1, 8, and 15, and adding new claim 21.

6. On November 6, 2008, a second non-final Office action issued, withdrawing all the rejections in the first Office action and setting forth new grounds of rejections under 35 U.S.C. § 103 for claims 1, 5, 8, 12, 15, 20 and 21 over Nabai in view of Anderson and Lee.

7. On January 6, 2009, patent owner filed a response to the November 6, 2008 second non-final Office action. Claims 1, 8, and 15 were amended. Claim 12 depended from claim 8.

8. On March 10, 2009, a final Office action was issued. The final rejections made in the action were essentially the same grounds of rejections based on prior art as set forth in the second non-final Office action. Claims 1, 5, 15, 20, and 21 were again rejected based on obviousness over Nabai in view of Anderson and Lee. Amended claims 8 and 12 were rejected based on obviousness over Lee in view of Nabai and Anderson.

9. On April 23, 2009, patent owner filed a petition requesting a one-month extension of time to file a response to the March 10, 2009 final Office action.

10. On April 27, 2009, the Office mailed a decision granting the one-month extension of time to file a response to the final Office action.

11. On June 3, 2009, patent owner filed a petition to request a second one-month extension of time to file a response to the March 10, 2009 final Office action.

12. On June 5, 2009, the Office mailed a decision granting the second one-month extension of time to file a response to the March 10, 2009 final Office action.

13. On July 8, 2009, patent owner filed a response after the final Office action, the response being accompanied by a declaration under 37 CFR 1.132 by William A. Bernie.

14. On July 22, 2009, a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) terminating the proceeding prosecution was mailed. The Notice stated that the January 6, 2009 amendment filed did not comply with 37 CFR 1.530 and that patent owner failed to timely correct the informality.

15. On July 24, 2009, patent owner filed a substitute response to correct the defects of the January 6, 2009 amendment indicated in the NIRC. The substitute response was accompanied by a copy of the §1.132 Bernie declaration (hereinafter "Bernie declaration") filed on July 8, 2009.

16. On August 10, 2009, patent owner filed a Notice of Appeal.

17. On September 8, 2009, patent owner filed a petition entitled "PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b)."

18. On October 9, 2009, the Office mailed a decision granting the September 8, 2009 petition under 37 CFR 1.137(b).

19. On October 27, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

20. On November 10, 2009, patent owner filed a petition entitled "REQUEST TO WITHDRAW PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

21. On November 13, 2009, the Office mailed an advisory Office action stating that the § 1.132 Bernie declaration filed after a final action would not be entered, pursuant to 37 CFR 1.116(e), because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence was necessary and was not earlier presented.

22. On November 24, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.181 FOR ENTRY OF AFFIDAVIT SUBMITTED AFTER FINAL ACTION."

23. On November 24, 2009, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.550(c) for filing an appeal brief.

24. On December 4, 2009, the Office mailed a decision dismissing the October 27, 2009 petition under 37 CFR 1.182 as withdrawn and granting the November 10, 2009 petition under 37 CFR 1.182 to withdraw petition.

25. On December 7, 2009, the Office mailed a decision denying the November 24, 2009 petition under 37 CFR 1.181.

26. On December 7, 2009, the Office mailed a decision granting a one-month extension of time to file an appeal brief.

27. On December 17, 2009, patent owner filed a petition entitled "SECOND PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

28. On January 8, 2010, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.181(a)(3) FOR REVIEW OF THE DIRECTOR OF THE CENTRAL REEXAMINATION UNIT'S DENIAL OF ENTRY OF AMENDMENTS AND AFFIDAVITS SUBMITTED AFTER FINAL ACTION."

29. On January 11, 2010, patent owner filed an appeal brief.

30. On January 22, 2010, the Office mailed a Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in *Ex Parte* Reexamination.

31. On February 1, 2010, the patent owner filed an amended appeal brief.

32. On February 2, 2010, the Office mailed a decision dismissing the December 17, 2009 petition under 37 CFR 1.182 as being premature.

33. On February 5, 2010, the Office mailed a decision denying the January 8, 2010 petition under 37 CFR 1.181.

34. On February 24, 2010, patent owner filed the present petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

RELEVANT REGULATIONS

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 1.182 provides:

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

DECISION

In March 2005, the Office issued a Notice entitled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] The Notice suggested that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in

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

an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition is to clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier; thus, a petition for continuation of the reexamination prosecution should explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

In the present renewed § 1.182 petition, patent owner requests that the Office grant continued reexamination of the above-captioned *ex parte* reexamination proceeding and enter and consider the post-final Bernie declaration filed on July 24, 2009. In the present renewed petition, patent owner proffers the same explanations made in the earlier petitions which were filed under 37 CFR 1.181, namely that the Bernie declaration filed after final could not have been presented earlier because the underlying arguments that the Office made in support of the rejections changed materially in the final Office action.[2] The petition further asserts that "review and consideration of the Bernie Declaration via continued reexamination will enable the Office to be more fully informed ..." [3]

The present renewed petition has been fully considered. With respect to patent owner's arguments concerning the teachings of the Anderson reference, these arguments are directed to the propriety of the examiner's rejection, which are not appropriate for consideration in a 37

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[2] Renewed petition at pages 3-4. Specifically, patent owner argues that the Office did not even hint in the non-final rejection based on Anderson that the Office considered IL-2 to be an optional element of the Anderson disclosure. Patent owner states that the Bernie declaration addresses the Office's contrived construction of the term "may" in one sentence of the Anderson patent, and affiant therein concluded that IL-2 is not optional. Patent owner also argues that "in the final action, the Office relied upon a previously unasserted construction of the term 'breast' as used in the claim." Patent owner asserts that "the Office argued that the term 'breast,' in the context of a 'breast biopsy,' includes the outer skin of the breast such that the Nabai patent, which discloses skin biopsies, is suggestive of the claimed invention which relates to an implant for use within the breast itself (i.e., the organ - not the skin covering it)." Patent owner states that paragraph 13 of the Bernie Declaration specifically notes that in the art, a biopsy of the outer skin on the surface of the breast is called a "skin biopsy and not a breast biopsy" and that consideration of Dr. Bernie's declaration will also materially advance prosecution by enabling the Office to properly construe the term "breast biopsy."

[3] Renewed petition at page 4.

CFR 1.182 petition. Insofar as the petition continues to argue as to whether there was a material change in the examiner's rejection in the final Office action, this argument has previously been addressed and rejected in Office decisions on petitions under 37 CFR 1.181.[4]

With respect to the ability of the submission to further the prosecution by its entry, petitioner does not provide specific rationale explaining how entry of the proffered declaration would act to define the issues for appeal, or the issuance of a reexamination certificate. Petitioner only states that entry of the Bernie declaration would "enable the Office to be more fully informed." However, the examiner, in the advisory Office action mailed on November 13, 2009, stated that the Bernie declaration substantially repeats the arguments presented in the patent owner response filed on January 6, 2009 and that the declaration was unpersuasive for the same reasons explained in the March 10, 2009 final Office action age pages 11-15. The examiner also stated in the advisory action that "even if the declaration was entered, the evidence of record as a whole, considered under a preponderance of evidence and with due consideration to the persuasiveness of any arguments and any secondary evidence, does not support a conclusion of nonobviounesses." Reopening of the prosecution to consider this declaration absent a showing of a *bona fide* effort to advance prosecution by defining the issues for appeal or the issuance of a reexamination certificate would validate the patent owner's unnecessary delay in presenting the Bernie declaration in this proceeding, contrary to the requirement of "special dispatch within the Office."

With respect to why petitioner patent owner's proposed response could not have been anticipated earlier, patent owner has not provided persuasive reasons why the Bernie declaration filed on July 24, 2009 could not have been submitted earlier. The Bernie declaration was stated to be submitted to address the rejections made in the final rejection; in particular, the Anderson reference.[5] Petitioner contends that the examiner's arguments made in support of the rejections changed materially in the final Office action. However, the examiner in the final Office action has set forth the essentially the same rejections based on prior art as in the non-final Office action. The "material modification" to which petitioner refers is merely examiner's response to arguments set forth in patent owner's response filed on January 6, 2009. To emphasize, the examiner was addressing arguments made by the patent owner in the final Office action and did not modify or alter the grounds of rejection.[6] Therefore, it can be seen that the affidavit filed on

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[4]On December 7, 2009, the Office mailed a decision denying the November 24, 2009 petition under 37 CFR 1.181. On February 5, 2010, the Office mailed a decision denying the January 8, 2010 petition under 37 CFR 1.181(a)(3) requesting review of the December 7, 2009 Office decision.

[5] Renewed petition age page 3.

[6] It is noted that in the March 10, 2009 final Office action at page 5, the examiner relied on the secondary reference to Anderson for the teaching of making the implant of Nabai radiodense. There is no mention in any of the rejections set forth in the final Office action that the use of IL-2, a therapeutic agent disclosed in the Anderson reference, is optional. In the November 6, 2008 second non-final Office action at page 4, the examiner stated in the obviousness rejection that "[w]hile Nabai does not explicitly teach performing the biopsy on the breast, it would have been obvious to one of ordinary skill that skin biopsy could be performed on the breast skin of the patient. Alternatively, it would have been obvious to one of ordinary skill in the art that the teachings of Nabai could be extended to breast biopsy in light of the teachings of Anderson and the Lee Article, discussed below, which teach a similar implant used in different areas of the body" The same obviousness rejection containing this statement was repeated verbatim in the final Office action. It is evident from this obviousness rejection that the examiner clearly maintained the same claim construction for the term "breast biopsy" in the final Office action as in the second non-final Office action. See also the petition decisions of December 7, 2009 and February 5, 2010.

July 24, 2009, addresses issues first raised in the non-final action that was mailed on November 6, 2008. Petitioner presents no persuasive reasoning why the need for the affidavit addressing issues raised in the November 6, 2008 non-final action could not have been anticipated earlier.

In this case, patent owner failed to submit evidence at the earliest possible point, despite the clear notice in MPEP 2272 that evidence submissions should be filed before final action and despite the statutory mandate for special dispatch in reexamination. As such, the petition fails for want of a persuasive explanation of why the patent owner did not consider and explore the need for the new evidence earlier in the prosecution of the present reexamination proceeding, which would have led to an earlier submission of the evidence to advance the need for special dispatch in reexamination.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above, the petition under 37 CFR 1.182 is **dismissed**.

CONCLUSION

1. The patent owner petition under 37 CFR 1.182 for continued reexamination filed on February 24, 2010 is **dismissed**.

2 Jurisdiction for the instant *ex parte* reexamination proceeding is being transferred to the Central Reexamination Unit for consideration of the correct appeal brief filed on February 1, 2010.

3. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

Kenpet8
4-29-10

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JAN 23 2009

CENTRAL REEXAMINATION UNIT

Anthony J Canning (For Patent Owner)
NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON DC 20004-2128

DECISION DISMISSING PETITION UNDER 37 CFR § 1.59 (b) TO EXPUNGE INFORMATION

In re: Miyazaki *et alia*
Ex Parte Reexamination Proceeding
Control Number 90/008,825
Deposited on: 14 November 2007
For U.S. Patent No. 7,061,016

This is a decision on the 25 August 2008, Patent Owner requested petition titled "Petition to Expunge Material Under 37 CFR § 1.59(b)."

This petition considers under 37 CFR 1.59 (b) a request to expunge materials submitted by the Patent Owner with the Information Disclosure Statement (IDS) filed 5 August 2008.

The petition was filed in a timely manner with the authorization for the appropriate fee from a deposit account pursuant to 37 CFR § 1.17 (g).

The petition is hereby dismissed as moot.

REVIEW OF RELEVENT FACTS

1. US Patent No 7,061,016 was granted on 13 June 2006.

2. On 14 November 2007 the patent owner requested *ex parte* reexamination of US Patent No. 7,061,016 which is identified under control no. 90/008,825

3. The Order was granted for reexamination on 19 December 2007.

4. An Information Disclosure Statement was filed on 5 August 2008.

5. The patent owner filed the instant Petition to Expunge on 25 August 2008

CITATION OF APPROPRIATE PROCEDURE

37 CFR § 1.59 (in-part)
Expungement of information or copy of papers in application file.
(a)
(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.
(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

DECISION

The petitioner requests that the documents submitted on 5 August 2008 be expunged from the *ex parte* proceeding. The petition authorizes the appropriate fee pursuant to 37 CFR § 1.59(b) and § 1.17 (g). It is noted that the examiner in charge of the proceeding considered the Information Disclosure Statement as indicated in the initialed and signed PTO form 1449 dated 19 September 2008. Since the Information Disclosure Statement has already been considered by the examiner in charge of the proceeding, the petition to expunge is considered to be moot.

CONCLUSION

1. The petition to expunge documents submitted by the patent owner on 5 August 2008 is hereby **dismissed as moot**.

2. The proceeding is hereby returned to the examiner in charge of the file for further action.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

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

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

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

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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,828	08/31/2007	6115074	4671-4672-001	2830

20872 7590 09/12/2008

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2008

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.
90/010,075	12/27/2007	6115074	230.1-US-RX	1819

20872 7590 09/12/2008

MORRISON & FOERSTER LLP
425 MARKET STREET
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2008

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SEP 12 2008

CENTRAL REEXAMINATION UNIT

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San Francisco, CA 94105-2482

Hovey Williams LLP (For Third Party Requester)
10801 Mastin Blvd., Suite 1000
Overland Park, KS 66210

Gates & Cooper LLP (For Third Party Requester)
Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045

In re Willis *et alia*
Reexamination Proceeding
Control No. 90/008,828
Request Deposited: August 31, 2007
For: U.S. Patent No. 6,115,074

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

In re Willis *et alia*
Reexamination Proceeding
Control No. 90/010,075
Request Deposited: December 7, 2007
For: U.S. Patent No. 6,115,074

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. 6,115,074 (hereinafter, the '074 patent), issued to Ozkan *et alia*, on September 5, 2000.

2. On August 31, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '074 patent. The reexamination proceeding was assigned Control No. 90/008,828 (hereinafter, the '8828 proceeding).

3. The Reexamination Order was granted in the '8828 proceeding on November 1, 2007.

4. There are currently no amendments in the '8828 proceeding.

5. On December 7, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '074 patent. The reexamination proceeding was assigned Control No. 90/010,075 (hereinafter, the '10075 proceeding).

6. The Reexamination Order was granted in the '10075 proceeding on March 14, 2008.

7. There are currently no amendments in the '10075 proceeding.

8. The '8828 and '10075 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 '8828 and the '10075 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. 90/008,828 and 90/010,075 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

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,828	08/31/2007	6115074	4671-4672-001	2830

20872 7590 08/12/2009

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/12/2009

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Jennifer C. Bailey
HOVEY WILLIAMS, LLP
10801 Mastin Blvd., Suite 1000
Overland Park, KS 66210

Date: MAILED

AUG 12 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008828 + 90/010075
PATENT NO. : 6115074
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Robert A Saltzberg
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO CA 94105-2482

(For Patent Owner

MAILED

AUG 12 2009

CENTRAL REEXAMINATION UNIT

HOVEY WILLIAMS LLP
10801 MASTIN BLVD., SUITE 1000
OVERLAND PARK, KS 66210

(For Third Party Requester)

Jason Feldmar
GATES & COOPER LLP
HOWARD HUGHES CENTER
6701 CENTER DRIVE WEST,
SUITE 1050
LOS ANGELES, CA 90045

(For Third Party Requester)

In re: Ozkan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,828
Deposited: 31 August 2007
For: US Patent No. 6,115,074

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

In re: Ozkan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,075
Deposited: 27 December 2007
For: US Patent No. 6,115,074

This is a decision on the 04 August 2009, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the Final Office action mailed 11 March 2009, be extended by one month. The petition was timely filed with the petition fee.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 11 March 2009, which set a two (2) months date for filing a response thereto. The Office action is a Final Office action. The patent owner submitted an after Final amendment on 11 May 2009. The advisory action mailed 20 and 22 July 2009 extended the response period to five (5) months. The patent owner's petition for extension of time was timely filed on 04 August 2009, together with the proper fee as required by 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. ...
>
> *Ex parte* prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement (by statute (35 U.S.C. 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR § 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. (emphasis added)...

MPEP § 2265 Extensions of time (in-part)

> I. FINAL ACTION — TIME FOR RESPONSE
>
> ...
>
> The filing of a timely first response to a final rejection having a shortened statutory period for response is construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted, but in no case may the period for response exceed 6 months from the date of the final action. Even if previous extensions have been granted, the primary examiner is authorized to grant the request for extension of time which is implicit in the filing of a timely first response to a final rejection. It should be noted that the filing of any timely first response to a final rejection will be construed as including a request to extend the shortened statutory period for an additional month, even an informal response and even a response that is not signed. (emphasis added) ...

ANALYSIS AND FINDINGS

The patent owner's petition to extend the period for response by one (1) month thereby further extending the period for response to six (6) months is before the Director of the CRU. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Final Office action was mailed 11 March 2009. The patent owner submitted a timely filed after Final amendment on 11 May 2009. The examiner's advisory action extended the period for response to five (5) months. The patent owner submitted a timely filed a petition for extension of time on 04 August 2009 with the appropriate fee.

The examiner once extended the period for response. MPEP § 2265 states that second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. The petitioner stated that "The attorneys have diligently attempted to prosecute this application." MPEP § 2265 requires:

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

The petition seeks extension of time awaiting a petition decision for a concurrently filed petition seeking entry of a declaration filed under 37 CFR § 1.132. The instant petition argues the merits of the petition filed under 37 CFR 1.181 as support for why the period for response should be extended by one (1) month thereby further extending the period for response to six (6) months.

"Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations." There is no indication as to how this situation is extraordinary.

The petition request to extend the response time further by one (1) month extending the time to six (6) months is hereby dismissed.

CONCLUSION

1. The patent owner's petition for further extending the time in which to file a response to the Final Office action dated 11 March 2009 is hereby **dismissed**

2. The Patent Owner's response was due **11 August 2009.**

3. The proceeding is hereby returned to the examiner for further handling.

4. Correspondence to the Office should be addressed as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,828	08/31/2007	6115074	4671-4672-001	2830

20872 7590 08/13/2009

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

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ART UNIT	PAPER NUMBER

DATE MAILED: 08/13/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,828	08/31/2007	6115074	4671-4672-001	2830

20872 7590 08/13/2009

EXAMINER	

ART UNIT	PAPER NUMBER

Jennifer C. Bailey
Hovey Williams LLP
10801 Mastin Boulevard, Suite 1000
84 Corporate Woods
Overland Park, KS 66210

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 Patent and Trademark Office
P.O. Box 1450
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Robert A Saltzberg
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425 MARKET STREET
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(For Patent Owner

HOVEY WILLIAMS LLP
10801 MASTIN BLVD., SUITE 1000
OVERLAND PARK, KS 66210

(For Third Party Requester)

MAILED

AUG 13 2009

CENTRAL REEXAMINATION UNIT

Jason Feldmar
GATES & COOPER LLP
HOWARD HUGHES CENTER
6701 CENTER DRIVE WEST,
SUITE 1050
LOS ANGELES, CA 90045

(For Third Party Requester)

In re: Ozkan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,828
Deposited: 31 August 2007
For: US Patent No. 6,115,074

DECISION
GRANTING
PETITION FOR ENTRY
OF DECLARATION
37 CFR § 1.181

In re: Ozkan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,075
Deposited: 27 December 2007
For: US Patent No. 6,115,074

This is a decision on the 04 August 2009, "Petition Under 37 § 1.181 Requesting Entry of Declaration After Final Office Action."

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner requests entry of the Bove declaration submitted 11 May 2009 under 37 CFR § 1.132. The petition was filed under 37 CFR § 1.181 for which no fee is required and was properly served on the third party requesters.

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.

ANALYSIS AND FINDINGS

It should be noted that the petitioner is factually incorrect in the statement that the Bove declaration submitted 11 May 2009 under 37 CFR § 1.132 is necessary to address the examiner's new grounds for rejection. Review of the non-final Office action mailed on 19 September 2008 and the final Office action mailed on 11 March indicates that the rejections to claims remain consistent; hence the finality of the Office action was correct and appropriate. Review of the proceeding indicates that the petitioner seeks to further address arguments with respect to the rejections.

However, to clarify the record and enable the patent owner to use the Bove declaration for support in the Appeal, the declaration is entered into the record. The proceeding will be returned to the examiner in charge of the proceeding for possible further consideration. The time for submission of the appeal brief continues to run from the date of the notice of appeal filed on 11 August 2009.

The patent owner's petition for entry of declaration is hereby granted.

CONCLUSION

1. The patent owner's petition for entry of declaration is hereby **granted**.

2. The Bove declaration submitted 11 May 2009 under 37 CFR § 1.132 is hereby entered.

3. The Patent Owner's appeal brief is due according to the requirements of MPEP § 2273

4. Correspondence to the Office should be addressed as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
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Alexandria, VA 22313-1450

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

By Hand: Customer Service Window
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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.
90/008,830	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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Alexandria, Virginia 22313-1450
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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

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WASHINGTON, DC 20006-1021

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,428	01/16/2007	6054270		7156

513 7590 04/29/2008

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
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WASHINGTON, DC 20006-1021

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ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2008

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APR 29 2008

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

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.
90/008,839	09/10/2007	6158924	F094 7000	8923

24504 7590 04/16/2008

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
600 GALLERIA PARKWAY, S.E.
STE 1500
ATLANTA, GA 30339-5994

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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United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

D. Scott Sudderth

Ian A. Calvert

Womble Carlyle Sandridge & Rice, PLLC

P. O. Box 7037

Atlanta, GA 30357-0037

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,839*.

PATENT NO. *6158924*.

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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(For Patent Owner)

Scott A. Horstmeyer
Thomas Kayden Horstmeyer & Risley LLP
600 Galleria Parkway, NW
Suite 1500
Atlanta, GA 30339

(For Requester)

D. Scott Sudderth
Ian A. Calvert.
Womble Carlyle Sandridge & Rice, PLLC
P. O. Box 7037
Atlanta, GA 30357-0037

In re Athens et al.	:
Reexamination Proceeding	: DECISION ON
Control No. 90/008,839	: PETITION UNDER
Filed: September 10, 2007	: 37 CFR 1.181
For: U.S. Patent No. 6,158,924	:

The paper filed by requester on December 3, 2007, entitled "Petition Under 37 CFR 1.181 and 1.515(c)," (hereinafter Petition) is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated November 2, 2007.

The Petition is GRANTED.

REVIEW OF FACTS

1. U.S. Patent No. 6,158,924 (hereinafter, the '924 patent) issued on December 12, 2000.

2. On October 8, 2004, a third party requester, Fruits and Associates, Inc., deposited a request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned Control No. 90/008,839 (hereinafter, the '839 proceeding).

3. Reexamination was requested for claims 1-4 of the '924 patent.

4. A Notice of Reexamination Request Filing Date was issued on October 2, 2007.

5. An order denying the request for reexamination for claims 1-4 was issued on November 2, 2007.

6. On December 3, 2007[1], the third party requester filed the Petition under 37 CFR §§ 1.515(c) and 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges several grounds for which petitioner feels the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the following three main arguments:

1. The examiner failed to 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 found that the EPA publication, Grant patent, and Hajali patent was cumulative of well known art, such as U.S. Patent No. 6,280,625 to Jackson, U.S. Patent No. 3,679,264 to Van Huisen and U.S. Patent No. 6,146,104 to Mastroianni in deciding whether to grant the order for reexamination.
3. The examiner incorrectly found that the request did not set forth a new light to the Land patent, which was cited and applied in the prior prosecution of the '924 patent, and that the Pezullo publication and Reijonen patent are merely cumulative to the Land patent in deciding whether to grant the order for reexamination.

[1] The request was timely because December 2, 2007, was a Sunday.

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-4 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-4 of the '924 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC § 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

III. Summary of the prior prosecution:

The '924 patent contains claims 1-4.

In a first Office action, dated November 9, 1999, the examiner rejected patent claim 27, which eventually became claim 1 of the '924 patent, under 35 U.S.C. 102 based on the Land patent. The applicant amended claim 27 to include the limitation of the fluid introducing means, and argued that Land fails to teach the fluid introducing means. The examiner indicated claim 27 as allowable because the Land reference does not disclose a well with a casing and a drop tube. See pages 2-5 of the Petition for a more detailed description.

IV. Analysis of the Request for Reexamination

The Request set forth the following substantial new questions of patentability:

(1) Claims 1 and 3 are unpatentable under 35 U.S.C. §102(b) and/or §103(a) over EPA, taken alone or in view of Pezzullo.

(2) Claims 1 to 4 are unpatentable under 35 U.S.C. §103(a) over Land in view of Grant or EPA, and optionally further in view of Reijonen.

(3) Claims 1 to 4 are unpatentable under 35 U.S.C. §103(a) over Land in view of Hajali, and optionally further in view of Reijonen.

(4) Claim 2 is unpatentable under 35 U.S.C. § 103(a) over EPA in view of Pezzullo.

(5) Claim 4 is unpatentable under 35 U.S.C. §103(a) over EPA alone, or in view of Pezzullo, further in view of Hajali.

The Request was denied on November 2, 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 the EPA publication, Grant patent, and Hajali patent, the examiner determined that these patents and publication were cumulative of well known art, such as U.S. Patent No. 6,280,625 to Jackson, U.S. Patent No. 3,679,264 to Van Huisen and U.S. Patent No. 6,146,104 to Mastroianni, and therefore, a reasonable examiner would not consider these teachings to be important in determining patentability of the claims. With regard to the Land patent, Pezullo publication and Reijonen patent, the examiner found that the request did not set forth a new light to the previously considered Land patent and that the Pezullo patent and Reijonen patent are merely cumulative to the Land patent, and therefore, the references 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 the EPA publication, the Pezullo publication, and the patents to Grant, Hajali, Land, and Reijonon raise substantial new questions of patentability. The Director has reviewed the entire request, and has determined that there is at least one substantial new question of patentability presented by the teachings of EPA publication for reasons set forth below. Accordingly, the denial of the request for reexamination mailed on November 2, 2007 is hereby withdrawn. The Grant, Hajali, Land, and Reijonen patents and the Pezzullo publication will not be addressed in this decision because it is not necessary since the order denying reexamination is withdrawn. As mentioned above, this decision will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-4 of the '924 patent

EPA publication: According to the request and Petition, the EPA publication raises a substantial new question of patentability regarding claims 1-4 of the '924 patent (see pages 4, 5, 7, 8, and 11-15 of the request, and pages 7-10 of the Petition).

The EPA publication was cited in the prior prosecution but was not applied or specifically mentioned. As explained on pages 4, 5, 7, 8, and 11-15 of the request, the EPA publication teaches, among other things, structure corresponding to the "fluid introducing means" of claim 1, including an extraction tube and well casing for introducing air into the space there between (see Exhibit XI-13 and pages XI-25 to XI-26). Since this teaching is directly related to subject matter considered as the basis for allowability of the claims in the application that issued as the '924 patent, a reasonable examiner would consider evaluation of the EPA publication as important in determining the patentability of claims 1-4. Furthermore, as pointed out by the petitioner on pages 8-9 of the petition, the patents to Jackson, Van Huisen, and Mastroianni were not of record in the prior prosecution of the '924 patent, and there is no indication that the examiner considered these patents in determining the patentability of the claims. Therefore, a determination that the teachings of the EPA publication is cumulative to the teachings of the Jackson, Van Huisen, and Mastroianni patents is not relevant in determining whether a substantial new question of patentability is set forth in the request. As such, it is agreed that the EPA publication raises a substantial new question of patentability with respect to claims 1-4 of the '924 patent.

Because it is agreed that the EPA publication raises a SNQ with respect to claims 1-4 of the '924 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision as it not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination.

CONCLUSION

1. Given the facts involved in this proceeding, the PETITION is GRANTED.

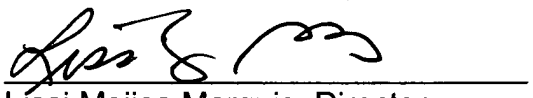
2. Accordingly, the request for *ex parte* reexamination of claims 1-4 of the '924 patent is GRANTED.

3. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Lynne Browne, Acting Supervisory Patent Examiner, at (571) 272-3670, or in their absence to the undersigned at (571) 272-1596.



Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,843	10/17/2007	6,918,532	X000000010/MP	1669

881 7590 05/12/2008

STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Stites & Harbison PLLC
1199 North Fairfax Street
Suite 900
Alexandria, VA 22314

(For Patent Owner)

MAILED

MAY 12 2008

CENTRAL REEXAMINATION UNIT

D. J. Bucklin
Volpe and Koenig, P. C.
United Plaza, Suite 1600
30 South 17th Street
Philadelphia, PA 19103

(For Requester)

In re: Sierra-Gomez *et alia*
Reexamination Proceeding
Control No. 90/008,843
Corrected Request Deposited: October 17, 2007
For: U.S. Patent No. 6,918,532

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

This is a decision on the May 9, 2008, "Expedited Petition Under 37 C.F.R. 1.550(c) For Extension Of Time To Respond To Office Action in *Ex Parte* Reexamination" requesting that the time to submit a Patent Owner response be extended an additional two months.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,918,532 (hereinafter, the '532 patent), issued to Sierra-Gomez *et alia*, on June 19, 2005.

2. On September 10, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '532 patent. The reexamination proceeding was assigned Control No. 90/008,843 (hereinafter, the '8843 proceeding). The original request was held non-compliant and a corrected request was deposited on October 17, 2007.

3. The reexamination order was granted in the '8843 proceeding on December 14, 2007.

4. A non-final rejection was mailed on March 13, 2008 setting a two-month shortened statutory period (SSP).

5. A petition for extension of time was filed on May 9, 2008.

DECISION

Initially, it is noted that a "Power of Attorney by Assignee" was filed on May 1, 2008. MPEP 324 states, in part, "[a]n officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization.... A person having a title (administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee." The submission of May 1, 2008 is signed by Chief Patent Counsel, who does not appear to be an officer with presumptive authority to sign. There is also no other indication in the record that the Chief Patent Counsel has authority to sign on behalf of assignee. Therefore, the power of attorney and correspondence address of record remains the same. The present decision will also be cc'ed to the address associated with Customer Number 48940.

The Patent Owner requests an extension of time in which to file a Patent Owner response to the non-final office action mailed March 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 May 9, 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 that "the Patent Owner first sought to retain other counsel based upon recommendations. The other counsel was unable to represent the Patent Owner due to issues relating to conflicts of interest. Unfortunately, it took several weeks of ongoing dialog to fully explore and attempt to resolve the conflicts of interest issues that ultimately precluded representation by the other counsel. The Patent Owner then retained the undersigned counsel for this proceeding." Reference is made to the petition for details of this and other issues.

Analysis and Findings

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

Accordingly, the time for filing the response is extended for one month and therefor the response is due on or before June 13, 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 in part. The period during which Patent Owner may file a response has been extended to June 13, 2008.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

Cc: Fitch Even Tabin & Flannery
120 S. LaSalle Street
Suite 1600
Chicago, IL 60603-3406

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CENTRAL REEXAMINATION UNIT

Mailed :

DDJ

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.: 90/008,429
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 all files and will be physically entered in each reexamination file. All papers filed by the patent owner must

consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/008,429 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.

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.
90/008,845	09/06/2007	5712327		9761

26161 7590 08/27/2008

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/27/2008

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

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Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GARDMER GROFF GREENWALD & VILLANUEV PC
2018 POWERS FERRY ROAD
SUITE 800
ATLANTA, GA 30339

Date:
MAILED

AUG 27 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008845
PATENT NO. : 5712327
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

Fish & Richardson PC (For Patent Owner)
P.O. Box 1022
Minneapolis, MN 55440-1022

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AUG 27 2008

CENTRAL REEXAMINATION UNIT

Gardner Groff Greenwald & Villanueva, P.C. (For Requester)
2018 Powers Ferry Road
Suite 800
Atlanta, GA 30339

Hershkovitz & Associates, LLC (Courtesy Copy)
2845 Duke Street
Alexandria, VA 22314

In re Chang et al :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,845 : **DISMISSING**
Filed: September 6, 2007 : **PETITION**
For: U.S. Patent No. 5,712,327 :

This is a decision on the June 30, 2008 patent owner petition entitled "Petition to Expunge," which is taken as a petition under 37 CFR 1.182 to seal certain documents in the Office record of this reexamination proceeding (hereinafter, "the June 30, 2008 patent owner petition to seal").

The June 30, 2008 patent owner petition to seal and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee required by 37 CFR 1.182 and 37 CFR 1.17(f) for the June 30, 2008 patent owner petition to seal will be charged to deposit account no. 50-2929, as authorized by the patent owner in the last line of page 2 of the instant petition.

SUMMARY

The June 30, 2008 patent owner petition under 37 CFR 1.182 to seal certain documents in the Office record is **dismissed**.

REVIEW OF FACTS

- On January 27, 1998, U.S. Patent No. 5,712,327 (hereinafter, "the '327 patent") issued to Chang et al.

- On September 6, 2007, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,845 (hereinafter, "the '8845 proceeding").

- On November 30, 2007, an order granting the *ex parte* reexamination request was mailed, providing the patent owner with two months from the mail date of the order to file a

patent owner's statement. Office records, however, fail to reveal the receipt of a patent owner's statement in the '8845 proceeding.

- On March 27, 2008, the patent owner filed a list of citations under 37 CFR 1.555, entitled "information disclosure statement."

- On June 30, 2008, the instant petition entitled "Petition to Expunge", which is taken as a petition under 37 CFR 1.182 to seal certain documents in the Office record (the June 30, 2008 patent owner petition to seal), and a petition under 37 CFR 1.181 to vacate the order granting reexamination in the '8845 proceeding, accompanied by Attachments A and B, were received.

- On July 11, 2008, the third party requester filed a document entitled "information disclosure statement", accompanied by copies of documents submitted in litigation involving the '327 patent, pursuant to MPEP 2282 (hereinafter, "the July 11, 2008 requester litigation papers").

- On July 24, 2008, the patent owner filed a second petition entitled "Petition to Expunge."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.59(b) provides:

> An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

37 CFR 1.182 provides:

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

MPEP 724.04(c) provides, in pertinent part (emphasis added):

> (B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is material to patentability.
>
> (C) If any portion or all of the submitted information is found to be material to patentability, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. Where a submission containing protected material is found to be material to patentability, it still may be possible to redact the submission to eliminate the protected material while retaining the important material (e.g., where a confidential identifying number, such as a serial number or social security number, is included, which is not needed for the context of the submission). If so, the redacted

version may be submitted to the Office along with a petition under 37 CFR 1.182 requesting that the unredacted version be sealed and be replaced with the redacted version.

(D) If all of the submitted information is found not to be material to patentability, the petition to expunge will be granted and the information expunged. If a portion of the submitted information is found not to be material to patentability, and a portion is found to be material to patentability, the petition to expunge will be dismissed, and patent owner (or the requester, in limited instances where appropriate) provided with an opportunity to separate the material and non-material information, such that the non-material information can be expunged. See item (C) above.

(E) If a petition to expunge is not filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d). **In the event materials have already been made of record by a party, and it is subsequently determined that the materials are protected, the proper petition to submit would be a petition to seal the protected material under 37 CFR 1.182, with the requisite fee.**

DECISION

The June 30, 2008 patent owner petition to expunge, which is taken as a petition under 37 CFR 1.182 to seal pursuant to MPEP 724.04(c)(E), appears to be incomplete. Specifically, the patent owner refers to Attachments C and D in the first paragraph of page 2, and quotes from Attachment D in the second paragraph of page 2 of the petition. Office records, however, fail to reveal that Attachments C and D have been received by the Office. Furthermore, the transmittal letter that accompanied the documents filed on June 30, 2008, lists Attachments A and B, but does not list Attachments C and D. Attachments C and D, therefore, do not appear to have been submitted with the instant petition.

In addition, the patent owner refers to documents that do not appear to be sufficiently identified. For example, the patent owner refers to Tabs D and G of the request for reexamination in the '8845 proceeding on page 2 of the petition and in Attachment A; however, Office records do not reveal any tabs, including Tabs D and G. The patent owner refers to specified pages of "Dr. Chang's deposition testimony" on page 2, as well as Attachment A, of the petition, but does not specify the date of the deposition (there may have been more than one deposition), and does not specify, in Attachment A, the litigation in which the document was filed. Similarly, the patent owner refers to a document entitled "Plaintiff's Reply Claim Construction Brief" on page 2 of the petition, as well as Attachment A; however, the patent owner does not provide the date of the document.

Furthermore, the patent owner states that the requester submitted documents in the '8845 proceeding in violation of a protective order issued by the federal district court in *Rembrandt Vision Technologies LP v. Bausch & Lomb, Inc. et al*, No. 2:05-CV-00491-TJW, and has provided a copy of the protective order. The patent owner, however, fails to show **with specificity** how the documents that are requested to be sealed by the instant petition are subject to the protective order, nor does the patent owner point to any portion of the protective order that would **specifically show** that the disclosure of these documents would violate the protective order. Bald statements such as, for example, that the documents include confidential information, that the pages (of Dr. Chang's deposition transcript) were protected from disclosure

under the protective order, or that the document (Plaintiff's Reply Claim Construction Brief) was filed under seal in the litigation, do not provide **specific evidence** that the documents that are requested to be sealed by the instant petition are subject to the provisions of the protective order.

For the reasons given above, the June 30, 2008 patent owner petition under 37 CFR 1.182 to seal certain documents from the Office record of the '8845 proceeding is **dismissed**.

Any renewed petition to seal filed in response to this decision must be accompanied, where appropriate, by a copy of the documents requested to be sealed, from which portions of those documents, which the patent owner has specifically shown to be covered by the protective order, **have been redacted**. For example, the patent owner points to specified pages of "Dr. Chang's deposition testimony," which the patent owner requests to be sealed. Any renewed petition to seal in response to this decision must be accompanied by a copy of Dr. Chang's deposition testimony from which the specific pages, which are requested to be sealed and which will be specifically shown to be subject to the protective order, have been redacted. If the renewed petition to seal is granted, the unredacted documents that are requested to be sealed will be provisionally sealed by removing the unredacted documents from public view in the Office's Image File Wrapper (IFW) database. The redacted versions of these documents, which accompanied any such grantable renewed petition to seal, would replace the unredacted versions of the provisionally sealed documents in the public file.

Pursuant to MPEP 724.04(c), any information shown to be protected will be reviewed by the examiner, or other appropriate Office official who is responsible for considering the information, at least prior to the mailing of the Notice of Intent to Issue a Reexamination Certificate (NIRC). The examiner or other appropriate Office official will make a determination as to whether or not any portion or all of the submitted information is material to patentability.

The Office will not expunge information found to be material to patentability, pursuant to MPEP 724.04(c). If the examiner, or other appropriate Office official, determines that all of the submitted information is not material to patentability, a petition to expunge this information may be filed, after this determination is made, to have the information expunged. If the examiner, or other appropriate Office official, determines that a portion of the submitted information is **not** material to patentability, and that the remaining portion **is** material to patentability, the patent owner may file a petition to expunge, after this determination is made, and separate the material and non-material information such that the non-material information can be expunged. Any documents at issue that have already been scanned into the Office's Image File Wrapper (IFW) database will be expunged by closing the documents in the public file, such that the documents will not be part of the official file and will not be available to the public. If all of the submitted information is found to be material to patentability, any petition to expunge this information will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.

The June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate the order granting reexamination in the '8845 proceeding, and the July 24, 2008 patent owner petition entitled "Petition to Expunge," will each be addressed under separate cover.

A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. Abraham Hershkovitz, Hershkovitz & Associates, LLC, 2845 Duke Street, Alexandria, VA 22314. In the absence of a change of power of attorney listing Mr. Hershkovitz 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

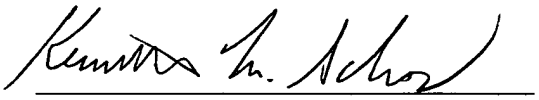
- The June 30, 2008 patent owner petition entitled "Petition to Expunge," which is taken as a petition under 37 CFR 1.182 to seal certain documents from the Office record, is **dismissed**.

- Any response by the patent owner to this decision must be mailed within two months from the mail date of this decision. This period for response is not extendible.

- Any renewed petition to seal filed in response to this decision must be accompanied by, where appropriate, a redacted version of the documents requested to be sealed pursuant to this decision.

- Jurisdiction over the '8845 proceeding is being retained by the Office of Patent Legal Administration to await any response to this decision, or the expiration of time to respond to this decision.

Any inquiry concerning this communication 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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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,845	09/06/2007	5712327		9761

26161 7590 08/28/2008

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/28/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GARDMER GROFF GREENWALD & VILLANUEV PC
2018 POWERS FERRY ROAD
SUITE 800
ATLANTA, GA 30339

Date:
MAILED

AUG 28 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008845
PATENT NO. : 5712327
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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AUG 28 2008

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In re Chang et al :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,845 : **GRANTING**
Filed: September 6, 2007 : **PETITION**
For: U.S. Patent No. 5,712,327 :

This is a decision on the July 24, 2008 patent owner petition under 37 CFR 1.182 entitled "Second Petition to Expunge," requesting the Office to expunge litigation documents filed by the third party requester on July 11, 2008, as being improper (hereinafter, "the July 24, 2008 patent owner petition to expunge"). Since the July 24, 2008 patent owner petition to expunge does not request the Office to expunge information submitted under seal pursuant to MPEP 724.02, the provisions of 37 CFR 1.59(b) do not apply.

The July 24, 2008 patent owner petition to expunge and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee required by 37 CFR 1.182 and 37 CFR 1.17(f) for the July 24, 2008 patent owner petition to expunge will be charged to deposit account no. 50-2929, as authorized by the patent owner in the last line of page 2 of the instant petition.

SUMMARY

The July 24, 2008 patent owner petition under 37 CFR 1.182 to expunge litigation documents filed by the third party requester on July 11, 2008 is **granted**.

REVIEW OF FACTS

- On January 27, 1998, U.S. Patent No. 5,712,327 (hereinafter, "the '327 patent") issued to Chang et al.

- On September 6, 2007, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,845 (hereinafter, "the '8845 proceeding").

- On November 30, 2007, an order granting the *ex parte* reexamination request was mailed, providing the patent owner with two months from the mail date of the order to file a patent owner's statement. Office records, however, fail to reveal the receipt of a patent owner's statement in the '8845 proceeding.

- On March 27, 2008, the patent owner filed a list of citations under 37 CFR 1.555, entitled "information disclosure statement."

- On June 30, 2008, the instant petition entitled "Petition to Expunge", which is taken as a petition under 37 CFR 1.182 to seal certain documents in the Office record (the June 30, 2008 patent owner petition to seal), and a petition under 37 CFR 1.181 to vacate the order granting reexamination in the '8845 proceeding, accompanied by Attachments A and B, were received.

- On July 11, 2008, the third party requester filed a document entitled "information disclosure statement", accompanied by copies of documents submitted in litigation involving the '327 patent, pursuant to MPEP 2282 (hereinafter, "the July 11, 2008 requester litigation papers").

- On July 24, 2008, the patent owner filed a second petition entitled "Second Petition to Expunge," which is taken as a petition under 37 CFR 1.182 to seal the July 11, 2008 requester litigation papers.

- On August 27, 2008, a decision was mailed, dismissing the June 30, 2008 patent owner petition to seal.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.59(b) provides:

> An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

37 CFR 1.182 provides:

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

37 CFR 1.550(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 1.552(a) provides (emphasis added):

Claims in an *ex parte* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

MPEP 724.04(c) provides, in pertinent part (emphasis added):

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is material to patentability.

(C) If any portion or all of the submitted information is found to be material to patentability, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. Where a submission containing protected material is found to be material to patentability, it still may be possible to redact the submission to eliminate the protected material while retaining the important material (e.g., where a confidential identifying number, such as a serial number or social security number, is included, which is not needed for the context of the submission). If so, the redacted version may be submitted to the Office along with a petition under 37 CFR 1.182 requesting that the unredacted version be sealed and be replaced with the redacted version.

(D) If all of the submitted information is found not to be material to patentability, the petition to expunge will be granted and the information expunged. If a portion of the submitted information is found not to be material to patentability, and a portion is found to be material to patentability, the petition to expunge will be dismissed, and patent owner (or the requester, in limited instances where appropriate) provided with an opportunity to separate the material and non-material information, such that the non-material information can be expunged. See item (C) above.

(E) If a petition to expunge is not filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d). **In the event materials have already been made of record by a party, and it is subsequently determined that the materials are protected, the proper petition to submit would be a petition to seal the protected material under 37 CFR 1.182, with the requisite fee.**

MPEP 2251 provides, in pertinent part:

The third party requester is not permitted to file any further papers after his or her reply to the patent owner's statement. Any further papers will not be considered and will be returned to the requester. The patent owner cannot file papers on behalf of the third party requester and thereby circumvent the rules.

MPEP 2258 provides, in pertinent part (emphasis added):

> **Issues relating to 35 U.S.C. 112 are addressed only with respect to new claims or amendatory subject matter in the specification, claims or drawings.**
>
> *
> *
>
> **Rejections will not be based on matters other than patents or printed publications, such as public use or sale, inventorship, 35 U.S.C. 101, conduct issues,** etc. In this regard, see *In re Lanham*, 1 USPQ2d 1877 (Comm'r Pat. 1986), and *Stewart Systems v. Comm 'r of Patents and Trademarks*, 1 USPQ2d 1879 (E.D. Va. 1986). A rejection on **prior public use or sale, insufficiency of disclosure**, etc., cannot be made even if it relies on a prior art patent or printed publication. Prior art patents or printed publications must be applied under an appropriate portion of 35 U.S.C. 102 and/or 103 when making a rejection.

MPEP 2267 provides, in pertinent part:

> Where an inappropriate (unauthorized, improper) paper has already been scanned into the Image File rapper (IFW) of the reexamination proceeding before discovery of the inappropriate nature of the paper, the paper cannot be physically returned to the party that submitted it. Instead, the paper will be "returned" by expunging it, i.e., by marking the paper as "non-public" and "closed" so that it does not appear in the active IFW record with the other active papers that comprise the public record of the reexamination proceeding.

MPEP 2282 provides, in pertinent part (emphasis added):

> Ordinarily, no submissions of any kind by third parties filed after the date of the order are entered into the reexamination or patent file while the reexamination proceeding is pending. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. **Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. Further, papers filed in the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments, such as a memorandum in support of summary judgment. If the argument has an entry right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right.** It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. **Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office. It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers.** Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information. Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office. It is to be understood that highlighting of certain text by underlining, fluorescent marker, etc., goes beyond bare notice of the prior or concurrent proceedings.

DECISION

The patent owner urges that the July 11, 2008 requester litigation papers, including a trial transcript of an inequitable conduct hearing, and a trial transcript of testimony by inventor Chang, be expunged from the record of the '8845 reexamination proceeding, as being improperly submitted.

Pursuant to MPEP 2282, the Office permits the filing, at any time by any party, of 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. **However, litigation papers containing issues that are not relevant to the reexamination proceeding, such as, for example, inequitable conduct, enablement of the original patent claims, and non-merit decisions involving sanctions, are improper, will not be entered, and will be expunged from the file.**

The July 11, 2008 requester litigation papers[1] consist of three documents: 1) a transcript of a March 27, 2008 inequitable conduct hearing, 2) a transcript of the January 31, 2008 trial testimony of inventor Sing-Hsiung Chang, and 3) a document entitled "Information Disclosure Statement" listing documents 1) and 2). These documents include issues that are not within the scope of reexamination.

Pursuant to MPEP 2258, issues that are not within the scope of reexamination include conduct issues (such as inequitable conduct), insufficiency of disclosure, public use or sale, and issues regarding 35 U.S.C. 101. Issues regarding 35 U.S.C. 112 with respect to the **original** disclosure, including the **original** claims, of the patent under reexamination are also **not** within the scope of reexamination.

The transcript of the March 27, 2008 inequitable conduct hearing is clearly drawn to issues of inequitable conduct, which is not within the scope of reexamination. The transcript of the January 31, 2008 trial testimony of inventor Sing-Hsiung Chang also includes inequitable conduct issues (see, for example, pages 83-84 and 142), and in addition, appears to include issues relating to 35 U.S.C. 112 regarding the enablement of the original claims of the '327 patent (see generally, for example, pages 66-79[2]), which are also not within the scope of reexamination.

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[1] The July 11, 2008 requester litigation papers are:

1) the 96-page document listed in document 3) as Rembrandt Vision Technologies L.P. v. CIBA Vision Corp. (E.D. Tex. 2:05- cv-491), Transcript of Trial Proceedings, Inequitable Conduct Hearing (March 27, 2008);

2) the 132-page document listed in document 3) as "Rembrandt Vision Technologies L.P. v. CIBA Vision Corp. (E.D. Tex. 2:05-cv-491), Transcript of Trial Proceedings, Testimony of Inventor Sing-Hsiung Chang (January 31, 2008); **and**

3) the document entitled "Information Disclosure Statement" listing documents 1) and 2).

[2] These page numbers are provided as an example. The entire submission should be reviewed for additional issues that are not within the scope of reexamination.

For the reasons given above, the July 11, 2008 requester litigation papers, which include issues that are not within the scope of reexamination, are improper.

Accordingly, the July 24, 2008 patent owner petition under 37 CFR 1.182 to expunge the July 11, 2008 requester litigation papers is granted. The July 11, 2008 requester litigation papers will be expunged from the official file, and will not be available to the public, by closing these documents in the Office's Image File Wrapper (IFW) system.[3]

The June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate the order granting reexamination in the '8845 proceeding will be addressed under separate cover.

A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. Abraham Hershkovitz, Hershkovitz & Associates, LLC, 2845 Duke Street, Alexandria, VA 22314. In the absence of a change of power of attorney listing Mr. Hershkovitz 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 July 24, 2008 patent owner petition under 37 CFR 1.182, entitled "Second Petition to Expunge," requesting the Office to expunge the July 11, 2008 requester litigation papers as being improper, is **granted**. The July 11, 2008 requester litigation papers will be expunged from the official file, and will not be available to the public, by closing these documents in the Office's Image File Wrapper (IFW) system.

- Jurisdiction over the '8845 proceeding is being retained by the Office of Patent Legal Administration for consideration of the June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate the '8845 reexamination proceeding.

Any inquiry concerning this communication 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

[3] See MPEP 2267.

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OCT 30 2008

CENTRAL REEXAMINATION UNIT

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In re Chang et al :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,845 : **DISMISSING**
Filed: September 6, 2007 : **PETITION**
For: U.S. Patent No. 5,712,327 :

This is a decision on the June 30, 2008 patent owner petition under 37 CFR 1.181 entitled "Petition to Vacate Reexamination Order" ("the June 30, 2008 patent owner petition to vacate"), seeking to invoke the statutory authority of the Director to vacate the order granting *ex parte* reexamination in this proceeding, as being an *ultra vires* action on the part of the Office.

This decision also addresses the October 17, 2008 patent owner request that the Office promptly issue a decision on the June 30, 2008 patent owner petition to vacate ("the October 17, 2008 patent owner request to issue a decision").

The June 30, 2008 patent owner petition to vacate, the October 17, 2008 patent owner request to issue a decision, and the record as a whole are before the Office of Patent Legal Administration for consideration.

SUMMARY

The June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate the reexamination order is **dismissed**.

The October 17, 2008 patent owner request that the Office issue a decision on the June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate is **granted** by the issuance of this decision.

The September 30, 2008 first Office action is **vacated**.

The September 30, 2008 first Office action is **reissued** by the issuance of this decision, as of the mail date of this decision. **The time period for response to the September 30, 2008 first Office action is hereby reset to expire two (2) months from the mail date of this decision.**

BACKGROUND

- On January 27, 1998, U.S. Patent No. 5,712,327 (hereinafter, "the '327 patent") issued to Chang et al.

- On September 6, 2007, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,845 (hereinafter, "the '8845 proceeding").

- On November 30, 2007, an order granting the *ex parte* reexamination request was mailed, providing the patent owner with two months from the mail date of the order to file a patent owner's statement. Office records, however, fail to reveal the receipt of a patent owner's statement in the '8845 proceeding.

- On June 30, 2008, the patent owner filed the present petition under 37 CFR 1.181, entitled "Petition to Vacate Reexamination Order" ("the June 30, 2008 patent owner petition to vacate").

- On September 30, 2008, a first Office action was mailed.

- On October 17, 2008, the patent owner filed a request that the Office promptly issue a decision on the June 30, 2008 patent owner petition to vacate ("the October 17, 2008 patent owner request to issue a decision").

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 303(a) provides:

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

35 U.S.C. 304 provides, in pertinent part:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question.

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;
>
> (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 . . .

*
*

(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.

37 CFR 1.525(a) provides, in pertinent part:

If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for *ex parte* reexamination of the patent for resolution of the question . . .

MPEP 2216 provides, in pertinent part:

Under 35 U.S.C. 304, the Office must determine whether "a substantial new question of patentability" affecting any claim of the patent has been raised. 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on prior patents and printed publications." If such a new question is found, an order for *ex parte* reexamination of the patent is issued . . .

*
*

The legal standard for ordering ex parte reexamination, as set forth in 35 U.S.C. 303(a), requires a substantial new question of patentability . . .

*
*

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination . . .

MPEP 2217, subsection III, provides, in pertinent part:

The consideration under 35 U.S.C. 303 of a request for ex parte reexamination is limited to prior art patents and printed publications. See *Ex parte McGaughey*, 6 USPQ2d 1334, 1337 (Bd. Pat. App. & Inter. 1988). Thus an admission, *per se*, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication . . .

*
*

The admission can reside in the patent file (made of record during the prosecution of the patent application) or may be presented during the pendency of the reexamination proceeding or in litigation. Admissions by the patent owner as to any matter affecting patentability may be utilized to determine the scope and content of the prior art **in conjunction with patents and printed publications** in a prior art rejection, whether such admissions result from patents or printed publications or from some other source. An admission relating to *any* prior art established in the record or in court may be used by the examiner in combination with patents or printed publications in a reexamination proceeding. The admission must stand on its own. Information supplementing or further defining the admission would be improper . . .

MPEP 2242, subsection I, provides, in pertinent part:

> The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.
>
> If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination or pending reexamination of the patent . . .
>
> 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 <u>important</u> in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim . . .

MPEP 2246 provides, in pertinent part (emphasis in original):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where <u>no discretion</u> to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> (A) the reexamination order is not based on prior art patents or printed publications; . . .

DECISION

The patent owner urges that the November 30, 2007 order granting *ex parte* reexamination in the '8845 proceeding is an *ultra vires* action because it not based on patents or printed publications, as required by 35 U.S.C. 303(a). Citing *Ex parte Natale,* 11 USPQ 2d 1222 (1988), the patent owner urges that the November 30, 2007 order is improperly based on alleged statements, characterized by the requester in the request for reexamination as "admissions" by the first-named inventor of the '327 patent, Dr. Sing-Hsiung Chang.

Contrary to patent owner's arguments, however, not all of the substantial new questions of patentability that are determined, in the November 30, 2007 order granting reexamination, to be raised by the request, are based on the alleged "admissions" of Dr. Chang. The patent owner fails to address any of the alternative grounds listed in the November 30, 2007 order granting reexamination, such as Mueller in view of Chen.[1] Note that the alleged "admissions" of Dr. Chang are listed in the order as part of a series of ***alternative*** secondary grounds that may be combined with either Mueller[2] and Chen[3], or Mueller and Merrill[4].

At page 8 of the order, the second substantial new question of patentability is addressed as follows:

> "It is agreed that consideration of Mueller in view of Chen, ***alternatively*** in view of Lima or Peyman or Wingler, in combination with the PO Admission from Chang '327 Patent and Admissions raises a substantial new question of patentability as to claims 1, 2, 6-8, 10, 11, 13, and 14 of the '327 Patent." [Original emphasis deleted; new emphasis added].

At page 9 of the order, the third substantial new question of patentability is addressed as follows:

> "It is agreed that consideration of Mueller in view of Merrill, ***alternatively*** in combination with the Admissions and the PO Admissions from the Chang '327 Patent raises a substantial new question of patentability as to claims 1, 2, 6-8, 10, 11, 13, and 14 of the '327 Patent." [Original emphasis deleted; new emphasis added].

In each instance, the "admission" is identified as an ***alternative*** ground for the substantial new question of patentability. For "Mueller in view of Chen" and "Mueller in view of Merrill", the patent owner simply provides no challenge to the two asserted substantial new questions of patentability. Since there are two substantial new questions of patentability upon which jurisdiction to reexamine is based, the patent owner does not provide a basis for granting the petition, regardless of the arguments made as to the asserted "admissions."

Further review of the November 30, 2007 order granting reexamination reveals that Mueller, alone, raises a substantial new question of patentability as to the claims of the '327 patent identified in the order. At page 9 of the order, the examiner states:

> "In addition, Mueller discloses a hydrophilic soft gas permeable contact lens comprised of a polymerization product of a composition comprising a polymerizable vinylic siloxane monomer and a hydrophilic vinylic monomer, and that its lenses 'may also be treated by any of the commonly used methods used to increase the wettability of hydrophobic surfaces, such as plasma-treatment and irradiation-grafting and oxidation.' There is a substantial new likelihood that a reasonable examiner would consider this teaching important in deciding whether claims 1, 2, 6-8, 10, 11, 13, and 14 are patentable."

---

[1] See page 8 of the November 30, 2007 order granting reexamination.
[2] U.S. Patent No. 4,605,712.
[3] U.S. Patent No. 4,143,949.
[4] U.S. Patent No. 3,916,033.

A similar statement appears on page 10 of the order.

This points out substantial new questions of patentability for both "Mueller in view of Chen" and "Mueller in view of Merrill." Mueller is mentioned in the background section of the Chang '327 patent; however, it was never cited in an information disclosure statement or specifically considered, and it certainly was never applied, by the examiner during the prosecution of the application that became the Chang '327 patent. Merrill (U.S. Patent No. 4,099,859) was applied under 35 U.S.C. 102(b) or alternatively under 35 U.S.C. 103(a) as the only rejections in the application that became the '327 patent. The teaching attributed to Mueller on pages 9 and 10 of the order was not considered during the prosecution of the application. This provides the requisite substantial new questions of patentability, upon which jurisdiction to reexamine is based.

For the reasons given above, the Office has the authority to grant reexamination in the '8845 proceeding.

As a final point regarding the present decision on petition, the June 30, 2008 patent owner petition to vacate the order granting reexamination was not filed within two months of the November 30, 2007 mail date of the order, as required by 37 CFR 1.181(f). The June 30, 2008 patent owner petition to vacate, therefore, is untimely filed.

In view of the above findings, the June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate the order granting reexamination in this reexamination proceeding is **dismissed**.

VACATING OF OFFICE ACTION

The September 30, 2008 first Office action was inadvertently issued by the Central Reexamination Unit while jurisdiction over the present proceeding resided with the Office of Patent Legal Administration. **Accordingly, the September 30, 2008 first Office action must be, and is, vacated**. Jurisdiction is now being returned to the Central Reexamination Unit to mail this decision. The September 30, 2008 first Office action is hereby **reissued** by virtue of this decision, as of the date of mailing this decision by the Central Reexamination Unit. **The time period for response to the September 30, 2008 first Office action is reset to expire two (2) months from the mail date of this decision.**

The October 17, 2008 patent owner request that the Office issue a decision on the June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate is **granted** by the issuance of this decision.

CONCLUSION

- The June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate the order granting reexamination in this reexamination proceeding, as being an *ultra vires* action on the part of the Office, is **dismissed**.

- The October 17, 2008 patent owner request that the Office issue a decision on the June 30, 2008 patent owner petition under 37 CFR 1.181 to vacate is **granted**.

- The September 30, 2008 first Office action is **vacated**.

- Jurisdiction is now being returned to the Central Reexamination Unit to mail this decision.

- The September 30, 2008 first Office action is **reissued** by the issuance of this decision, as of the mail date of this decision. **The time period for response to the September 30, 2008 first Office action is reset to expire two (2) months from the mail date of this decision.**

- After the mailing of this decision, jurisdiction over the '8845 proceeding should, in due course, be transferred to the Office of Patent Legal Administration for consideration of an October 27, 2008 renewed patent owner petition to seal that has been filed.

- Any inquiry concerning this communication should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or, in her absence, to the undersigned at (571) 272-7710.

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

cn

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUL 14 2009

CENTRAL REEXAMINATION UNIT

Rothwell, Figg, Ernst & Manbeck, P.C. (For Patent Owner)
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005

Gardner Groff Greenwald & Villanueva, P.C. (For Requester)
2018 Powers Ferry Road
Suite 800
Atlanta, GA 30339

In re Chang et al :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,845 : **GRANTING**
Filed: September 6, 2007 : **PETITION**
For: U.S. Patent No. 5,712,327 :

This is a decision on the June 29, 2009 patent owner petition requesting withdrawal of the December 4, 2008 patent owner petition seeking reconsideration of its June 30, 2008 petition to vacate the reexamination order.

The December 4, 2008 patent owner petition, the June 29, 2009 patent owner petition to withdraw the December 4, 2008 patent owner petition, and the record as a whole are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the December 4, 2008 petition is **dismissed as withdrawn** and has not been considered on the merits. The June 29, 2009 patent owner petition is **granted**.

DECISION

In the December 4, 2008 patent owner petition, the patent owner requested the Office to reconsider its June 30, 2008 petition to vacate the reexamination order. The June 30, 2008 petition was dismissed by the Office on October 30, 2008.[1]

In the June 29, 2009 petition, the patent owner requested that the Office withdraw from consideration the December 4, 2008 patent owner petition seeking reconsideration of its June 30, 2008 petition to vacate the reexamination order, in light of the fact that the Office has mailed a Notice of Intent to Issue a Reexamination Certificate in the present proceeding, rendering moot the December 4, 2008 patent owner petition.

In light of the patent owner request that the Office withdraw from consideration the December 4, 2008 patent owner petition , the December 4, 2008 petition is hereby **dismissed as withdrawn** and has not been considered on its merits. The June 29, 2009 petition is **granted**.

[1] See the October 30, 2008 decision.

CONCLUSION

- The December 4, 2008 patent owner petition is **dismissed as withdrawn**.
- The June 29, 2009 patent owner petition is **granted**.
- Jurisdiction over the '8845 proceeding is being returned to the Central Reexamination Unit (CRU).

Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

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

cn

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,853	09/24/2007	5867422	PHJM0904-005	8618

26948 7590 07/15/2009

VENABLE, CAMPILLO, LOGAN & MEANEY, P.C.
1938 E. OSBORN RD
PHOENIX, AZ 85016-7234

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Mark L. Becker
LATTICE SEMICONDUCTOR CORP.
5555 NE Moore Court
Hillsboro, OR 97124-6421

Date:

MAILED

JUL 15 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008853
PATENT NO. : 5867422
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
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Joseph R Meaney.
VENABLE, CAMPILLO, LOGAN
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PHOENIX AZ 85016-7234

(For Patent Owner)

MAILED

JUL 15 2009

CENTRAL REEXAMINATION UNIT

Mark L. Becker
LATTICE SEMICONDUCTOR
CORPORATION
5555 NE MOORE CT
HILLSBORO, OR 97124

(For Third Party Requester)

In re: Lizy K John
Ex Parte Reexamination Proceeding
Control No. 90/008,853
Deposited: 24 September 2007
For: US Patent No. 5,867,422

DECISION DISMISSING
PETITION UNDER
37 CFR § 1.181(a)(3)

This is a decision on the 11 May 2009, "Petition to Vacate the Reexamination" requesting that the proceeding is *ultra vires* and should be vacated. The patent owner has petitioned under 37 CFR § 1.181(a)(3).

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

The petition is dismissed as untimely for the reasons set forth below, without consideration of the merits.

SUMMARY OF RELEVANT FACTS

1. On 02 February 1999 US Patent No. 5,867,422 was granted to Lizy K. John.

2. On 24 September 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,853.

3. On 05 November 2007 the Order was granted for *ex parte* reexamination in control number 90/008,853.

4. On 12 September 2008 a non-final Office action was mailed.

5. On 12 November 2008 a response from the patent owner was received.

6. On 26 March 2009 a Final Office action was mailed.

7. On 11 May 2009 the instant petition was submitted.

DISCUSSION

The Patent Owner requests that the reexamination proceeding be vacated. The petitioner considers the action taken by the Office by granting the Order to reexamine the patent as an *ultra vires* action by the Office.

The request to vacate the reexamination proceeding is dismissed, as untimely.

STATEMENT OF RELEVANT AUTHORITY

37 CFR 1.181(f) states:

> 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.** (Emphasis added.)

...

DECISION

The patent owner brings before the Office a petition under 37 CFR § 1.181(a)(3) to vacate an ordered *ultra vires* reexamination proceeding as not raising a proper substantial new question of patentability. The patent owner filed the petition on May 11, 2009. The action from which relief is requested is the Order granting reexamination, which was mailed on November 5, 2007. Therefore, the petition was filed over **eighteen** months from the mailing date of the action from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

CONCLUSION

1. The patent owner's petition vacate the reexamination under 37 CFR §§ 1.181(a)(3) proceeding is hereby **dismissed**, as untimely, without consideration of the merits.

2. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

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..

Gregory Morse
Director,
Central Reexamination Unit 3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,853	09/24/2007	5867422	PHJM0904-005	8618

26948 7590 07/22/2009

VENABLE, CAMPILLO, LOGAN & MEANEY, P.C.
1938 E. OSBORN RD
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Mark L. Becker
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5555 NE Moore Court
Hillsboro, OR 97124-6421

Date:
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JUL 222009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008853
PATENT NO. : 5867422
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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Joseph R Meaney.
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(For Patent Owner)

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

Mark L. Becker
LATTICE SEMICONDUCTOR
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(For Third Party
Requester)

In re: Lizy K John
Ex Parte Reexamination Proceeding
Control No. 90/008,853
Deposited: 24 September 2007
For: US Patent No. 5,867,422

DECISION
DISMISSING
PETITION
TO WITHDRAW FINALITY
PURSUANT TO
37 CFR § 1.181

This is a decision on the 15 July 2009, "Petition to Withdraw Finality of Office Action" requesting that the finality of the Office action mailed 26 March 2009 be withdrawn. The patent owner has petitioned under 37 CFR § 1.181(a)(3).

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 02 February 1999 US Patent No. 5,867,422 was granted to Lizy K. John.

2. On 24 September 2007 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/008,853.

3. On 05 November 2007 the Order was granted for *ex parte* reexamination in control number 90/008,853.

4. On 12 September 2008 a non-final Office action was mailed.

5. On 12 November 2008 a response from the patent owner was received.

6. On 26 March 2009 a Final Office action was mailed.

7. On 15 July 2009 the instant petition was submitted.

DISCUSSION

The Patent Owner requests that the finality of the Office action mailed 26 March 2009 be withdrawn. The petitioner seeks to have the finality of the office action mailed 26 March 2009 be withdrawn "to allow her to respond to the new issues."

The request to vacate the reexamination proceeding is dismissed.

STATEMENT OF RELEVANT AUTHORITY

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

(a) Petition may be taken to the Director:
(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.

MPEP § 2258 Scope of Ex Parte Reexamination (in-part)

G. Claim Interpretation and Treatment
Original patent claims will be examined only on the basis of prior art patents or printed publications applied under the appropriate parts of 35 U.S.C. 102 and 103. See MPEP § 2217. During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (In re Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)). In a reexamination proceeding involving claims of an expired patent, claim construction pursuant to the principle set forth by the court in Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim are not subject to amendment. The statutory presumption of validity, 35 U.S.C. 282, has no application in reexamination (In re Etter, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985)). (emphasis added)
...

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.

The statement which the patent owner may file under 37 CFR § 1.530 and the response to the first Office action should completely respond to and/or amend with a view to avoiding all outstanding grounds of rejection.

It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will generally be made final. 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. Both the patent owner and the examiner should recognize that a reexamination proceeding may result in the final cancellation of claims from the patent and that the patent owner does not have the right to renew or continue the proceedings by refiling under 37 CFR §§ 1.53(b) or 1.53(d) or former 37 CFR §§ 1.60 or 1.62, nor by filing a request for continued examination under 37 CFR § 1.114. Complete and thorough actions by the examiner coupled with complete responses by the patent owner, including early presentation of evidence under 37 CFR §§ 1.131 or 1.132, will go far in avoiding such problems and reaching a desirable early termination of the reexamination prosecution.

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed and any grounds or rejection relied on should be reiterated. The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal. However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the patent owner's response.

DECISION

The patent owner brings before the Office a petition under 37 CFR § 1.181(a)(3) to withdraw the finality of the Office actions mailed 26 March 2009. The relevant authority in determining the petition is addressed in MPEP §§ 2258 & 2271.

The patent owner contends that The Final Office action dated 26 March 2009 rejects the claims based on a reinterpretation of their meaning contrary to the original examiner's interpretation. The patent owner further states that "[p]rior to the Final Office action, neither the Examiner nor Requester had ever suggested a claim construction issue existed." The patent owner further asserts that "[p]revious rejections never explained why the claims that were originally allowable over art such as Motorola "product review" (Motorola) were now rejected."

Germane to the discussion is the criteria for determining the scope of *ex parte* reexamination pursuant to MPEP § 2258 "During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims." The order granting reexamination notes that Motorola raises a substantial new question

with respect to the patentability of at least claims 1 and 8. It is clear that the Motorola reference raised the question with respect to at least claims 1 and 8. The non-final Office action mailed 12 September 2008, incorporated the requesters claim chart as to how the limitations are considered to have been met by the Motorola reference. Any question as to the utility examiner's position difference was clearly set forth on the record with this Office action rejecting the patent claims.

It is important to note that the standard for claim construction in reexamination is not that of the application examiner but that "[d]uring reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims." Review of the non-final Office action and the Final office action clearly states how the limitations are anticipated under 35 USC 102(a) of patent claims 1 and 8 by Motorola and further the examiner's position has remained constant throughout prosecution of the proceeding.

Pursuant to MPEP § 2271 "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." Review of the Office actions indicates that the examiner's position remained constant throughout the non-final and Final Office actions.

ANALYSIS AND FINDINGS

The standard by which an action is made final is addressed in MPEP § 2271 in which "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." In the instant proceeding the claims were twice rejected with the same references using the same position as to how the claim limitations were anticipated by the references applied. The position of the reexamination examiner remained constant.

The petitioner contends that "neither Examiner nor Requester has ever explained why they believe original examination and claim construction was incorrect." While this may be correct, the standard for claim construction as outlined in MPEP § 2258 "During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims." Since the claim construction given by the application examiner is not the standard by which the scope of the claims are considered in rejection of claims in a reexamination proceeding, the application examiner's position is not germane to the rejection of claims in the proceeding.

The examiner in the prosecution of the instant proceeding has clearly set forth the reasons as to why the claims are rejected by Motorola since the limitations are fully matched, the examiner's position is clear. Rejecting the patent claims by Motorola and the other references twice with the same position supports the finality of the action mailed 26 March 2009.

The petition to withdraw the finality of the Office action under 37 CFR § 1.181(a)(3) is hereby dismissed.

CONCLUSION

1. The patent owner's petition vacate the reexamination under 37 CFR §§ 1.181(a)(3) proceeding is hereby **dismissed.**

2. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

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..

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,853	09/24/2007	5867422	PHJM0904-005	8618

26948 7590 11/25/2009

VENABLE, CAMPILLO, LOGAN & MEANEY, P.C.
1938 E. OSBORN RD
PHOENIX, AZ 85016-7234

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/25/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mark L. Becker
LATTICE SEMICONDUCTOR CORP.
5555 NE Moore Court
Hillsboro, OR 97124-6421

Date:

MAILED

NOV 25 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008853
PATENT NO. : 5867422
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MAILED

NOV 25 2009

CENTRAL REEXAMINATION UNIT

Inventor: Lizy Kurian John
Reexamination Proceeding
90/008,853
Filed: September 24, 2007
For: U. S. Patent 5,867,422
Title: Computer Memory Chip With Field Programmable Memory Cell Arrays (FPMCAS), and Method of Configuring

: **DECISION ON**
: **§ 1.181 PETITION**

This is a decision on the May 11, 2009 patent owner petition pursuant to 37 C FR 1.181 seeking to vacate an order for *ex parte* reexamination dated November 5, 2007.[1] A final rejection was mailed on March 26, 2009 and an Appeal Brief was filed on September 28, 2009. The petition alleges that the substantial new question of patentability and the final rejection were based on a new claim construction, which new construction is an improper basis for determining a substantial new question of patentability or conducting a reexamination. The petition is before the Office of Patent Legal Administration for consideration.

The § 1.181 petition is dismissed for the reasons set forth below.

I. Background

1) U.S. Patent number 5,867,422 (the '422 patent) issued February 2, 1999 with 10 claims, claims 1 and 8 being independent claims.[2] Claim 1[3] is illustrative:

> 1. A field programmable memory cell array including a memory array composed of a sea of N memory cells addressed by a row decoder and a column decoder to input or output data by means of input/output circuits, input data control circuits and output data control circuits as determined by select/write enable logic, comprising in combination a

[1] Service on the requestor was made by first class mail on May 11, 2009. 37 CFR 1.248(a)(4). An Opposition was not submitted by the requestor, such as within the required two weeks of service. MPEP 2246.

[2] The patent is being asserted against the Requestor before the U.S. District Court for the Eastern District of Texas (Marshall) in the case styled: *John v. Lattice Semiconductor Corporation*, Case #: 2:07-cv-00241-DF-CE. Request for Ex Parte Reexamination at page 3.

[3] The patent claim 1 for which reexamination was ordered and the reexamination claim 1 ultimately appealed are identical.

programmable address decoder and a programmable interconnect for selective reconfiguration of the sea of N memory cells to N/kxk bits, where K is a power of two.

In essence the invention resides in a memory circuit that may be selectively reconfigurable to **any** power-of-two word length within the memory's size parameters (N/kxk bits, where k is a power of two, by the use of a programmable address decoder (fig. 5 element 30), and a programmable interconnect (figure 8, element 34)).[4]

2) All the claims were finally rejected over 11 references with claim 1, for example, being rejected as anticipated over each of eight prior art references. [5]

3) The gravamen of the instant petition, concerns construction of claim 1 as to whether the scope of the claim:

a) includes a "limited" or "select few"[6] power-of-two word length reconfigurations as is admitted by the patent owner as being shown by the prior art, such as by Motorola, or
b) requires the ability to obtain "any" power-of- two word length reconfigurations within the memory size parameters.[7]

4) An order for reexamination was issued on November 5, 2007, a final rejection issued on March 26, 2009, and an Appeal Brief was filed on September 28, 2009.

5) The instant § 1.181 petition was filed on May 11, 2009, seeking to have the order for reexamination vacated. The petition objects to a reexamination being ordered based only on a new construction being given to the claims for purposes of reexamination that is contrary to the construction given by the Office when the patent was issued.

II. Prosecution of Patent

The specification of the '422 patent discusses the Motorola prior art, which has a memory chip that is capable of being reconfigured to different widths. Reconfiguration is stated to be possible from 1Mx4 to 2Mx2 bits but no other reconfigurations are possible.[8]

An October 16, 1997 Information Disclosure Statement was filed listing Motorola, which citation was initialed by the examiner.

An August 7, 1997 nonfinal Office action contained a rejection under 35 U.S.C. 102. Motorola was not applied or discussed by the examiner. The rejection stated:

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[4] Petition at pages 5, 16 and 17.

[5] i) 35 U.S.C. 102(b) as anticipated over Yabasake et al, ii) 35 U.S.C. 102(b) as anticipated over Motorola, iii) 35 U.S.C. 102(b) as anticipated by Tanaka, et al, iv) 35 U.S.C. 102(b) as anticipated by Ishii, v) 35 U.S.C. 102(b) as anticipated by Wada, vi) 35 U.S.C. 102(b) as anticipated by Saito, vii) 35 U.S.C. 102(b) as anticipated by Mills, and viii) 35 U.S.C. 102(b) as anticipated by Masumoto. All of the art, including Motorola recited in the specification of the patent and the other, new art presented in the Request for Ex Parte Examination, are based on the same new claim construction urged by the Requester. Petition at pages 22 and 25.

[6] Petition at page 7.

[7] While Petitioner generally uses the unrestricted "any configuration" concept, Petitioner recognizes that such concept is limited by any power of two word length within the memory's size parameters. Petition at page 7.

[8] Col 2, lines 22-30. Motorola will be utilized as representative of the other prior art.

> Claims 1-11 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Whitaker or Pickett et al cited by Applicant.
>
> The claims read directly on the art cited by applicant. There are not seen to be structural nor method limitations recited upon which to predicate patentability.

Applicant, in a February 17, 1998 reply to the rejection, presented the following argument to distinguish over the applied references:

> New Claims 12-21 includes specific limitations to reconfiguring the memory array to one that has a word width of k bits wide. The ability to reconfigure the word width of the memory array is not taught by either of Whitaker or Pickett.
>
> In the case of Whitaker, the use of PASS transistors is taught for reconfigurability, but there is not a teaching of reconfiguring a memory array to achieve different word widths. In the case of Pickett, memory paging is taught, similar to that referenced in the Background of the Invention, but again there is no teaching of reconfiguring a memory array to achieve different word widths.[9]

A Notice of Allowance was mailed on July 29, 1998, without a reasons for allowance.

III. Scope of Claim Language in Issue

The scope of claim 1 will be reviewed as illustrative and the focus will be on "for selective reconfiguration ... to N/kxk bits, where k is a power of two."

The patent owner argues that the language in issue must be construed as permitting reconfiguration for **any** power of two, so long as it is within the memory size parameters. Claim 1 does not itself utilize the term "any," but merely recites an equation that permits for an unrestricted number of reconfigurations, that Petitioner translates into "any' reconfiguration. It is noted that claim 1 does not confine the possible reconfigurations to the memory size parameters.

The requester and the examiner construe the claim language in issue as permitting only one possible reconfiguration, such as Motorola where k is **a** power of two, and reconfiguration is from 1Mx4 bits to 2Mx2 bits.[10]

In effect, the scope issue resides on whether Petitioner's imputed "any" of claim 1 requires an expansive reading that all reconfigurations be permitted, or is satisfied by a narrow reading of the existence of a single reconfiguration being sufficient.

Petitioner recognizes that "limitations from the specification cannot be read into the claims,"[11] but notes that proper claim construction is based on giving the claims their broadest reasonable construction in light of the specification.[12]

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[9] Request for *Ex Partes* Reexamination, page 11.
[10] Patent No. 5,867,422 at col. 2, lines 22-30.
[11] Petition, pages 6 and 7.
[12] Citing to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 205), Id.

Petitioner points to a discussion of Motorola in the specification of the patent being reexamined (col. 2. lines 22-30):

> It is desirable to be able to configure the memory chip to [a] different widths. The only known memory chip that is capable of being reconfigured is the Motorola 1Mx4/2Mx2 bit Fast Static RAM memory chip (Part Number MCM101524). This Motorola chip is a 4Mb RAM whose I/O can be electrically reconfigured from a normal configuration as 1Mx4 bits to 2Mx2 bits by applying power supply voltage to a mode select pin on the chip. Unfortunately, no other reconfigurations are possible.

Petitioner particularly relies on the last line "that no other reconfigurations are possible" to establish the definition of the imputed "any" to require more than a single reconfiguration or more than 2 or 3 or 4 reconfigurations.[13]

Petitioner also refers to objects of the invention that refer to reconfiguration in general. [14]

Petitioner also argues that the examiner before whom the application was prosecuted also gave the interpretation to "any" that required more than a single reconfiguration.[15] That argument is apparently based on: (1) the examiner's consideration of Motorola as evidenced by the examiner initialing the information disclosure list, an act intended to signal consideration, and (2) the examiner not utilizing Motorola to reject the claims.

Notwithstanding the naked formula presented in claim 1, Petitioner's need to impute the term 'any" to the language of claim 1, and the interpretation given by the examiner in the instant reexamination, the claim language itself has not be amended to, on its face, comport with the interpretation urged by Petitioner.[16]

During reexamination, claims are given the broadest reasonable interpretation consistent with the specification, and limitations in the specification are not read into the claims.[17] It is fair for the Office to insist on the broadest reasonable interpretation as applicant (or the patent owner in reexamination) "always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued will be interpreted more broadly than is justified."[18] The Office, however, cannot interpret a claim contrary to an explicit definition supplied by the specification for a claim term.

A review of the claim language itself clearly does not command an interpretation that would exclude less than the full set of possible reconfigurations defined by the formula. Consequently, a determination is required as to whether the specification support the claim would require such interpretation of the claim. The specification's description of the claimed

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[13] Petition pages 6, 22 (the referred to page 77 of patent owner's response reads "Ishii's structural block diagram is limited to four modes....").
[14] Petition at pages 12 and 13.
[15] Petition at page 13.
[16] Rather, petitioner argues that the Requester is "free to propose its new claim construction during a *Markman* hearing in the co-pending litigation. Petition at pages 21 and 26.
[17] This assumes that the patent term has not expired, which is the case here. *See* MPEP 2258, part G as to claim construction in reexamination.
[18] MPEP 211.01 citing *In re Prater*, 415 F.2d 1393, 162 UDPQ 541 (CCPA 1969)

invention does not provide an explicit definition of the imputed "any" that requires exclusion from the term prior art where there is only the possibility of less than all possible reconfigurations. Rather, Petitioner relies on the concept of "disavowal" based on the specifications criticism of Motorola-type products.[19]

Additionally, Petitioner's interpretation of "any" requires "any" to cover only one possibility – the ability for a general reconfiguration of N/kxk where k is a power of two within the memory's size parameters. Under the rule of construction offered by the patent owner, the interpretation of claim 1 would appear to be susceptible to a third possible definition of "any"[20] as excluding any device or programming method based on multiple reconfigurations that are less than all reconfigurations of the general formula, but more than the admitted 2, 3 and 4 known reconfigurations. [21]

Prosecution history of the application leading to the patent being reexamined did not address the specific scope issue now in conflict during the present reexamination.

It is not the intent of the instant Decision to determine the actual scope of claim 1, but only to recognize that the issue is in fact subject to debate, and consequently it cannot be said that reexamination of claim 1 based on the scope of claim 1 is redundant of issues pursued during prosecution of the application leading to the patent.

IV. Patent Owner's § 1.181 Petition to Vacate Order for Reexamination

The Final Office action (and the order for reexamination) relies upon the scope of claim 1 meaning at least two modes of k,[22] in other words, the claim includes the presence of only one reconfiguration. Having determined that the scope of claim 1 may arguably be construed to include only one reconfiguration, the petition which challenges the Office's reliance in the reexamination on giving such scope to claim 1 will now be treated.

The petition requests that the order for reexamination be vacated as based on an *ultra vires* act, the application of the Motorola reference to support the reexamination, which act also is asserted to infect the analysis of the other new references that are also being utilized.[23] It is argued that an order for reexamination cannot be based on a different interpretation of claim scope than used by the Office during prosecution of the application that issued as the patent for which reexamination is being requested. Reconsidering claim construction is asserted not to raise a proper new question to support reexamination.[24]

Petitioner's position is that the original examiner correctly construed the claims, to exclude only one reconfiguration and thereby properly allowed the claims over the Motorola reference. Petitioner makes much of the allowance of claim 1 over the discussion of Motorola in the specification and its consideration by the examiner as an IDS reference. [25] It

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[19] Petition at page 18.
[20] In addition to the possibilities of permitting all reconfigurations where k is a power of two, or at least one reconfiguration where k is a power of two.
[21] See footnote 13.
[22] Petition at page 8.
[23] Petition at page 3.
[24] Petition, page 2, and bridge of pages 11 and 12
[25] Petition at pages 9, 11, 13, 17, 19, 24 and 25.

is asserted that claim 1 should have been rejected by the examiner if the examiner had believed that claim 1 covered only one reconfiguration. Hence, it is argued that the proper interpretation of claim 1 must be that it does not cover a single reconfiguration.

A. Ultra Vires Act

The MPEP at 2246, page 2200-64, II recites in-part:

> [N]either the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted. ... These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued.[26] Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

The MPEP, id., does provide that:

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order .... In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration will be entertained. (emphasis in original).

A list is provided by the MPEP, id. of appropriate circumstances under which a § 1.181(a)(3) petition could be granted that includes:

> (E) the reexamination order is based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent ...).

Accordingly, it is appropriate for the Office to entertain the instant *ultra vires* petition, as it is directed towards arguing that a new question of patentability has not been raised because one cannot be raised based on claim scope alone when using previous considered prior art.[27]

B. Standard for Establishing a Substantial New Question of Patentability

Any request for *ex parte* reexamination must identify a substantial new question of patentability. 35 U.S.C. 303(a), 37 CFR 510(b)(1), and 37 CFR 515(a).

A substantial new question of patentability is not, however, raised if the Office has (MPEP 2242, II Policy in Specific Situations, A):

> previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technoligies*, 83 F.3d 1394, 38

[26] The current final rejection is not a final agency decision.

[27] In view of the issues raised, the Office will not insist on the two month time period § 1.181(f) for filing the (May 11, 2009) petition from the action complained of (in this case the order for reexamination on November 5, 2007)

> USPQ2d 1776 (Fed. Cir. 1996).[28] The Office's position that the same piece of art could be used as the only ground of rejection once reexamination was initiated on new art, was rejected by the court based on the statute as it then existed.[29] The court relying on the legislative history noted that "reexamination as enacted was carefully limited to new prior art ... which may have escaped review at the time of the initial examination of the patent application."[30]

The inability to rely solely on previously used prior art was reaffirmed in *In re Portola Packaging Inc.*, 42 USPQ2d 1295 (Fed. Cir. 1997), directed to utilizing a combination of two references in the reexamination that while used to reject clams in the original examination of the patent, were never earlier used in combination with each other.[31] The court explained that its decision to bar reexamination on the same reference and on the same ground in *In re Recreative* was based on preventing raising the question of patentability based on a rejection that was previously considered.[32] The court in interpreting the intent of the statute as it then existed noted that "Congress did not authorize the PTO to evaluate patentability anew whenever there existed doubt as to a patent's validity." [33] Therefore, "[w]hether the earlier examination was correct or not, reexamination of the same claims in light of the same references does not raise a substantial new question of patentability ...."[34]

35 U.S.C. 303(a) has been amended subsequent to *In re Recreative* and *In re Protola* and currently provides in-part:

> The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

Prior art that was "previously cited/considered" in an earlier Office examination of the patent is referred to as "old art." The mere reliance solely on old art to support a new question of patentability is not fatal, 35 U.S.C. 303(a), so long as the old art is being:

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[28] The reexamination was ordered solely based on new prior art cited in the reexamination request. Once ordered, the examiner rejected the claims based on the same reference (Orta) on the same ground (35 U.S.C. 103) as used in the original examination. The Board of Patent Appeal and Interferences, reversed the rejection and *sua sponte* applied the same reference in a different ground of rejection (35 U.S.C. 102).

[29] The court did not reach the "interesting question" regarding whether a rejection, based on the same reference as used in the original examination but styled as lack of novelty instead of obviousness, could support a substantial new question as the issue was first raised by the Board's *sua sponte* new ground of rejection. At page 1779.

[30] At page 1778.

[31] During the initial examination of the patent, a Hunter reference was used as anticipation and a Faulstrich reference was use in combination with two other references in a rejection. The reexamination request relied on in part the Hunter reference as anticipatory, and Hunter combined with Faulstrich, which combination has not been used in the initial examination of the patent. The rejection as affirmed by the Board of Patent Appeals and Interferences was based on the combination of Hunter with Faulstrich.

[32] At page 1297.

[33] At page 1298.

[34] At page 1299. "Congress intended that on reexamination a patent holder would not have to argue that claims were valid over the same references that had been considered by the PTO during the original examination." In so doing, the court did not accept an argument that the absence of direct evidence that the original examiner considered the two references together in the context of section 103 indicates that the examiner did not so consider them. Rather, the court assumed that if references were in front of the examiner, the examiner reviewed them both alone and in combination with each other.

presented/viewed in a new light, or a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request.[35]

IV. Can an order for reexamination be based solely on a new interpretation of the scope of the patent claims?

Determinations of a substantial new question are based on a fact-specific inquiry done on a case-by-case basis.[36] Petitioner, however, in the instant reexamination, seeks to establish a general rule that a new claim construction alone cannot support a finding of a substantial new question of patentability based on only old art.

A. Petitioner's Position

Petitioner's position is that Motorola is relied upon for the very teaching described by applicant in the patent specification, a single reconfiguration. Thus, Motorola is not being viewed in a "new light" or in a "different way." The only thing that has changed is construing claim 1 to encompass a single reconfiguration rather than requiring the ability for any power-of-two word length within the memory size parameters.[37]

Petitioner's position is that reexamination is permitted only in light of new, non-cumulative technical teachings that were "missing or misunderstood in the original examination, regardless of whether those technological teachings come from new art or old art.[38] Accordingly, it is asserted that any substantial new question of patentability cannot be based on a new claim interpretation,[39] but must come from a new issue relating to the teachings in the prior art previously considered.

Reliance is had on *In re Recreative Technologies*[40] that by Congressional design, reexaminations are not permitted to repeat decisions on the identical ground that had been previously raised and overcome during the original examination.

Reliance is also had on *In re Swanson*[41] - the only critical question to be addressed is the existence of substantial evidence to suggest that the examiner in the original application: (1) did not previously consider, or (2) did not properly understand the technological teaching in the original examination.[42]

Petitioner then argues that since that portion of Motorola now being relied upon to support the finding of a substantial new question was explicitly discussed in the specification, and Motorola was cited in an IDS and considered by the examiner, the examiner correctly construed the claim as excluding the single reconfiguration of Motorola.[43] A corollary of

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[35] MPEP 2216.
[36] MPEP 2242, II., A., page 2200-59.
[37] The anticipation rejection is "not based on a new understanding of what Motorola does, but rather a new interpretation of what claims 1-10 cover." Petition at pages 2 and 7.
[38] Petition at page 9.
[39] Petition, bridge of pages 11 and 12.
[40] Petition at page 10.
[41] 540 F.3d 1368; 88 USPQ2d 1196 (Fed. Cir. 2008).
[42] Petition at pages 11, and12.
[43] Petition at page 13.

applicant's argument would be that even if the examiner incorrectly construed the scope of claim 1, any error in claim 1's construction would not be reviewable under reexamination, which must be directed towards new issues.

B. Decision On New Claim Interpretation Supporting Order for Reexamination

Petitioner has not offered any direct support for the proposition that a substantial new question cannot be supported solely by a new claim construction. The court in *In re Portola* recognized that the:

> PTO's goal is to perform thoroughly and conscientiously its function of allowing applications claiming only patentable subject matter, and that in order to do so it wishes to take advantage of a second opportunity to examine claims it once issued when reexamination gives it that chance.

Accordingly, the Office does not wish to surrender an iota of jurisdiction that the reexamination statute may provide the Office – at least for strong cases of unpatentability, unless it is made clear to the Office by the statute, legislative history or court interpretation of the statute that the Office does not in fact have jurisdiction to order reexamination based on a given set of circumstances. The instant issue is whether the Office may order reexamination based on the amended statute where the new issue is a different claim interpretation, where the claim is not amended and the prior art will be assumed arguendo to be old prior art (but see C below).

The statute does not define what constitutes a "'substantial new question of patentability.[44] The Federal Circuit in *In re Swanson*, decided subsequent to the amendment to the reexamination statute, recognized that Congress disagreed with the restrictive scope of reexamination imposed by the court in *In re Potrola* baring reexamination based on prior art previously applied in examination of the original patent.[45] The court then analyzed the amended language of 35 U.S.C. 303(a) – "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited to the Office or considered by the Office" – in regard to the issue presented by *In re Swanson*. A Deutsch reference was initially used as secondary teaching during examination of the patent, and was later used as an anticipatory reference in the reexamination.[46]

In analyzing the effect of the statutory change, the *Swanson* court determined that the statutory amendment "removes the focus of the new question inquiry from whether the reference was previously considered, and returns it to whether the particular question of patentability ... was previously evaluated by the PTO."[47] The court reemphasized that the requirement for a substantial new question of patentability is not to "simply repeat prior examination on identical grounds previously raised, or to merely question the judgment of the examiner in the prosecution of the patent where the examiner has made a judgment call.[48]

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[44] *In re Swanson* at page 1202.
[45] At page 1201.
[46] At page 1205. As the patentee did not challenge the rejection of the claims in light of Deutsch, the court only considered whether Deutsch raised a substantial new question of patentability. At page 1200.
[47] At page 1204.
[48] At page 1205.

What has been eliminated via the statutory amendment is the bright line rule of *In re Portola* that was based on the presumption that -where a single reference alone or in combination created multiple possible grounds of rejection and thus raised more than one question of patentability – "the examiner had properly discharged his duties and thus had considered all question[s] of patentability raised by any reference before him.[49] Rather, the key is the presence of a new patentability issue based on prior art, *i.e.*, one that was not previously raised.

When applying old art, must the substantial new question of patentability may be based on a new interpretation raised only by the old art itself. The Office believes it is of no moment whether the new interpretation under which old art is applies is raised by reinterpreting the teaching of the old art or reinterpreting the scope of the patented claim that makes the old art viable. So long as the new interpretation has not been the subject of prior prosecution, the issue would be a new question based on prior art and is a valid basis to order reexamination. In applying old art as anticipatory, rather than in combination, such as in *In re Swanson*, it can be expected that such change could be based on the re-interpretation of claim scope rather than a reinterpretation of the reference's teaching (the latter is admittedly what actually happened in *In re Swanson*). The Office concedes that questions of claim scope unrelated to the application of prior art, such as under 35 U.S.C. 112, would not offer a basis for ordering reexamination.

Petitioner would require an explicit finding that the examiner in the initial examination did not properly consider the scope of the claim. *In re Swanson*, refers to the legislative history stating that there should be substantial evidence that the "examiner '"did not properly understand the reference, or did not consider a portion of the reference in making his decision."'

The standard for establishing a substantial new question in regard to scope of the claim initially examined is no different from establishing a substantial new question in regard to a new application of old prior art. The Office need not show an explicit error made by the examiner. It is sufficient that the examiner did not raise the particular issue of scope in issue regarding a substantial new question of patentability. For example, the Office sees no difference between permitting an order for reexamination based on the use of a different portion of the reference vs. permitting reinterpretation of a claim term to broaden its reach to cover old prior art. In either case, the examiner error would be in non-recognition rather than in an explicit action.

C. Consideration of the Motorola Old Art

MPEP 2216 provides:

> After the enactment of the Patent and Trademark Office Authorization Act of 2002 ("the 2002 Act"), a substantial new question of patentability can be raised by patents and printed publications "previously cited by or to the Office or considered by the Office" ("old art").

[49] Id.

Since Motorola was previously cited to the Office, it is "old art." Petitioner raises a basic prohibition (that applies to "old art") against reexamination unless there is a new, non-cumulative technology teaching that was not previously considered and discussed.[50] Petitioner's position is that: (1) the teachings of Motorola were unequivocally presented when the application was allowed, and (2) there must be some evidence to suggest that the examiner misunderstood the teachings of Motorola, for a substantial new question to be raised. As there is no evidence to suggest that the examiner did in fact misunderstand the teachings of Motorola, the finding of a substantial new question of patentability was an *ultra vires* act.[51]

A review of the patent file record does not reveal that the broadened scope of claim 1 and Motorola's relation thereto, to include a singe reconfiguration was ever considered by the examiner. Motorola was cited by applicant in an IDS, the list of which contained 5 pages of citations,[52] and the Motorola citation was initialed by the examiner. The Office actions did not, however, utilize, apply or discuss Motorola. Applicant's remarks in response to the first Office non-final rejection were based on the applied references not having the ability to reconfigure the memory array to "achieve different word widths," a discussion that does not distinguish the ability to achieve one reconfiguration versus the ability to achieve many. The next Office action was a Notice of Allowance, without a statement of reasons for allowance.[53]

In re Swanson specifically recognizes that "Ideally, a reexamination could be requested based on prior art cited by an applicant that the examiner failed to adequately consider.[54] In this instance, the record does not reveal that Motorola was previously considered, as argued by patent owner, based on its discussion in the specification and citation in an IDS, despite the fact that the examiner did not apply the reference or independently discuss it. The requirement of examiner consideration based on applicant discussion in the specification coupled with the minimum examiner review required by a citation in an IDS does not provide evidence of such consideration. MPEP provides:

> Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. ... Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citation on the PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

In this manner, the record does not reveal that Motorola was previously considered by the examiner as to the construction of claim 1 to encompass a single reconfiguration rather than requiring the ability for any power-of-two word length within the memory size parameters.

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[50] Petition at page 10 referencing MPEP 2216.
[51] Petition at page 9.
[52] 10 U.S. patents, and 13 non-patent literature citations, including two Motorola citations.
[53] Office records indicate that a Miscellaneous action was mailed on August 5, 1998 with a shortened statutory period, but only the cover sheet is present.
[54] At page 1205.

The record does not even reveal that Motorola was previously considered by the examiner as to the ability to achieve one reconfiguration or the ability to achieve many.

Unless the examiner specifically applied a piece of prior art or at least discussed it as to the issue now being raised, the prior art is not barred from being applied as the basis for reexamination. It cannot be said what the examiner understood regarding the prior art. That is not to say there is a question whether the examiner in fact reviewed Motorola pursuant to the above MPEP 609 citation, as the record indicates was done, but that it is unclear what the examiner came away with from such review. Background information, such as the invention's relationship to the prior art, in the specification is not required to be reviewed by the examiner, unlike the situation where the relationship discussion was made part of the IDS.

As a final point, all the references applied during prosecution of the application leading to the patent being reexamined, according to the applicant, did not teach reconfiguration; thus, there is no issue regarding Motorola being cumulative.

D. Finding on Ultimate Issue

The patent owner may, by way of appeal, challenge the Office's construction of claim 1 to encompass a single reconfiguration rather than requiring the ability for any power-of-two word length within the memory size parameters. However, patent owner has not established the absence of a substantial new question of patentability that would preclude continuing the present proceeding. Petitioner is referred to *Heinl v. Godici*, (E.D.Va. 2001), 143 F. Supp.2d 593. In *Heinl*, 143 F.Supp.2d at 601, the court stated:

> Under the well established *ultra vires* doctrine, the exhaustion and final agency requirements are excused 'only if plaintiff is able to show that the PTO clearly exceeded its statutory authority,' quoting from *Philip Morris, Inc. v Block*, 755 F.2d 368, 370 (4th Cir. 1985) (quoting *Mayor and City Council of Baltimore v Mathews*, 562 F.2d 914, 920 (4th Cir. 1977), vacated on other grounds, 571 F.2d 1273 (4th Cir. 1978).

The court went on to state:

> Put differently, when an agency acts in 'brazen defiance' of its statutory authorization, courts need not await the conclusion of the underlying proceedings.

After a review of the record, and based upon the above discussion, it is found that petitioner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office's determination to continue the present reexamination proceedings.

Conclusion

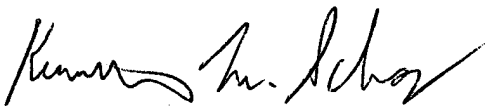
1. The petition under 37 CFR 1.181 is dismissed.

2. Petitioner has failed in its burden to establish the absence of a colorable argument supporting the new question of patentability based on the scope of claim 1, and that

therefore the Office has acted in brazen disregard of the statutory mandate to only order reexaminations based a new issue.

3. Further action by the examiner in charge of the reexamination proceeding will be forthcoming.

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.



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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.
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26948 7590 05/21/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Date:
MAILED

MAY 2 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008853
PATENT NO. : 5867422
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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MAILED

MAY 21 2010

CENTRAL REEXAMINATION UNIT

Inventor: Lizy Kurian John : **REVISED DECISION ON**
Reexamination Proceeding : **§ 1.181 PETITION**
90/008,853 :
Filed: September 24, 2007 :
For: U. S. Patent 5,867,422 :
Title: Computer Memory Chip With Field Programmable Memory Cell Arrays (FPMCAS), and Method of Configuring

This is a supplemental decision[1] on the petition filed May 11, 2009, seeking vacatur of the November 5, 2007 order for reexamination of the above-identified patent on the basis that the order for reexamination of the above-identified patent is *ultra vires*.

The petition to vacate the November 5, 2007 order for reexamination of the above-identified patent is **DENIED**.

I. Background

1) U.S. Patent No. 5,867, 422 (the '422 patent) issued on February 2, 1999.

2) An order for reexamination issued on November 5, 2007, based on the finding of a substantial new question of patentability in view of 11 references each taken alone, including the Motorola reference.[2] The Motorola reference was the only reference (asserted in the reexamination request) that was present in the patent file, with the other references being newly cited by the request for reexamination.[3]

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[1] The decision of November 25, 2009 is hereby vacated.

[2] Page 2 of the reexamination Order lists the references relied upon: (i) Yabusake et al, ii) Tanaka, iii) Ishii, (iv) Wada, v) Saito, vi) Mills, vii) Cliff, (viii) Nicholes, ix) Masumoto, (x) Ngai, and (xi) Motorola.

[3] Two Motorola references, each one page in length, appear on the face of the patent under the Publications section. The background description of the patent at col. 2 refers only to a Motorola 1Mx4/2Mx2 chip product review citation (but not the Motorola 64K x 18 bit memory Product Review citation). The Order Granting Reexamination refers to the same citation as does the background of the patent specification. All references in the instant decision will be to the Motorola 1Mx4/2Mx2 chip publication.

3) The present proceeding has progressed to the point where a final rejection issued on March 26, 2009, and an Appeal Brief was filed on September 28, 2009 in the reexamination.

4) The instant § 1.181 petition was filed on May 11, 2009, seeking to have the order for reexamination vacated based on the argument that the finding of a substantial new question of patentability in the order was an erroneous finding, and thus, the order was asserted to be an *ultra vires* act.[4]

5) An Office decision dismissing the petition was mailed on November 25, 2009.

6) Petitioner appealed to the United States Court of Appeals for the Federal Circuit, seeking review of the November 25, 2009 Decision on the May 11, 2009 petition.

7) On May 19, 2010, the United States Court of Appeals for the Federal Circuit dismissed the appeal for lack of jurisdiction and indicated that review may be sought from a final decision of the Board of Patent Appeals and Interferences (BPAI).

II. Prosecution of the Patent

The specification of the '422 patent discusses the Motorola reference, as having a memory chip that is capable of being reconfigured to a different word width. Reconfiguration is stated to be possible from 1Mx4 to 2Mx2 bits, but no other reconfigurations are possible.[5]

In the application which matured into the patent, an Information Disclosure Statement was filed[6] citing the Motorola reference, which citation was initialed by the examiner and therefore considered by the examiner.

On August 7, 1997 a non-final Office action was issued (for the application) which contained a rejection under 35 U.S.C. 102. The Motorola reference was not applied or discussed by the examiner in the Office action. The rejection stated that:

> Claims 1-11 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Whitaker or Pickett et al cited by Applicant.
>
> The claims read directly on the art cited by applicant. There are not seen to be structural nor method limitations recited upon which to predicate patentability.

Applicant, in a February 17, 1998 reply to the rejection, presented the following argument to distinguish the claims over the applied references:

> New claims 12-21 include specific limitations to reconfiguring the memory array to one that has a word width of "k" bits wide. The ability to reconfigure the word width of the memory array is not taught by either of Whitaker or Pickett.

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[4] Service on the requestor was made by first class mail on May 11, 2009. 37 CFR 1.248(a)(4). An Opposition was not submitted by the requestor, such as within the required two weeks of service. MPEP 2246.

[5] Col 2, lines 22-30.

[6] The list of references is date stamped October 16, 1995, but has a paper date of August 7, 1997.

> In the case of Whitaker, the use of PASS transistors is taught for reconfigurability, but there is not a teaching of reconfiguring a memory array to achieve different word widths. In the case of Pickett, memory paging is taught, similar to that referenced in the Background of the Invention, but again there is no teaching of reconfiguring a memory array to achieve different word widths.[7]

On July 29, 1998 a Notice of Allowance was mailed for the application without a statement of Reasons for Allowance.

III. Patent Owner's § 1.181 Petition to Vacate the Order for Reexamination

The petition alleges that the substantial new question of patentability was based on a new claim construction, which new construction is an improper basis for determining a substantial new question of patentability. Reexamination is stated to only be authorized for a new, non-cumulative technology teaching that was not previously considered in issuance of the patent. A new claim construction is urged to be different than a new technology teaching.[8]

Petitioner explains that Motorola was previously considered by the examiner as evidenced by the examiner initialing the IDS Motorola citation in the application maturing into the patent being reexamined, and petitioner consequently argues that Motorola therefore cannot form the basis of a substantial new question of patentability to grant reexamination of the patent. The gravamen of petitioner's argument is that as Motorola was previously considered by the examiner during prosecution of the patent for which reexamination has been granted, the scope of the claim is defined by the non-application of Motorola to the claims (*e.g.*, the scope of the claim is such that the teaching of Motorola would not read on the claim – thus, it is asserted that the claim scope excludes the one reconfiguration of Motorola). Petitioner alleges that the prior art now being used to support the substantial new question of patentability is an impermissible new (different) interpretation of the claim scope that now allegedly allows Motorola (allowing only one reconfiguration), and the new art (allowing only a few reconfigurations[9]) to be used to support a substantial new question of patentability.

Petitioner also asserts that the Office must establish that the original examiner misunderstood the cited (but not applied) Motorola reference during the initial examination of the application maturing into the patent being reexamined before a substantial new question of patentability would exist.[10]

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[7] Request for *Ex Partes* Reexamination, page 11.
[8] Petition at pages 1 and 2.
[9] Petition at page 7.
[10] Petition at pages 9 and 12.

IV. *Ultra Vires* Standard

Petitioner may seek vacatur of an order for ex parte reexamination via petition under 37 CFR 1.181 if petitioner can establish that the Office's finding of a substantial new question of patentability was an *ultra vires* act (*i.e.*, where the Office clearly exceeded its statutory authority in the order for reexamination). *See* MPEP 2246. A petition under the *ultra vires* standard must demonstrate that the Office acted in "brazen defiance" of its statutory authorization. *See Heinl v. Godici*, 143 F. Supp 2d 593, 601 (E.D. Va, 2001).

The Office is authorized to order reexaminations based on a substantial new question of patentability. As set forth below, the finding of a substantial new question of patentability is not an *ultra vires* act when, as in the current reexamination proceeding, it is based on prior art never discussed or applied by the examiner in the examination of the application maturing into the patent being reexamined. Additionally, it cannot be said to be an *ultra vires* act when, as in the current reexamination proceeding, it is based on prior art not cumulative to the previously cited art (instant petitioner's own admission), particularly when such art is not in the file of the application that matured into the patent being reexamined.

V. Standard for Establishing a Substantial New Question of Patentability

Any request for *ex parte* reexamination must identify a substantial new question of patentability. 35 U.S.C. 303(a).

35 U.S.C. 303(a) was amended in 2002 to add:

> The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

As amended, the statute permits on its face the use of prior art cited to the Office during prosecution of the patent to support a substantial new question of patentability in a reexamination of that same patent. Such art is referred to as "old art."[11]

The U.S. Court of Appeals for the Federal Circuit (Federal Circuit) recently addressed the 2002 amendment of 35 U.S.C. 303(a) as a matter of first impression in the context of an appeal from the final decision of the Office (a final decision by the Board of Patent Appeals and Interferences) in a reexamination proceeding. *See In re Swanson*, 540 F.3d 1368 (Fed. Cir. 2008). *Swanson* makes clear that the ability to use previously applicant cited old art, as well as previously examiner cited or used old art, to support a substantial new question of patentability is not automatic. The Office has recognized this in the MPEP when identifying that a substantial new question of patentability may be based solely on old art where:

> the old art is being presented/viewed in a new light, or a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request.[12]

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[11] MPEP 2242, page 2200-59.

In analyzing the effect of the 2002 amendment of 35 U.S.C. 303(a), the Federal Circuit in *Swanson* determined that the amendment "removes the focus of the new question inquiry from whether the reference was previously considered, and returns it to whether the particular question of patentability ... was previously evaluated by the PTO." The Federal Circuit reemphasized that the requirement for a substantial new question of patentability exists to prevent simply repeating a prior examination on identical grounds (issues and arguments) previously raised and overcome, or to avoid merely questioning the judgment of the examiner in the prosecution of the patent.[13]

The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute. The Office considers there to be a substantial new question of patentability where there is a "substantial likelihood that a reasonable examiner would consider the prior patent or printed publication important in deciding whether or not the claim is patentable."[14] In the instant reexamination proceeding, the references used to support the finding of a substantial question of patentability have also been relied upon by the examiner to reject the claims in the final Office action.

The ultimate question presented herein is whether or not the substantial new question of patentability found to be raised in the reexamination order had been previously considered or decided (by the examiner) in the examination of the application maturing into the '422 patent currently being reexamined.[15]

VI. Motorola

Motorola was not applied against any of the claims by the examiner during the prosecution of the application maturing into the '422 patent. Moreover, Motorola was not discussed by the examiner during prosecution of the application maturing into the patent being reexamined. Therefore, Motorola can be used to support a substantial new question of patentability. Additionally, it is not necessary for the Office to rely on a new claim construction in order to find that Motorola supports a substantial new question of patentability.

Petitioner argues that basing a substantial new question of patentability on Motorola is barred since (a) Motorola was cited by applicant in an IDS during prosecution of the application maturing into the '422 patent, (b) the examiner initialed the Motorola citation as having considered the citation, and (c) applicant discussed the import of Motorola in the application's specification.

Swanson[16] recognizes that even where a reference was used in a rejection in the application for patent, that reference may then be later used to support a substantial new question of

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[12] *Id.*

[13] *Swanson*, 540 F.3d at 1380-81.

[14] MPEP 2242, page 2200-57.

[15] Id. at II. Policy in Specific Situations, A.

[16] *Swanson* did not involve a facial challenge to an order for reexamination on the basis that it is *ultra vires*, but rather involved an appeal from the final decision of the Office (a decision by the BPAI). As Motorola supports a substantial new question of patentability under *Swanson*, it follows *a fortiori* that the order for reexamination of the above-identified patent based upon Motorola is not *ultra vires*.

patentability in a reexamination proceeding, as long as the use of the reference in the reexamination proceeding is not the same as that in the application. Consequently, the mere citation by applicant to the Office of Motorola, absent any application of the reference by the examiner, and absent any discussion of the reference by the examiner, does not preclude Motorola from being used to support the finding of a substantial new question of patentability for the present proceeding. *See* 35 U.S.C. 303(a). If Motorola had been applied or discussed by the examiner during the prosecution of the application maturing into the '422 patent being reexamined, then the issue would be whether Motorola was being used for a different purpose. However, as Motorola was not used or discussed by the examiner, there can be no issue as to whether the current use in supporting a substantial new question of patentability is a new use.

Petitioner is not alleging that Motorola is unrelated to the claimed invention, but that Motorola, having been cited by applicant in the patent prosecution file, may now procedurally not be used to support the finding of a substantial new question of patentability. Petitioner focuses on the IDS citation of Motorola along with its discussion in the patent specification as acting to define the claim scope of the patent so as to represent a previous decision by the examiner that excluded the application of Motorola to the claims and therefore that Motorola is now unfit to support a finding of a substantial new question of patentability. Petitioner's position is that the examiner's failure to use Motorola during prosecution of the application maturing into the '422 patent represents a positive statement in the prosecution record by the examiner that the scope of the claim being examined was different from the invention taught by Motorola. However, the failure to use Motorola simply cannot be transformed into definitive prosecution history. Rather, the nonuse of Motorola simply means that the present requester is newly applying the reference in a manner never explored by the examiner in the examination of the '422 patent.

What was actually considered during the initial examination: Petitioner raises a basic prohibition against reexamination unless there is a new technology teaching that was not previously considered and discussed.[17] In this instance, there is no evidence of record to suggest that the examiner understood the full technology teachings of Motorola, which are now (in the reexamination) applied to support the findings of a substantial new question of patentability and reject the claims. The present consideration of the technology teachings of the Motorola reference to support the finding of a substantial new question of patentability was not an *ultra vires* act.

Discussion of the examiner's failure to consider applying the technology teachings of Motorola to reject the claims: A review of the patent file record does not reveal that the examiner ever considered the scope of claim 1 in light of Motorola's single reconfiguration. Motorola was cited by applicant in an IDS, which contained 5 pages of citations.[18] All the citations were initialed by the examiner including the Motorola citation indicating that the examiner did consider Motorola along with all the other citations. The consideration of Motorola, however, amounted to no more than a brief review in the same manner as documents are generally considered during a search of Office file records.[19] The examiner

[17] Petition at page 10 referencing MPEP 2216.

[18] 10 U.S. patents, and 13 non-patent literature citations, including two Motorola citations.

[19] Consideration of information cited in an IDS means "nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search." MPEP 609, at page 600-142.

cannot be held to have specifically focused on Motorola or otherwise appreciated its full technical teachings. The fact that applicant identified Motorola in applicant's specification does not amount to the examiner having a full understanding of all that Motorola teaches.

The Federal Circuit in *Swanson* indicated that Congress in passing the amended statute has rejected the presumption that where an examiner has considered a reference, the reference has been fully considered for all questions of patentability that could be raised by the reference.[20]

Based on the application record, it cannot be said what the examiner understood regarding Motorola and what determination was made by the examiner in regard to the relationship of Motorola to the invention being claimed. That is not to say there is a question whether the examiner in fact reviewed Motorola, as the record indicates such was done, but rather that consideration of Motorola by the examiner does not equate to the examiner fully understanding and appreciating all the technical teachings of Motorola.

The Federal Circuit in *Swanson* indicated that the purpose of the amended statute is to remove the "focus of the new question inquiry from whether the reference was previously considered, and returns it to whether the particular question of patentability presented by the reference in reexamination was previously evaluated by the PTO."[21] Arguments already decided and judgments already made by the examiner are not to be used to simply repeat the prior examination in a reexamination. Such is not the case in the present reexamination. There is no evidence that the examiner made the judgments that petitioner asserts the examiner to have made. Where a reference has not been discussed or applied by the examiner in the initial examination, it cannot be said that reliance on the reference to establish a substantial new question of patentability is "re-conducting" of the prior examination. Accordingly, such reliance and subsequent finding of a substantial new question of patentability by the Office is not an *ultra vires* action.

VII. Additional Art Cited to Support Order for Reexamination.

The order for reexamination was also supported by prior art in addition to Motorola. The additional prior art was not of record in the patent file and was first presented in the request for reexamination. While Motorola showed only one reconfiguration, the additional art shows multiple configurations, such as 4 modes.[22] Petitioner concedes that the additional prior art is not cumulative of Motorola,[23] though the additional art is also alleged to be prohibited from being used to support a new substantial question of patentability.[24] As with Motorola, petitioner relies upon the finding of a substantial new question of patentability based on the additional prior art as being based on an impermissible need to review a prior

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[20] At page 1205.
[21] At bridge of pages 1204 and 1205.
[22] Petition at page 22. discussion of Ishii.
[23] Petition at page 25.
[24] A cumulative reference is one that is repetitive of a prior art reference that was previously applied or discussed. "For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings or a reference that was either previously relied upon or discussed in a prior Office proceeding .... However, it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter." MPEP 2258.01, page 2200-101.

alleged examiner determination of claim scope (by the non-application of Motorola to the claims based on applicant's citation of and description of Motorola).

The above discussion as to Motorola in regard to its ability to support a finding of a substantial new question of patentability would be equally applicable to the use of the additional art. For example, Ishii's teaching of 4 reconfigurations would represent a substantial new question of patentability. There is nothing in the file record of the original examination that addresses the scope of applicant's claims over 4 reconfigurations. The position by petitioner that Ishii would be cumulative to Motorola, based on the claim scope allegedly determined by the examiner is not sustainable. Accordingly, the finding of a substantial new question of patentability based on these additional documents is not an *ultra vires* action on the part of the Office.

VIII. Conclusion

1. The petition under 37 CFR 1.181 for vacatur of the reexamination proceeding as being an *ultra vires* action by the Office is **denied**.

2. Further action by the examiner in charge of the reexamination proceeding will be forthcoming.

3. The issue of whether a substantial new question of patentability was raised in petitioner's brief to the BPAI and any further review of the SNQ issue beyond the 'ultra vires' issue addressed here, will be conducted by the BPAI.

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, Kenneth M. Schor, Senior Legal Advisor at (571) 272-7710, both in the Office of Patent Legal Administration.

5. Any further correspondence with respect to this matter should be addressed as follows:

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CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/007,878
Filed : January 17, 2006
For U.S. Patent No. : 5,514,154

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,865
Filed : October 4, 2007
For U.S. Patent No. : 5,514,154

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/007,878 was ordered in a decision mailed February 14, 2006. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 have been filed subsequent to the response. There have been no changes made to the specification, claims or drawings. Claims 1-23, all of the claims, are being reexamined in this proceeding.

Reexamination in application control No. 90/008,865 was ordered in a decision mailed November 26, 2007. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. There have been no changes made to the specification, claims, or drawings. Claims 1, 3, 4 and 8-11 are being reexamined in this proceeding.

As evidenced by the above facts, reexamination control No. 90/007,878 and reexamination control No. 90/008,865 are currently pending. Since the order to reexamine has been mailed in

both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination of claims 1-23 will be conducted in accordance with the following guidelines and requirements.

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

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

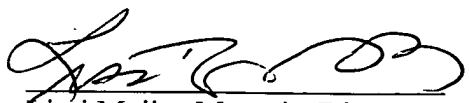
Conduct of Proceedings

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

Conclusion

Reexamination Control Nos. 90/007,878 and 90/008,865 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Lissi Mojica Marquis, Director
Central Reexamination Unit

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Fulwider Patton LLP
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(For Patent Owner)

MAILED

MAY 20 2009

CENTRAL REEXAMINATION UNIT

Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
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(For 3rd Party Requester)

Reexam Control No.: 90/007,878
Filed : January 17, 2006
For U.S. Patent No. : 5,514,154

Reexam Control No.: 90/008,865
Filed : October 4, 2007
For U.S. Patent No. : 5,514,154

Reexam control No.: 90/009,309
Filed : October 24, 2008
For U.S. Patent No. : 5,514,154

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings, all filed by the same third party requester, are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/007,878 was ordered in a decision mailed February 14, 2006, indicating that claims 1-23, all of the claims in the patent, would be reexamined. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 were filed subsequent to the March 23, 2007 response. The response made no changes to the specification, drawings, and/or claims.

Reexamination in application control No. 90/008,865 was ordered in a decision mailed November 26, 2007, indicating that claims 1, 3, 4, and 8-11 would be reexamined. No patent owner's statement was filed in this proceeding.

In a decision mailed January 31, 2008, reexamination proceedings 90/007,878 and 90/008,865 were merged. The decision indicated that claims 1-23, all of the claims in the patent, would be reexamined. A non-final Office action was mailed June 30, 2008. A request for extension of time was received July 11, 2008 and granted in a decision mailed July 22, 2008, extending the period for response up to and including September 30, 2008. On October 2, 2008 an amendment was filed with a certificate of mailing dated September 30, 2008. On March 18, 2009 an Information Disclosure Statement was filed. The amendment of October 2, 2008 made no changes to the specification, drawings and/or claims. No Office action has been prepared that is responsive to the October 2, 2008 amendment.

Reexamination in application control 90/009,309 was ordered in a decision mailed December 12, 2008, indicating that claims 4 and 12 would be reexamined. No patent owner's statement was filed in this proceeding. An Information Disclosure Statement was filed March 18, 2009. No changes to the specification, drawings and/or claim have been made in this proceeding. No Office action has been issued in this proceeding since the mailing of the decision granting reexamination.

As evidenced by the above facts, reexamination control No. 90/007,878, reexamination control No. 90/008,865, and reexamination control No. 90/009,309 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims, Drawings, and Specification in Each Proceeding

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-23, all of the patent claims, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the three reexaminations. All papers issued by the Office will contain the identifying data for each of the cases, and each action will be entered into each of the files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example,

only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,878, 90/008,865, and 90/009,309 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination unit for issuance of an Office action.

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

Gregory Morse,
Director
Central Reexamination Unit

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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.
90/008,869	10/05/2007	6886553	68803(302728?)	1108

24504 7590 12/02/2009

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/02/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

INTELLECTUAL PROPERTY PRACTICE GROUP
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BOSTON, MA 02205

Date:

MAILED

DEC 0 2 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008869
PATENT NO. : 6886553
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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MAILED

DEC 0 2 2009

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In Re Daniel Yim :
Ex parte Reexamination Proceeding : **DECISION DISMISSING**
Control No. 90/08,869 : **PETITION TO STAY**
Filed: October 5, 2007 : ***EX PARTE* REEXAMINATION**
For: U.S. Patent No. 6,886,553 :

This is a decision on patent owner's October 9, 2009 "PETITION TO STAY *EX PARTE* REEXAMINATION PROCEEDING (37 CFR 1.182)".

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

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

A petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 was charged to petitioner's credit card as authorized by the October 9, 2009 EFS-WEB submission.

REVIEW OF THE RELEVANT FACTS

1. On May 3, 2005, United States Patent No. 6,886,553 (the '553 patent) issued to Daniel H. Yim.

2. On October 5, 2007, a request for *ex parte* reexamination of the '553 patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/008,869 (the '8869 reexamination proceeding).

3. On December 10, 2007, an order granting the'8869 *ex parte* reexamination request was mailed.

4. On December 25, 2007, a notice of the filing of the'8869 *ex parte* reexamination was published in the *Official Gazette*.

5. On March17, 2008, a non-final Office action was issued in the '8869 reexamination proceeding.

6. On May 19, 2008, patent owner filed a response in the '8869 reexamination proceeding, to include an amendment to the claims.

7. On April 7, 2009, a final Office action was issued in the '8869 reexamination proceeding.

8. On June 8, 2009, patent owner filed a response after final in the '8869 reexamination proceeding, to include another amendment to the claims.

9. On July 1, 2009, an advisory action issued in the '8869 reexamination proceeding denying entry of the June 8, 2009 after final response.

10. On August 5, 2009, patent owner filed a notice of appeal in the '8869 reexamination proceeding.

11. On October 5, 2009, patent owner filed an appeal brief in the '8869 reexamination proceeding.

12. On October 7, 2009, patent owner filed a reissue application for the '553 patent, which was assigned application number 12/575,049 (the '049 reissue application). The reissue application included a preliminary amendment to the claims, identical to the un-entered amendment after final in the '8869 reexamination proceeding, dated June 8, 2009. No Office action has been mailed in the '049 reissue application.

13. On October 9, 2009, patent owner filed a petition to stay the '8869 reexamination proceeding, which is the subject of this decision.

14. On November 24, 2009, a notice of the filing of a reissue application was published in the *Official Gazette* for the present reissue application.

A review of the prosecution history for the '8869 reexamination proceeding and the '049 reissue application reveals that the claims, as amended by the October 7, 2009 preliminary amendment filed in the '049 reissue application, are NOT identical to those of the '8869 reexamination proceeding in which patent owner is requesting a stay of proceedings.

DECISION

Under 37 CFR 1.565(d) states (in part):

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

The instant *ex parte* reexamination proceeding control number 90/008,869 and reissue application number 12/575,049 and are both currently pending for the same patent. As an order

has been mailed pursuant to 37 CFR 1.525 in the *ex parte* reexamination proceedings, and because both proceedings have been announced in the *Official Gazette*, a decision under 37 CFR 1.565(d) is timely.

MPEP 2285 states (in part):

> The general policy of the Office is that a reissue application examination and an *ex parte* reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both proceedings to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Accordingly, if both a reissue application and an *ex parte* reexamination proceeding are pending concurrently on a patent, a decision will normally be made (A) to merge the two proceedings or (B) to stay one of the two proceedings. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

MPEP 2285 II C states (in part):

> In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination. In addition, consideration will also be given to the status of the reexamination proceeding. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them.

In light of the above it is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time as to the same patent. 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. As pointed out above, the claims of the reissue application and the claims of the reexamination proceeding are NOT identical. Furthermore, it is untenable to guarantee that they can be made and maintained identical in two separate proceedings. As the two proceedings advance, the potential for continued and expanding inconsistencies and conflicts to develop between them will only grow. This would run contrary to the preventing of inconsistencies. The remaining alternatives are merger (consolidation) of the '049 reissue and the '8869 reexamination proceeding, or suspension of one of either the '049 reissue or the '8869 reexamination proceeding.

35 USC 305 states (in part) that "[a]ll reexamination proceedings under this section, including any on appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office." In this instance, the '8869 reexamination proceeding is at the appeal stage and has developed mature and focused issues of patentability. A substantial amount of prosecution has taken place in the '8869 reexamination proceeding. The request for reexamination was filed over two years after issuance of the patent and has been ongoing for over another two years, while the instant reissue application was not filed until after the '8869 reexamination proceeding was in the appeal process, *i.e.*, after the '8869 reexamination proceeding was on appeal and briefed by patent owner. It would be contrary to the 35 U.S.C.

305 unqualified statutory mandate of special dispatch to remove the '8869 reexamination preceding from the appeal process to merge it the present reissue application.[1]

In this instance, no Office action on the merits has been issued for the present '049 reissue application. The '049 reissue application was not filed until October 7, 2009, after the appeal in the '8869 reexamination proceeding had been initiated and briefed by patent owner.

In view of the above, merger of the present '049 reissue application with the '8869 reexamination proceeding will not be ordered. The remaining alternatives are suspension of the reissue proceeding or suspension of the '8869 reexamination proceeding. A suspension of the '8869 reexamination proceeding would result in an unsubstantiated delay that is contrary to the unqualified statutory mandate of special dispatch. Thus, it is the present '049 reissue application that must be suspended.

The reissue application includes amendments which patentee asserts as correcting an alleged error by narrowing the claims. If this "error" is grounded in the fact that the claims are "too broad" in light of the prior art of record in the '8869 reexamination proceeding, the patent owner had ample opportunity to address any concerns of undue breadth of the claims, during the '8869 reexamination proceeding, but failed to do so. In any event, patentee may call up the '049 reissue application for consideration at the conclusion of the '8869 reexamination proceeding.[2] However, in the event that a reexamination certificate should issue canceling all patent claims and not including any newly added claims, patent owner would need to file a grantable petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d) so that prosecution of the '049 reissue application could continue.

As a final point, if the present reissue was filed merely to continue the prosecution of the '8869 reexamination proceeding based on an unanticipated issue raised for the first time in the final rejection, to which all added claims are directed, such is not the purpose of the reissue statute. Rather, to address that situation, the Office issued a Notice [3] providing that a patent owner in a reexamination proceeding 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 as to entry of the amendment and/or evidence in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances, and patent owner could have filed such a petition prior to filing the appeal brief. On the other hand, if the reissue application was filed merely to provide new argument, patent owner could have been provided such in the '8869 reexamination proceeding via the appeal brief, the reply brief, or both. If neither of these

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[1] As pointed out in MPEP § 2285, part II C, "if the reexamination proceeding is on appeal ..., 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."

[2] Patent owner filed the reissue application prior to publication of a reexamination certificate for the patent.

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

applies, patent owner cannot be permitted to delay the prosecution of the reexamination proceeding by adding new issues to that proceeding by way of merger.

In view of the above, the petition to stay the '8869 reexamination proceeding in favor of the '049 reissue application is DISMISSED. Based upon the above, a decision is being concurrently issued, *sua sponte* suspending action in the '049 reissue application pursuant to 37 CFR 1.103(e) in favor of the '8869 *ex parte* reexamination proceeding.

CONCLUSION

1. Patent owner's October 9, 2009 "PETITION TO STAY *EX PARTE* REEXAMINATION PROCEEDING (37 CFR 1.182)" is dismissed.

2. On an even date, a decision is being mailed in the '049 reissue application *sua sponte* suspending action in the '049 application pursuant to 37 CFR 1.103(e), until completion of the'8869 *ex parte* reexamination proceeding.

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

4. Telephone inquiries relating 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
Office of the Deputy Commissioner
for Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,873	10/09/2007	6186842	31171/10001	2243

46260 7590 08/04/2009

BRINKS HOFER GILSON & LIONE/PML
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2009

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Date:
MAILED
AUG 04 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008873
PATENT NO. : 6186842
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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Brinks Hofer Gilson & Lione
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Chicago, Illinois 60610

(Patent Owner)

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AUG 04 2009

CENTRAL REEXAMINATION UNIT

Marshall, Gerstein & Borun LLP
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(Third Party Requester)

In re Hirschbold *et al.*
Reexamination Proceeding
Control No.: 90/008,873
Filed: October 9, 2007
For: U.S. Patent No.: 6,186,842

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

This is a decision on the July 20, 2009 patent owner petition under 37 CFR 1.182 requesting the Office to enter and consider an information disclosure statement (IDS) filed after the termination of the prosecution in the above captioned 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 20, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. On February 13, 2001, the Office issued U. S. patent number 6,186,842 (the '842 patent).
2. On October 9, 2007, a request for reexamination of the '842 patent, assigned reexamination control no. 90/008,873 (the '8873 proceeding), was filed by a third party requestor.
3. On November 9, 2007, the Office ordered reexamination of the '842 patent in the '8873 proceeding.
4. The proceeding progressed to the point where, on July 17, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the '8873 proceeding.
5. On July 20, 2009, patent owner filed the instant petition, accompanied by a new Information Disclosure Statement (IDS), which patent owner requests the Office to consider.
6. The reexamination proceeding is being processed toward publication of the reexamination certificate.

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 item (A) and (B) because it fails to include a full factual accounting to explain why the information submitted could not be submitted earlier and an adequate explanation of the relevance of information submitted with respect to the claimed invention in the reexamination proceeding.

In regard to providing a factual accounting to explain why the information could not be submitted earlier, it appears that the petition is attempting to explain why Brinks Hofer Gilson & Lion could not have submitted the IDS earlier, but does not explain why patent owner could not have submitted the IDS earlier. The petition indicates that a proceeding involving the '842 patent had produced expert reports with a significant amount of material and new references. Patent owner states that the expert reports were given to patent owner's counsel at Dykema Gossett on June 18, 2009. Patent owner further states that the expert reports were given to counsel at Brinks Hofer Gilson & Lione on July 6, 2009. Finally, the patent owner asserts that counsel at Brinks Hofer Gilson & Lione gathered copies of the references and submitted them along with the present petition and an Information Disclosure Statement on July 20, 2009. This is not a full factual accounting in accordance with MPEP 2256 guidance. At page 3 of the petition, it states:

> "During this litigation, several expert reports were filed. These expert reports generated a significant amount of material and new references. One of these expert reports related to the '842 Patent."

What is not stated is when during the litigation the expert report related to the '842 patent was generated. In addition, the expert reports were provided to patent owner's counsel at Dykema Gossett more than a month before the present petition was filed, and the submitted factual accounting is not sufficient to explain why the expert report could not have been provided sooner by the counsel at Dykema Gossett to counsel at Brinks Hofer Gilson & Lione. Further, there is no explanation as to why counsel at Dykema Gossett could not have prepared and filed the IDS. In addition, the petition states a delay in locating copies of references, but that is no explanation of why they could not have been located and submitted earlier, including the efforts made to do so, and when these efforts were made. Accordingly, patent owner has failed to satisfy the MPEP 2256, item (A), requirement for submission of a post NIRC IDS.

In regard to explaining the relevance of the submitted information (B), the patent owner only makes vague statements regarding the relevance of the information. Patent owner states that the expert report provided an opinion in regards to the validity of the patent in this reexamination. However, this is not an adequate explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding as required by MPEP 2256. While discussing each submitted cited reference, the patent owner provided little or no information as to why it would be relevant to the claim limitations in the present proceeding. For example, some references were provided with the explanation of relevance as "no further explanation" which is an insufficient explanation of its relevancy. As justification for the delay in submitting the IDS, patent owner asserts that the delay was caused by reviewing the expert reports, determining whether they were cumulative or not to references previously cited, and evaluating the references for their relevancy to the claimed invention of the reexamination proceeding. However, despite going through this lengthy process of assessing relevancy of the references, patent owner does not adequately explain the relevancy of the references 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 a post NIRC IDS.

In summary, patent owner does not make a full factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; nor does patent owner provide the requisite 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 IDC 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 July 17, 2008, and the proceeding is in 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 and the submitted information considered, 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 not granted 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).

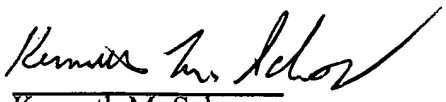
The IDS submitted by patent owner will be placed in the file, and will remain of record. However, because prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

CONCLUSION

1. The petition is **dismissed** as to the request for consideration of the IDS filed on July 20, 2009.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will be placed in the electronic file for the proceeding.

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



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

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.
90/008,877	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

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.
90/008,369	01/24/2007	5,601,741	70465.00008.RE04	9971

7590 11/26/2008

EXAMINER	

GEORGE R. CORRIGAN
CORRIGAN LAW OFFICE
5 BRIERCLIFF CT.
APPLETON, WI 54915

ART UNIT	PAPER NUMBER

DATE MAILED: 11/26/2008

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

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)

MAILED

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
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.

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

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

Peng Chen and Elizabeth Cary Miller (For Patent Owner)
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

Audrey A. Millemann (For Third Party)
Weintraub Genshlea Chediak Law Corporation
400 Capitol Mall, 11th floor
Sacramento, CA 95814

Helena C. Richlicki, Esq. (For Third Party)
Connally Bove Lodge & Hutz LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

MAILED

OCT 07 2008

CENTRAL REEXAMINATION UNIT

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control Number: 90/008,592
Filed: April 12, 2007
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control Number: 90/008,879
Filed: October 16, 2007
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control Number: 90/009,066
Filed: March 3, 2008
For: U.S. Patent 6,010,729

DECISION MERGING REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,010,729 issued January 4, 2000, is the subject of Reexamination Control Nos. 90/008,592, 90/008,879 and 90/009,066.

2. A first request for Reexamination, assigned Reexamination Control No. 90/00,592, was filed April 12, 2007 for the Patent Owner by Peng Chen and Elizabeth Cary Miller of Morrison & Foerster, LLP in San Diego, CA. The request urged that a substantial new question of patentability was raised by newly cited references and by references that were previously cited but not applied in a rejection regarding claims 1-7,9, 13, 16, 17 and 21.

3. Reexamination was ordered for 90/008,592 on July 11 2007.

4. No Patent Owner's response was received in the 90/008,592 proceeding.

5. A second request for Reexamination, assigned Reexamination Control No. 90/008,879, was filed October 18, 2007 for a Third Party Requester by Audrey A. Millemann of Weintraub Genshlea Chediak Law Corporation in Sacramento, California. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1-9, 13, 17 and 21.

6. Reexamination was order for 90/008,879 on January 11, 2008.

7. No Patent Owner's response was received in the 90/008,879 proceeding.

8. A third request for Reexamination, assigned Reexamination Control No. 90/009,066, was filed March 3, 2008 for a Third Party Requester by Helena C. Richlicki of Connolly, Bove, Lodge & Hutz LLP in Wilmington, Delaware. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1, 7, 17 and 22

9. Reexamination was order for 90/009,066 on May 20, 2008.

10. No Patent Owner's response was received in the 90/009,066 proceeding.

LEGAL BASIS

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 paragraph 1.570.

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

If the second request is based upon essentially the same patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as 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

In accordance with 37 C.F.R. 1.565(c), the 90/008,592, 90/008,879 and 90/009,066 proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements. 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 duplicate**, each bearing a signature and identifying data for **all** files, for entry into each file. See MPEP 2283, "Merger of Reexaminations."

CONCLUSION

Reexamination Control Nos. 90/008,592, 90/008,879 and 90/009,066 are merged. **Since there has been no amendment in any of the files, the requirement to file a "housekeeping amendment" is waived.** The merged reexamination files are being forwarded to the examiner for preparation of an Office action to be issued in due course.

CORRESPONDENCE

All correspondence from the USPTO will be addressed to the Patent Owner's representative address listed in Reexamination Control Nos. 90/008,592, 90/008,879 and 90/009,066 as:

Peng Chen and Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control No. 90/008,879 as:

Audrey A. Millemann
Weintraub Genshlea Chediak Law Corporation
400 Capitol Mall, 11th floor
Sacramento, CA 95814

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control No. 90/009,066 as:

Helena C. Richlicki, Esq.
Connally Bove Lodge & Hutz, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

for Gregory A. Morse, Director
Central Reexamination Unit

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

Peng Chen and Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

(for Patent Owner)

MAILED

JUN 19 2009

Audrey A. Millemann
WEINTRAUB GENSHLEA CHEDIAK LAW CORP.
400 Capitol Mall, 11th Floor
Sacramento, CA 95814

(for Third Party)

CENTRAL REEXAMINATION UNIT

Helena C. Richlicki, Esq. and Robert G. McMorrow, Esq.
CONNALLY BOVE LODGE & HUTZ, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

(for Third Party)

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,592
Filed: April 12, 2007
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,879
Filed: October 16, 2007
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/009,066
Filed: March 3, 2008
For: U.S. Patent 6,010,729

In re: Gutzmann et al.
Ex Parte Reexamination Proceeding
Control No.: 90/010,462
Filed: March 20, 2009
For: U.S. Patent 6,010,729

DECISION MERGING REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. United States Patent 6,010,729, issued January 4, 2000, is the subject of Ex Parte Reexamination Control Nos. 90/008,592; 90/008,879; 90/009,066; and 90/010,462.

2. A first request for Ex Parte Reexamination, assigned Reexamination Control No. 90/008,592 ('8592), was filed April 12, 2007 for the Patent Owner by Peng Chen and Elizabeth Cary Miller of Morrison & Foerster, LLP in San Diego, California. The request urged that a substantial new question of patentability was raised by newly cited references and by references that were previously cited but not applied in a rejection regarding claims 1 - 7, 9, 13, 16, 17, and 21.

3. Reexamination was ordered for 90/008,592 on July 11, 2007.

4. No Patent Owner statement was received in the 90/008,592 proceeding.

5. A second request for Ex Parte Reexamination, assigned Reexamination Control No. 90/008,879, was filed on October 16, 2007 for a Third Party Requester by Audrey A. Millemann of Weintraub Genshlea Chediak Law Corporation in Sacramento, California. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1 - 9, 13, 17, and 21.

6. Reexamination was ordered for 90/008,879 on January 11, 2008.

7. No Patent Owner statement was received in the 90/008,879 proceeding.

8. A third request for Ex Parte Reexamination, assigned Reexamination Control No. 90/009,066, was filed March 3, 2008 for a Third Party Requester by Helena C. Richlicki of Connolly, Bove, Lodge & Hutz, LLP in Wilmington, Delaware. The request urged that a substantially new question of patentability was raised by newly cited references and references that were previously cited but not applied in a rejection regarding claims 1, 7, 17, and 22.

9. Reexamination was ordered for 90/009,066 on May 20, 2008.

10. No Patent Owner's statement was received in the 90/009,066 proceeding.

11. A Decision Merging Reexamination Control Nos. 90/008,592; 90/008,879; and 90/009,066 was mailed on October 7, 2008.

12. A non-final Office action was mailed on October 30, 2008.

13. Personal Interview with the Examiner on December 9, 2008.

14. Patent Owner filed an amendment on December 30, 2008 and a corrected amendment on January 2, 2009.

15. A fourth request for Ex Parte Reexamination, assigned Reexamination Control No. 90/010,462 was filed on March 20, 2009 for a Third Party Requester by Robert G. McMorrow of Connally, Bove, Lodge & Hutz, LLP in Wilmington, Delaware. The request urged that a substantially new question of patentability was raised by a newly cited reference and references that were previously cited but not applied in a rejection regarding claims 1, 4 - 9, 13, 16, 17, 21, 22, 25 - 29, 31, 34, 35, 39, 40, and 43 - 47.

16. Reexamination was ordered for 90/010,462 on April 28, 2009.

17. Patent Owner filed a "Waiver of the Right to File a Statement under 37 CFR 1.530" on May 18, 2009.

LEGAL BASIS

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 paragraph 1.570.

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,592; 90/008,879; 90/009,066; and 90/010,462 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 all four files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of this 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 quadruplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

CORRESPONDENCE

All correspondence from the USPTO will be addressed to the Patent Owner's representative address listed in Reexamination Control Nos. 90/008,592; 90/008,879; 90/009,066 and 90/010,462.

Peng Chen and Elizabeth Cary Miller
MORRISON & FOERSTER, LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control No. 90/008,879 as:

Audrey A. Millemann
WEINTRAUB GENSHLEA CHEDIAK LAW CORP.
400 Capitol Mall, 11th Floor
Sacramento, CA 95814

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control Nos. 90/009,066 and 90/010,462

Helena C. Richlicki, Esq. and Robert G. McMorrow, Esq.
CONNALLY BOVE LODGE & HUTZ, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

CONCLUSION

Reexamination Control Nos. 90/008,592; 90/008,879; 90/009,066 and 90/010,462 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

for Deborah Jones
Greg Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JUN 13 2008

CENTRAL REEXAMINATION UNIT

CARL KLING
22 ANNADALE STREET
ARMONK NY 10504

(For Patent Owner)

MORRISON & FOERSTER LLP
Attn: Robert A Saltzberg
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

(For Third Party Requester)

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

In re: Jain
Ex Parte Reexamination Proceeding
Control No. 90/008,881
Deposited on: 16 October 2007
For: US Patent No. 4,924,257

This is a decision on the 5 June 2008 , petition for "Request Under 37 CFR § 1.550 (c) for Extension of time," requesting that the time for responding to the Office action mailed 22 May 2008 be extended by two-months.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 22 May 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 5 June 2008, together with the $200.00 petition fee required by 37 CFR § 1.515(c) and § 1.17(g).

37 CFR § 1.550 (c) states:

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

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

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

Analysis and Findings

The petitioner representing the patent owner states that the Office action is extremely long action of 188 pages with numerous prior art references and highly technical and complex subject matter of micro lithography. The Office action is in fact 17 pages but does make reference to the claim charts of the request. The patent owner also noted that there are two holidays in the time period for response and the plans to schedule an interview. As well as Jury Duty of the lead counsel. While interviews and holidays are not typically considered to support "sufficient cause' for the purpose of granting an extension of time, on balance, given the extensive Office action and the complexity of the subject matter under reexamination, the request for extension of time is considered to support a one-month extension of time.

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

Conclusion

1. The patent owner's petition for extension of two-months time in which to file a response to the Office action dated 22 May 2008 is **granted in part**.

2. A one-month extension of time is hereby granted.

3. The Patent Owner's response is due **22 August 2008**.

4. Response may be submitted as follows:

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

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

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner at (571) 272-1611 or Eric Keasel, Supervisory Patent Examiner at (571) 272-4929, in the Central Reexamination Unit, Art Unit 3992.

MARK J. REINHART
CRU SPE-AU 3992

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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(For Patent Owner)

MAILED
APR 01 2009
CENTRAL REEXAMINATION UNIT

Robert A. Saltzberg
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425 MARKET STREET
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(For Third Party Requester)

DECISION GRANTING PETITION UNDER 37 CFR § 1.59 (b) TO EXPUNGE INFORMATION

In re: Kantilal Jain
Ex Parte Reexamination Proceeding
Control Number 90/008,881
Deposited on: 16 October 2007
For U.S. Patent No. 4,924,257

This is a decision on the 30 September 2008, Patent Owner requested petition titled "Petition to Expunge Information." This petition considers under 37 CFR 1.59 (b) a request to expunge materials submitted by the Patent Owner with the Information Disclosure Statement (IDS) also filed 30 September 2008. The petition was filed in a timely manner with the authorization for the appropriate fee from a deposit account pursuant to 37 CFR § 1.17 (g).

The petition is hereby granted.

REVIEW OF RELEVENT FACTS

1. US Patent No 4,924,257 was granted on 8 May 1990.

2. On 16 October 2007 a third party requester requested *ex parte* reexamination of US Patent No. 4,924,257 which is identified under control no. 90/008,881.

3. The Order was granted for reexamination on 29 November 2007.

4. Documents were filed as "confidential" with the required petition on 30 September 2008.

CITATION OF APPROPRIATE PROCEDURE

37 CFR § 1.59 (in-part)
Expungement of information or copy of papers in application file.

(a)

(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

....

MPEP § 724.04

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR § 1.11(d) will be treated in the following manner:

(A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR § 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a

reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.

(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR § 1.11(d).

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR §1.59(b) will be treated in accordance with MPEP § 724.05.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR § 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

(A) a clear identification of the information to be expunged without disclosure of the details thereof;

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

(E) the fee as set forth in 37 CFR § 1.17(g) for a petition under 37 CFR § 1.59(b).

DECISION

The petitioner seeks to have the "Confidential" materials "expunged if and when they are found not to be material to the patentability of the '257 patent." Since the examiner has prepared the Notice of Intent to Issue a Re-examination Certificate (NIRC) and determined that the submission is not material to the patentability of the claims before the examiner for *ex parte* reexamination in the proceeding identified by control number 90/008,881, the documents are expunged. Further the petitioner has met the requirements pursuant to 37 CFR § 1.59(b) and MPEP § 724.

The petitioner has committed to retain the materials for the period of the '257 patent.

Since the petitioner has fully complied with the requirements and the submission is not material to the patentability of the claims before the Office in this proceeding, the petition is hereby granted.

The materials submitted as Confidential are hereby returned to the petitioner.

CONCLUSION

1. The petition to expunge documents submitted by the patent owner on 30 September 2008 as confidential is hereby **granted**

2. The confidential submission is hereby **returned** to the petitioner.

3. The patent owner is reminded that for compliance pursuant to MPEP § 724.05 the submission will be retained for the period of the patent.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

_____

Gregory Morse
Director,
Central Reexamination Unit 3999

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.
90/008,890	11/08/2007	5884096	2540-1086	7904

42624 7590 10/09/2008

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MAILED

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CENTRAL REEXAMINATION UNIT

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(For Third Party

DECISION
GRANTING-IN-PART
PETITION FOR
EXTENSION
OF TIME
[37 CFR § 1.550(c)]

In re: Beasley *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,890
Deposited on: 8 November 2007
For: US Patent No. 5,884,096

This is a decision on the 3 October 2008, petition for "Petition Under 37 CFR § 1.1550 (c) for Extension of Time in an Ex Parte Reexamination" requesting that the time for responding to the Office action mailed 23 September 2008, be extended by one-month.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is granted-in-part for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 23 September 2008, which set a one-month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on 3 October 2008, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

Addressing the requirement of 37 CFR § 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

Analysis and Findings

On balance, there is always a question when considering the balance between the need for "special dispatch" and the need for a fair opportunity to respond to the outstanding Office action. The showing of sufficient cause is the criteria for this evaluation. In this petition the patent owner has not provided an explanation for sufficient cause as to why the time is needed and should be granted. Interviews with examiners are not considered to be sufficient cause to extend the period for response. While interviews with examiners are not normally considered sufficient cause for extension of time, since the examiner is out of the Office for a weeks period of time the time for response is granted-in-part. For any additional time there should be outlined in the petition exactly why the time is needed and how it is beyond the control of the patent owner to work within the time period set for response to said Office action.

The petition request is hereby **granted in part** for a period of one-week

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated 23 September 2008 is hereby **granted-in-part**

2. The period for response is extended by one-week.

3. The Patent Owner's response is due **30 October 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
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/Mark Reinhart/

Gregory Morse
Director,
Central Reexamination Unit 3999