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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,891	10/19/2007	5,543,047	22401-001RX1/0504649	1908

7590 04/23/2009

LEYDIG, VOIT & MAYER
700 THIRTEENTH STREET, N.W.
SUITE 300
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/23/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DOROTHY P. WHELAN
FISH & RICHARDSON P.C.
60 SOUTH SIXTH STREET, STE 3300
MINNEAPOLIS,MN 55402

Date: MAILED

APR 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008891
PATENT NO. : 5543047
ART UNIT : 3991

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

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

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www.uspto.gov

Leydig, Voit & Mayer
Suite 300
700 Thirteenth Street NW
Washington, DC 20005

(Patent Owner)

Fish & Richardson P.C.
60 South Sixth Street, Suite 3300
Minneapolis, MN 55402

(Third Party Requester)

MAILED

APR 23 2009

CENTRAL REEXAMINATION UNIT

In re Stoyell *et al.*
Reexamination Proceeding
Control No.: 90/008,891
Filed: October 19, 2007
For: U.S. Patent No.: 5,543,047

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the January 28, 2009 patent owner petition under 37 CFR 1.182, as supplemented on February 20, 2009, 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 January 28, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. On August 6, 1996, the Office issued U. S. patent number 5,543,047 (the '047 patent).
2. On October 19, 2007, a request for reexamination of the '047, assigned reexamination control no. 90/008,891 (the '8891 proceeding), was filed by a third party requestor.
3. On December 21, 2007, the Office ordered reexamination of the '047 patent in the '8891 proceeding.
4. The proceeding progressed to the point where, on December 19, 2008, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the '8891 proceeding.
5. On December 29, 2008, patent owner conducted an interview to discuss with the examiner of record a mis-categorization of the status of some of the claims as they appear on the face of USPTO form PTOL-469.
6. On January 8, 2009, the Office issued a Supplemental Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '8891 proceeding to correct the categorization of the claims as they appear in the status section on the face of USPTO form PTOL-469.

7. On January 16, 2009, patent owner conducted a second interview to discuss with the examiner of record another mis-categorization of the status of some of the claims as they appear on the face of USPTO form PTOL-469.

8. On January 28, 2009, patent owner filed the instant petition, accompanied by a new IDS, which patent owner requests the Office to consider.

9. On January 30, 2009, the Office issued a second Supplemental Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '8891 proceeding to make an additional correct the categorization of the claims as they appear in the status section on the face of USPTO form PTOL-469.

10. On February 20, 2009, patent owner filed a petition supplementing the January 28, 2009 petition.

11. 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 item (B), because there is no explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS item of information (the art citation) is relevant to the claim limitations in the present reexamination proceeding. To the contrary, patent owner expressly states that the prior art reference being submitted is not material to any of the pending claims in reexamination, and that the reference is merely cumulative of prior art already cited in the '8891 proceeding. The patent owner does provide a discussion of the substance of the information with respect to relevance to the claims, but rather provides discussion in terms as to how the reference is NOT relevant to the claim limitations in the present reexamination proceeding.

In summary, there is a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; however, there is no explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on December 19, 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 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 January 28, 2009, as supplemented on February 20, 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. 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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090618

DATE : June 29, 2009

TO SPE OF : ART UNIT 3991

SUBJECT : Request for Certificate of Correction on Patent No.: 5,543,047 C1

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

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

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

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

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

☒ **Approved** **All** changes apply.

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

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

Comments:

Office Mistake in Ex Parte Reexamination Certificate (6862nd) US 5,543,047 C1

SPE: Eric Keasel **Art Unit** 3992

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.: 5,543,047 C1

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

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

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

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

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

☒ **Approved** **All** changes apply.

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

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

Comments:

Office Mistake in Ex Parte Reexamination Certificate (6862nd) US 5,543,047 C1

SPE: Eric Keasel **Art Unit** 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,892	10/19/2007	5,690,765	22401-001RX2	2783

7590 03/31/2009

EXAMINER	

LEYDIG VOIT & MAYER
SUITE 300
700 THIRTEENTH STREET , N.W.
WASHINGTON, DC 20005

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2009

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Leydig, Voit & Mayer
Suite 300
700 Thirteenth Street NW
Washington, DC 20005

(Patent Owner)

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CENTRAL REEXAMINATION UNIT

Fish & Richardson P.C.
60 South Sixth Street, Suite 3300
Minneapolis, MN 55402

(Third Party Requester)

In re Stoyell et al.
Reexamination Proceeding
Control No.: 90/008,892
Filed: October 19, 2007
For: U.S. Patent No.: 5,690,765

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the January 28, 2009 patent owner petition under 37 CFR 1.182, as supplemented on February 20, 2009, 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 January 28, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. On November 25, 1997 the Office issued U. S. patent number 5,690,765 (the '765 patent).
2. On October 19, 2007, a request for reexamination of the '765, assigned reexamination control no. 90/008,892 (the '8892 proceeding), was filed by a third party requestor.
3. On December 20, 2007, the Office ordered reexamination of the '765 patent in the '8892 reexamination.
4. On December 19, 2008, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '8892 proceeding.
5. On January 2, 2009, the '8892 proceeding entered the printing cycle, for printing of a reexamination certificate.
6. On January 28, 2009, patent owner filed the instant petition, accompanied by a new IDS, which patent owner requests the Office to consider.

7. On February 20, 2009, patent owner filed a petition supplementing the January 28, 2009 petition.

8. On March 17, 2009, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (6697th), US 5,690,765 C1.

DECISION

The present reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (6697th), US 5,690,765 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the ' 765 patent. Therefore, the submission of information for consideration by the examiner is not authorized by statute. Accordingly, the petition is **dismissed.**

ADDITIONAL DISCUSSION

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on December 19, 2008, and the proceeding has now resulted in issuance of *Ex Parte* Reexamination Certificate (6697th), thereby divesting the Office of jurisdiction over the ' 765 patent. However, even had the petition been addressed prior to issuance of the certificate, the submitted IDS would not have had an entry right. Note the following discussion:

Patent owner filed the petition requesting consideration of information, well after issuance of a NIRC and after the '8892 proceeding had already entered the printing cycle for issuance of a reexamination certificate. 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. Note that, for *ex parte* reexamination, 35 U.S.C. 305 mandates that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Given that 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.*

The conditions for entry of an IDS after NIRC are explicitly set forth in MPEP 2656 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

Even had the petition been addressed prior to issuance of the certificate, the fact situation did not satisfy the above-cited conditions, grounded on the statutory requirement for special dispatch. The instant petition was filed very late in the examination of the reexamination. Petitioner has failed to provide a statement as to why the submitted information (an art citation) makes at least one claim unpatentable. To the contrary, patent owner expressly states that the prior art reference being submitted is not material to any of the pending claims in reexamination, and that the reference is merely cumulative of prior art already cited in the '8892 proceeding. Moreover, the patent owner does not provide an amendment along with an explanation as to how the amendment renders the claims patentable in light of the submitted prior art as applicable to the confirmed claims in the '8892 reexamination proceeding. Therefore, the present petition does not satisfy the conditions for consideration of an IDS after the proceeding had entered the print cycle, and would not have been granted in contravention of the statutory mandate for special dispatch.

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

Although the IDS submitted by patent owner is not being entered of record on the reexamination proceeding, it will remain in the file. However, since the proceeding has concluded by issuance of the *Ex Parte* Reexamination Certificate, the IDS will not, and cannot, be considered.

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 January 28, 2009, as supplemented on February 20, 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. 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.
90/008,894	11/27/2007	5,873,359		8547

26161 7590 03/12/2009

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BROOKE QUEST
STEPTOE & JOHNSON LLP
2121 AVENUE OF THE STARS SUITE 2800
LOS ANGELES, CA90067

Date:
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MAR 12 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008894
PATENT NO. : 5873359
ART UNIT : 3993

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

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

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(For Patent Owner)

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MAR 12 2009

CENTRAL REEXAMINATION UNIT

PAUL T. CLARK
FISH & RICHARDSON
225 FRANKLIN STREET
BOSTON, MA 02110-2804

(For Requester)

BROOKE QUIST
STEPTOE & JOHNSON LLP
2121 AVENUE OF THE STARS SUITE 2800
LOS ANGELES, CA 90067

In re Zapol et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 90/008,894	:	UNDER 37 CFR 1.181
Filed: November 27, 2007	:	
For: U.S. Patent No.: 5,873,359	:	

This is a decision on a petition filed by the patent owner on February 13, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181 TO WITHDRAW THE FINALITY OF THE DECEMBER 22, 2008 FINAL OFFICE ACTION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and withdraw the finality of the December 22, 2008 Office action.

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 February 13, 2009 is denied with respect to withdrawal the finality of the December 22, 2008 Office action.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,873,359 (hereinafter, the '359 patent) issued on February 23, 1999.

2. A corrected request for *ex parte* reexamination, assigned control No. 90/008,894 (hereinafter, the '359 proceeding), was filed by a third party requester on November 27, 2007.

3. *Ex parte* reexamination was ordered for the '359 proceeding on January 16, 2008.

4. On April 25, 2008, patent owner filed an information disclosure statement including 6 pages of cited patent documents, non-patent literature, and documents from foreign opposition proceedings and litigation proceedings.

5. On May 13, 2008, patent owner filed a second information disclosure statement including 8 pages of cited patent documents, non-patent literature, and documents from foreign opposition proceedings and litigation proceedings.

6. On May 14, 2008, patent owner filed a third information disclosure statement including 2 pages of cited patent documents, and non-patent literature.

7. On May 21, 2008, patent owner filed a fourth information disclosure statement including 3 pages of documents from litigation proceedings.

8. On May 23, 2008, the patent owner filed a preliminary amendment to the claims. The response included proposed amendments to claims 1, 7, 14, 23, 26, 41, 42, 45, 46, 51, 55, 60, 83, 92, 96, 97, 102, 105, 109, 110, 114, 116, 122, 126, and 130, and added proposed new claims 132-161.

9. On July 28, 2008, a non-final Office action, which rejected claims 1, 7, 14, 22, 23, 36-46, 51-68, 74, 80-85, 89, 92-97, 102-116, and 122-161 was mailed in the '359 reexamination proceeding.

10. On September 9, 2008, a personal interview was held. A brief telephone follow-up interview as held on September 11, 2008.

11. On September 26, 2008, the patent owner filed a response, including amendments to claims 1, 7, 14, 23, 26, 41, 42, 45, 46, 51, 55, 60, 83, 92, 96, 97, 102, 103, 109, 110, 114, 116, 122, 126, and 130, and added new claims 132-197 and filed declarations pertaining to secondary considerations.

12. On December 22, 2008, the Office issued a Final rejection Office action, which addressed the patent owner's response of September 26, 2008. The Office action rejected claims 1, 14, 36-39, 41-46, 55-58, 60-68, 74, 92-94, 96, 97, 105-107, 109-112, 114-116, 126-128, 130, 132-136, 140-143, 148-150, 154-157, and 161-197; objected to claims 163, 164, 171, 172, 180, 183, 186, 188, 191, and 194; and indicated claims 7, 17, 22, 23, 40, 51-54, 59, 80-85, 89, 95, 102-104, 108, 113, 122-125, 129, 131, 135, 137-139, 144-147, 151-153, and 158-160 as allowable.

13. On February 4, 2009, another personal interview was held.

14. On February 12, 2009, the patent owner filed a petition for a one month extension of time and the petition requesting withdrawal of the finality of the December 22, 2008 Office action.

15. On February 18, 2009, the Office granted the petition for the one-month extension of time.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding to make the December 22, 2008 final because many issues have not yet been fully clarified. These issues include:

1) whether the Examiner's new grounds of rejection of the claims subject to reexamination were in fact necessitated by patent owner's amendments to the claims, which governs the propriety of the final rejection;

2) the level of skill of one of ordinary skill in the art at the time the invention was made, a factor that must - as a matter of law - be considered in a proper obviousness analysis;

3) the probative value of patent owner's proffered evidence of commercial success - and what additional evidence of "nexus," if any, the Examiner would wish to see added to the present record;

4) the probative value of patent owner's proffered evidence of surprising results, long-felt need, skepticism of others, and tribute by others;

5) the probative value of an action taken by the European Patent Office in an opposition on a related case, and whether that means that the record should be expanded to include evidence of how the European Patent Office and other patent offices around the world have uniformly found the patent owner's claims to be nonobvious; and

6) the appropriate weight to be given to partisan statements made in declarations and expert reports authored by individuals hired by the patent owner's adversaries in prior litigation or in foreign opposition proceedings, and what additional evidence, if any, the Examiner would wish to see added to the present record to further rebut declarations and expert reports.

See pages 5-6 of the petition.

In response to patent owner's arguments that the examiner erred in deciding in deciding to make the December 22, 2008 final, 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. See MPEP 2272.

Turning to the facts in this proceeding, the Final rejection of December 22, 2008 sets forth substantially the same grounds of rejection based on prior art as set forth in the first Office action, except for the new ground of rejection to claims 1 and 14, and indicated many of the claims allowable. The patent owner has had two opportunities to enter amendments to the claims as a matter of right. The patent owner has not yet filed a response to the action of December 22, 2008. In the petition, patent owner alleges that the examiner erred in deciding to make the December 22, 2008 final because there are many issues that have not yet been fully clarified.

1. In support of this allegation, the patent owner explains how the amendment of September 26, 2009 to claim 1 and 14 did not necessitate the new ground of rejection. The patent owner does admit that the claims were amended to specifically define the nitric-oxide releasing compound as either a solid or liquid, but contends that the amendment did not change the scope of the claims and were made only for clarity. See page 6 of the petition. Looking at the new grounds of rejection, it is clear that the examiner applied the teachings of Contractor in response to the newly added limitations due to the amendment of September 26, 2008. While claims are read in light of the specification, limitations from the specification are not read into the claims. In addition, claims are given their broadest reasonable interpretation in reexamination proceedings. Accordingly, the examiner was not required to read into the claims the limitations set forth in the specification. Therefore, patent owner's argument that the amendment of September 26, 2008 did not change the scope of the claims is not persuasive.

   Patent owner also contends that the examiner's use of Kagawa as evidence in support of the rejection of Maeda in view of Oda, which was made in the first Office action of July 28, 2008 also provides a reason for why the finality of the December 22, 2008 Office action should be withdrawn. Upon review of the record, it is clear that Kagawa was cited by the patent owner in the information disclosure statement dated May 14, 2008. Therefore, the patent owner should have been aware of this reference. Furthermore, the Kagawa reference was discussed in the patent owner's response of September 26, 2008 (see pages 39-41 of the response). Therefore, the examiner also discussed and cited as evidence to rebut a point raised by the patent owner for the first time in their response dated September 26, 2008. As required by Office policies and procedures, the examiner must rebut any arguments set forth in the patent owner's response and must reflect reconsideration of the grounds of rejection. See MPEP 2271. The examiner followed Office procedures and policies by addressing the patent owner's arguments and supporting that rebuttal with evidence. Upon review, the

examiner's rebuttal is consistent with the prior position taken by the examiner in the first Office action, and therefore does not constitute a reason for withdrawing the finality of the December 22, 2008 Office action.

2. Patent owner states that the examiner's findings of fact regarding the level of ordinary skill in the art constitute grounds for withdrawing the finality of the action. See pages 7-9 of the petition. Upon review of the record, it is clear that the evidence used was to rebut a point raised by the patent owner for the first time in their response dated September 28, 2008. It is also clear that the evidence used was already of record from information disclosure statements filed by the patent owner in April and May of 2008. Therefore, the patent owner should have been aware of these references. The examiner followed Office procedures and policies by addressing the patent owner's arguments and supporting that rebuttal with evidence. Upon review, the examiner's rebuttal is consistent with the prior position taken by the examiner in the first Office action, and therefore does not constitute a reason for withdrawing the finality of the December 22, 2008 Office action.

3. Patent owner contends that the examiner did not address and appropriately weight the evidence of secondary considerations, and therefore, the finality of the December 22, 2008 Office action should be withdrawn. See pages 9-11 of the petition. First, it is noted that the examiner did indicate certain claims allowable based, in part, on the evidence submitted by the patent owner (e.g., see pages 29-31 of the December 22, 2008 Office action). Second, it is noted that the examiner provided specific reasons why the declaration alleging commercial success was not sufficient to over the obviousness rejection. See page 22 of the December 22, 2008 Office action. Patent owner states that because the examiner's position presenting secondary evidence is presented for the first time in the Office action of December 22, 2008, the finality of the Office should be withdrawn so the patent owner can respond. The record shows that patent owner submitted this evidence with the response of September 26, 2008. It was not possible for the examiner to respond to the evidence in the first Office action. Also, in order for secondary evidence to be entitled to substantial weight, the patent owner should establish a nexus between the rebuttal evidence and the claimed invention, i.e., objective evidence of nonobviousness must be attributable to the claimed invention. The Federal Circuit has acknowledged that patent owner bears the burden of establishing nexus, stating:

> In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitute commercial success. C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 ([BPAI] 1990) (evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

As stated above, the examiner evaluated this secondary evidence and clearly set forth explicit reasons why the evidence is not sufficient to overcome the obviousness rejection. In regards to the other secondary evidence, such as surprising results, long-felt need, etc..., this

evidence was submitted in response to the rejections of claims 51-54, 102-104, 122-125, 138, 139, 152, 153, 159, and 160 (see pages 48-54 of the September 26, 2008 response). The examiner withdrew the rejection of these claims and indicated such claims as allowable. Therefore, there is no apparent reason to address this other evidence. From the September 26, 2008 response, it is unclear if this evidence was intended to respond to other rejections. Upon review, the examiner's rebuttal is consistent with the Office's policies and procedures regarding consideration of secondary considerations, and therefore does not constitute a reason for withdrawing the finality of the December 22, 2008 Office action.

4. Patent owner contends that the examiner "unilaterally" credited the evidence of adversaries of the patent owner, and therefore the finality of the December 22, 2008 Office action should be withdrawn (see pages 11-12 of the petition). Upon review of the record, the director respectfully disagrees that the examiner "unilaterally" credited such evidence. As required by Office policies and procedures, the examiner weighed ***all*** the evidence of record, which includes the voluminous number of documents submitted by the patent owner. The patent owner should have been aware of these documents because they made such documents of record. The examiner did specifically point to the evidence of record that presents opposing evidence to the evidence offered by the patent owner, and explained why the patent owner's evidence was not sufficient. In addition, the patent owner spend most of the one and one half hour interview on February 4, 2009 presenting their view point on the evidence the examiner cited in the December 22, 2008 action. Therefore, the patent owner's comments about being prejudice because of their lack of ability to respond are not persuasive. Upon review, the examiner's rebuttal is consistent with the Office's policies and procedures regarding consideration of patent owner's position, and therefore does not constitute a reason for withdrawing the finality of the December 22, 2008 Office action.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the action of December 22, 2008 should be made final in the interest of the statutorily mandate of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to make the Office action of December 22, 2008 final.

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 withdrawal of the finality of the December 22, 2008 action is denied.

2. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing

reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

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 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.
90/008,894	11/27/2007	5,873,359		8547

26161 7590 06/05/2009

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BROOKE QUEST
STEPTOE & JOHNSON LLP
2121 AVENUE OF THE STARS SUITE 2800
LOS ANGELES, CA90067

Date:
MAILED
JUN 052009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008894
PATENT NO. : 5873359
ART UNIT : 3993

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

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

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FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

(For Patent Owner)

Brooke Quist
Steptoe & Johnson LLP
2121 Avenue of the Stars, Suite 2800
Los Angeles, CA 90067

(For Third Party Requester)

In re Zapol *et al.*
Reexamination Proceeding
Control No.: 90/008,894
Filed: November 27, 2007
For: U.S. Patent No.: 5,873,359

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

This is a decision on the March 23, 2009 patent owner petition under 37 CFR 1.182 request for continued reexamination in the present proceeding.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was paid by check as of March 25, 2009.

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

REVIEW OF THE FACTS

1. On February 23, 1999, the Office issued U.S. Patent No. 5,873,359 (the '359 patent) to Zapol *et al.*

2. On November 27, 2007, a corrected request for *ex parte* reexamination of the '359 patent, assigned control number 90/008,894 (the '8894 proceeding), was filed by a third party requester.

3. On January 16, 2008, the Office issued an order granting the'8894 *ex parte* reexamination request.

4. On July 28, 2008, the Office issued a first Office action on the merits rejecting claims 1, 7, 14, 22-23, 36-46, 51-68, 74, 80-85, 89, 92-97, 102-116 and 122-161.

5. On September 26, 2008 patent owner filed a response amending claims 1, 7, 14, 23, 26, 41-42, 45-46, 51, 55, 60, 83, 92, 96-97, 102-103, 109-110, 114, 116, 122, 126 and 130,

adding new claims 132-197, and providing evidence in the form of declarations regarding secondary considerations and included remarks alleging patentability over the prior art of record.

6. On December 22, 2008, the Office issued a final Office action responsive to patent owner's September 26, 2008, rejecting claims 1, 14, 36-39, 41-46, 55-58, 60-68, 74, 92-94, 96-97, 105-107, 109-112, 114-116, 126-128, 130, 132-136, 140-143, 148-150, 154-157 and 161-197; objecting to claims 163-164, 171-172, 180, 183, 186, 188, 191 and 194; and confirming or designating as allowable claims 7, 17, 22-23, 40, 51-54, 59, 80-85, 89, 95, 102-104, 108, 113, 122-125, 129, 131, 135, 137-139, 144-147, 151-153 and 158-160.

7. On February 12, 2009, patent owner filed a petition under 37 CFR 1.181 requesting withdrawal of finality of the December 22, 2008 Office action.

8. On March 12, 2009, the Office issued a decision dismissing patent owner's February 12, 2009 petition requesting withdrawal of finality.

9. On March 23, 2009, patent owner filed a petition under 37 CFR 1.182 requesting continued reexamination in the '8894 proceeding. Concurrently with the petition, patent owner filed an after-final response to the December 22, 2008 final Office action. This petition is the subject of the instant decision.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '8894 reexamination proceeding to provide consideration of the response to the December 22, 2008 final Office action which accompanied the instant petition.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

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

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, because this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

Based on the facts and circumstances of the present case, Petitioner patent owner's response in the form of an amendment and remarks/arguments directed towards a determination of patentability is not a *bona fide* effort *in toto* to advance prosecution, and as such, the granting of the present petition is inconsistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner presents five arguments to justify the granting of the extraordinary relief of request for continued reexamination (RCR):

(1) The addition of new claims that embrace the written description's express definition of the claim term "therapeutically effective" while simultaneously maintaining other claim sets that would not contain such express limitations;
(2) The submission of additional declarations that contain a better explication of an existence of a nexus between the evidence of record regarding commercial success and the claimed invention;
(3) Additional arguments regarding the alleged unexpected results declarations of record as to the claimed invention;
(4) Additional arguments regarding the examiner's use of documentary evidence from parties to an European Patent Office (EPO) opposition proceeding of an EPO patent related to patent owner's '359 U.S. patent; and
(5) Additional arguments regarding the examiner's position in regards to the level of ordinary skill in the relevant field of endeavour for the '359 patent's invention.

Petitioner's first argument that continued reexamination should be granted due to patent owner's addition of a written description express definition for the claim term "therapeutically effective" in a newly presented claim after final is not persuasive. Even if this amendment were to render the *newly presented* claim as patentable, under the doctrine of claim differentiation, the other claims of record that do not contain the entire express definition for the claim term "therapeutically effective" could not be rendered patentable, as their different claim scope would still be different and broader, and subject to the same unpatentability determination made by the examiner. Therefore the addition of claims with the express definition does not advance prosecution by reducing issues and resolving or better defining issues for appeal, or issuance of a reexamination certificate, but instead just gives patent owner another opportunity to argue the claim construction regarding the claim limitation of "therapeutically effective" which was established and communicated to patent owner by dint of the analysis used by the examiner

during the open examination phase of the '8894 proceeding. Accordingly, patent owner's first argument is not persuasive.

Petitioner's second argument that continued reexamination should be granted is so that patent owner can, by dint of additional declarations, establish a nexus between the commercial success evidence of record and the claimed invention is not persuasive. Upon submission of the commercial success evidence, it was reasonably foreseeable that the examiner would undertake an analysis of the submission to insure that a sufficient nexus was established between the commercial success evidence submitted and the claimed invention as patent owner bears the burden for establishing the nexus. Therefore a full, complete and robust showing of the nexus should have been made at the time of the initial attempt to show commercial success. Furthermore, 37 CFR 1.116(e) permits the submission of an affidavit or other evidence after a final rejection in an *ex parte* reexamination, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. The patent owner, however, fails to provide any reason why the additional declarations are necessary and not earlier presented after the matter was pointed out in the final rejection. Therefore, patent owner has failed to provide good and sufficient reasons as to why these declarations should be entered or how the examiner's finding of a lack of a nexus was not reasonably foreseeable. Accordingly, patent owner's second argument is not persuasive.

Petitioner's third argument that continued reexamination should be granted is so that patent owner can further argue the merit of the evidence of unexpected results that is already of record in the '8894 proceeding. Patent owner alleges that the examiner did not communicate a full analysis of the unexpected results evidence to patent owner until the December 22, 2008 final Office action. Petitioner's fourth argument that continued reexamination should be granted is so that patent owner can further argue the lack of merit in the examiner's reliance upon documentary evidence generated by an EPO opposition proceeding regarding the EPO patent equivalent to the '359 U.S. patent, until the December 22, 2008 final Office action where the examiner cited, commented on, analyzed and weighed all the evidence. These arguments would be persuasive, if the March 23, 2009 submission were solely limited to addressing the matters of these arguments. The submission is not so limited.

Petitioner's fifth and final argument that continued reexamination should be granted is so that patent owner can further argue the level of skill in the relevant art form which the claimed invention should be analyzed because the examiner did not expressly state the level of ordinary skill until the December 22, 2009 final Office action is not persuasive. The appropriate level of skill in the relevant art can be reflected by the prior art references.[2] Patent owner raised the issue of level of skill in the relevant art in their September 28, 2008 response to the July 28, 2008 Office action. The examiner responded to patent owner's September 28, 2008 arguments regarding level of skill and cited to prior art references that were already of record. Therefore, the issues was not *sua sponte* raised for the first time by the examiner in the final Office action, and patent owner was on notice regarding the appropriate level of skill in the art as reflected by the prior art references of record that the examiner cited to when responding to patent owner's arguments regarding the matter. Furthermore, the examiner's position expressed was not

[2] See MPEP 2141.03 (II)

inconsistent with the evidence of record regarding the level of skill in the art. Accordingly the actions taken were not reasonably unforeseeable and therefore patent owner's argument is not persuasive. Also, any argument patent owner wishes to make as to this matter could have gained entry if filed after final rejection without the amendment and evidence, and such argument can be made on appeal.

In view of the above and the fact situation presented by the record, the petition is dismissed, and jurisdiction of the proceeding is returned to the Central Reexamination Unit (CRU) to proceed with examination of the proceeding in accordance with its current stage of prosecution.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The '8894 *ex-parte* reexamination proceeding will continued its current patent reexamination process.

3. Jurisdiction for the '8894 reexamination proceeding is returned to the CRU.

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

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

June 3, 2009
C:\Kiva\Kenpet7\RCR\

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,897	10/23/2007	6,017,598	307910.3027734	1315

26646 7590 07/08/2008

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2008

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Joyce Ram
Kenyon & Kenyon LLP
1500 K Street N.W.
Suite 700
Washington, D.C. 20005-1257

(For Patent Owner)

FAX RECEIVED

JUL 08 2008

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceedings
Kreischer et al.
Control No. 90/008897
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 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 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 at 571-272-7710.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,903	12/26/2007	5819292		4100

7590 09/05/2008

Steven A. Swernofsky
P.O. BOX 640640
San Jose, CA 95164-0640

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/05/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Ronald L. Yin

DLA Piper vs LLP

2000 University Avenue

East Palo Alto, CA 94303-2248

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,903*.

PATENT NO. *5891292*.

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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CENTRAL REEXAMINATION UNIT

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210

(For Patent Owner)

DLA Piper US LLP
2000 University Avenue
East Palo Alto, CA 94303

(For Third Party Requester)

In re Hitz *et alia*
Reexamination Proceeding
Control No. 90/008,903
Request Deposited: October 25, 2007
For: U.S. Patent No. 5,819,292

In re Hitz *et alia*
Reexamination Proceeding
Control No. 90/009,103
Request Deposited: April 4, 2008
For: U.S. Patent No. 5,819,292

: 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. 5,819,292 (hereinafter, the '292 patent), issued to Hitz *et alia*, on October 6, 1998.

2. On October 25, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '292 patent. The reexamination proceeding was assigned Control No. 90/008,903 (hereinafter, the '8903 proceeding).

3. The Reexamination Order was granted in the '8903 proceeding on March 18, 2008.

4. There are currently no amendments in the '8903 proceeding.

5. On April 4, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '292 patent. The reexamination proceeding was assigned Control No. 90/009,103 (hereinafter, the '9103 proceeding).

6. The Reexamination Order was granted in the '9103 proceeding on June 6, 2008.

7. There are currently no amendments in the '9103 proceeding.

8. The '8903 and '9103 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 '8903 and the '9103 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. 90/008,903 and 90/009,103 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 /G

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,903 90/009,103	12/26/2007	5819292	112056-0499C1RX	4100

24267 7590 09/08/2009

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RONALD L. YIN
DLA PIPER, US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

Date:
MAILED
SEP 08 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008903, 90/009,103
PATENT NO. : 5819292
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

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

(For Patent Owner)

Ronald L. Yin
DLA Piper US LLP
2000 East University Ave
East Palo Alto, CA 94303

(For Third-Party Requester)

In re Hitz *et alia*
Reexamination Proceeding
Control No. 90/008,903
Request Deposited: October 25, 2007
For: U.S. Patent No. 5,819,292

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

In re Hitz *et alia*
Reexamination Proceeding
Control No. 90/009,103
Request Deposited: April 14, 2008
For: U.S. Patent No. 5,819,292

This is a decision on the September 2, 2009, "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R §1.550(c)" requesting that the time to submit a Patent Owner response be extended "for additional time beyond the shortened statutory period".

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No5,819,292 (hereinafter, the '292 patent), issued to Hitz *et alia*, on October 6, 1998

2. On October 25, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '292 patent. The reexamination proceeding was assigned Control No. 90/008,903(hereinafter, the '8903 proceeding).

3. The reexamination order was granted in the '8903 proceeding on March 18, 2008.

4. On April 4, 2008 , a third party deposited a Request for *Ex Parte* Reexamination of the '292 patent. The reexamination proceeding was assigned Control No. 90/009,103 (hereinafter, the '9103 proceeding).

5. The reexamination request was granted in the '9103 proceeding and the two proceedings were merged on October 25, 2007.

6. Later in prosecution of the merged proceeding, a final office action was mailed on June 16, 2009.

7. An after final amendment was filed on August 17, 2009. No advisory has mailed to date.

8. A petition for extension of time was received on September 2, 2009.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response. 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 2, 2009, 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.

MPEP 2272 states:

The statutory period for response to a final rejection in a reexamination proceeding will normally be two (2) months. If a response to the final rejection is filed, the time period set in the final rejection continues to run. The time period is automatically extended by 1 months (in accordance with the guidelines set for the in MPEP 2265) if the response is the first response after the final rejection and a notice of appeal has not yet been filed. Any advisory Office action using form PTOL -467, *Ex Parte* Reexamination Advisory Action Before the Filing of an Appeal Brief, which is issued in reply to patent owner's response after final rejection (and prior to the filing of the notice of appeal) will inform the patent owner of the automatic 1 month extension of time. It should be noted that the filing of any timely first response to a final rejection (even an informal response or even a response that is not signed) will automatically result in the extension of the shortened statutory period for an additional month. Note further that the patent owner is entitled to know the examiner's ruling on a timely response file after final rejection before being required to file a notice of appeal. Notification of the examiner's ruling should reach the patent owner with sufficient time for the patent owner to consider the ruling and act on it. Accordingly, the period of response to the final rejection should be appropriately extended in the examiner's advisory action. See *Theodore Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPW@d 1787 (D.D.C. 1988). The period for response may not, however, be extended to run past 6 months from the date of the final rejection.

Analysis and Findings

Patent owner petitions for a one month extension of time, up to and including October 16, 2009 to further respond to or appeal from the outstanding Final Office Action. Patent owner is of the postion that the filing of the after final response on August 17, 2009 extended the response period one month and is requesting addition time to further respond as no response has been received from the examiner. However, as explained in MPEP 2272, the automatic 1 month extension of time effectuated by the filing of a timely response after final in a reexamination proceeding is noticed in any advisory action issued by the examiner (such as the situation where the proposed after final response does not result in the issuance of a Notice of Intent to Issue Reexamination Certificate). It is not triggered by the filing of the after final response. Rather the time is extended from the final rejection by the examiner in the advisory action and will give owner sufficient time (usually at least one additional month from the mailing date of the advisory) to consider the examiner's response and take appropriate action. Accordingly, any advisory action issued in the instant proceeding will notice owner of the automatic extension and re-set the period for response running from the final rejection a sufficient number of months so as to ensure owner has at least one additional month to consider the advisory action and act upon it. The instant petition is premature.

CONCLUSION

1. Petitioner's request is **dismissed** as premature. The period during which Patent Owner may file a response to the final rejection remains running from the date of the Final rejection. Any extension thereto will be noticed in any forthcoming Advisory Action.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to J. Harrison at (517) 272-4449, Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

/J. Harrison/ for

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,903	12/26/2007	5819292	112056-0499C1RX	4100

24267 7590 09/11/2009

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RONALD L. YIN
DLA PIPER, US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

Date: MAILED

SEP 11 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008903
PATENT NO. : 5819292
ART UNIT : 3992

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

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

Commissioner for Patents
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Duane H Dreger
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

(For Patent Owner)

MAILED

SEP 11 2009

CENTRAL REEXAMINATION UNIT

Ronald L Yin
DLA PIPER LLP (US)
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

(For Third Party Requester)

In re: David Hitz *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,903
Deposited: 26 December 2007
For: US Patent No. 5,819,292

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

In re: David Hitz *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,103
Deposited: 04 April 2008
For: US Patent No. 5,819,292

This is a decision on the 02 September 2009, "Request for Extension of Time Pursuant to 37 CFR §1.550(c)" requesting that the time for responding to the Final Office action be extended by one (1) month. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g).

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

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

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to Final Office action, which set a two (2) months date for filing a response thereto. An after Final amendment was timely submitted 17 August 2009. The petition for extension of time was filed on 02 September 2009. An advisory action extending the period for response to four (4) months was mailed on 08 August 2009

The extension of time is dismissed as moot

37 CFR § 1.550 (c) states:

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

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

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

MPEP 2265 (in-part)

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

ANALYSIS AND FINDINGS

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

The patent owner timely submitted an after Final amendment on 17 August 2009. The patent owner sought an extension of time awaiting the response from the examiner. The examiner extended the period for response in the advisory Office action mailed 08 September 2009 to four (4) months. The examiner's action meets the time requested by the patent owner. In light of the examiner's extension of time the petition is dismissed as moot.

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

CONCLUSION

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

2. The time to respond to the Final office action continues to run four (4) months from the date of the Final Office action mailed on 16 June 2009.

3. Response is due on **16 October 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

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.
90/008,903	12/26/2007	5819292	112056-0499C1RX	4100

24267 7590 01/05/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RONALD L. YIN
DLA PIPER, US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

Date:
MAILED

JAN 05 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008903
PATENT NO. : 5819292
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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,103	04/04/2008	5819292	112056-0499C1RX	5691

24267 7590 01/05/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

Date:
MAILED

JAN 05 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009103
PATENT NO. : 5819292
ART UNIT : 3992

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JAN 05 2010

CENTRAL REEXAMINATION UNIT

MICHAEL E. ATTAYA
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

:(for Owner)

RONALD YIN
DLA PIPER LLP (US)
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

:(for Requester)

In re Application of: Hintz et alia
Control No.: 90/008,903
Deposited: December 26, 2007
For: US Patent No. 5,819,292

DECISION ON PETITION
Under 37 CFR 1.59

In re Application of: Hintz et alia
Control No.: 90/009,103
Deposited: April 4, 2008
For: US Patent No. 5,819,292

This is a response to the petition under 37 CFR 1.59(b), filed on October 15, 2009 by which petitioners request to expunge information from the above identified proceeding.

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 fee of $ 200 required by 37 CFR 1.17(g) has been charged to Deposit Account No. 03-1237.

The petition is hereby dismissed.

REVIEW OF RELEVENT FACTS

1. On December 26, 2007 a third party requester requested *ex parte* reexamination of US Patent No. 5,819,292 which is identified under control no. 90/008,903.

2. On April 4, 2008 a third party requester requested *ex parte* reexamination of US Patent No. 5,819,292 which is identified under control no. 90/009,103.

3. Both requests were granted for *ex parte* reexamination and the two proceedings merged into a single proceeding on September 5, 2008.

4. Prosecution has continued and a final Office action was mailed on June 16, 2009.

5. On October 15, 2009 the instant petition with artifacts under seal were filed.

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(c) (in-part)

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

(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

Petitioner requests that two documents marked "Attorney's Eyes Only" and submitted as an artifact pursuant to a protective order entered on February 20, 2008 in related litigation be expunged from the record. These documents were filed October 15, 2009.

The petition is deficient because:

1) the petition does not contain a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information as required.

Petitioner may request reconsideration of the petition. Any such request must be resubmitted within two months of the mailing date of this decision and supply the omitted statement(s). No fee will be due with any request for reconsideration.

Any questions regarding this petition decision should be directed to Jessica Harrison, Supervisory Primary Examiner of AU 3992 at 571-272-4449.

PETITION DISMISSED.

/J. Harrison/

Jessica J. Harrison
SPE AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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MICHAEL E. ATTAYA
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
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:(for Owner)

RONALD YIN
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:(for Requester)

In re Application of: Hintz et alia
Control No.: 90/008,903
Deposited: December 26, 2007
For: US Patent No. 5,819,292

: DECISION ON PETITION
: Under 37 CFR 1.59

In re Application of: Hintz et alia
Control No.: 90/009,103
Deposited: April 4, 2008
For: US Patent No. 5,819,292

This is a response to the petition under 37 CFR 1.59(b), filed on October 15, 2009 by which petitioners request to expunge information from the above identified proceeding.

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 fee of $ 200 required by 37 CFR 1.17(g) has been charged to Deposit Account No. 03-1237.

The petition is hereby dismissed.

REVIEW OF RELEVENT FACTS

1. On December 26, 2007 a third party requester requested *ex parte* reexamination of US Patent No. 5,819,292 which is identified under control no. 90/008,903.

2. On April 4, 2008 a third party requester requested *ex parte* reexamination of US Patent No. 5,819,292 which is identified under control no. 90/009,103.

3. Both requests were granted for *ex parte* reexamination and the two proceedings merged into a single proceeding on September 5, 2008.

4. Prosecution has continued and a final Office action was mailed on June 16, 2009.

5. On October 15, 2009 the instant petition with artifacts under seal were filed.

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(c) (in-part)

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

(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

Petitioner requests that two documents marked "Attorney's Eyes Only" and submitted as an artifact pursuant to a protective order entered on February 20, 2008 in related litigation be expunged from the record. These documents were filed October 15, 2009.

The petition is deficient because:

1) the petition does not contain a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information as required.

Petitioner may request reconsideration of the petition. Any such request must be resubmitted within two months of the mailing date of this decision and supply the omitted statement(s). No fee will be due with any request for reconsideration.

Any questions regarding this petition decision should be directed to Jessica Harrison, Supervisory Primary Examiner of AU 3992 at 571-272-4449.

PETITION DISMISSED.

/J. Harrison/

Jessica J. Harrison
SPE AU 3992
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.
90/008,903	12/26/2007	5819292	112056-0499C1RX	4100

24267 7590 01/13/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RONALD L. YIN
DLA PIPER, US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

Date:

MAILED

JAN 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008903
PATENT NO. : 5819292
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.
90/009,103	04/04/2008	5819292	112056-0499C1RX	5691

24267 7590 01/13/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

Date: MAILED

JAN 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009103
PATENT NO. : 5819292
ART UNIT : 3992

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

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

United States Patent and Trademark Office

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

JAN 13 2010

CENTRAL REEXAMINATION UNIT

Michael E. Attaya
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

(For Patent Owner)

Ronald Yin
DLA PIPER LLP (US)
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

(For Third Party Requester)

In re Hitz et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,903
Filed: December 26, 2007
For: U.S. Patent No. 5,819,292

In re Hitz et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,103
Filed: April 4, 2008
For: U.S. Patent No. 5,819,292

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the October 9, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION."

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

The petition fee of $400.00 under 37 C.F.R. § 1.17(f) has been charged.

The petition is **dismissed**.

BACKGROUND

1. On December 26, 2007, a request for *ex parte* reexamination of claims 1-4 and 8-20 of U.S. Patent Number 5,819,292 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/008,903.

2. On March 18, 2008, an order granting reexamination of claims 1 and 4 of the '292 patent was mailed in the '8903 proceeding.

3. On April 4, 2008, a request for *ex parte* reexamination of claims 4, 8, 11-15, and 20 of U.S. Patent Number 5,819,292 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/009,103.

4. On June 6, 2008, an order granting reexamination of claims 4, 8, 11-15, and 20 of the '292 patent was mailed in the '9103 proceeding.

5. On August 5, 2008, a decision merging the '8903 and '9103 proceedings (hereinafter, the merged '8903/'9103 proceeding) was issued.

6. On August 26, 2008, a non-final Office action, in which all claims subject to reexamination (claims 1, 4, 8, 11-15, and 20) were rejected under multiple grounds based upon 35 U.S.C. § 102(b), was mailed in the merged '8903/'9103 proceeding.

7. On May 12, 2009, patent owner submitted a timely and compliant response to the outstanding Office action, including an amendment to claim 1 and new claims 21-24.

8. On June 16, 2009, a final rejection was mailed, finding claims 1, 21, and 22 patentable, and rejecting claims 4, 8, 11-15, 20 on grounds previously set forth in the August 26, 2008 rejection, and rejecting newly added claims 20, 23, and 24.

9. On August 17, 2009, patent owner submitted a timely submission as a response to the June 16, 2009 final rejection. The submission included amendments to claims 11, 15, 23, and 24. Rejected independent claim 4 was not sought to be amended.

10. On September 8, 2009, the Office issued an advisory action refusing entry to the claim amendments proposed in the August 17, 2009 patent owner submission, finding that the amendments neither simplified the issues for appeal nor placed the claims in condition for allowance/confirmation. Rather, the advisory action stated that the amendments would raise new issues requiring further consideration and/or search.

11. On October 9, 2009, the instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION" was filed seeking continuation of the reexamination proceeding and entry of the amendments and cancellations of the claims set forth in the August 17, 2009 patent owner paper.

12. On October 15, 2009, patent owner filed a Notice of appeal.

13. On December 15, 2009, the Office granted a December 11, 2009 petition under 37 C.F.R. § 1.550(c) granting an extension of time for filing an appeal brief until January 15, 2010.

PERTINENT REGULATIONS

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).

DECISION

The October 9, 2009 patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of an amendment previously denied entry. 37 C.F.R. § 1.182 provides for relief that is not currently provided by an existing rule. In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding **to seek entry of an amendment and/or evidence that was denied entry** after an action closing prosecution in an *inter partes* reexamination proceeding.

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. Therefore, 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. Furthermore, the filing of such a § 1.182 petition is strictly controlled by the Office to further the statutory mandate of 35 U.S.C. § 305 that "[a]ll reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. In keeping with the requirement of special dispatch, a petition under 37 C.F.R. § 1.182 for continued reexamination must show how granting the petition would further the prosecution of the reexamination proceeding. Prosecution may be furthered by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate.

On October 9, 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 reexamination, thereby meeting the "situations not specifically provided for" language in § 1.182. Second, the requirement set forth in the March, 2005 Notice that the amendment has been previously denied entry is deemed to have been met. The petition was filed after a final rejection in an *ex parte* reexamination proceeding to seek entry of an amendment that was previously denied entry in the September 8, 2009 advisory action.

---

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

Third, with respect to reasons why the need for the amendment could not have been anticipated earlier, patent owner states that the amendment was in response to "comments made by the Examiner for the first time in the Final Office Action" (for claim 15) and in response to Examiner comments made in a July 30, 2009 interview and in the September 8, 2009 advisory action (for claims 11 and 24), and because "the Examiner continues to **construe** [claim] terms more broadly than Patent Owner believes is correct" (for claim 23; bold emphasis added).

With respect to the above reasons given by the patent owner:

For claim 15, patent owner's rationale is based on the grounds that while the rejection has not changed, and while patent owner continues to disagree with the Examiner's interpretation, patent owner now amends the claims to advance prosecution. *See* page 7. This is not a statement that can be interpreted as submission of an amendment in response to a new condition raised in the final Office action; rather, this statement shows that patent owner continues to disagree with the original rejection made in the first non-final Office action of August 26, 2008. Patent owner's amendment to claim 15 is a tactical choice made "to advance prosecution," and was not occasioned by a change in the Examiner's position from the August 26, 2008 Office action, or in response to an unclear rejection being first sufficiently explained in a later Office action.[2] In this instance, based on the totality of the circumstances, the patent owner has failed to meet the burden of presenting evidence why the amendment to claim 15 is not one the need for which could not have been anticipated based upon the original rejection made in the first non-final Office action of August 26, 2008.[3]

For claims 11 and 24, patent owner's rationale is based on language in unamended, parent claim 8, the grounds for rejection of which has not changed. While patent owner continues to disagree with the Examiner's interpretation, patent owner now amends dependent claims 11 and 24 to advance prosecution. *See* page 8. Following the reasoning given above for claim 15, the amendment with respect to the language in claim 8, now suggested to be added to claims 11 and 24, is not one whose need could not have been anticipated based upon the original rejection made in the first non-final Office action of August 26, 2008. With regard to patent owner's statement that the instant amendment is responsive to suggestions made by the examiner in a July 30, 2009 interview, the examiner stated in the September 8, 2009 advisory action that no specific amendments were suggested to patent owner, and similarly does not show that the need for the amendment could not have been anticipated earlier.

Likewise, for claim 23, patent owner's rationale is based on the grounds that while patent owner continues to disagree with the Examiner's interpretation, patent owner now amends the claims to

---

[2] Where a situation arises such that patent owner seeks relief from an erroneous closing of prosecution on the rationale that an unclear rejection was first sufficiently explained in a later Office action, a petition under § 1.181 is the sole proper vehicle for relief, not a petition under § 1.182.

[3] MPEP 706.02(b) sets forth four ways in which a rejection based on 35 U.S.C. § 102(b) may be overcome: persuasive argument, amendment that patentably distinguishes over the prior art, perfection of benefit under 35 U.S.C. § 120, and perfection of benefit under 35 U.S.C. § 119(e). A patent owner's argument may never be presumed to be persuasive prior to review by the examiner. One making an argument may be convinced of its correctness yet still anticipate that the audience may not be persuaded and that other avenues may be needed.

advance prosecution. *See* page 10. Patent owner takes issue with the examiner's initial claim construction of "file system information structure," an issue which did not first arise in the final Office action of June 15, 2009, but rather arose in the first Office action. Therefore, the amendment to claim 23 is one the need for which could have been anticipated based upon the original rejection made in the first non-final Office action of August 26, 2008. Therefore, the need for the submission is not one that could not have been anticipated earlier.

Fourth, the effect of entry of the amendment would not further the prosecution by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate. As at least independent claim 4 remains rejected, entry of the amendment, which does not amend claim 4 along with the other proposed amendments, or cancel claim 4, would not place the claims in condition for the issuance of a reexamination certificate. Furthermore, as the advisory action stated, the amendment did not attempt to amend claims in conformance with that deemed allowable by the examiner. For those reasons, entry of the amendment would not simplify the issues for appeal.

Taking into consideration the above discussion, the effect of entry of the amendment is not determined to be in accordance with conducting the proceeding with special dispatch. The intent of enactment of 35 U.S.C. § 305 for *ex parte* reexamination was to provide a speedy alternative to litigation of issued patents, with § 305 explicitly stating that reexamination proceedings are to be conducted with special dispatch, and a continuation of examination for reexamination proceedings on issued patents, absent strong reasons for such continuation, runs contrary to § 305. Any continuation of a reexamination proceeding must be weighed with the legislative history of the enactment of § 305, which expressed an intent for rapid and compact reexamination proceedings. [4]

The instant petition seeks entry of an amendment that would neither presented in a manner to resolve all of the issues in the proceeding such that the claims would be in condition for allowance/confirmation, nor in a manner to reduce the number of issues such that the proceeding would be handled more rapidly upon appeal. Entry of the August 17, 2009 amendment would therefore unduly prolong the reexamination proceeding in contravention of treatment of the proceeding with special dispatch.

In conclusion, a petition under 37 C.F.R. § 1.182, for relief not otherwise provided under the regulations, is of necessity a highly fact-specific inquiry. Based on the facts in this proceeding, it is found that continuation of examination through entry of the August 17, 2009 amendment would not 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 fail to satisfy the requirements set forth in the Notice.

[4] A comprehensive discussion of the statutory mandate for special dispatch can be found in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).

CONCLUSION

- The petition is **dismissed**.
- 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

January 12, 2010
C:\Kiva\Kenpet7\RCR\

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.
90/008,904	10/26/2007	4934831	060191RE2	9847

757 7590 06/12/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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 G. Knedeisen
KIRKPATRICK & LOCKHART, PRESTON, GATES, ELLIS, LLP
535 Smithfield Street, Henry W. Oliver Bldg.
Pittsburgh, PA 15222-2312

Date:
MAILED

JUN 12 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008904
PATENT NO. : 4934831
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

MAILED

JUN 12 2008

KIRKPATRICK & LOCKHART PRESTON
GATES ELLIS LLP
Attn: MARK KNEDEISEN
535 SMITHFIELD STREET
PITTSBURGH, PA 15222

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

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

In re: Volbrecht
Ex Parte Reexamination Proceeding
Control No. 90/008,040
Deposited: 8 June 2006
For U.S. Patent No. 4,934,831

In re: Volbrecht
Ex Parte Reexamination Proceeding
Control No. 90/008,904
Deposited: 26 October 2007
For U.S. Patent No. 4,934,831

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/008,040 and the reexamination control number 90/008,904 pursuant to 37 C.F.R. § 1.565(c).

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/008,040 and 90/008,904 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

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

II. Conduct of Merged Proceeding.

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

Reexamination Control Nos. 90/008,040 and 90/008,904 are hereby **merged**. Since there are no amendments in either proceeding, no "housekeeping" amendment is necessary. The proceedings are thus returned to the examiner in charge of the proceedings for s first Office action on the merits.

CONCLUSION

1. Reexamination Control Nos. 90/008,040 and 90/008,904 are **merged**.

2. The proceedings are thus returned to the examiner in charge of the proceedings for s first Office action on the merits.

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

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

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

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

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

MARK J. REINHART
SPE ~~SPRE~~-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica. Marquis,
Director,
Central Reexamination Unit

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.
90/008,909	12/11/2007	5899855	518852801200	5350

60683 7590 07/07/2008

HEALTH HERO NETWORK, INC.
2400 GENG ROAD, SUITE 200
PALO ALTO, CA 94303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Health Hero Network, Inc.
2000 Seaport Blvd.
Suite 400
Redwood City, CA 94063

(For Patent Owner)

MAILED

JUL 07 2008

Richard C. Kim
Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130

(For 3rd Party Requester) CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/008,234
Filed : October 31, 2006
For U.S. Patent No. : 5,899,855

Reexam Control No.: 90/008,909
Filed : December 11, 2007
For U.S. Patent No. : 5,899,855

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/008,234 was ordered in a decision mailed December 13, 2006 indicating that claims 47-50 would be reexamined. Prosecution has progressed to the point where an amendment was filed May 15, 2008 amending claim 47. No further action has taken place since the filing of the amendment.

Reexamination in application control No. 90/008,909 was ordered in a decision mailed January 24, 2008 indicating that claims 47-50 would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. Thus, there have been no changes made to the specification, claims, or drawings.

As evidenced by the above facts, reexamination control No. 90/008,234 and reexamination control No. 90/008,909 are currently pending. Since the order to reexamine has been mailed in

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

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

As noted above, claim 47 has been amended in the '234 reexamination proceeding by virtue of the amendment filed May 15, 2008. No amendment has been filed in the '909 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files**. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 47-50, the only claims for which reexamination has been requested, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/008,234 and 90/008,909 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files**. Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,910	10/31/2007	5191525	DIS 03741 PTRX	6175

32233 7590 01/27/2010

STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,609	07/17/2009	5191525	1484.19	1767

32233 7590 01/27/2010

STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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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

ANTON HOPEN
SMITH AND HOPEN, P.A.
180 PINE AVENUE N.
OLDSMAR, FL 34677

Date:

MAILED

JAN 27 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008910
PATENT NO. : 5191525
ART UNIT : 3992

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

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

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

Date: JAN 2 7 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SMITH HOPEN, PA
180 PINE AVENUE NORTH
OLDSMAR, FL 34677

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010609
PATENT NO. : 5191525
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
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STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

(For Patent Owner)

MAILED

JAN 27 2010

CENTRAL REEXAMINATION UNIT

ANTON HOPEN
SMITH & HOPEN, P.A.
180 PINE AVENUE N.
OLDSMAR, FL 34677

(For Third Party Requester)

In re LeBrun *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/008,910	: MERGING
Request Deposited: November 6, 2007	: REEXAMINATION
For: U.S. Patent No. 5,191,525	: PROCEEDINGS
In re LeBrun *et alia*	:
Reexamination Proceeding	:
Control No. 90/010,609	:
Request Deposited: July 17, 2009	:
For: U.S. Patent No. 5,191,525	:

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. 5,191,525 (hereinafter, the '525 patent), issued to LeBrun *et alia*, on March 2, 1993.

2. On November 6, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/008,910 (hereinafter, the '8910 proceeding).

3. On July 17, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/010,609 (hereinafter, the '10609 proceeding).

4. The Reexamination Order was granted for claims 1-92 in the '8910 proceeding on December 19, 2007. Prosecution has resulted in amendments to the claims.

5. The Reexamination Order was granted for claim 1, 12, 16, 18-23, 32-36, 82 and 89 in the '10609 proceeding on August 28, 2009.

DECISION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in 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 '8910 and the '10609 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, numerous original claims have been amended in the '8910 reexamination proceedings. It appears that original claims 17, 37, 61, 81 and 89 were amended with the paper of 11/25,2008, claims 37, 51, 71, 75, 87 were amended and claims 93-98 were added with the paper of 7/7/2009 and claims 37, 51, 71, 73, 75, 87, were amended and claim 74 was cancelled with the paper of 8/24/2009. 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.

It is also noted that Patent owner has had difficulty in presenting amendments in the '8910 proceeding which follow the requirements of 37 CFR 1.530 (d) – (i) in as much as it appears no amendment to the '8910 proceeding has met all requirement upon presentation, including the August 24, 2009 amendment which still lacks support for the claim changes as required by 37 CFR 1.530(d) and as noticed in the 8/21/2009 Notice of Defective Paper in Ex Parte Reexamination. Patent owner is noticed that continued failure to present amendments not in full compliance with 37 CFR 1.530 may result in termination of the proceeding under 37 CFR 1.550 (d). The "housekeeping" amendment must be in full compliance with 37 CFR 1.550 and bring the claims in the 90/010609 proceeding in line with those presently presented in the '8910 proceeding.

III. Conduct of Merged Proceeding.

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

After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/008910 and 90/010609 are MERGED.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

4. Telephone inquiries related to this decision should be directed to Jessica Harrison at (571) 272-4449, Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

/J. Harrison/

Jessica Harrison
SPE AU 3992 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.
90/008,912	11/05/2007	6,133,122	04070 PTRX	7085

21874 7590 11/04/2008

EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Storm LLP
Bank of America Plaza
901 Main Street, Suite 7100
Dallas, TX 75202

Date: NOV 14 2008

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008912
PATENT NO. : 6133122
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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EDWARDS ANGELL PLAMER & DODGE LLP
P.O. BOX 55874
Boston, Massachusetts 02205

(For Patent Owner)

NOV 04 2008

STORM LLP
Bank of America Plaza
901 Main Street, Suite 7100
Dallas, TX 75202

In re Yamamoto	: DECISION DISMISSING
Reexamination Proceeding	: PETITION FOR
Control No. 90/008,912	: EXTENSTION OF TIME
Request Deposited: November 5, 2007	: [37 CFR 1.550(c)]
For: U.S. Patent No. 6,133,122	:

This is a decision on the October 20, 2008, "PETITION AND REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R §1.550(c)" requesting that the time to submit a Patent Owner response be extended "for additional time beyond the shortened statutory period".

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

The petition is **dismissed** for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,133,122 (hereinafter, the '122 patent), issued to Yamamoto, on October 17, 2000.

2. On November 5, 2007, third party requester deposited a Request for *Ex Parte* Reexamination of the '122 patent. The reexamination proceeding was assigned Control No. 90/008,912 (hereinafter, the '8912 proceeding).

3. The reexamination order was granted in the '8912 proceeding on December 19, 2007.

4. Later in prosecution, a non-final office action was mailed on September 19, 2008. A two month period for response was set.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on October 21, 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 must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date of the request for extension is submitted, an (B) why, in spite of the actions 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 reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

Analysis and Findings

In the request, it is stated that each item of correspondence in this proceeding must be translated into Japanese before it can be read and studied by the inventor. Further, the instructions from the assignee/inventor must be translated from Japanese to English prior to filing of responses. It is stated that four prior art reference applied in the Office action require translation, and these US patents are complex technical subject matter which limits the availability of translators. However, no factual accounting of reasonably diligent behavior taken to date by all those responsible for preparing a response to the outstanding office action has been submitted. Further, no explanation as to why, in spite of the actions taken thus far, the requested additional

time is needed. The request fails to meet the requirements as outlined in MPEP 2265 for granting of a request for extension of time under 37 CFR 1.550(c).

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running two months from the date of the outstanding Office action.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html.**

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272- 4449.

/J. Harrison/ for

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,914	11/05/2007	6610597	04071 PTRX	6239

21874 7590 11/05/2008

EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/05/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JOHN J. PATTI
STORM LLP
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

Date:
MAILED

NOV 05 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008914
PATENT NO. : 6610597
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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William L. Brooks
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON MA 02205

(For Patent Owner)

MAILED

NOV 05 2008

CENTRAL REEXAMINATION UNIT

John J Patti
STORM, LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR
EXTENSION OF TIME
[37 CFR § 1.550(c)]

In re: Kobayashi
Ex Parte Reexamination Proceeding
Control No. 90/008,914
Deposited: 5 November 2007
For: US Patent No.6,610,597

This is a decision on the 28 October 2008, petition for "Petition and Request for Extension Of Time Under 37 CFR § 1.550(c) and § 1.17(g)," requesting that the time for responding to The non-final Office action, mailed 29 September 2008 be extended by thirty (30) days.

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 non-final Office action mailed 29 September 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 non-final Office action be extended to thirty (30) days. Since the petitioner has provided "sufficient cause" for granting-in-part an extension of time, the petition is granted-in-part.

An extension of time of two additional weeks is hereby granted.

37 CFR 1.550 (c) states:

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

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

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

Analysis and Findings

The patent owner petitions the director if the Central reexamination unit for an extension of time of two-month for which to submit a response to the non-final Office action. The petitioner notes that the assignee is a Japanese corporation and that the inventor is a Japanese citizen. The petitioner further notes that the references must be translated in to Japanese for understanding the rejections of the claims.

When considering a petition for extension of time consideration must be given for the patent owner to be given opportunity to present a complete response versus the need for special dispatch in the instant proceeding. It is for these reasons that one must always determine whether there is "sufficient cause" to support an extension for time in a reexamination proceeding.

While it is noted that the assignee is a Japanese corporation and that the reference rejecting

the claims are US English language patents. Based upon the consideration of the need for special dispatch as well as a fair opportunity for the patent owner to properly respond to the outstanding Office action, an extension of two-weeks (14 days) is hereby granted.

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

Conclusion

1. The patent owner's petition for extension of thirty (30) days time in which to file a response to the Final Office action dated 29 September 2008 is hereby **granted-in-part**.

2. This petition grants an extension of **two-weeks (14 days)** additional time for which to respond to the outstanding Office action.

3. The non-final Office action mailed 29 September 2008 which set a two-months period for response for which to respond will end with the grant of this petition decision on **13 December 2008**.

4. Future correspondence may be submitted as follows:

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

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

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

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

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

/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
www.uspto.gov

LAW OFFICES OF MARK A. HAMILL P.C. (For Patent Owner)
45 South Park Blvd.
Suite 205
Glen Ellyn, IL 60137

HOMMER TOOL & MANUFACTURING, INC. (Requester)
3111 W. University Drive
Arlington Heights, IL 60004

In re Garry Zydron	:
Reexamination Proceeding	: DECISION
Control No. 90/008,921	: DISMISSING
Request Deposited: November 13, 2007	: EXTENSION OF
For: U.S. Patent No. 7,293,341	: TIME PETITION
	:

This is a decision on the March 7, 2008 patent owner petition for an extension of time to submit a patent owner's statement in response to a granted order for reexamination entitled, "PETITION UNDER 37 C.F.R. § 1.550(c)."

The petition is before the Director's Office for the Central Reexamination Unit (CRU) of the United States Patent and Trademark Office.

SUMMARY

The petition for extension of time filed March 7, 2008 is dismissed as moot for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,293,341 (hereinafter, the '341 patent), issued to *Garry Zydron*, on November 13, 2007.

2. On November 13, 2007, a third party deposited a request for *ex parte* reexamination of claims 1-15 of the '341 patent. The reexamination proceeding was assigned Control No. 90/008,921 (hereinafter, the '8921 proceeding).

3. On November 20, 2008, a "Notice of *Ex parte* Reexamination Request Filing Date" was mailed for the '8921 proceeding. The notice stated the filing date of the request for reexamination to be November 13, 2007.

4. On January 3, 2008 reexamination was ordered in the'8921 *ex parte* reexamination proceeding.

5. On February 22, 2008, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 VACATING A REEXAMINATION FILING DATE," requesting vacation of the filing date due to an improper service of process which resulted in non-receipt of the request.

6. On March 7, 2008, patent owner filed a petition for an extension of time to submit a patent owner's statement in response to a granted order for reexamination entitled, "PETITION UNDER 37 C.F.R. § 1.550(c)."

7. Concurrent with the issuance of this decision, the Office is issuing a decision in response to patent owner's February 22, 2008 petition granting patent owners request to vacate the '8921 proceeding's filing date. The concurrent Office decision also vacates the January 3, 2008 order granting reexamination.

DECISION

37 CFR 1.550(c) States (in part):

> 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).

The petition for extension of time filed March 7, 2008 is **dismissed as moot** in light of the Office decision granting patent owner's February 22, 2008 petition to vacate the '8921 proceeding filing date for failure to comply with 37 CFR 1.510(b)(5), and vacates the January 3, 2008 order granting reexamination, which is concurrently issued with this decision.

CONCLUSION

1. The petition for extension of time filed March 7, 2008 is **dismissed as moot**.

2. Telephone inquiries related to this decision should be directed to Lynne Browne Supervisory Patent Examiner at (571) 272-3670 or Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Lissi M. Marquis
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LAW OFFICES OF MARK A. HAMILL P.C. (For Patent Owner)
45 South Park Blvd.
Suite 205
Glen Ellyn, IL 60137

MAILED

APR 16 2008

CENTRAL REEXAMINATION UNIT

HOMMER TOOL & MANUFACTURING, INC. (Requester)
3111 W. University Drive
Arlington Heights, IL 60004

In re Garry Zydron
Reexamination Proceeding
Control No. 90/008,921
Request Deposited: November 13, 2007
For: U.S. Patent No. 7,293,341

: DECISION
: DISMISSING
: EXTENSION OF
: TIME PETITION

This is a decision on the March 7, 2008 patent owner petition for an extension of time to submit a patent owner's statement in response to a granted order for reexamination entitled, "PETITION UNDER 37 C.F.R. § 1.550(c)."

The petition is before the Director's Office for the Central Reexamination Unit (CRU) of the United States Patent and Trademark Office.

SUMMARY

The petition for extension of time filed March 7, 2008 is dismissed as moot for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,293,341 (hereinafter, the '341 patent), issued to *Garry Zydron*, on November 13, 2007.

2. On November 13, 2007, a third party deposited a request for *ex parte* reexamination of claims 1-15 of the '341 patent. The reexamination proceeding was assigned Control No. 90/008,921 (hereinafter, the '8921 proceeding).

3. On November 20, 2008, a "Notice of *Ex parte* Reexamination Request Filing Date" was mailed for the '8921 proceeding. The notice stated the filing date of the request for reexamination to be November 13, 2007.

4. On January 3, 2008 reexamination was ordered in the'8921 *ex parte* reexamination proceeding.

5. On February 22, 2008, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 VACATING A REEXAMINATION FILING DATE," requesting vacation of the filing date due to an improper service of process which resulted in non-receipt of the request.

6. On March 7, 2008, patent owner filed a petition for an extension of time to submit a patent owner's statement in response to a granted order for reexamination entitled, "PETITION UNDER 37 C.F.R. § 1.550(c)."

7. Concurrent with the issuance of this decision, the Office is issuing a decision in response to patent owner's February 22, 2008 petition granting patent owners request to vacate the '8921 proceeding's filing date. The concurrent Office decision also vacates the January 3, 2008 order granting reexamination.

DECISION

37 CFR 1.550(c) States (in part):

> 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).

The petition for extension of time filed March 7, 2008 is **dismissed as moot** in light of the Office decision granting patent owner's February 22, 2008 petition to vacate the '8921 proceeding filing date for failure to comply with 37 CFR 1.510(b)(5), and vacates the January 3, 2008 order granting reexamination, which is concurrently issued with this decision.

CONCLUSION

1. The petition for extension of time filed March 7, 2008 is **dismissed as moot**.

2. Telephone inquiries related to this decision should be directed to Lynne Browne Supervisory Patent Examiner at (571) 272-3670 or Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Lissi M. Marquis
Director
Central Reexamination Unit

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

McQuade, Blasko, Fleming & Faulkner, Inc. (For Patent Owner)
811 University Drive
State College, Pennsylvania 16801

MAILED

APR 29 2009

CENTRAL REEXAMINATION UNIT

Patrick D. Kelly (For Requester)
11939 Manchester #403
St. Louis, Missouri 63131

In re Sen *et al.*
Reexamination Proceeding
Control No.: 90/008,925
Filed: January 22, 2008
For: U.S. Patent No.: 7,119,226

DECISION DISMISSING AND EXPUNGING PETITION

This is a decision on the March 30, 2009 third party requester petition entitled "PETITION UNDER 37 CFR § 1.183 TO CONVERT *EX PARTE* REEXAMINATION .INTO *INTER PARTES* REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

The petition is **dismissed**.

The third party requester petition paper is an improper paper. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the third party requester. Thus, the present petition paper is **expunged** from the record by marking it "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

BACKGROUND

1. Patent number 7,119,226 (the '226 patent) issued on October 10, 2006.

2. A request for reexamination, assigned control No. 90/008,925 (the '8925 proceeding), was filed on January 22, 2008 by a third party requester. [2]

3. On March 17, 2008, an order granting the '8925 reexamination request was mailed.

4. On May 1, 2008, patent owner filed a patent owner's statement under 37 CFR 1.530.

---

[1] See MPEP 2267.

[2] A request for reexamination that was not filing date compliant was deposited on November 19, 2007. In response to notification by the Office, requester submitted a compliant filing on January 22, 2008.

5. On June 2, 2008, third party requester filed a protest under 37 CFR 1.291 in response to the patent owner's statement.

6. On August 21, 2008, the Office mailed a decision expunging the May 1, 2008 patent owner statement and the third party requester's June 2, 2008 paper as improper papers not entitled to entry in the file.

7. On September 19, 2008, patent owner filed a patent owner's statement under 37 CFR 1.530.

8. On October 13, 2008, third party requester filed a reply under 37 CFR 1.535.

9. On January 2, 2009 the Office mailed an Office action rejecting all pending claims in the reexamination proceeding.

10. On February 19, 2009, patent owner timely response to the Office action of January 2, 2009.

11. On March 20, 2009 the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC).

12. On March 24, 2009, third party requester filed a paper entitled "Rebuttal of Patent Owner's Response" that was asserted by third party to be authorized by 37 CFR 1.535. This paper was expunged from the file as improper in a decision mailed April 27, 2009.

13. On March 30, 2009, third party requester filed petition entitled "PETITION UNDER 37 CFR § 1.183 TO CONVERT *EX PARTE* REEXAMINATION INTO *INTER PARTES* REEXAMINATION."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C § 304 provides:

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to

him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

37 CFR 1.535 Reply by third party requester in ex parte reexamination.

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

37 CFR 1. 550 Conduct of ex parte reexamination proceedings.

(a) All ex parte reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the ex parte reexamination order and expiration of the time for submitting any responses, **the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an ex parte reexamination certificate under § 1.570. [Emphasis added]

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 March 30, 2009 third party requester petition is filed under 37 CFR 1.183; however, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '8925 proceeding.

Waiver/suspension of the rules to permit the third party submission via the petition is not justified in view of the legislation and implementing rules which make reexamination under 35

U.S.C. §§ 302 - 307 an *ex parte* proceeding. See *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the Court said (paragraph bridging pages 1868 & 1869):

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

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

On its face, the third party requester's March 30, 2009 petition paper is filed after the statutory statement and reply period ended in the '8925 proceeding. The statutory statement and reply period ended in the '8925 proceeding when the third party requester filed a reply under 37 CFR 1.535 on October 13, 2008. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's March 30, 2009 petition paper. Therefore, the petition is **dismissed**.

Lack of Proof Of Service

Pursuant to 37 CFR 1.550(f):

> "After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. **The document must reflect service or the document may be refused consideration by the Office."** [Emphasis added]

A review of the instant petition shows that the requisite proof of service (of the instant petition) by the third party requester on the patent owner was not included with the present petition.

As pointed out in MPEP § 2266.03:

> "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." [Emphasis added]

A certificate of service pursuant to MPEP § 2266.03 has not been found attached to the instant petition. This provides separate basis for dismissal of the third party requester March 30, 2009 petition (however, while this basis could be remedied, the main basis for this decision cannot be).

Since the patent owner was not provided with a copy of the petition submitted by the third party requester, a copy is being forwarded (via this decision) to the patent owner together with all attachments thereto.

CONCLUSION

1. The petition is **dismissed**.

2. The petition paper filed by the third party requester on March 30, 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 '8925 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."

3. No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.

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

5. Any inquiry concerning this decision should be directed to Pinchus K. Laufer., Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7710.

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

(Enclosure: Copy of March 30, 2009 third party requester petition with attachments.)

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.
90/008,927	11/16/2007	6651618	8351.0489-00	6049

22852 7590 08/01/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/01/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
Alexandria, VA 22313-1450
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Finnegan, Henderson, Farabow,
Garrett & Dunner LLP
901 New York Avenue, NW
Washington, DC 20001-4413

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Womble Carlyle Sandridge & Rice, PLLC
P.O. Box 7037
Atlanta, GA 30357-0037

(For *Inter Partes* Requester)

In re Coleman, et al.
Ex parte Reexamination Proceeding
Control No. 90/008,927
Filed: November 16, 2007
For: U.S. Patent No. 6,651,618

In re Coleman, et al.
Inter partes Reexamination Proceeding
Control No. 95/000,049
Filed: August 27, 2004
For: U.S. Patent No. 6,651,618

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,651,618 (the '618 patent), issued November 25, 2003, is the subject of both *inter partes* Reexamination Control Number 95/000,049 and *ex parte* Reexamination Control Number 90/008,927.

2. A request for *inter partes* reexamination of the '618 patent, assigned Reexamination Control No. 95/000,049 (the '049 proceeding), was filed August 27, 2004, by a third party requester.

3. An order granting *inter partes* reexamination was mailed for the '049 proceeding on November 23, 2004, and a non-final action in the '049 was also mailed on November 23, 2004.

4. On January 24, 2005, patent owner responded to the first non-final Office Action in the '049 proceeding. No amendments were submitted by patent owner.

5. On September 22, 2005 the Office issued an action closing prosecution of the '049 proceeding.

6. On October 25, 2007, Patent Owner filed a notice of Appeal in the '049 proceeding.

7. A request for *ex parte* reexamination of the '618 patent, assigned Reexamination Control No. 90/008,927 (the '927 proceeding), was filed November 16, 2007 by the patent owner.

8. A notice of concurrent proceedings was filed on November 19, 2007.

9. An order granting *ex parte* reexamination was mailed for the '927 proceeding on January 11, 2008.

10. On December 28, 2007, patent owner provided notice of a statutory disclaimer under 37 CFR 1.321(a) filed by the patent owner on December 28, 2007, for the '618 patent, the same patent at issue in both reexamination proceedings.

DECISION

I. MERGER OF PROCEEDINGS

As reexamination has been ordered for both proceedings, and there is no longer an opportunity for filing a patent owner's statement and/or requester's reply, consideration of merger is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two 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 95/000,049 and 90/008,927 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, the *ex parte* reexamination was filed by the patent owner; thus, there is no *ex parte* reexamination third party requester.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action that applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner and the third party requester will contain the identifying data for 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 hand to:

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

Patent owner and requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including any papers filed *via* facsimile transmission.

C. Amendments:

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,049 and *ex parte* Reexamination Control No. 90/008,927 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. The resolution of the statutory disclaimer under 37 CFR 1.321(a) filed by the patent owner on December 28, 2007, for the '618 patent, is to be taken into account.

3. Any questions concerning this communication should be directed to the undersigned at 571-272-7710.

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

July 31, 2008
C:\KIVA\KENPET3\8927-95_049_EP-IP-Merge_cls-same_no-EP-3PR_discl-filed.doc

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

Merchant & Gould PC
P.O. Box 2903
Minneapolis, MN 55402-0903

(For Patent Owner)

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SEP 04 2008

CENTRAL REEXAMINATION UNIT

Baker Botts L.L.P.
30 Rockefeller Plaza
44th Floor
New York, NY 10112-4498

(For Patent Owner)

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

(For 3rd Party Requester)

Reexam Control No.: 90/008,173
Filed : August 16, 2006
For U.S. Patent No. : 6,134,461

Reexam Control No.: 90/008,928
Filed : November 16, 2007
For U.S. Patent No. : 6,134,461

DECISION MERGING REEXAMINATION PROCEEDINGS

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

Reexamination in application control No. 90/008,173 was ordered in a decision mailed October 25, 2006 indicating that claims 1-4 would be reexamined. Prosecution has progressed to the point where an amendment was filed August 22, 2007, amending claim 1 and adding claims 30-188. A number of Information Disclosure Statements have been filed but no Office action has been issued that is responsive to the August 22, 2007 amendment.

Reexamination in application control No. 90/008,928 was ordered in a decision mailed January 16, 2008 indicating that claims 1-4 would be reexamined. Patent Owner filed a "Waiver of Patent Owner's Statement under 37 CFR §1.530" on February 25, 2008. A number of Information Disclosure Statements have been filed since the filing of the waiver but no Office action has been prepared.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines.

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

As noted above, claims have been amended and added in n the '8,173 reexamination proceedings by virtue of the amendment filed August 22, 2007. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in both files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-4 and new claims 30-188 are the claims that are currently subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Dual Correspondence

Currently, patent owner appears to be represented by two different representatives. In reexamination proceeding control No. 90/008,173, patent owner is represented by the Baker Botts LLP law firm per the "Submission of Revocation of Power of Attorney with New Power of Attorney" paper filed June 29, 2007. In reexamination control No. 90/008,928, patent owner is represented by the law firm of Merchant & Gould PC. Under 37 CFR 1.33(a), the Office will not engage in double correspondence with more than one registered attorney or agent except as deemed necessary by the Director. Accordingly, the patent owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision.

Conclusion

Reexamination Control Nos. 90/008,173 and 90/008,928 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in both files and to name but a single representative.** Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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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
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,942	12/31/2007	D519,704	WUFA3003RX/REF/SAB	5619

4586 7590 04/23/2008

ROSENBERG, KLEIN & LEE
3458 ELLICOTT CENTER DRIVE-SUITE 101
ELLICOTT CITY, MD 21043

EXAMINER	
RAMIREZ, CYNTHIA	

ART UNIT	PAPER NUMBER
2911	

MAIL DATE	DELIVERY MODE
04/23/2008	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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4-23-08

BACON & THOMAS, PLLC
625 SLATERS LANE, FOURTH FLOOR
ALEXANDRIA, VA 22314-1176

In re Application of: US Design Patent No. D519,704
Serial No.: 90/008,942
Filed: December 31, 2007
Docket No.: WUFA3003RX/REF/SAB
Title: Golf Cart

DECISION ON PETITION TO ADMIT AMENDMENT UNDER 37 C.F.R. §§ 1.515(c) and 1.181

This is a decision on the petition under 37 C.F.R. §§ 1.515(c) and 181 timely filed on March 24, 2008 requesting reconsideration of examiner's denial of the request for *ex parte* reexamination of US Design Patent D519,704, mailed on February 22, 2008.

The petition is GRANTED.

REGULATION AND PRACTICE

37 CFR § 1.515(c) states that the requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

37 CFR § 1.181 requires *inter alia* that a petition to the director include a statement of the facts involved and the point or points to be reviewed and the action requested.

MPEP 2242 establishes the criteria for granting a request for reexamination. The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. Furthermore, 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.

STATEMENT OF FACTS

In the examiner's Order Denying Request for *Ex Parte* Reexamination mailed February 22, 2008, the examiner found that the prior art cited by the Third Party Requester did not establish a *prima facie* case of obviousness of the claim over the prior art. The Order did not establish the presence or absence of a substantial new question of patentability, or whether a reasonable examiner would consider the prior art patents and printed publications were considered important in deciding whether or not the claim is patentable.

Without these determinations, the examiner could not properly conclude that the request for reexamination of the patent should be denied. Furthermore, there is no evidence that the same question of patentability had 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.

DECISION

For the above-stated reasons, the petition to reconsider the decision of the examiner is GRANTED.

This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Jacqueline M. Stone
Director, Technology Center 2900

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.
90/008,943	11/30/2007	6,208,805	272192800100	7160

29973 7590 12/05/2008

CAREY, RODRIGUEZ, GREENBERG & PAUL LLP
ATTN: STEVEN M. GREENBERG, ESQ.
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON, FL 33487

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID L. FEHRMAN
MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET, SUITE 3500
LOS ANGELES, CA 90013-1024

Date:

MAILED

DEC 05 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008943
PATENT NO. : 6208805
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)).

MAILED

DEC 05 2008

CENTRAL REEXAMINATION UNIT

SCOTT D. PAUL
MAX ABECASSIS
18457 LONG LAKE DRIVE
BOCA RATON, FL 33496

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Scott D Paul
MAX ABECASSIS
3207 CLINT MOORE ROAD, #205
BOCA RATON FL 33496-3938

(For Patent Owner, Address of Record)

MAILED

DEC 05 2008

CENTRAL REEXAMINATION UNIT

Scott D Paul
MAX ABECASSIS
18457 Long Lake Drive
Boca Raton, FL 33496

(For Patent Owner, Courtesy Address Only)

David L Fehrman
MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR
EXTENSION OF TIME
[37 CFR § 1.550(c)]

In re: Abecassis
Ex Parte Reexamination Proceeding
Control No. 90/008,943
Deposited: 28 December 2007
For: US Patent No. 6,208,805

This is a decision on the 25 November 2008, petition for "Request for Extension of Time To Respond To Office Action In Ex Parte Reexamination," requesting that the time for responding to the non-final Office action, mailed 26 September 2008 be extended by two (2) 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.

Summary of Relevant Facts

1. On 30 November 2007 a third party requester, requested reexamination of US Patent No. 6,208,943.

2. On 18 December 2008 a Notice of Reexamination Request Filing Date was mailed to the address of record.

3. On 14 February 2008 the Order Granting Request for *Ex Parte* Reexamination was mailed to the address of record.

4. On 26 September a non-final Office action was mailed to the address of record,

Decision

The Patent Owner requests an extension of time in which to file a response to the non-final Office action mailed 26 September 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 non-final Office action be extended by two (2) additional months. Since the petitioner has provided "sufficient cause" for granting 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 if the Central reexamination unit for an extension of time for an additional two (2) months for which to submit a response to the non-final Office action. The petitioner states that the Office action was mailed to the "incorrect" address.

The petitioner states that "[o]n or about September 10, 2004, along with a Maintenance fee Transmittal Form of the same date, Patent Owner filed a change of correspondence address with the PTO." The petitioner further submitted a copy of a power of attorney letter signed by president of the corporation to which the patent is assigned. The letter does not indicate that it was submitted to the US patent and Trademark Office as a part of any address change nor is there any change of address submitted in the file for the instant proceeding. The patent owner does however submit a declaration attesting to having submitted a change of address in the parent file for which reexamination was requested. It is also noted that since the Patent Owner was aware of the instant proceeding from the original filing by the third party requester as stated in the petition for extension of time, the patent owner had opportunity to submit a proper change of address for to the Office following the initial request, the mailing of the Notice of Reexamination Request Filing Date mailed 18 December 2007 and available via Public PAIR, the Order Granting Request for *Ex Parte* Reexamination mailed 14 February 2008 and available via public PAIR, the patent owner should have been reasonably aware of the actions taken by the Office and if the address of record incorrect, corrected in a timely manner.

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. Further, the patent owner is reminded that to change the address of record, that it will be necessary to submit a proper change of address form in this proceeding as there is nothing in the record of the Office listing a change of address. A one (1) month extension of time is hereby granted.

The petition request is hereby **granted-in-part**.

A **one (1) month** extension of time is hereby granted

Conclusion

1. The patent owner's petition for extension of two (2) months time in which to file a response to the Office action dated 26 September 2008 is **granted-in-part**.

2. A **one (1) month** 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 **26 December 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

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/

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.
90/008,945	12/04/2007	6249570	V1100.0040	3079

7590 05/22/2008

EXAMINER

DAVID LEASON, ESQ
LEASON ELLIS LLP
81 MAIN STREET
SUITE 100
WHITE PLAINS, NY 10601

ART UNIT	PAPER NUMBER

DATE MAILED: 05/22/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MICHAEL J SCHEER
DICKSTEIN SHAPIRO LLP
1177 AVENUE OF THE AMERICAS (6TH AVENUE)
NEW YORK, NY 10036-2714

Date:
MAILED
MAY 22 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008945
PATENT NO. : 6249570
ART UNIT : 3992

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

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

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

MAILED

MAY 22 2008

CENTRAL RE... ...ON UNIT

DAVID LEASON, ESQ
LEASON ELLIS LLP
81 MAIN STREET
SUITE 100
WHITE PLAINS NY 10601

(For Patent Owner)

MICHAEL J SCHEER
DICKSTEIN SHAPIRO LLP
1177 AVENUE OF THE AMERICAS
(6TH AVENUE)
NEW YORK, NY 10036-2714

(For Third Party Requester)

In re: Glowny *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,945
Deposited on: 4 December 2007
For: US Patent No. 6,249,570

DECISION DENYING PETITION UNDER 37 CFR §§ 1.181 & 37 CFR 1.515 (c)

This is a decision on the 24 March 2008, "Petition to the Director Under 37 CFR §§ 1.1818 and 1.515 to Review the Order Denying Request for *Ex Parte* Reexamination." Petitioner, the third party requester, requests that the decision denying the request for reexamination of US Patent 6,249,570 be reversed. The petition request was timely filed.

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

The petition is **DENIED** for the reasons set forth below.

Background

1. On 4 December 2007, the third party requester requested *ex parte* reexamination of U.S. Patent No. 6,249,570.

2. On 22 February 2008, the examiner denied the request for reexamination.

3. On 24 March 2008, the present petition was timely filed by the patent owner requester.

Discussion

37 CFR § 1.515. Determination of the request for ex parte reexamination.

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

MPEP § 2248 (in part)

After a request for reexamination has been denied, jurisdiction over the reexamination proceeding is retained by the Central Reexamination Unit (CRU), to await the possibility of a petition seeking review of the examiner's determination refusing reexamination. If a petition seeking review of the examiner's determination refusing reexamination is not filed within one (1) month of the examiner's determination, the CRU will then process the reexamination file as a concluded reexamination file. See MPEP § 2247 and § 2294.

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be *de novo*.

Decision

A petition filed under 37 CFR § 1.181, requesting that the examiner's decision denying the request for reexamination be reversed, is decided by the Central Reexamination Unit (CRU) Director. The Manual of Patent Examining Procedure 2248 further states that the CRU Director's review will be *de novo.*

The patent owner in the petition filed on 24 March 2008, has not presented persuasive evidence that the documents provided to support a substantial new question of patentability with respect to patent no. 6,249,570 for which reexamination is sought are sufficient to raise a substantial new question of patentability.

The petition filed 24 March 2008, argues that the examiner did not properly construe the claim language with "its broadest reasonable interpretation and **must** construe the terms in accordance with their plain meaning." (emphasis in petition language) The petitioner seeks a broader interpretation of the Glowny *et alia* claim language of US Patent number 6,249,570 than that given by the examiner in the Order Denying Request for Ex Parte Reexamination dated 22 February 2008.

The construction of the Glowny patent claims by the petitioner are not sufficiently consistent with the Glowny disclosure to support a substantial new question of patentability to provide for reexamination of the patent.

Considering the petition filed 24 March 2008 there is insufficient evidence to provide for a substantial new question of patentability with respect to patent no. 6,249,570. As such the petition is hereby DENIED.

Conclusion

1. A petition seeking review of the denial of the substantial new question of patentability affecting the claims of U.S. patent 6,249,570 to Glowny *et alia* has been presented by requester for the reasons set forth above.

2. The petition is **DENIED**

3. This decision is final and non-appealable. See 35 U.S.C. § 303(c) and 37 CFR § 1.515(c). No further communication on this matter will be acknowledged or considered.

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis, Director
Central Reexamination Unit

2-COMMON OUTGOING (*EX PARTES*)

☐ 1449 _____
Reviewed List of Refs Cited by Appl

☐ 892. _____
List of Refs Cited by Examiner

☐ EXIN. _____
Examiner Interview Summary

☐ ~~NIRC.~~ RXNIRC _____
Notice of Intent to Issue Reexam Certificate

☐ RXADV. _____
Reexam proceeding Advisory Action

☐ RXCERT _____
Reexam Certificate

☐ RXDOR _____
Director Initiated Order for Reexam

☐ RXEPQ. _____
Reexam Exparte Quayle Action

☐ RXFR. _____
Reexam Final Rejection

☐ RXLET. _____
Reexam Misc Incoming Letter

☐ RXLITSR _____
Reexam Litigation Search

☐ RXMISC _____
Reexam Miscellaneous Outgoing Action or Letter

☐ ~~RXR~~ NF _____
Reexam Non-Final Office Action

☐ RXREXO _____
Order Granting Reexamination

☐ SRFW _____
Examiner's Search Notes

OTHER

☑ RxPTGR _____
Other document (Please indicate doc code & page count)

DRAFT

Document Date: - - 08

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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Kenneth L. Cage
McDermott, Will & Emery
600 13th street, N.W.
Washington, DC 20005

Date:

MAILED

MAY 15 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008949
PATENT NO. : 5195984
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

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.
90/008,949	12/06/2007	5195984 C1	52734-036-D	2977

7590 05/15/2008

BEN D. TOBOR
11757 KATY FREEWAY, SUITE 1400
HOUSTON, TX 77079

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/15/2008

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

Ben D. Tobor
11757 Katy Freeway
Suite 1400
Houston, TX 77079

(For Patent Owner)

McDermott Will & Emery LLP
Patterson Thuente Skarr & Christensen PA
600 13th Street, NW
Washington, DC 20005-3096

(For Third Party Requester)

MAILED

MAY 15 2008

CENTRAL REEXAMINATION UNIT

In re Cordis Corporation
Ex Parte Reexamination Proceeding
Control No.: 90/008,949
Filed: December 6, 2007
For: U.S. Patent No. 5,195,984 C1

: DECISION
: GRANTING
: PETITION

The 90/008949 *ex parte* reexamination proceeding is before the Office of Patent Legal Administration for consideration of the third party requester's February 19, 2008 petition entitled "Petition Seeking Suspension of the Rules Under the Provisions Of 37 C.F.R. 1.183 to Enter a Supplemental Petition Regarding Recent Federal Circuit Authority .... "

The petition is granted to the extent set forth below.

PETITION FEE

The petition fee of $400.00 set by 37 CFR 1.17(f), as required by 37 CFR 1.183, is being charged to Deposit Account No. 50-0417.

REVIEW OF FACTS

1. U.S. Patent No. 5,195,984 (the '984 patent) issued to Richard A. Schatz on March 23, 1993, and is currently assigned to Cordis Corporation.

2. A first request for *ex parte* reexamination of the '984 patent was filed by a third party requester on July 13, 2005 and was assigned Control Number 90/007,628 ("the '628 reexamination proceeding"). Reexamination was requested for "at least claims 1 and 3" of the '984 patent.

3. On October 11, 2005, *ex parte* reexamination was ordered for claims 1-6 (*i.e.*, all of the claims) of the '984 patent.

4. On April 26, 2006, the first Office action on the patentability of the claims of the '984 patent was mailed. The Office action was a *"Notice of Intent to Issue Ex Parte Reexamination Certificate,"* and it stated that the patentability of all of the claims of the '984 patent "are confirmed."

5. On October 3, 2006, an "EX PARTE REEXAMINATION CERTIFICATE" for U.S. Patent No. 5,195,984 was published, confirming the patentability of all of the patent claims, without amendment.

6. On December 6, 2007, a second request for *ex parte* reexamination of the '984 patent was filed by the same third party requester and was assigned Control Number 90/008,949 (the '949 reexamination proceeding). Reexamination was requested for "at least claims 1 and 3" of the '984 patent.

7. On January 18, 2008, the request for *ex parte* reexamination in the '949 reexamination proceeding was denied by the Primary Examiner.

8. On February 19, 2008, third party requester filed a petition under 37 CFR 1.515(c), for supervisory review and reconsideration of the Primary Examiner's January 18, 2008 Order denying reexamination in the '949 *ex parte* reexamination proceeding.

9. On April 10, 2008, patent owner filed the present petition under 37 CFR 1.183 to suspend the rules in order to permit the entry and consideration of a concurrently filed supplemental 37 CFR 1.515(c) petition for the purpose of bringing a recent decision of the Court of Appeals for the Federal Circuit and a recent decision of the USPTO Board of Patent Appeals and Interferences ("BPAI") to the attention of the deciding Official who will address the February 19, 2008 petition.

DISCUSSION

I. Background

On July 13, 2005 the '628 request for *ex parte* reexamination of the claims of the '984 patent was filed by a third party requester. Reexamination was ordered in the '628 *ex parte* reexamination proceeding. On October 3, 2006, an *ex parte* reexamination certificate for the '984 patent issued based on the '628 reexamination proceeding, in which all of the '984 patent claims were confirmed as being patentable.

The present '949 *ex parte* reexamination proceeding for the '984 patent resulted from a request filed on December 6, 2007, by a third party requester. The '949 request for reexamination alleged that certain prior patents and printed publications established a substantial new question of patentability (SNQ) for certain of the '984 patent claims. The prior patents and printed publications relied upon to establish an SNQ in the '949 request for reexamination were determined by the examiner to be the same prior patents and printed publications that had been relied upon to establish an SNQ for the '984 patent claims in the earlier filed '628 *ex parte* reexamination proceeding.

Office practice, as set forth at MPEP §2242 is that:

> "[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).

On January 18, 2008, the Primary Examiner denied the request for reexamination in the '949 reexamination proceeding on the basis that the request did not demonstrate any SNQ for the '984 patent claims, because (1) the request was based only on prior patents and printed publications that had established the SNQ for the '984 patent claims in the earlier '628 *ex parte* reexamination proceeding (i.e., "old art"), and (2) no "new light" has been shed by the request on the cited "old art" references. On February 19, 2008, third party requester (hereinafter "petitioner") in the '949 reexamination proceeding filed a petition, as permitted by 37 CFR 1.515(c), and as discussed in MPEP §2248, requesting supervisory review and reconsideration of the Primary Examiner's Order dated January 18, 2008 denying *ex parte* reexamination. Petitioner's asserted basis for requesting supervisory review and reconsideration of the Primary Examiner's Order may be summarized as follows:

> (1) The law regarding the manner in which 35 U.S.C. § 103 nonobviousness is to be determined has recently been "changed" by the United States Supreme Court in *KSR Int'l Co. V. Teleflex Inc.*, ., 550 U.S. _; 127 S. Ct. 1727; 82 USPQ2d 1385 (2007) ("*KSR*");
>
> (2) Due to that "change," the request for reexamination filed in the '949 *ex parte* reexamination proceeding raises an SNQ for the '984 patent claims, because it presents the prior patents and printed publications previously considered to raise an SNQ in the '628 *ex parte* reexamination (but that were not considered to render any patent claims unpatentable for "obviousness" under 35 U.S.C § 103), and *KSR* necessarily presents the same prior art "in a new light" in the '949 *ex parte* reexamination proceeding; and
>
> (3) Reexamination should, therefore, be ordered in the '949 *ex parte* reexamination proceeding in accordance with the practice discussed at MPEP § 2242(II)(A).

II. Relief Requested

The present petition requests waiver of the regulations pursuant to 37 CFR 1.183 in order to permit entry and consideration of a concurrently filed supplemental 37 CFR 1.515(c) petition presenting additional authority from the Court of Appeals for the Federal Circuit and the USPTO Board of Patent Appeals and Interferences on the manner in which the *KSR* decision has been applied by these tribunals.

III. Decision

After briefly reviewing the petition filed on February 19, 2008, and the authorities provided in the present third party requester petitions, and in light of the unique facts and circumstances of this proceeding, which present a matter of first impression, it appears that it is in the interest of justice to address all currently available input in this matter of first impression. Accordingly, the petition is granted.

CONCLUSION

1. The third party requester petition filed on April 10, 2008 is granted.

2. Jurisdiction over the '949 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit to address the February 19, 2008 petition under 37 CFR 1.515(c) and the present supplemental 37 CFR 1.515(c) petition.

3. Telephone inquiries related to the present 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

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May 13, 2008

May 13, 2008
C:\kiva\kenpet 7\Deny_reex\8949 grant 1.183 - to enter suppl 515 re new Fed Cir KSR-type decision.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,949	12/06/2007	5195984 C1	52734-036-D	2977

7590 06/17/2008

EXAMINER	
ART UNIT	PAPER NUMBER

BEN D. TOBOR
11757 KATY FREEWAY, SUITE 1400
HOUSTON, TX 77079

DATE MAILED: 06/17/2008

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

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Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Kenneth L. Cage
McDermott, Will & Emery
600 13th street, N.W.
Washington, DC 20005

MAILED Date:

JUN 17 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008949
PATENT NO. : 5195984
ART UNIT : 3993

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

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

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Ben D. Tobor
11757 Katy Freeway
Suite 1400
Houston, TX 77079

(For Patent Owner)

MAILED

JUN 17 2008

CENTRAL REEXAMINATION UNIT

McDermott Will & Emery LLP
Patterson Thuente Skarr & Christensen PA
600 13th Street, NW
Washington, DC 20005-3096

(For Third Party Requester)

In re Cordis Corporation
Ex Parte Reexamination Proceeding
Control No.: 90/008,949
Filed: December 6, 2007
For: U.S. Patent No. 5,195,984 C1

: DECISION
: GRANTING
: PETITION

The 90/008,949 *ex parte* reexamination proceeding is before the Office of Patent Legal Administration for consideration of the third party requester's May 28, 2008 petition entitled "Petition Seeking Suspension of the Rules Under the Provisions Of 37 C.F.R. 1.183 to Enter a Supplemental Petition Regarding Canadian Federal Court Authority .... "

The petition is granted to the extent set forth below.

PETITION FEE

The petition fee of $400.00 set by 37 CFR 1.17(f), as required by 37 CFR 1.183, is being charged to Deposit Account No. 50-0417.

REVIEW OF FACTS

1. U.S. Patent No. 5,195,984 (the '984 patent) issued to Richard A. Schatz on March 23, 1993, and is currently assigned to Cordis Corporation.

2. A first request for *ex parte* reexamination of the '984 patent was filed by a third party requester on July 13, 2005 and was assigned Control Number 90/007,628 ("the '628 reexamination proceeding"). Reexamination was requested for "at least claims 1 and 3" of the '984 patent.

3. On October 11, 2005, *ex parte* reexamination was ordered for claims 1-6 (*i.e.*, all of the claims) of the '984 patent.

4. On April 26, 2006, the first Office action on the patentability of the claims of the '984 patent was mailed. The Office action was a "*Notice of Intent to Issue Ex Parte Reexamination Certificate*," and it stated that the patentability of all of the claims of the '984 patent "are confirmed."

5. On October 3, 2006, an "EX PARTE REEXAMINATION CERTIFICATE" for U.S. Patent No. 5,195,984 was published, confirming the patentability of all of the patent claims, without amendment.

6. On December 6, 2007, a second request for *ex parte* reexamination of the '984 patent was filed by the same third party requester and was assigned Control Number 90/008,949 (the '949 reexamination proceeding). Reexamination was requested for "at least claims 1 and 3" of the '984 patent.

7. On January 18, 2008, the request for *ex parte* reexamination in the '949 reexamination proceeding was denied by the Primary Examiner.

8. On February 19, 2008, third party requester filed a petition under 37 CFR 1.515(c), for supervisory review and reconsideration of the Primary Examiner's January 18, 2008 Order denying reexamination in the '949 *ex parte* reexamination proceeding.

9. On April 10, 2008, third party requester filed a petition under 37 CFR 1.183 to suspend the rules in order to permit the entry and consideration of a concurrently filed supplemental 37 CFR 1.515(c) petition for the purpose of bringing a recent decision of the Court of Appeals for the Federal Circuit and a recent decision of the USPTO Board of Patent Appeals and Interferences ("BPAI") to the attention of the deciding Official who will address the February 19, 2008 petition.

10. A decision granting the April 10, 2008 third party requester petition to suspend the rules was mailed on May 15, 2008.

11. On May 28, 2008, third party requester filed the present petition under 37 CFR 1.183 to suspend the rules in order to permit the entry and consideration of a concurrently filed supplemental 37 CFR 1.515(c) petition for the purpose of submitting a recent decision of Canadian Federal Court to the attention of the deciding Official who will address the February 19, 2008 petition.

DISCUSSION

I. Background

On July 13, 2005 the '628 request for *ex parte* reexamination of the claims of the '984 patent was filed by a third party requester. Reexamination was ordered in the '628 *ex parte* reexamination proceeding. On October 3, 2006, an *ex parte* reexamination certificate for the '984 patent issued based on the '628 reexamination proceeding, in which all of the '984 patent claims were confirmed as being patentable.

The present '949 *ex parte* reexamination proceeding for the '984 patent resulted from a request filed on December 6, 2007, by a third party requester. The '949 request for reexamination alleged that certain prior patents and printed publications established a substantial new question of patentability (SNQ) for certain of the '984 patent claims. The prior patents and

printed publications relied upon to establish an SNQ in the '949 request for reexamination were determined by the examiner to be the same prior patents and printed publications that had been relied upon to establish an SNQ for the '984 patent claims in the earlier filed '628 *ex parte* reexamination proceeding.

Office practice, as set forth at MPEP § 2242 is that:

> "[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).

On January 18, 2008, the Primary Examiner denied the request for reexamination in the '949 reexamination proceeding on the basis that the request did not demonstrate any SNQ for the '984 patent claims, because (1) the request was based only on prior patents and printed publications that had established the SNQ for the '984 patent claims in the earlier '628 *ex parte* reexamination proceeding (i.e., "old art"), and (2) no "new light" has been shed by the request on the cited "old art" references. On February 19, 2008, third party requester (hereinafter "petitioner") in the '949 reexamination proceeding filed a petition, as permitted by 37 CFR 1.515(c), and as discussed in MPEP §2248, requesting supervisory review and reconsideration of the Primary Examiner's Order dated January 18, 2008 denying *ex parte* reexamination. Petitioner's asserted basis for requesting supervisory review and reconsideration of the Primary Examiner's Order may be summarized as follows:

> (1) The law regarding the manner in which 35 U.S.C. § 103 nonobviousness is to be determined has recently been "changed" by the United States Supreme Court in *KSR Int'l Co. V. Teleflex Inc.*, ., 550 U.S. _; 127 S. Ct. 1727; 82 USPQ2d 1385 (2007) ("*KSR*");
>
> (2) Due to that "change," the request for reexamination filed in the '949 *ex parte* reexamination proceeding raises an SNQ for the '984 patent claims, because it presents the prior patents and printed publications previously considered to raise an SNQ in the '628 *ex parte* reexamination (but that were not considered to render any patent claims unpatentable for "obviousness" under 35 U.S.C § 103), and *KSR* necessarily presents the same prior art "in a new light" in the '949 *ex parte* reexamination proceeding; and
>
> (3) Reexamination should, therefore, be ordered in the '949 *ex parte* reexamination proceeding in accordance with the practice discussed at MPEP § 2242(II)(A).

II. Relief Requested

The present petition requests waiver of the regulations pursuant to 37 CFR 1.183 in order to permit entry and consideration of a concurrently filed supplemental 37 CFR 1.515(c) petition presenting additional authority from the Canadian Federal Court.

III. Decision

After briefly reviewing the petitions filed on February 19, 2008 and April 10, 2008, as well as the authority provided in the present third party requester petition, and in light of the unique facts and circumstances of this proceeding, which present a matter of first impression, it appears that

it is in the interest of justice to address all currently available input in this matter of first impression. Accordingly, the petition is granted.

ADDITIONAL DISCUSSION

Note is taken that the original third party requester petition for relief from the examiners Order dated January 18, 2008 denying the December 17, 2007 request for *ex parte* reexamination was filed on February 19, 2008. Third party requester has now submitted two supplemental petitions presenting authority stated to be relevant to the issues raised in the February 19, 2008 petition. However, the original February 19, 2008 still remains to be decided. Unless some limitation is placed on the ability of the third party requester to obtain consideration of additional subsequently filed supplemental petitions, it would appear that a decision on the original February 19, 2008 petition could be delayed beyond the point of equity with respect to the patent owner's interest in this matter.

Accordingly, absent a strong showing that a supplemental petition is being presented that specifically states that the decision of the United States Supreme Court in *KSR Int'l Co. V. Teleflex Inc.*, 550 U.S. _; 127 S. Ct. 1727; 82 USPQ2d 1385 (2007) has been determined to directly and specifically affect the substantial new question of patentability standard in the reexamination statute, no additional petition filed by the third party requester to waive 37 CFR 1.1515(c) for the purposes of obtaining consideration of a petition filed to present additional authority regarding a finding of obviousness will be deemed to present an extraordinary situation that mandates waiver of the regulations in the interest of justice. Stated differently, unless additional legal authority goes beyond merely finding obviousness in a matter, or applying the so-called "KSR standard" to determine patentability under 35 U.S.C. § 103, the necessity to provide a timely decision on the issue raised by third party requester will be deemed to outweigh any benefit obtained from consideration of additional legal authority on the matter presented in the February 19, 2008 petition that is merely cumulative to the authority already presented in that petition and the supplemental petitions filed on April 10, 2008 and May 28, 2008.

CONCLUSION

1. The third party requester petition filed on May 28, 2008 is granted.

2. Jurisdiction over the '949 *ex parte* reexamination proceeding is returned to the Central Reexamination Unit to address the February 19, 2008 petition under 37 CFR 1.515(c) and the present supplemental 37 CFR 1.515(c) petition.

3. Telephone inquiries related to the present 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
June 17, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,949	12/06/2007	5195984 C1	52734-036-D	2977

7590 10/24/2008

EXAMINER	

BEN D. TOBOR
11757 KATY FREEWAY, SUITE 1400
HOUSTON, TX 77079

ART UNIT	PAPER NUMBER

DATE MAILED: 10/24/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Kenneth L. Cage
McDermott, Will & Emery
600 13th street, N.W.
Washington, DC 20005

Date:

MAILED

OCT 24 2003

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008949
PATENT NO. : 5195984
ART UNIT : 3993

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

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

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

Ben D. Tobor
11757 Katy Freeway
Suite 1400
Houston, TX 77079

(For Patent Owner)

McDermott Will & Emery LLP
Patterson Thuente Skarr & Christensen PA
600 13th Street, NW
Washington, DC 20005-3096

(For Third Party Requester)

MAILED

OCT 24 2008

CENTRAL REEXAMINATION UNIT

In re Cordis Corporation :
Ex Parte Reexamination Proceeding : DECISION
Control No.: 90/008,949 : DENYING
Filed: December 6, 2007 : PETITION
For: U.S. Patent No. 5,195,984 C1 :

This is a decision on the third party requester petition entitled "PETITION SEEKING REVIEW UNDER 37 C.F.R. §§ 1.515(c) and 1.181 OF THE EXAMINER'S DETERMINATION REFUSING *EX PARTE* REEXAMINATION OF U.S. PATENT NO. 5,195,984" filed on February 19, 2008. The supplemental petitions filed on April 10, 2008, and on May 28, 2008, are also addressed in this decision. The petitions are before the Director of the Central Reexamination Unit for consideration.

Summary: The third party requester petition is denied. The decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c).

REVIEW OF FACTS

1. U.S. Patent No. 5,195,984 (the '984 patent) issued to Richard A. Schatz on March 23, 1993, and is currently assigned to Cordis Corporation.

2. A first request for *ex parte* reexamination of the '984 patent was filed by a third party requester on July 13, 2005 and was assigned Control Number 90/007,628 ("the '628 reexamination proceeding"). Reexamination was requested for "at least claims 1 and 3" of the '984 patent.

3. On October 11, 2005, *ex parte* reexamination was ordered by the Office for claims 1-6 (*i.e.*, all of the claims) of the '984 patent.

4. On April 26, 2006, the first Office action on the patentability of the claims of the '984 patent was mailed. The Office action was a "*Notice of Intent to Issue Ex Parte Reexamination*

Certificate," and it stated that "Claims 1-6 are confirmed over the prior art in this reexamination proceeding."

5. On October 3, 2006, "EX PARTE REEXAMINATION CERTIFICATE" No. 5,195,984 C1 was published for the '984 patent, confirming the patentability of all of the patent claims, without amendment.

6. On December 6, 2007, a second request for *ex parte* reexamination of the '984 patent was filed by the same third party requester and was assigned Control Number 90/008,949 (the '949 reexamination proceeding). Reexamination was requested for "at least claims 1 and 3" of the '984 patent.

7. On January 18, 2008, the request for *ex parte* reexamination was denied.

8. On February 19, 2008, the present third party requester petition was filed.

9. On April 10, 2008, third party requester filed a petition under 37 CFR 1.183 to suspend the rules in order to allow the filing of a supplemental petition for the purpose of bringing a recent decision of the Court of Appeals for the Federal Circuit to the attention of the deciding Official for the present third party requester petition.

10. On May 15, 2008, the April 10, 2008 petition was granted.

11. On May 28, 2008, third party requester filed a petition under 37 CFR 1.183 to suspend the rules in order to allow the filing of a supplemental petition for the purpose of bringing a recent decision of the Canadian Federal Court to the attention of the deciding Official for the present third party requester petition.

12. On June 17, 2008, the May 28, 2008 petition was granted.

DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '949 reexamination proceeding has petitioned seeking relief from the examiner's January 18, 2008 Order denying *ex parte* reexamination.

35 U.S.C. § 303(c) provides:

> A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR 1.515(c) provides:

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

MPEP § 2248 provides, in pertinent part:

> If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo*. Each decision by the CRU Director will conclude with the paragraph:
>
> "This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition,[1] has been made as to whether the December 6, 2007 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '984 patent filed in the '949 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

II. Examiner's Basis for Finding that the Request for Reexamination Did Not Raise an SNQ

The examiner's decision to deny the request for reexamination was based on a determination that the request for reexamination did not establish a SNQ because:

(a) The request in the present '949 proceeding relies on U.S. Patent No. 4,739,762 ("Palmaz"), in view of Wallace, Michael J. et al "Tracheobronchial Tree: Expandable Metallic Stents Used in Experimental and Clinical Applications," (Radiology 1986, 158:309-312 ("Wallace") or, Charnsangavej *et al*, "Stenosis of the Vena Cava: Preliminary Assessment of Treatment with Expandable Metallic Stents," Radiology 1986, 161:295-298 ("Charnsangavej") to establish a substantial new question of patentability for claim 1 of the '984 patent;

(b) The request in the '949 proceeding relies on Palmaz in view of Wallace or Charnsangavej *et al*, further taken with U.S. Patent No. 4,969,458 ("Wiktor") to establish a substantial new question of patentability for claim 3 of the '984 patent; and

(c) The cited references listed above are the identical references that were relied upon by third party requester to raise the substantial new question of patentability that was found to exist in the prior concluded '628 reexamination request for claims 1 and 3 of the '984 patent, and these references were urged to be applied claims 1 and 3 in essentially the same manner in both the prior concluded '628 reexamination request and in the '949 reexamination request.

In other words, the Office previously evaluated the same patents and printed publications in the prior proceeding before the Office (the '628 reexamination proceeding) in the same context and scope as that they have been presented in the request for reexamination of this

[1] Subsequent references to "the petition" or to "the present petition" are to be understood as referring to the originally filed petition taken together with the subsequently filed supplemental petitions of April 10, 2008 and May 28, 2008.

proceeding (the '949 proceeding.) Therefore, the question of patentability being raised in the '949 reexamination request was previously evaluated by the Office (e.g., is not "new"), and therefore not a SNQ.

III. *De Novo* Review of the Request for Reexamination - Findings and Analysis

A. Petitioner takes the position that the request in the '949 reexamination request must be deemed to raise a substantial "new" question of patentability, because of the decision by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. _; 127 S. Ct. 1727; 82 USPQ2d 1385 (2007) (hereinafter the "*KSR Decision*").[2] This position is taken despite the examiner's finding that all of the prior art references relied upon in the reexamination request to raise a SNQ in the '949 reexamination request (1) are identical to the references that were relied upon to raise the SNQ in the prior concluded '628 reexamination; and (2) are being relied upon for the same technical teachings that they evidenced in the prior '628 reexamination proceeding. Petitioner argues that the *KSR Decision* has created a less rigid and more flexible standard than the "teaching-suggestion-motivation" ("TSM") test that had been applied by the Federal Circuit. Petitioner points out that, in the Notice of Intent to Issue Reexamination Certificate ("NIRC") in the earlier concluded '628 reexamination proceeding, the examiner's "Statement of Reasons for Patentability and/or Confirmation" of the '984 patent claims stated, in part:

> "Therefore, one of ordinary skill in the art at the time the invention was made would not have looked to the teachings of Wallace or Charnsangavej to provide the motivation to modify Palmaz in a way so as to produce the flexible stent "chain of the instant invention." [3]

Petitioner argues that, based on the *KSR Decision*, a substantial new question of patentability *per se* exists in the '949 reexamination proceeding based on the identical technical teachings contained in the same prior art that was previously considered in the earlier concluded '628 reexamination proceeding, which used the TSM test for nonobviousness. Petitioner takes that position because, in Petitioner's view, such prior art must be considered "in a new light" in view of the *KSR Decision*. Based on this reasoning, Petitioner concludes that it was error for the examiner in the '949 reexamination proceeding to hold that the prior art relied on in the '949 request for reexamination did not raise an SNQ when viewed in light of the *KSR* decision.

A *de novo* review of the request for reexamination in the '949 *ex parte* reexamination, as it was filed on December 6, 2007, shows that the request for reexamination was based upon an assertion by third party requester that the references (prior patents and printed publications) set forth in Sections II(a) & (b), *supra* raised a SNQ for patent claims 1 and 3. Those references had previously been relied upon in the request for reexamination in the prior '628 reexamination proceeding in the same context that they are relied upon in the December 6, 2007 request in the '949 proceeding.

Addressing this situation, MPEP § 2216 provides –

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[2] In the *KSR Decision*, Supreme Court reviewed a decision of the United States Court of Appeals for the Federal Circuit (hereinafter the "Federal Circuit") that had held certain patent claims to be valid because the claims were nonobvious under 35 U.S.C. § 103. The Supreme Court reversed the Federal Circuit's decision, finding that the patent claims at bar were invalid for failing to define a nonobvious invention pursuant to Section 103. The basis for the Supreme Court's holding was its finding that the Federal Circuit had not applied proper test for determining nonobvious of a patent claim, as announced in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Rather, the Federal Circuit had applied a "teaching-suggestion-motivation" ("TSM") test for nonobviousness of patent claims in an overly rigid and formalistic way.

[3] Reexamination proceeding 90/007,628, *Notice of Intent to Issue Ex Parte Reexamination Certificate*, April 26, 2006, at page 4.

> "It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents **a new, non-cumulative technological teaching** that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested." (Emphasis added)

Petitioner has not identified a new, non-cumulative technological teaching that was not previously considered and discussed on the record in an earlier Office examination of the '984 patent. The *KSR* decision does not provide anything new as to the technology with respect to the same prior art that is being re-applied in this proceeding in essentially the same context and scope. The *KSR* decision does not present the teachings contained in the patents and publications previously considered in the '628 reexamination proceeding "in a new light" as to the technology; thus, a SNQ is not raised in the request of the present '949 reexamination proceeding based on those same teachings.

The December 6, 2007 request does not rely upon new documents containing new technical teachings. Rather, an evaluation of the alleged SNQ in the December 6, 2007 request reveals that the references were presented in the same context and scope as they were in the prior '628 reexamination. The evaluation also shows that Petitioner (third party requester) is not relying upon the references for a substantially different purpose.[4] The identical references relied upon in the prior '628 reexamination proceeding are again being relied upon in the December 6, 2007 request for the same teachings to establish the same question of obviousness under 35 U.S.C. § 103 as in the prior proceeding. Further, the December 6, 2007 request does not show that the examiner in the '628 reexamination proceeding failed to appreciate technical teachings of the references as those references were considered and discussed on the '628 reexamination record. In fact, there is no evidence that the examiners, in either the '628 or '949 reexamination proceedings, failed to understand the references or consider a relevant portion or portions of the references.[5] Therefore, the request did not establish that the references contained any new technical teachings. The requisite new technological teachings are also not established by the *KSR* decision or by the decisions cited in the supplemental petitions, because these decisions are directed to claim patentability - these decisions do not clarify, explain, or in any way address the technical teachings contained in the patents and publications previously considered in the prior examinations (*e.g.*, the examination of the application that matured into the '984 patent and the examination of the '984 patent in the prior concluded '628 reexamination proceeding). Therefore, the decisions do not cast the teachings of the art in a "new light" or establish a substantial new question of patentability, which is required to give the Office jurisdiction to re-examine the '984 patent.

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[4] See: *In re Swanson et al*,, No. 2007-1534 (Reexamination No. 90/006,785), 2008 U.S. App. LEXIS 18928, at *31-32 (Fed. Cir. 2008) (citing H.R. Rep. No 107-120, at 3 – "The appropriate test to determine whether a 'substantial new question of patentability' exists should not merely look at the number of references or whether they were previously considered or cited but their combination in the appropriate context of a new light as it bears on the question of the validity of the patent."

[5] *Id.*, at *32-33 (citing H.R. Rep No. 107-120, at 3 (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.").

B. Petitioner identifies an article entitled "*Palmaz, J.*, et al., "Expandable Intraheptic Portacaval Shunt Stents: Early Experience in the Dog," *AJR*, 145:821-825 (1985) (hereinafter "the *Palmaz* publication"), as being newly relied on in the present '949 reexamination proceeding.[6] Petitioner alleges, beginning at page 17 of the present petition, that the *Palmaz* publication (Exhibit 19 in the '949 request for reexamination) is "new evidence" presented in the '949 reexamination proceeding. Petitioner argues that the examiner failed to consider this "new evidence" and that such requires reversal of the examiner's decision denying *ex parte* reexamination.[7] However, in the December 6, 2007 request for reexamination in the present proceeding, Petitioner mentions the *Palmaz* publication only once – as a second listed reference in footnote 11 on page 28. The mere mention of this reference in the '949 request, without any discussion of a new technical teaching in the reference or a discussion of how the teaching relates to the claimed invention would not have been important to a reasonable examiner, does not raise a SNQ. Note that the *Palmaz* publication was also cited in the July 13, 2005 request of the prior '628 reexamination proceeding and considered by the examiner in the October 11, 2005 order of the prior proceeding, and the request clearly does not explain how the publication is viewed differently with respect to the technology. Petitioner cannot persuasively bootstrap a new discussion of the *Palmaz* publication into being "new evidence" establishing a SNQ in the request for reexamination in the '949 proceeding by *now*, for the first time in the record, making arguments directed to its teachings via the present petition. If requester wishes to attempt to assert *Palmaz* in a manner that differs from its prior use in the Office, requester is free to do so in a new filing of a reexamination request.

Petitioner also points to "[t]he identification of his [patent owner's] admission as to the problem in the prior art was not previously presented to the examiner in the '7628 proceeding"[8] as a ground for finding the presentation of a SNQ. Petitioner alleges, at page 19 of the present petition, that since the admission as to problem solved by the invention was not previously presented to the examiner in the '628 reexamination proceeding, this "new evidence" provides a basis of "reversible error" to find that a SNQ is raised in the '949 proceeding. To the extent that the teaching comes from the patent under reexamination, the teaching has always been part of the record in both the '628 and '949 proceedings. However, neither the '628 request nor the '949 request mentions the teachings located at column 3, lines 26-39, of the '984 patent. As the teaching was not discussed in the '949 request, a *de novo* review of that request does not indicate that the examiner should have identified it as raising a SNQ. See also MPEP 2217, subsection III, which states that admissions, *per se*, may not be the basis for establishing a SNQ.

The December 6, 2007 request for reexamination did not meaningfully rely on the *Palmaz* publication or the alleged admission to establish a SNQ. Accordingly, *de novo* review of the request of December 6, 2007 does not show that reexamination should have been ordered on the basis of any new technical teachings.

C. The *de novo* review on the record of the request for reexamination in the '949 reexamination proceeding, undertaken in light of the arguments presented in the present petition, and its supplemental petitions, compels the conclusion that the request for reexamination in the '949 reexamination proceeding does not raise a new SNQ with respect to the claims of the '984 patent for which reexamination was requested. This decision is without prejudice to the right of the

---

[6] "Petition Seeking Review ... ," February 19, 2008, at pages 17-18.

[7] Specifically, petitioner argues that "[T]he 'new evidence' presented in the '8949 Request is the article entitled "*Palmaz, J.*, et al., "Expandable Intraheptic Portacaval Shunt Stents: Early Experience in the Dog," *AJR*, 145:821-825 (1985), Request at Exhibit 19." Petitioner further argues that this "new evidence" establishes the level of skill in the relevant art as to overlapping co-axial stents and identifies the problem in stent flexibility.

[8] "Petition Seeking Review ... ," February 19, 2008, at page 19.

requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

CONCLUSION

1. The third party requester petition seeking review of the examiner's decision is denied, as to the underlying relief requested. Base on a *de novo* review on the record of the request for reexamination, a SNQ is not found to have been raised by the request for reexamination.

2. This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

3. Telephone inquiries related to the present decision may be directed to the undersigned, at 571-272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

Pet7/Deny reexam
10-23-08

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,953	12/05/2007	7,072,947	0-07-947	8860

20350 7590 10/14/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KEVIN D. MCCARTHY
ROACH BROWN MCCARTHY & GRUBER, P.C.
420 MAIN STREET- 1620 LIBERTY BUILDING
BUFFALO, NY 14202

Date:

MAILED

OCT 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008953
PATENT NO. : 7072947
ART UNIT : 3992

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

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

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United States Patent and Trademark Office
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OCT 14 2009

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

KEVIN D. MCCARTHY
ROACH, BROWN, MCCARTHY, & GRUBER, P.C.
420 MAIN STREET
1620 LIBERTY BUILDING
BUFFALO, NY 14202

(For Third Party Requester)

In re Knox et al.
Reexamination Proceeding
Control No.: 90/008,953
Filed: December 5, 2007
For: U.S. Patent No.: 7,072,947

DECISION
DISMISSING PETITION
UNDER 37 CFR 1.182

This is a decision on the August 7, 2009 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this merged reexamination proceeding.

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

The petition is **dismissed** for the reasons set forth below.

Thus, the IDS filed August 7, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 7,072,947 (the '947 patent) issued on July 4, 2006.
2. On December 5, 2007, third party requester filed a request for *ex parte* reexamination of claims 1-44.
3. On February 2, 2008, the Office issued an order granting the December 5, 2007 request, which was accorded control number 90/008,953 (the '8953 proceeding).
4. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '8953 proceeding on June 24, 2009.

5. On June 26, 2009, the '8953 proceeding was forwarded to the Office of Publications.
6. The instant petition was filed on August 7, 2009, accompanied by an IDS that the patent owner requests the Office to consider.
7. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

. . . All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2256 provides, (in part):

. . . Once the reexamination has entered the Reexamination Certificate printing cycle (452 status), pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):
"(c) Once the issue fee has been paid, the **application will not be withdrawn from issue upon petition by the applicant for any reason except**:
(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"
The printing cycle for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the printing cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its printing cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c).
Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made **while a proceeding is in its printing cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (see item (A) above) factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier.** The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the printing cycle for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph.
(latter emphasis added)

DECISION

There is no issue fee in reexamination, and, in this instance, the reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present merged proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 has provided such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256, which requires that the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable.

In the present instance, the submission fails to satisfy the above-noted criteria. Patent owner states that the document submitted in the IDS did not exist until approximately three weeks after the NIRC was issued. Patent owner has therefore submitted a sufficient factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. However, the instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS item of information makes at least one claim unpatentable. To the contrary, patent owner merely provides an Office action from an application that has a benefit claim to a provisional application also claimed by the '947 patent. There are no statements by the patent owner that unequivocally state why the document submitted makes at least one claim unpatentable.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Since it has been required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory provision for special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2256, as reproduced above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on June 24, 2009, and the proceeding has now entered the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section . . . will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding and the failure to identify a question of patentability of the claim under reexamination, the present merged reexamination proceeding will not be reopened at this late date to consider the proffered IDS paper.

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

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on August 7, 2009.

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 Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Joseph Weiss at (571) 272-7759.

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

October 13, 2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,955	12/05/2007	4733159	40085-7	2192

7590 09/04/2008

EXAMINER	

Donald B. Southard
MOTOROLA, INC.
1303 Algonquin Road
Schaumburg, IL 60196

ART UNIT	PAPER NUMBER

DATE MAILED: 09/04/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,506	02/26/2007	4,733,159	078944.010600	5715

62204 7590 09/04/2008

GE TRADING & LICENSING
1 RESEARCH CIRCLE
ATTN: BRANDON, K1 - 2C11
NISKAYUNA, NY 12309

EXAMINER	
ART UNIT	PAPER NUMBER

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NISKAYUNA NY 12309

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Donald B. Southard
MOTOROLA, INC.
1303 Algonquin Road
Schaumburg IL 60196

(For Patent Owner)

GREENBERG TRAURIG, LLP
1200 SEVENTEENTH STREET,
SUITE 2400
DENVER, CO 80202

(For Third Party Requester)

WOODARD, EMHARDT, MORIARTY,
MCNETT & HENRY LLP
111 MONUMENT CIRCLE,
SUITE 3700
INDIANAPOLIS, IN 46204-5137

(For Third Party Requester)

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
37 C.F.R. § 1.565(c) &
CLARIFICATION OF THE PATENT OWNER'S REPRESENTATION
37 CFR § 1.33

In re: Edwards *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,506
Deposited: 26 February 2007
For: US Patent No. 4,733,159

In re: Edwards *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/008,955 :
Deposited: 5 December 2007 :
For: US Patent No. 4,733,159 :

The above-identified reexamination proceedings 90/008,506 and 90/008,955 are before the Director of the Central Reexam Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

The Director further wishes to clarify the representation of the patent owner pursuant to 37 CFR § 1.33.

BACKGROUND

1. Patent No. 4,733,159 issued on 22 March 1988.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,506 was requested by a third party requester on 26 February 2007.

3. The Reexamination Order was granted in proceeding, control no. 90/008,506 on 10 April 2007.

4. There are currently no amendments proceeding control number 90/008,506.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,955 was requested by a third party requester filed on 5 December 2007.

6. The Reexamination Order was granted in proceeding, control no. 90/008,955 on 25 January 2008.

7. There are currently no amendments proceeding control number 90/008,955.

8. Proceedings control numbers 90/008,506 and 90/008,955 await action from the assigned examiner.

9. On 7 June 2007 a change of address and power of attorney was received in the proceeding control number 90/008,506.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,506 and 90/008,955 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CORRESPONDENCE

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings. (in-part)

(a) Correspondence address and daytime telephone number . When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first

named inventor (if provided, see § § 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address.

...

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.32(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to § § 11.5 and 11.11 of this subchapter, or if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner 's attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.

It is noted that there are two addresses given for the patent owner. The addresses are different in each individual proceeding. The patent owner is reminded that double correspondence will not be undertaken and the record of the merged proceedings clarified as to whom the patent owner wishes representation. According to the requirements of 37 CFR 1.33 response to this paper requires clarification as to whom the patent owner has selected for representation in these merged proceedings

CONCLUSION

1. Reexamination Control Nos. 90/008,506and 90/008,955 are hereby **MERGED**.

2. The Patent Owner is hereby required to clarify to whom correspondence shall be addressed.

3. The reexamination files are being forwarded to the examiner for further action.

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

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

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

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

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

/Mark Reinhart/
for

_____
Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/008,957	12/03/2007	6453302	R65328	8912

40401 7590 07/17/2008

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/17/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

TIMOTHY J. MAY
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

MAILED

JUL 17 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,957*.

PATENT NO. *6453302*.

ART UNIT *3992*.

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

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

(For Patent Owner)

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JUL 17 2008

CENTRAL REEXAMINATION UNIT

Timothy J. May
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, D.C. 20001-4413

(For Requester)

In re Johnson et al
Ex Parte Reexamination Proceeding
Control No. 90/008,957
Filed: December 3, 2007
For: U.S. Patent No. 6,453,302

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

This is a decision on the December 3, 2007 third party requester petition under 37 CFR 1.182, to allow the submission of color documents in *ex parte* reexamination proceeding control no. 90/008,957 ("the December 3, 2007 requester petition".)

The December 3, 2007 requester petition and the record as a whole are before the Office of Patent Legal Administration for consideration.

The December 3, 2007 requester petition to allow the submission of color documents in *ex parte* reexamination proceeding control no. 90/008,957 is **dismissed as moot**.

REVIEW OF FACTS

- On September 7, 2002, U.S. Patent No. 6,453,302 (hereinafter, "the '302 patent") issued to Jerome D. Johnson and Dale A. Mehr.

- On December 3, 2007, a request for *ex parte* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 90/008,957 (hereinafter, "the '8957 proceeding"). The request was accompanied by the instant submission of color documents.

- On February 4, 2008, an order granting the reexamination request was mailed.

- No Office action on the merits has been mailed in the '8957 proceeding.

[1] The request for *ex parte* reexamination was filed by FedEx Corporation, the third party requester.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

MPEP 2218 provides, in pertinent part (emphasis added):

> It is required that a copy of each patent or printed publication relied on or referred to in the request, be filed with the request (37 CFR 1.510(b)(3)). If the copy provided is not legible, or is such that its image scanned into the Image File Wrapper system (IFW) will not be legible, it is deemed to not have been provided. **An exception is color photographs and like color submissions, which, if legible as presented, will be retained in an "artifact" file and used as such.**

DECISION

The requester urges the Office to allow the submission of color documents, specifically, color excerpts of papers filed in a related litigation, in the '8957 proceeding. The submission of color documents accompanied the December 3, 2007 request for *ex parte* reexamination. No petition is necessary, however, to enter into the record documents in color that will not be published as part of the issued patent (such as color drawings, for example). Black and white versions of these documents appear to have been submitted as Exhibit LIT-C.[2] The black and white versions of these documents have been scanned into the Office's Image File Wrapper (IFW) system and have been made part of the official record. The instant submission of color documents, which accompanied the December 3, 2007 request, has been placed in an artifact file pursuant to MPEP 2218.

For the reasons given above, the December 3, 2007 requester petition under 37 CFR 1.182 to allow the submission of color documents in the '8957 proceeding is **dismissed as moot**.

The Office takes this opportunity to notify the parties that, while color versions of, for example, exhibits or prior art may be placed in an artifact file pursuant to MPEP 2218, artifact files are not easily available to the examiner, the Board, or the public. For this reason, color versions of prior art documents or exhibits should only be submitted when absolutely necessary, such as when it is not possible to submit these documents in a black and white format that is capable of being scanned into the Office's IFW system.

CONCLUSION

- The December 3, 2007 requester petition under 37 CFR 1.182 to allow the submission of color documents in the '8957 proceeding is **dismissed as moot**.

- Jurisdiction over the proceeding is being forwarded to the examiner in the Central Reexamination Unit (CRU) for appropriate action.

[2] See footnote no. 1 on page v of the December 3, 2007 request for reexamination; see also page 2 of the instant petition.

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

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

cn

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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.
90/008,957	12/03/2007	6453302	R65328	8912

40401 7590 11/13/2008

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/13/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

TIMOTHY J. MAY
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

MAILED

NOV 13 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,957*.

PATENT NO. *6453302*.

ART UNIT *3992*.

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

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

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United States Patent and Trademark Office
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Abraham Hershkovitz
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

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NOV 13 2008

CENTRAL REEXAMINATION UNIT

Timothy J. May
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE,
NW WASHINGTON, DC 20001-4413

(For Third Party Requester)

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

In re: Johnson *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,957
Deposited: 3 December 2007
For: US Patent No. 6,453,302

This is a decision on the 10 November 2008, petition for "Petition for Extension of Time Under 37 CFR § 1.550(c)," requesting that the time for responding to the Office action, mailed 15 September 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 15 September 2008, which set 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 Office action be extended by two (2) months. Since the petitioner has failed to provide "sufficient cause" for granting an extension of time, the petition is dismissed.

37 CFR 1.550 (c) states:

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

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

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

Analysis and Findings

The patent owner petitions the director if the Central reexamination unit for an extension of time of two (2) months for which to submit a response to the outstanding Office action. The petitioner seeks the extension of time to schedule an interview with the examiner of record..

When considering a petition for extension of time consideration must be given for the patent owner to be given opportunity to present a complete response versus the need for special dispatch in the instant proceeding. It is for these reasons that one must always determine whether there is "sufficient cause" to support an extension for time in a reexamination proceeding.

While it is noted that interviews can frequently resolve questions before the examiner, the scheduling of an interview has not been considered sufficient cause for the purpose of granting an extension of time. Since there are no other grounds for which an extension of time may be considered for "sufficient cause," in consideration of the fact pattern set forth by the patent owner it is determined that no additional time may be granted for the reasons set

forth in the petition. The petition is hereby dismissed.

In dismissing the petition for extension of time, the patent owner may resubmit the petition without the requirement of an additional petition fee.

The petition request is hereby **Dismissed**.

Conclusion

1. The patent owner's petition for extension of two (2) months time in which to file a response to the Office action dated 15 September 2008 is hereby **dismissed**.

2. The Office action mailed set a two (2)-month response time for which to respond, will end on **15 November 2008**.

3. The patent owner may resubmit the petition without the requirement of an additional petition fee.

4. Future correspondence may be submitted as follows:

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

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, Supervisory Patent Examiner, Art Unit 3992, at 571-272-4929 may be contacted.

/Mark Reinhart/

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,957	12/03/2007	6453302	R65328	8912

40401 7590 02/09/2009

EXAMINER	
ART UNIT	PAPER NUMBER

TIMOTHY J. MAY
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

DATE MAILED: 02/09/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,957	12/03/2007	6453302	R65328	8912

40401 7590 02/09/2009

Hershkovitz & Associates, LLC
2845 Duke Street
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EXAMINER	
ART UNIT	PAPER NUMBER

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2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

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FEB 09 2009

CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Third-Party Requester)

In re Johnson *et alia*
Reexamination Proceeding
Control No. 90/008,957
Request Deposited: December 30, 2007
For: U.S. Patent No. 6,453,302

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

This is a decision on the February 5, 2009, "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 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.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,453,302 (hereinafter, the '302 patent), issued to Johnson *et alia*, on September 17, 2002.

2. On December 30, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '302 patent. The reexamination proceeding was assigned Control No. 90/008,957 (hereinafter, the '8957 proceeding).

3. The reexamination order was granted in the '8957 proceeding on February 4, 2008.

4. An interview was held on December 11, 2008.

5. A final rejection was mailed on January 7, 2009 setting a one-month shortened statutory period (SSP) for response.

6. The Patent Owner filed a paper entitled "STATEMENT OF SUBSTANCE OF INTERVIEW UNDER 37 CFR 1.560(b)" on February 4, 2009.

7. The present petition for extension of time was filed on February 5, 2009.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response. The present petition for extension of time was filed on February 5, 2009, 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.

37 CFR §1.560 (b) states:

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

37 CFR §1.550 (d) states:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the 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.

A review of the record indicates that action by the Patent Owner was due on January 12, 2009. January 11, 2009 was a Sunday, one month after the interview. As required by 37 CFR

§1.560(b), a written statement of the interview must be filed within one month. Patent Owner did not file the statement of the substance of the interview until February 4, 2009. 37 CFR §1.550(c) requires that any request for an extension must be filed on or before the day on which action by the patent owner is due. Since the filing of the present petition was after the day on which action was due, the petition is untimely and **dismissed**.

CONCLUSION

1. Petitioner's request is **dismissed**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

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For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel for
Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,957	12/03/2007	6453302	R65328	8912

40401 7590 02/09/2009

EXAMINER	

TIMOTHY J. MAY
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

ART UNIT	PAPER NUMBER

DATE MAILED: 02/09/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,957	12/03/2007	6453302	R65328	8912

40401 7590 02/09/2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

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ART UNIT	PAPER NUMBER

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Third-Party Requester)

In re Johnson *et alia*
Reexamination Proceeding
Control No. 90/008,957
Request Deposited: December 30, 2007
For: U.S. Patent No. 6,453,302

: DECISION DISMISSING
: PETITION UNDER
: 37 CFR 1.181
:
:

This is a decision on the February 4, 2009, "PETITION UNDER 37 C.F.R §1.181 TO HAVE THE FINAL REJECTION OF JANUARY 7, 2009 VACATED".

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

The petition is **dismissed** for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,453,302 (hereinafter, the '302 patent), issued to Johnson *et alia*, on September 17, 2002.

2. On December 30, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '302 patent. The reexamination proceeding was assigned Control No. 90/008,957 (hereinafter, the '8957 proceeding).

3. The reexamination order was granted in the '8957 proceeding on February 4, 2008.

4. An interview was held on December 11, 2008.

5. A final rejection was mailed on January 7, 2009 setting a one-month shortened statutory period (SSP) for response to the final office action.

6. The Patent Owner filed a paper entitled "STATEMENT OF SUBSTANCE OF INTERVIEW UNDER 37 CFR 1.560(b)" and the present petition on February 4, 2009.

DECISION

The Patent Owner requests "that the Final Rejection of January 7, 2009 be vacated."

37 CFR §1.560(b) states:

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

37 CFR §1.550(d) states:

(d) If the patent owner **fails to file a timely** an 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. (emphasis added)

A review of the record indicates that action by the Patent Owner was due on January 12, 2009. (January 11, 2009 was a Sunday, one month after the interview.) As required by 37 CFR § 1.560(b), a written statement of the interview must be filed within one month. Patent Owner did not file the statement of the substance of the interview within that time period.

If the facts of the proceeding permit, Patent Owner may wish to consider filing a petition under 37 CFR § 1.137 to accept the late filed Statement of the Substance of the Interview filed on February 4, 2009 as being timely (see MPEP 2268).

Accordingly, this is a terminated reexam prosecution. The present 37 CFR § 1.181 petition is not addressed as to its substance since the proceeding is not pending, and vacating the final rejection (or not vacating) would not change the terminated status of the reexam prosecution. Accordingly, the requested relief to vacate the final office action mailed January 7, 2009 is **dismissed**.

CONCLUSION

1. Petitioner's request is **dismissed**.

2. Patent Owner may wish to consider filing a petition under 37 CFR §1.137 to accept the late filed Statement of the Substance of the Interview filed on February 4, 2009 as being timely (see MPEP 2268).

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**.

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

By hand: Customer Service Window
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Alexandria, VA 22314

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.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,957	12/03/2007	6453302	R65328	8912

40401 7590 03/16/2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/16/2009

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MAR 16 2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22312

(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER LLP
901 New York Avenue, NW
Washington, DC 20001-4413

(For Third-Party Requester)

In re: Johnson *et alia*
Reexamination Proceeding
Control No. 90/008,957
Request Deposited: December 3, 2007
For U.S. Patent No 6,453,302

: **DECISION ON PETITION**
: **TO VACATE FINAL**
: **REJECTION, OR**
: **ALTERNATIVELY TO**
: **ACCEPT UNINTENTIONALLY**
: **DELAYED PAPER**

The reexamination is before the Director of the Central Reexamination Unit for consideration of the petition filed February 27, 2009 under 37 CFR 1.181 to have the final rejection of January 7, 2009 vacated, or in addition, under 37 CFR 1.137(b) to accept unintentionally delayed late paper.

The combined petitions under 37 CFR 1.181 and 37 CFR 1.137(b) are not considered and **DISMISSED** under 37 CFR 1.4(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,453,302 (hereinafter, the '302 patent), issued to Johnson et alia, on September 17, 2002.

2. On December 3, 2007, a third party deposited a Request for Ex Parte Reexamination of the '302 patent. The reexamination proceeding was assigned Control No. 90/008,957 (hereinafter, the '8957 proceeding).

3. The reexamination order was granted in the '8957 proceeding on February 4, 2008.

4. An interview was held on December 11, 2008.

5. A final rejection was mailed on January 7, 2009 setting a one-month shortened statutory period (SSP) for response to the final office action.

6. The Patent Owner filed a paper entitled "STATEMENT OF SUBSTANCE OF INTERVIEW UNDER 37 CFR 1.560(b) and a petition under 37 CFR 1.181 to have the final rejection of January 7, 2009 vacated on February 4, 2009.

7. A decision dismissing the petition under 37 CFR 1.181 to have the final rejection of January 7, 2009 vacated was mailed by the Office on February 9, 2009.

8. A petition for extension of time under 37 CFR 1.550(c) was filed by Patent Owner on February 5, 2009.

9. A decision dismissing the petition under 37 CFR 1.550(c) was mailed by the Office on February 9, 2009.

10. The Patent Owner filed the present petition(s) with exhibits A-C in support thereof, along with a proposed amendment and response/argument on February 27, 2009.

DECISION

37 CFR 1.4(c) states:

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

The instant petition raises multiple issues which are addressed by different branches of the office. In view of the fact that the petition improperly combines multiple, distinct matters in a single paper, the petition under 37 CFR 1.181 to have the final rejection of January 7, 2009 vacated and the petition under 37 CFR 1.137(b) to accept unintentionally delayed late paper is dismissed under 37 CFR 1.4(c).

ADDITIONAL INFORMATION

The instant proceeding stands terminated based upon a failure to timely file a written statement of the reasons presented at the interview as warranting favorable action as required by 37 CFR 1.560(b) and 37 CFR 1.550(d) . Relief can not be granted in a terminated file. Further, note a grantable petition under 37 CFR 1.137(b) must be accompanied by either an amendment which places all claims in the proceeding in prima facia condition for allowance or a Notice of Appeal.

CONCLUSION

1. Petitioner's requests are dismissed.

2. Any response to this decision should be directed to:

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

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

3. Telephone inquiries related to this decision should be directed to J. Harrison at (571) 272-4449, Eric Keasel at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Greg Morse
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,957	12/03/2007	6453302	R65328	8912

40401	7590	02/09/2009	EXAMINER

TIMOTHY J. MAY
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

ART UNIT	PAPER NUMBER

DATE MAILED: MAR 16 2009

REQUESTER

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

Hershkovitz & Associates, LLC (For Patent Owner)
2845 Duke Street
Alexandria, VA 22314

Timothy J. May (For Requester)
Finnegan Henderson Farabow
Garret & Dunner LLP
901 New York Avenue, N.W.
Washington, D.C. 20001-4413

MAILED

JUL 21 2009

CENTRAL REEXAMINATION UNIT

In re Jerome D. Johnson et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,957 : **GRANTING**
Filed: December 3, 2007 : **PETITION UNDER**
For: U.S. Patent No. 6,453,302 : **37 CFR 1.137(b)**

This is a decision on the March 21, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Patent Owner's Statement of Interview and Notice of Appeal and revive the present terminated reexamination prosecution, as supplemented on June 22, 2009, and then further supplemented on July 1, 2009 ("the supplemented March 21, 2009 petition to revive").[1]

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the supplemented March 21, 2009 petition under 37 CFR 1.137(b) has been paid.

The supplemented March 21, 2009 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The supplemented March 21, 2009 petition to revive is **granted**.

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file the written statement of interview required under 37 CFR 1.560(b) for the interview of December 11, 2008. Patent owner has also failed to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of January 7, 2009.

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 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 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.

With respect to item (1), the prosecution on this reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the December 11, 2008 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview. At the time of the December 11, 2008 interview, a response to an Office action was not outstanding. Therefore, 37 CFR 1.560(b) required the submission of the statement as a separate paper within one month from the December 11, 2008 interview date. Patent owner's submission of a statement under 37 CFR 1.560(b) on March 21, 2009, was thus untimely.

With further respect to item (1), prior to the termination of the prosecution of this reexamination proceeding for failure to timely submit a statement of the substance of the December 11, 2008 interview, a final Office action issued January 7, 2009. The January 7, 2009 final Office action set a one-month period for response. The February 4, 2009 paper titled "Supplemental Response and Proposed Amendment Under 37 CFR 1.530" states on page 1 that it was filed in supplemental response to the September 15, 2008 non-final Office action. The February 27, 2009 paper titled "Response Under 37 CFR 1.116 and Proposed Amendment Under 37 CFR 1.530" was submitted in a reexamination proceeding that was not pending.

The primary examiner for the instant reexamination proceeding has confirmed that neither of the February 4 and February 27, 2009 responses is an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the claims of this reexamination proceeding in condition for issuance of a reexamination certificate.[2] Therefore, for the purpose of evaluating whether the supplemented March 21, 2009 patent owner petition to revive satisfies item (1), the proffered amendment papers did not provide a proper response, within the meaning of 37 CFR 1.113, to the January 7, 2009 final Office action, with respect to providing the complete response required for granting the petition. However, the submission of the statement under 37 CFR 1.560(b) on March 21, 2009, together with the submission of the Notice of Appeal and corresponding fee of $540.00 as part of the June 22, 2009 supplement to the March 21, 2009 petition to revive, do satisfy item (1).[3]

A petition fee of $1,620.00 was submitted on March 21, 2009, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) with respect to the March 21, 2009 statement under 37 CFR 1.560(b) was submitted as part of the March 21, 2009 petition to revive. Patent owner submitted a proper statement under 37 CFR 1.137(b)(3) with respect to the June 22, 2009 Notice of Appeal as part of the July 1, 2009 supplement to the March 21, 2009 petition to revive. Item (3) has thus been satisfied.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[4]

Accordingly, the supplemented March 21, 2009 patent owner petition to revive is **granted**.

---

[2] *See*: MPEP 711.03(c)(II)(A)(2)(b)
[3] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[4] *See*: 37 CFR 1.137(d)(3).

CONCLUSION

1. The 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, Art Unit 3992, for processing of the March 21, 2009 Statement Of Substance Of Interview Under 37 CFR 1.560(b) and the June 22, 2009 Notice of Appeal, and addressing the February 4 and February 27, 2009 patent owner responses.

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, Mary Steelman, of CRU Art Unit 3992, at (571) 272-3704.

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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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,957	12/03/2007	6453302	R65328	8912

40401 7590 07/27/2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/27/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FINNEGANHENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Date:

MAILED

JUL 272009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008957
PATENT NO. : 6453302
ART UNIT : 3992

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

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

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

HERSHKOVITZ & ASSOCIATES
2845 Duke St
Alexandria VA 22314

: (For Patent Owner)

MAILED

JUL 27 2009

CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

: (For Third-Party Requester)

In re Johnson *et alia*
Reexamination Proceeding
Control No. 90 / 008,957
Request Deposited: December 30, 2007
For: U.S. Patent No.6,453,302

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

This is a decision on the March 22, 2009 petition entitled "Renewed Petition under 37 CFR 1.181 to have the Final Rejection of January 7, 2009 Vacated". The petition is before the Director of the Central Reexamination Unit for consideration. The petition is considered pursuant to 37 CFR 1.181. No fee is required.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,453,302 (hereinafter, the '302 patent), issued to Johnson et alia, on September 17, 2002.

2. On December 30, 2007, a third party deposited a Request for Ex Parte Reexamination of the '302 patent. The reexamination proceeding was assigned Control No. 90/008,957 (hereinafter, the '8957 proceeding).

3. The reexamination order was granted in the '8957 proceeding on February 4, 2008.

4. An interview was held on December 11, 2008.

5. A final rejection was mailed on January 7, 2009 setting a one-month shortened statutory period (SSP) for response to the final office action.

6. Reexamination proceedings TERMINDATED on January 12, 2009 as a result of Owner failure to timely file a statement of the interview as required by 37 CFR 1.560(b) and 37 CFR 1.550(d).

7. On February 4, 2009, Patent Owner filed a paper entitled "STATEMENT OF SUBSTANCE OF INTERVIEW UNDER 37 CFR 1.560(b) and a petition under 37 CFR 1.181 to have the final rejection of January 7, 2009 vacated.

8. A decision dismissing the petition under 37 CFR 1.181 to have the final rejection of January 7, 2009 vacated was mailed by the Office on February 9, 2009. No basis exists for granting any relief in a terminated proceeding.

9. On February 27, 2009 Patent Owner filed a combined petition under 37 CFR 1.181 requesting vacatur of the January 7, 2009 Final Rejection or, in the alternative, relief under 37 CFR 1.137(b) to revive the proceeding and accept a delayed statement of the interview. This petition was dismissed under 37 CFR 1.4(c)

10. After various other petitions, all dismissed, a petition to revive under 37 CFR 1.137(b) was filed on March 22, 2209 concurrently with the instant petition. This petition included a notice of appeal.

11. The petition to revive has been granted as noticed July 20, 2009. Consideration of Owner's petition under 37 CFR 1.181 on the merits is now appropriate.

DECISION

In response to the first office action mailed September 15, 2008, Patent Owner filed a response with amendment on November 16, 2008. No amendments were made to the patented claims; however, new claims were added. A final rejection issued on January 7, 2009. The final rejection maintained all previous rejections presented in the first office action and rejected newly added claims. No new grounds of rejection were added to the original claims.

The criteria for making a rejection final in an ex parte reexamination proceeding is analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application. Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure

statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Owner, in his petition, has failed to point out any instances where the examiner has made any new grounds of rejection. Nor has Owner highlighted any errors or inconsistencies within the final rejection. Thus the final appears to have been properly issued and there is no basis for granting relief as requested. The petition is dismissed.

ADDITIONAL DISUCSSION

In the March 22, 2009 petition entitled "Renewed Petition under 37 CFR 1.181 to have the Final Rejection of January 7, 2009 Vacated", Patent Owner advances for consideration a variety of arguments which are not germane to the issue of the propriety of the Final Rejection.

Regarding arguments presented for reconsideration of the February 9, 2009 dismissal of the petition under 1.181, Patent Owner has failed to present any reasoning as to why refusal to consider a petition in a terminated file is improper. Disagreement with the status of terminated is not persuasive.

Patent Owner asserts that the issuance of the Office Action unfairly operated to shorten the one month period that the patent holder had under the rules to prepare and file the statement of the interview and argues that the examiner has no authority to truncate that regulatory period. That period is not an automatic delay in the proceeding, which would appear to be contrary to the statutory mandate of special dispatch. Rather, it is a mechanism requiring that arguments made at an interview be put on the record. The examiner's issuance of the Office Action did not truncate any regulatory period as Patent Owner contends. Multiple periods may be running simultaneously in a proceeding; the running of a first period is not suspended, altered or affected by the running of a second period.

Patent Owner further contends the issuance of an Office Action prior to having Owner's interview summary serves to undermine the USPTO's reliance on the statement as such should be material to the Examiners' consideration of the merits of the case. The requirement of Owner's statement of the interview is to provide a complete record of the prosecution of the proceeding rather than introducing additional arguments or amendments in the summary. Further, supplemental amendments and arguments are not entered as a matter of right, but are limited to situations specifically proscribed in MPEP 2266.

CONCLUSION

1. Petitioner's request is **DISMISSED.**

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 3 0 2009

CENTRAL REEXAMINATION UNIT

DUANE MORRIS LLP
IP DEPARTMENT
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103-4196

In re Application of :
SAMARAS, G. :
Control No. 90/008,960 (US PAT 6,092,322) : DECISION ON PETITION
Filed: February 4, 2008 : TO WITHDRAW
Attorney Docket No. ALU01.002 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 20, 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 Stephan P. Gribok on behalf of all attorneys of record who are associated with customer No. 08933.

All attorneys/agents associated with the Customer Number 08933 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor or the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant

There is an outstanding Office action mailed January 09, 2009 that requires a reply from the applicant.

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

Patricia Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: GREG SAMARAS
35-24 209TH STREET
BAYSIDE, NY 11361

cc: KEITH NOWAK (Third Party Requester)
CARTER LEDYARD & MILBURN LLP
2 WALL STREET
NEW YORK, NY 121907

cc: SUSQUEHANNA PATRIOT BANK
ATTENTION: ALAN WILSON
115 EAST HIGH TOWER
POTTSTOWN, PA 19464

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,960	02/04/2008	6092322		9605

34661 7590 05/04/2009

CHARLES N. QUINN
FOX ROTHSCHILD LLP
2000 MARKET STREET, 10TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2009

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

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MAY 04 2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Keith D. Nowak
Carter Ledyard & Milburn LLP
2 Wall Street
New York, NY 10005

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,960*.

PATENT NO. *6092322*.

ART UNIT *3993*.

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

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Susquehanna Patriot Bank
Attention: Alan Wilson
115 East High Street
Pottstown, PA 19464 .

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MAY 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,960*.

PATENT NO. *6092322*.

ART UNIT *3993*.

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

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

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Duane Morris LLP
IP Department
30 South 17th Street
Philadelphia, PA 19103-4196

(For Patent Owner)

MAILED

MAY 04 2009

CENTRAL REEXAMINATION UNIT

Keith D. Nowak
Carter Ledyard & Milburn, LLP
2 Wall Street
New York, NY 10005

(For Third Party Requester)

Susquehanna Patriot Bank
Attention Alan Wilson
115 East High Street
Pottstown, PA 19464

(Courtesy Copy)

In re Greg Samaras
Reexamination Proceeding
Control No: 90/008,960
Filed: February 4, 2008
For: U.S. Patent No. 6,092,322

DECISION DISMISSING PETITION TO SUSPEND *EX PARTE* REEXAMINATION UNDER 37 CFR § 1.182 AND 1.183

This is a decision on the March 6, 2009 third party requester petition titled "Petition To Suspend Ex Parte Reexamination Under 37 CFR § 1.182 and 37 CFR § 1.183" ("the March 6, 2009 petition to suspend").

A petition fee under 37 CFR 1.17(f) of $400 has been charged to third party requester's deposit account, pursuant to the authorization for same in the Petition Fee Under 37 CFR 1.17(f), (g) & (h) Transmittal accompanying the March 6, 2009 petition to suspend.

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

For the reasons set forth below, the petition to suspend is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,092,322 ("the '322 patent") issued to Greg Samaras ("the inventor") on July 25, 2000.

2. The inventor filed a request for *ex parte* reexamination of the '322 patent on December 19, 2007; it was assigned Control No. 90/008,960 ("the '8960 *ex parte* reexamination proceeding").

3. A Notice of Failure to Comply With *Ex Parte* Request Filing Requirements (37 CFR 1.510(c)) was mailed to counsel for the inventor on January 4, 2008.

4. On February 4, 2008, the inventor deposited a corrected request for *ex parte* reexamination, which, upon review by the Office, was accorded a filing date of February 4, 2008.

5. On March 31, 2008, the Office ordered reexamination for claims 1-29 (i.e., all of the claims) of the '322 patent.

6. Based on information included in the request for reexamination of the '322 patent that identified an issue of ownership of the '322 patent, the March 31, 2008 order includes a provision providing for the inventor and the putative assignee BuckWing Products, Inc. ("BuckWing") to each file a statement in accordance with 37 CFR 1.530, or to elect to not file such a statement and instead file a paper so notifying the Office that would be confined to showing of facts supporting its claim of ownership of the '322 patent. The provisions of 37 CFR 1.530 and 37 CFR 1.535 are waived to the extent necessary to accommodate this change in reexamination procedure.

7. On May 15, 2008, BuckWing filed (i) a statement regarding its position that it is the assignee of the '322 patent, (ii) a power of attorney, and (iii) a change of address in favor of BuckWing's counsel.

8. On May 30, 2008, the inventor filed a statement stating that he, and not BuckWing, is the owner of the '322 patent.

9. Also on May 30, 2008, the inventor filed a power of attorney and change of correspondence address in favor of the inventor's counsel, revoking the May 15, 2008 power of attorney and change of correspondence that had been filed by BuckWing.

10. On December 16, 2008, the Office issued a Decision Determining Ownership of Patent and Status of Parties. The Decision states that BuckWing is determined to be the owner of the '322 patent for purposes of the '8960 *ex parte* reexamination proceeding and will be entitled to conduct prosecution in that proceeding. The Decision also states that Greg Samaras is determined to be the third party requester in the '8960 reexamination proceeding, and his participation in the proceeding is limited to that of a third party requester in an *ex parte* reexamination.

11. On January 9, 2009, the Office issued a non-final Office action in the '8960 reexamination proceeding. The Office action states that: (i) claims 2, 6-7, 10-11, 19, 21-22, and 24-29 are patentable and/or confirmed, and (ii) claims 1, 3-5, 8-9, 12-18, 20, and 23 are rejected. The Office action sets a two-month shortened statutory period for response.

12. On January 20, 2009, counsel for BuckWing filed a Request for Withdrawal as Attorney or Agent and Change of Correspondence Address. The Request includes a request that

all future correspondence be directed to Susquehanna Patriot Bank, Attention Alan Wilson, 115 East High Street, Pottstown, PA, 19464.

13. On January 30, 2009, the Office issued a Decision on Petition to Withdraw from Record. The Decision approves BuckWing counsel's request to withdraw as attorney of record. The Decision states that there is no attorney of record for patent owner at this time. The Decision further states that the request to change the correspondence address of record is not acceptable, because the Susquehanna Patriot Bank correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 CFR 3.71.

14. On March 6, 2009, third party requester, i.e., the inventor - Greg Samaras, filed the instant petition seeking to suspend the '8960 reexamination proceeding. The March 6, 2009 petition to suspend states that the inventor "filed an action against Susquehanna Bank, the purported assignee of [the '322 patent] in the U.S. District Court for the Eastern District of Pennsylvania ... thereby placing [the '322 patent] in litigation to judicially determine the issue of ownership."

DECISION

I. Pertinent Statutes, Regulations, and Procedures

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

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding, $1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $500.

35 U.S.C. 133 provides:

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

35 U.S.C. 305 provides:

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

37 CFR 1.111 provides, in pertinent part:

(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment.

*

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

37 CFR 1.137 provides, in pertinent part:

(a) *Unavoidable.* If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable ...

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ...

*

*

(d) *Terminal Disclaimer.*

*

*

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

37 CFR 1.181(f) provides:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

37 CFR 1.550 provides, in pertinent part:

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension.

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

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

(1) The delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable; a petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a); or

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

MPEP 2268 provides, in pertinent part:

I. PETITION BASED ON UNAVOIDABLE DELAY

The unavoidable delay provisions of 35 U.S.C. 133 are imported into, and are applicable to, *ex parte* reexamination proceedings by 35 U.S.C. 305. See *In re Katrapat*, 6 USPQ2d 1863 (Comm'r Pat. 1988). Accordingly, the Office will consider, in appropriate circumstances, a petition showing unavoidable delay under 37 CFR 1.137(a) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide an adequate showing of the cause of unavoidable delay, including the details of the circumstances surrounding the unavoidable delay and evidence to support the showing. Additionally, the petition must be accompanied by the petition fee set forth in 37 CFR 1.17(l) and a proposed response to continue prosecution (unless it has been previously filed).

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

II. Findings and Analysis

Patent owner did not respond to the January 9, 2009 Office action, as is required by 37 CFR 1.111. Third party requester's March 6, 2009 petition to suspend is noted; however, under 37 CFR 1.181(f), the mere filing of third party requester's March 6, 2009 petition did not serve to stay the period for patent owner to respond to the January 9, 2009 Office action. In view of patent owner's failure to respond to the January 9, 2009 Office action, the '8960 reexamination proceeding prosecution is terminated and not pending, pursuant to 35 U.S.C. 133.

The Office does not have jurisdiction to decide a petition under 37 CFR 1.182/1.183 on the merits, where the underlying proceeding is not pending. Therefore, the instant petition is dismissed.

ADDITIONAL DISCUSSION

As stated in the December 16, 2008 Decision, BuckWing is the owner of record of the '322 patent for purposes of the '8960 *ex parte* reexamination proceeding. BuckWing therefore has the option to seek revival of the '8960 reexamination proceeding, pursuant to 37 CFR 1.137, based upon either unintentional or unavoidable delay (as is appropriate).

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

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

The Office assignment records for the '322 patent reveal that an assignment of assignor's interest was recorded on March 27, 2009, from assignor BuckWing to assignee Susquehanna Bank. In order for Susquehanna Bank to seek revival of the '8960 reexamination proceeding, pursuant to 37 CFR 1.137, based upon either unintentional or unavoidable delay, it must establish its right to take action in accordance with 37 CFR 3.73.

In order for third party requester, i.e., the inventor, to seek revival of the '8960 reexamination proceeding, pursuant to 37 CFR 1.137, based upon either unintentional or unavoidable delay, he **must provide** a copy of a decree from a court of competent jurisdiction that establishes his ownership of the '322 patent. Third party requester must also show due diligence, including: (i) an explanation as to why the instant petition to suspend was not filed prior to three days before

the expiration of the time period for responding to the January 9, 2009 Office action; and (ii) a showing that ownership of the '322 patent was diligently pursued in court in response to this Decision.

PATENT OWNER'S ADDRESS

The January 20, 2009 Request for Withdrawal as Attorney or Agent and Change of Correspondence Address includes a request that all future correspondence be directed to Susquehanna Patriot Bank, Attention Alan Wilson, 115 East High Street, Pottstown, PA, 19464. However, as stated in the January 30, 2009 Decision on Petition to Withdraw from Record, the Susquehanna Patriot Bank correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 CFR 3.71. Therefore, the proper patent owner correspondence address of record continues to be that of BuckWing's counsel, i.e., Duane Morris LLP, IP Department, 30 South 17th Street, Philadelphia, PA 19103-4196.

As a courtesy, this decision is being mailed to the Susquehanna address identified in the January 20, 2009 Request for Withdrawal. The above address of BuckWing's counsel will be the sole patent owner address used in future correspondence, until a change in patent owner correspondence address in the patent and the reexamination is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. Third party requester's March 6, 2009 petition to suspend is dismissed.

2. The '8960 *ex parte* reexamination proceeding will not be suspended.

3. Jurisdiction over the proceeding is being retained by the Office of Patent Legal Administration for ONE MONTH from the mailing of this Decision to provide an opportunity for filing a petition pursuant to 37 CFR 1.137, based upon either unintentional or unavoidable, in an effort to revive the proceeding. If such a petition is not filed within the ONE MONTH time period, jurisdiction over the '8960 reexamination proceeding will be returned to the Central Reexamination Unit, for processing as a terminated prosecution.

3. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

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.
90/008,960	02/04/2008	6092322		9605

34661 7590 06/02/2009

CHARLES N. QUINN
FOX ROTHSCHILD LLP
2000 MARKET STREET, 10TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Keith D. Nowak
Carter Ledyard & Milburn LLP
2 Wall Street
New York, NY 10005

Date:

MAILED

JUN 0 2 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008960
PATENT NO. : 6092322
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Charles N. Quinn (For Patent Owner)
FOX ROTHSCHILD LLP
2000 Market Street, 10th Floor
Philadelphia, PA 19103

MAILED

JUN 0 2 2009

CENTRAL REEXAMINATION UNIT

Keith D. Nowak (For Requester)
Carter Ledyard & Milburn, LLP
2 Wall Street
New York, NY 10005

In re Greg Samaras :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,960 : **GRANTING**
Filed: February 4, 2008 : **PETITION UNDER**
For: U.S. Patent No. 6,092,322 : **37 CFR 1.137(b)**

This is a decision on the May 5, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination[1] ("the May 5, 2009 patent owner petition to revive").

The appropriate petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the May 5, 2009 patent owner petition to revive has been paid.

The May 5, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 5, 2009 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a response under 37 CFR 1.550(b) to the January 9, 2009 Office action.

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *
> (d) *Terminal disclaimer.*
> > *
> > *
> > (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

> (b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.
>
> *

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the May 5, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a response to the January 9, 2009 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a response to any Office action. The January 9, 2009 Office action set a two-month period for response. A response to the January 9, 2009 Office action was not filed until May 5, 2009, which was untimely. However, for the purpose of evaluating whether the May 5, 2009 patent owner petition to revive is a grantable petition, the submission of the May 5, 2009 response to the January 9, 2009 Office action satisfies item (1).[2]

Accordingly, the May 5, 2009 patent owner petition to revive is **granted**.

ADDITIONAL DISCUSSION

In the May 4, 2009 Decision, Buckwing Products, Inc. was identified as the owner of record of U.S. Patent No. 6,092,322 ("the '322 patent"), in view of the December 16, 2008 Decision, and in view of Susquehanna Bank's then-failure to establish its right to take action in accordance with 37 CFR 3.73.

Pursuant to the May 5, 2009 Statement Under 37 CFR 3.73(b), Susquehanna Bank is now considered the owner of record of the '322 patent for purposes of the '8960 *ex parte* reexamination proceeding.

CONCLUSION

1. The May 5, 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 3993, for processing of the May 5, 2009 Response To Office Action.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jeffrey Gellner, of CRU Art Unit 3993, at (571) 272-6887.

---

[2] This decision is not directed to the persuasiveness and propriety of the arguments presented in the May 5, 2009 response as to each of the rejections set forth in the January 9, 2009 Office action; such is the examiner's province.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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.
90/008,962	12/17/2007	RE 36,203	04072 PTRX	6687

21874 7590 11/06/2008

EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/06/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JOHN J. PATTI
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

Date:
MAILED
NOV 06 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008962
PATENT NO. : RE36203
ART UNIT : 3992

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

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

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

William L. Brooks
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON MA 02205

(For Patent Owner)

MAILED

NOV 06 2008

CENTRAL REEXAMINATION UNIT

John J Patti
STORM, LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR
EXTENSION OF TIME
[37 CFR § 1.550(c)]

In re: Matsui
Ex Parte Reexamination Proceeding
Control No. 90/008,962
Deposited: 17 December 2007
For: US Patent Reissue No.36,203

This is a decision on the 31 October 2008, petition for "Petition and Request for Extension Of Time Under 37 CFR § 1.550(c) and § 1.17(g)," requesting that the time for responding to The non-final Office action, mailed 30September 2008 be extended by thirty (30) days.

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 non-final Office action mailed 30 September 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 non-final Office action be extended to thirty (30) days. Since the

petitioner has provided "sufficient cause" for granting-in-part an extension of time, the petition is granted-in-part.

An extension of time of two additional weeks is hereby granted.

37 CFR 1.550 (c) states:

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

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

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

Analysis and Findings

The patent owner petitions the director if the Central reexamination unit for an extension of time of two-month for which to submit a response to the non-final Office action. The petitioner notes that the assignee is a Japanese corporation and that the inventor is a Japanese citizen. The petitioner further notes that the references must be translated in to Japanese for understanding the rejections of the claims then all response translated back into English.

When considering a petition for extension of time consideration must be given for the patent owner to be given opportunity to present a complete response versus the need for special dispatch in the instant proceeding. It is for these reasons that one must always determine whether there is "sufficient cause" to support an extension for time in a reexamination proceeding.

While it is noted that the assignee is a Japanese corporation and that the reference rejecting the claims are US English language patents. Based upon the consideration of the need for special dispatch as well as a fair opportunity for the patent owner to properly respond to the outstanding Office action, an extension of two-weeks (14 days) is hereby granted.

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

Conclusion

1. The patent owner's petition for extension of thirty (30) days time in which to file a response to the Final Office action dated 30 September 2008 is hereby **granted-in-part**.

2. This petition grants an extension of **two-weeks (14 days)** additional time for which to respond to the outstanding Office action.

3. The non-final Office action mailed 29 September 2008 which set a two-months period for response for which to respond will end with the grant of this petition decision on **14 December 2008**.

4. Future correspondence may be submitted as follows:

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

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

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

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

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

/Mark Reinhart/

Gregory 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

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CENTRAL REEXAMINATION UNIT

Haynes and Boone, LLP (For Patent Owner)
IP Section
2323 Victory Avenue
SUITE 700
Dallas TX 75219

Orrick, Herrington & Sutcliffe LLP (For Requester)
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

In re Doktor : DECISION DENYING
Reexamination Proceeding : PETITION UNDER
Control No. 90/008,965 : 37 CFR 1.181 AND
For: U.S. Patent No. 5,617,567 : 37 CFR 1.515(c)

This is a decision on the April 14, 2008 paper entitled "PETITION FOR REVIEW OF DENIAL OF REQUEST FOR *EX PARTE* REEXAMINATION OF U.S. PATENT NO. 5,617,567, PURSUANT TO 1.515(c) AND 1.181(b). No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

The petition is **DENIED** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,617,567 (hereinafter, the '567 patent) issued on April 1, 1997 to Doktor.

2. The '567 patent was subject to a merged reexamination/reissue proceeding assigned control number 90/007,705. A reexamination certificate issued in this proceeding on September 30, 2008.

3. On December 18, 2008, the instant request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/008,965 (hereinafter, the '8965 proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on March 14, 2008. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

4. On April 14, 2008, the present petition was filed.

DECISION

Third party requester ("Petitioner") in the '8965 reexamination proceeding has petitioned seeking relief from the examiner's March 14, 2008 Order denying *ex parte* reexamination for all requested claims.

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for claims 1-16 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the

examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '567 Patent

The '567 patent issued on April 1, 1997 to Doktor. During the prior reexamination/reissue proceeding, the Examiner indicated that claim 1 was allowable because:

"... Tsichritzis fails to anticipate or render obvious the recited feature of a relational database, as well as the storage of a first and second search path records as in independent claims 1-16." *90/007,705 proceeding, Notice of Allowance mailed 2/22/2008, Page 6.*

"... Munz fails to anticipate or render obvious the recited feature of a relational database, as well as the storage of a first and second search path records as in independent claims 1-16, and the storage of abbreviated results, as in independent claims 2, 4, 6, 8, and 13-16." *90/007,705 proceeding, Notice of Allowance mailed 2/22/2008, Page 7.*

III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination has been made as to whether the December 18, 2007 request for ex parte reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

For the reasons set forth below, the request for *ex parte* reexamination of the '567 patent filed in the '8965 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

Petitioner first argues that the Elmasri reference raises a SNQ over the requested claims. Elmasri will raise a SNQ if the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination. *MPEP §2242.* A reasonable Examiner would not consider the teachings of Elmasri important in deciding whether or not the claims are patentable because Elmasri's teachings are not on point as to the distinguishing features of the '567 patent.

As noted above, in the prior reexamination/reissue proceeding, it was noted that the prior art of record did not teach "the recited feature of a relational database, as well as the storage of a first and second search path records as in independent claims 1-16, and the storage of abbreviated results, as in independent claims 2, 4, 6, 8, and 13-16." *90/007,705 proceeding, notice mailed 2/22/2008, Page 7.* The claims require that the storage of the first and second search path records is completed using an inquiry definition table and that first and second search path records are related and share a common second entity. *See claim 1.* The features of the relational database, while not present in the prior art of record, are well known in the art and described in the background of the '567 patent and accordingly those features do not distinguish the '567 patent from the prior art. *see '567 patent, columns 4-6.*

Elmasri does not raise a SNQ because Elmasri does not teach the distinguishing features of the storage of the first and second search path records and the storage of abbreviated results. Turning to the feature of the storage of first and second search path records, the request states:

> "Elmasri teaches the storage of a first search path record. Query by example, "is a user-friendly relational query language" that enables a user to retrieve items in a relational database. Elmasri at 241-42. QBE queries may also be stored within a search path record. Elmasri at 248 ("QBE also has facilities for view definition, authorization, storing query definitions for later use, and so on.")" *Request for Reexamination, Page 43*

> "Elmasri also teaches that the first search record storing means includes an inquiry definition table. Specifically, Elmasri discloses that QBE has facilities for storing query definitions for later use. Elmasri at 249." *Request for Reexamination, Page 44*

> "Elmasri also teaches that the means for storing the second search path record is operatively coupled to memory means. The second search path record is stored with the database within the greater database system environment. See Fig. 1.1. Elmasri further teaches that the second search path record may be an element of a nested query. Elmasri at 184-186. In such a nested query, the second search path record corresponds to the outer query. These nested queries are processed in series, using the results of the first nested query to derive information used in the second nested query and the final outer query. This is the same process used in the '567 patent.

> Elmasri also teaches that said second search path record storing means includes an inquiry definition table means. According to Elmasri, QBE also has facilities for storing query definitions for later use. Elmasri at 249. Thus, search path records, or QBE queries generated in the above elements may be stored in inquiry definition table means as claimed:" *Request for Reexamination, Pages 46-47*

The request also does not establish that Elmasri teaches the distinguishing feature of the storage of abbreviated results as presented in independent claims 2, 4, 6, 8, and 13-16. Regarding this distinguishing feature of the '567 patent, the request states:

> "Elmasri teaches storage of said second entity in an abbreviated results gathering means.
>
> In response to the first search path record discussed above, the database management system retrieves information about all PROJECTs (second entity) that an EMPLOYEE (first entity) WORKS_ON (first relation). Second entity PROJECT is related to the first entity EMPLOYEE by first relation WORKS_ON, in the COMPANY database depicted in Figure 12.1.
>
> As further shown in Table 12.1 of Elmasri, joining the EMPLOYEE and WORKS ON tables results in a first materialized join view PROJECT table being created. This materialized join view table containing the PROJECTs retrieved by the first search path record is the abbreviated results gathering means." *Request for Reexamination, Page 55*

The request does not raise a SNQ with respect to Elmasri because the request does not establish that Elmasri teaches the features that distinguished the '567 patent over the prior art. First, the request does not establish that Elmasri teaches the storage of a first and second search path records. At most, Elmasri discusses "storing query definitions for later use." *Elmasri at 249.* However, there is no teaching regarding the storage of first and second search path records where the first and second search path records are related. The request seems to suggest that one could look to the statement regarding "storing query definitions for later use" and then look to a wholly separate section where Elmasri discusses nested queries that operate in a similar manner to the '567 patent's queries to meet the claim limitation *(see Elmasri, pages 184-186).* However, Elmasri provides no discussion of the storage of these nested queries in an inquiry definition table or any discussion of the storage of those queries. Accordingly, the request has not established that Elmasri teaches the distinguishing feature of the storage of the first and second search path records.

Turning to the storage of abbreviated results, the request does not establish that Elmasri teaches the storage of abbreviated results because the cited portions of Elmasri merely discuss the relational schema of the database and how the entities are related. The '567 patent notes that the abbreviated gathering means is used to store the abbreviated results and then trigger the expansion the abbreviated results into full results *(Shaw, column 28 line 62 – column 29 line 10).* Thus it is clear that the '567 patent's abbreviated results are not "intermediate" results, but instead of results that are "shortened" or "abbreviated" before being expanding into full results.

Elmasri does not explicitly disclose the storage of abbreviated results as required by the claims because Elmasri teaches nothing more than "intermediate results" that are combined with other "intermediate" results to form a final results table. Accordingly, Elmasri would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '567 patent.

Petitioner next argues that the Elmasri reference in combination with Shaw raises a SNQ over the requested claims. As noted above, Elmasri does not independently raise a SNQ over the requested claims. Similarly, Shaw does not raise a SNQ over the requested claims because Shaw does not provide teachings that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable. The request states:

> "Shaw teaches how to synthesize a linear (SQL) query for accessing the contents of a relational database from a graphic query input at a user terminal, including relation records. Shaw, 1:9-30. Shaw takes the QBE skeleton tables, and generates an SQL query, which is then used to retrieve the inquiry results from the relational database. Id." *Request for Reexamination, Page 59*

> "Shaw teaches that said first search path record storing means includes an inquiry definition table means. Shaw discloses storage of a search path record in a table of one or more example elements and implied operand predicates, and which appear in rows and columns of an example table including one or more source and target tables. Shaw, 2:36-43. Figure 5 of Shaw also discloses a table GFTTABLE 72 (an inquiry definition table means), which has one entry for each skeleton or example table in a query 2. The first search path records would therefore constitute one entry of GFTTABLE." *Request for Reexamination, Page 63*

> "Shaw also teaches storage of said second entity in an abbreviated results gathering means. Shaw teaches abbreviated results gathering means via the creation of results tables generated from the operation of SELECT and UNION SQL commands on the underlying database. The search paths generated in the QBE skeleton tables trigger SQL commands that operate more directly on the underlying database. Shaw at 15:37-40 ("A SQL SELECT statement is generated for each query depended row that appears in a retrieval request".) These SQL commands, such as SELECT and UNION statements act to find and retrieve data from various tables with common data within the underlying database. These SELECT statements are used (along with other SQL commands) in subqueries as well. Shaw, 17:1-5. Data retrieved from one target retrieval may be used to combine data and/or collect data from more than one table. Shaw, 16:13-16. This is also disclosed by the use of nested SQL queries, in Elmasri. Elmasri at 184-186.

> In addition, Shaw's Extended Cartesian Product (ECP) may be interpreted as an abbreviated results gathering means. "When multiple target print rows appear in a target print query, each print row is treated like a separate query ..... An ECP is formed for each query, and the results are UNIONed to form a final results table." Shaw, 9:36-40. Table

> 33 of Shaw shows a skeleton results table on the right hand side with two "P."s There are two linked source skeleton tables: HQLOC and EMP. An ECP is formed for each of the P. query rows (i.e., an ECP for each SELECT statement). Either ECP can be an abbreviated results gathering means. The two ECPs are UNIONed together to create the final results table." *Request for Reexamination, Page 82*

Shaw's teachings are not on point as to the distinguishing feature of the storage of a first and second search path records. The request relies on Shaw's GFTTABLE 72 where Shaw discloses the storage of a skeleton or example table in a query (*Shaw, column 11 lines 1-6).* However, Shaw does not specifically disclose the storage of a first search path record and a second search path record where the first and second search path records are related and share a second entity as is required by claims 1-16. Instead, Shaw merely discloses the storage of the example table. The storage of an example table is not the same as the storage of a first search path record and a second search path record because an example table is the storage of an array of elements and not a path record (*see Shaw, column 3 lines 44-65).*

Similarly, Shaw's teachings are not on point as to the distinguishing feature of the storage of abbreviated results. The request asserts that Shaw teaches the claimed abbreviated results means by disclosing results tables generated by the operation of SELECT and UNION SQL commands and Shaw's Extended Cartesian Product (ECP) method. Neither of these portions of Shaw is on point with the distinguishing feature of the '567 patent. The SELECT and UNION SQL commands as well as the ECP method provide intermediate results which are then combined to form a final set of results. This is not the same as the storage of "abbreviated results." The '567's abbreviated results are not conventional query results, but instead are results detailing the level of an inquiry and a relation to an entity that are later expanded into user-understandable results (*'567 patent, column 33 lines 1-21; Figure 9*). Accordingly, Shaw would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '567 patent.

Petitioner next argues that the Shaw reference in combination with Zloof and Teorey raises a SNQ over the requested claims. As noted above, Shaw does not independently raise a SNQ over the requested claims. Similarly, Zloof and Teorey do not raise a SNQ over the requested claims because they do not provide teachings that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable. Regarding Teorey, the request does not rely on Teorey to teach any of the distinguishing limitations. Regarding Zloof, Petitioner asserts on Page 26 that Zloof teaches the abbreviated results gathering means and the request states:

> "Zloof also teaches abbreviated results gathering means. As observed above in the Elmasri section, a snapshot is a newly stored table that contains the data from the resultant table. Giving the resultant table results in the creation of a snapshot. For example, a resultant table (the top table in Figure 48 in Zloof) contains the results of a search on the two skeleton tables: SALES and SUPPLY, also shown in Fig. 48 of Zloof.

> This resultant table, once named ("SS"), becomes a newly stored table, i.e., a snapshot." *Request for Reexamination, Page 29*
>
> "Zloof teaches a first search path record storing means including an inquiry definition table. The QBE skeleton tables of Zloof are the inquiry definition table means. Zloof at 325-6. As is well known to one of ordinary skill in the arts these linked QBE tables can inherently be stored for later use: "QBE has facilities for view definition, authorization, storing query definitions for later use, and so on." Elmasri textbook at 248. Thus, Zloof teaches a first search path record storing means in an inquiry definition table means." *Request for Reexamination, Page 105*

In a similar manner to Shaw, Zloof's teachings are not on point as to the distinguishing feature of the storage of abbreviated results. The request cites portions of Zloof that are directed to the storage of intermediate results and not to the storage of abbreviated results as is described in the '567 patent. Zloof's teachings are not the same as the storage of "abbreviated results." The '567's abbreviated results are not conventional query results, but instead are results detailing the level of an inquiry and a relation to an entity that are later expanded into user-understandable results (*'567 patent, column 33 lines 1-21; Figure 9*). Accordingly, Zloof would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '567 patent.

In a similar manner to Elmasri, Zloof's teachings are not on point as to the distinguishing feature of the storage of a first and second search path records. The request contends that Zloof teaches the feature inherently through QBE tables. However, evening assuming the request is correct in that Zloof's QBE tables inherently teach storing query definitions for later use, Zloof does not teach the storage of first and second search path records where the first and second search path records are related as claimed. Accordingly, Zloof would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '567 patent.

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

2. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Gregory Morse, Director
Central Reexamination Unit

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

SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVE., N.W.
WASHINGTON DC 20037-3202

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JUL 14 2010

OFFICE OF PETITIONS

In re application of :
Martin Fermann, et al :
Issue Date: October 27, 2009 : DECISION ON PETITIONS
Application No. 90/008,971 :
Filed: December 21, 2007 :
Attorney Docket No. 16577-003RX1

This is a decision on the petition filed June 21, 2010, under 37 CFR 1.182, requesting issuance of a duplicate Ex-Parte Reexamination Certificate for the above-identified application. This is also a decision on the petition to expedite filed June 21, 2010.

The petitions are **GRANTED**.

The Office of Data Management is directed to issue a duplicate Ex-Parte Reexamination Certificate.

As authorized, the $400 fee for the petitions under 37 CFR 1.182 has been assessed to petitioner's deposit account as authorized.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3208. Inquiries regarding the issuance of a duplicate Ex-Parte Reexamination Certificate may be directed to Niomi Farmer in the Office of Data Management at (703) 756-1556.

A copy of this decision is being faxed to the Office of Data Management for issuance of a duplicate Ex-Parte Reexamination Certificate.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

cc: Niomi Farmer, Randolph Square, 9th Floor, Room D30-B (Fax No. (571) 270-9753)

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

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JUN 18 2008

CENTRAL REEXAMINATION UNIT

Scott J. Fields (For Patent Owner)
Synnestvedt & Lechner
2600 One Reading Center
1101 Market St.
Philadelphia, PA 19107

Vernon W. Francissen (For Third Party Requester)
Francissen Patent Law, P.C.
53 W. Jackson Blvd., Suite #1320
Chicago, IL 60604

Arthur A. Gasey (Courtesy Copy)
Niro, Scavone, Haller & Niro
181 West Madison Street, Suite 4600
Chicago, IL 60602

In re Rozmanith :
Ex Parte Reexamination Proceeding :
Control No.: 90/008,972 : **DECISION**
Filed: April 11, 1991 : **DISMISSING**
For: U.S. Patent No.: 5,253,341 : **PETITION**
:

This is a decision on the petition filed by patent owner on April 24, 2008 for a suspension of the rules under 37 CFR 1.183 to make the above-identified Reexamination proceeding specially expedited.

The patent owner petition is granted to the extent that the petition to waive the rules has been considered, but is dismissed as to the relief requested for the reasons set forth below.

BACKGROUND

1. On June 6, 2000, a request for *ex parte* reexamination of U.S. patent 5, 253,341 ("the '341 patent") was filed by a third party requester.
2. On July 24, 2007, the Office issued a reexamination certificate for the '341 patent.
3. On December 21, 2007, a second request for *ex parte* reexamination of the '341 patent was filed, and assigned control No. 90/008,972 ("the '972 reexamination proceeding").
4. On March 5, the Office issued an order granting the reexamination request in the '972 reexamination proceeding.
5. No Office action on patentability has issued.
6. The instant petition requests suspension of the rules so that the '972 reexamination proceeding will be handled on a "specially expedited basis."

FEES

The $400.00 fee for a petition under 37 CFR 1.183 has been charged to Deposit Account No. 14-1131 as authorized at page 1 of the present patent owner petition.

DECISION

Patent owner requests a suspension of the rules under 37 CFR 1.183 so that the '972 reexamination proceeding will be handled on a "specially expedited basis." [1]. The Office does not treat *ex parte* reexamination proceedings on a "specially expedited basis." Rather, 35 U.S.C. § 305 provides 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."

Although the petitioner patent owner points out that this is a reexamination proceeding having concurrent litigation, the Office does not take a reexamination proceeding out of turn based solely on the existence of concurrent litigation. Current statistics (through December 31, 2007) show that 26% of the *ex parte* reexamination requests filed and 52% of the *inter partes* reexamination requests filed involved patents that were also subject to litigation. Thus, it does not appear that the existence of concurrent litigation involving a patent for which reexamination has been requested presents an extraordinary situation. In addition, although the petitioner patent owner states that the first reexamination proceeding took more than seven years to conclude, the '972 reexamination stands on its own merits and will be conducted with special dispatch within the Office.

It is to be noted that to treat a given *ex parte* reexamination proceeding on a "specially expedited basis," *e.g.,* ahead of other *ex parte* reexamination proceedings filed earlier than that given *ex parte* reexamination, (and potentially ahead of other prior filed *inter partes* reexamination proceedings as well [2]) , would be to relegate some of the prior filed reexamination proceedings to an inferior status in derogation of the statutory mandate that such proceedings be conducted with special dispatch within the Office. It is further to be noted that the '972 reexamination proceeding is not the only reexamination proceeding pending in the Office that is the subject of one or more litigation proceedings.

If, during subsequent prosecution of the '972 reexamination proceeding, petitioner patent owner feels that prosecution is being inordinately delayed, a petition under 37 CFR 1.181 directed to the Director of the Central Reexamination Unit requesting the exercise of supervisory authority would be the appropriate vehicle to address the situation on an as-needed basis in each individual instance. Waiver of the rules would not be necessary.

---

[1] It is noted that a waiver of 37 CFR 1.540 is necessary, because the regulation provides that "[N]o submissions other than the statement pursuant to § 1.530 and the reply by the ex parte reexamination requester pursuant to § 1.535 will be considered prior to examination. The present petition was filed prior to the expiration of the time for filing a patent owner statement under 37 CFR 1.530.

[2] 35 U.S.C. § 314(c) provides that "[U]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

ADDITIONAL DISCUSSION

The correspondence address of record for the patent owner appears to be different from the address provided below the signature line in the petition filed by patent owner on April 24, 2008. Patent owner should note that, under 37 CFR 1.33(c), the correspondence address for the patent owner in a reexamination proceeding is the address of record in the file of the patent to be reexamined. If appropriate, the correspondence address should be changed. In this instance only, a courtesy copy will be sent to the address provided below the signature line in the petition filed by the patent owner.

CONCLUSION

1. The petition filed on April 24, 2008 for a suspension of the rules is granted to the extent that the present patent owner petition has been considered, but is dismissed as to the relief requested.

2. Jurisdiction over the '972 reexamination proceeding is being returned to the Central Reexamination Unit for appropriate action not inconsistent with this decision.

3. Telephone inquiries related 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

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.
90/008,972	12/21/2007	5,253,341 C1		5169

7590 08/28/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Niro,Scavone,Haller & Niro
181 West Madison Street
Suite 4600
Chicago, IL 60602-4515

DATE MAILED: 08/28/2009

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

Copied from 90009381 on 09/14/2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,381	01/12/2009	5,253,341		7059

7590 08/28/2009

NIRO, SCAVONE, HALTER & NIRO
181 W. MADISON
SUITE 4600
CHICAGO, IL 60602

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/28/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

VERON W. FRANCISSEN
FRANCISSEN PATENT LAW, P.C.
53 W. JACKSON BLVD., SUITE 1320
CHICAGO, IL 60604

Date:

MAILED

AUG 2 8 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009381
PATENT NO. : 5253341
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

VERNON W. FRANCISSEN
FRANCISSEN PATENT LAW, P.C.
53 W. JACKSON BLVD., SUITE#1320
CHICAGO,IL 60604

Date:

MAILED

AUG 2 8 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008972
PATENT NO. : 5253341
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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CENTRAL REEXAMINATION UNIT

Niro,Scavone,Haller & Niro
181 West Madison Street
Suite 4600
Chicago IL 60602-4515

(For Patent Owner)

FRANCISSEN PATENT LAW, P.C.
53 W. JACKSON BLVD., SUITE1320
CHICAGO, IL 60604

(For Third Party Requester)

In re Rozmanith *et alia*
Reexamination Proceeding
Control No. 90/008,972
Request Deposited: December 21, 2007
For: U.S. Patent No. 5,253,341

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

In re Rozmanith *et alia*
Reexamination Proceeding
Control No. 90/009,381
Request Deposited: January 12, 2009
For: U.S. Patent No. 5,253,341

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. 5,253,341 (hereinafter, the '341 patent), issued to Rozmanith *et alia*, on October 12, 1993. A first reexamination certificate issued on July 24, 2007.

2. On December 21, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '341 patent. The reexamination proceeding was assigned Control No. 90/008,972 (hereinafter, the '8972 proceeding).

3. The Reexamination Order was granted in the '8972 proceeding on March 5, 2008.

4. After two office actions, Patent Owner filed an amendment canceling all pending claims in the '8972 reexamination on July 30, 2009.

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5. On January 12, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '341 patent. The reexamination proceeding was assigned Control No. 90/009,381 (hereinafter, the '9381 proceeding).

6. The Reexamination Order was granted in the '9381 proceeding on April 3, 2009.

7. Patent Owner filed an amendment canceling all pending claims in the '9381 reexamination on July 30, 2009.

DECISION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in 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 '8972 and the '9381 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. Currently, all claims are cancelled.

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

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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. 90/008,972 and 90/009,381 are MERGED.

2. The reexamination files are being forwarded to the examiner for action.

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

Eric Keasel
SPE, AU 3992

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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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,662	05/25/2007	7017874	INNOFF 3.5-005 CONTDIVIIA	4687

530 7590 04/30/2008

EXAMINER	

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

ART UNIT	PAPER NUMBER

DATE MAILED: 04/30/2008

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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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,976	12/21/2007	4935184	065640-0260	6753

22653 7590 08/30/2008

EDWARD W CALLAN
NO. 705 PMB 452
3830 VALLEY CENTRE DRIVE
SAN DIEGO, CA 92130

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2008

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

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Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

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(for Patent Owner)

AUG 29 2008

CENTRAL REEXAMINATION UNIT

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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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: 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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,976	12/21/2007	4935184	SRDT.007RX	6753

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

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
Pava Agarwal
FOLEY & LARDNER LLP
3000 K Street NW, Suite 500
Washington, DC 20007

Date:
MAILED

JUN 01 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008976
PATENT NO. : 4935184
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
www.uspto.gov

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(For Patent Owner)

Arnold Turk, Esq.
Greenblum & Bernstein PLC
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

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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JUN 30 2010

CENTRAL REEXAMINATION UNIT

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(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: 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

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

(For 3rd Party Requester)

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

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

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

MAILED

SEP 10 2008

CENTRAL REEXAMINATION UNIT

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

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

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

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

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

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

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

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

Conduct of Proceedings

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

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

Conclusion

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

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

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

(For Patent Owner)

MAILED

APR 02 2009

CENTRAL REEXAMINATION UNIT

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

(For *Inter Partes* Requester)
(For first *Ex Parte* Requester)

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

(For second *Ex Parte* Requester)

Inter Partes Reexamination Proceeding Control No. 95/001,086 Filed: October 2, 2008 For: U.S. Patent No. 7,225,231	
Ex Parte Reexamination Proceeding Control No. 90/008,981 Filed: January 9, 2008 For: U.S. Patent No. 7,225,231	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
Ex Parte Reexamination Proceeding Control No. 90/010,299 Filed: October 2, 2008 For: U.S. Patent No. 7,225,231	

The above-captioned *inter partes* and *ex parte* 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. 7,225,231 (the '231 patent) issued to Mendez *et al.* on May 29, 2007.

2. A first request for *ex parte* reexamination of claims 1-6 of the '231 patent was filed on January 9, 2008, by third party requester Research In Motion Limited, and the request was assigned control number 90/008,981 (the '8981 *ex parte* proceeding).

3. On February 29, 2008, *ex parte* reexamination was ordered for the '8981 proceeding based on the examiner's determination that the January 9, 2008 request raised a substantial new question of patentability.

4. A second request for *ex parte* reexamination of claims 1-6 of the '231 patent was filed on October 2, 2008, by third party requester Wei Wei Jeang, Haynes and Boone, LLP, and the request was assigned control number 90/010,299 (the '10299 *ex parte* proceeding).

5. Concurrently, on October 2, 2008, a request for *inter partes* reexamination of claims 1-6 of the '231 patent was filed by third party requester Research In Motion Limited, and the request was assigned control number 95/001,086 (the '1086 *inter partes* proceeding).

6. On November 28, 2008, *inter partes* reexamination was ordered for the '1086 proceeding based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability.

7. On November 29, 2008, *ex parte* reexamination was ordered for the '10299 proceeding based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability.

8. There has been no Office action in the '1086 *inter partes* proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 expired in the '8981 *ex parte* proceeding after April 29, 2008 and expired in the '10299 *ex parte* proceeding after January 29, 2009. [1]

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 '1086 proceeding) is an *inter partes* proceeding. All of the proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where

[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.

merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

In accordance with 37 CFR 1.989(a), the 95/001,086, 90/008,981 and 90/010,299 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 ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Since the claims are the same in all files, a "housekeeping amendment" is NOT needed in this instance.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *ex parte* reexamination proceedings 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 requesters of the *ex parte* reexamination proceedings are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '8981 *ex parte* reexamination was requested by the same third party that requested the *inter partes* reexamination. And, that third party (Research In Motion) 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 all 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 all 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 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(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

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(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:

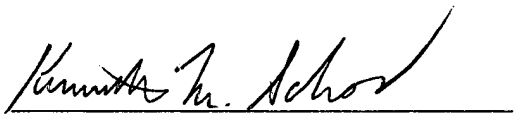
Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,086 and *ex parte* Reexamination Control Nos. 90/010,299 and 90/008,981 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Nicole 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
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,982	01/15/2008	6,614,776	TAN-2-1407.01.RX	2598

24374 7590 03/31/2010

VOLPE AND KOENIG, P.C.
DEPT. ICC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner) MAILED

MAR 31 2010

CENTRAL REEXAMINATION UNIT

VOLPE AND KOENIG, P.C.
DEPT. ICC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA PA 19103

In re: Proctor, Jr.
Reexamination Proceeding
Control No. 90/008,982
Request Deposited: January 15, 2008
For: U.S. Patent No. 6,614,776

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

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of a petition filed August 7, 2009 entitled PETITION TO THE DIRECTOR UNDER 37 C.F.R. §1.181 "requesting entry of the amendments in the June 8, 2009 Reply."

The petition is **DISMISSED** for the reasons set forth below.

BACKGROUND

In the non-final office action of December 19, 2008, the examiner rejected original patent claims 1-3, 6, 7, 15-17, 20-23, and 26 as being anticipated by Ejzak and rejected original claims 4, 5, 18, 19, 24, and 25 as being obvious over Ejzak in view of Bingeman. Claim 8-14 were not subject to reexamination.

In response, Patent Owner amended independent claims 1, 15, and 21 to include new limitations regarding the FEC coder operating according to a turbo code and the enhanced source signal not being modulated prior to receipt by the demultiplexer (or prior to distributing). Claims 4-6, 18-20, and 24-26 were cancelled and new dependent claims 27-31 were added. The turbo code limitation is similar to limitations in original dependent claims. The limitation regarding the enhanced source signal being not modulated prior to receipt by the demultiplexer (or prior to distributing) was not in any of the original claims.

The examiner searched the newly claimed limitation and found references to Herzog (both a US patent and a published PCT) which met the newly added limitation. In the final rejection of April 8, 2009, the examiner rejected claims 1, 2, 7, 15, 16, 21, 23, and 27-31 as being anticipated by Herzog and rejected claims 3, 17, and 22 as being obvious over Herzog in view of Ejzak. Claims 8-14 remain not subject to reexamination.

In response, Patent Owner proposed an after-final amendment adding additional limitations to independent claims 1, 15, and 21 regarding the source signal corresponding to a subframe and the source signal having an appended cyclic redundancy check code. The added limitations did not appear in any previously presented claim. Patent Owner also proposed to add new claims 32-40 without proposing to cancel any currently pending claims. Patent Owner argued that the Herzog reference did not meet the newly proposed claims, but made no showing under 37 CFR 1.116 as to good and sufficient reasons why the amendment is necessary and was not earlier presented.

The examiner issued an advisory action on June 12, 2009 indicating that the proposed amendments will not be entered because the "[l]imitations added to the claims have not previously been presented and require additional search/consideration", because they are not deemed to placed the proceeding in better form for appeal by simplifying issues for appeal and because they present additional claims without canceling a corresponding number of finally rejected claims.

DECISION

Petitioner notes the Herzog was not cited by the examiner until the final office action. Petitioner argues that "[b]ased on the absence of Herzog or Herzog PCT in the record, Applicant [sic, presumably Patent Owner] could not have presented an amendment in light of Herzog or Herzog PCT at any time prior to the Final Office Action." Petitioner argues that this is a sufficient showing under 37 CFR 1.116 for entry of the amendments.

It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution.

Many of the difficulties encountered in the prosecution of reexaminations proceedings after final rejection may be alleviated if Patent Owner includes, at the time of filing (if Patent Owner requested) or in a Patent Owner statement, or no later than the first reply to the non-final office action, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

In the present proceeding, Patent Owner filed an amendment after the non-final office action with changes to the independent claims which overcame the rejection of record and also

presented various additional dependent claims. Petitioner suggests that an incremental prosecution should be conducted with the Patent Owner merely presenting claims marginally narrower at the presentation of any new rejection. Petitioner also asserts that the application of any newly cited reference in a final rejection should prompt unfettered after-final prosecution. This is contrary to the concept of a final rejection precluding unrestricted further prosecution and also runs contrary to the "special dispatch" provision of 35 USC 305.

Petitioner also argues that the refusal to enter the amendment was improper because the advisory fails to give the required explanations for refusal. However, the advisory action states that the new limitations added to the claims were not previously presented and that additional search and/or consideration would be required if entered.

Petitioner would have to argue that the newly added limitations (i.e., the source signal corresponding to a subframe and the source signal having an appended cyclic redundancy check code) would not require further search or consideration to persuasively argue that the examiner must enter the amendment. However, petitioner has made no such argument.

Accordingly, the petition is **dismissed**.

CONCLUSION

1. Petitioner's request is **dismissed**.

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

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

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,989	01/14/2008	5136783	108643-158913	9655

25943 7590 05/28/2009

SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/28/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILLIAM O. GENY.; ESQ
CHERNOFF, VILHAUER, MCCLUNG & STENZEL, LLP
601 SW SECOND AVENUE, SUITE 1600
PORTLAND, OR 97204-3157

Date: MAILED

MAY 28 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008989
PATENT NO. : 5136783
ART UNIT : 3993

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

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

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(For Patent Owner)

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MAY 28 2009

CENTRAL REEXAMINATION UNIT

CHRISTOPHER J. LEWIS
SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OREGON 97204

(For Requester)

WILLIAM O. GENY, ESQ.
CHERNOFF, VILHAUER, MCCLUNG & STENZEL, LLP
601 SW SECOND AVENUE, SUITE 1600
PORTLAND, OREGON 97204-3157

In re Bell et al..	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 90/008,989	:	UNDER 37 CFR 1.181
Filed: January 14, 2008	:	
For: U.S. Patent No.: 5,136,783	:	

This is a decision on a petition filed by the patent owner on April 24, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181 TO REOPEN EXAMINATION" (hereinafter "the petition"), and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and reopen examination, which was effectively closed as of the mailing date of the Final Rejection: March 6, 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 April 24, 2009 is denied with respect to reopening examination.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,136,783 (hereinafter, "the '783 patent") issued on August 11, 1992.

2. A request for *ex parte* reexamination, assigned control No. 90/008,989 (hereinafter, "the '989 proceeding"), was filed by a third party requester on January 14, 2008.

3. *Ex parte* reexamination was ordered for the '989 proceeding on January 31, 2008.

4. On June 26, 2008, a non-final Office action, which rejected claim 1 was mailed in the '989 reexamination proceeding.

5. On August 26, 2008, the patent owner filed a response consisting of arguments only and filed declarations pertaining to the applied reference.

6. On March 6, 2009, the Office issued a Final rejection Office action, which addressed the patent owner's response of August 26, 2008. The Office action rejected claim 1.

7. On March 9, 2009, a personal interview was held.

8. On April 24, 2009, the patent owner filed the petition requesting withdrawal of the finality of the March 6, 2009 Final Office action and reopening of examination, along with additional declarations pertaining to the applied reference.

9. On May 6, 2009, the patent owner filed a response consisting of arguments only and filed declarations pertaining to the applied reference.

DECISION

The patent owner (petitioner) states that the examiner failed to address, in the final rejection of March 6, 2009, patent owner's argument that the Nitschmann reference, U.S. Patent No. 4,756,221 (hereinafter "Nitschmann") did not enable a person of skill in the art, back in 1991, to make or use the invention of claim 1 of the '783 patent. See pages 2-4 of the petition. Accordingly, patent owner argues that because this argument was not addressed during examination, the case is not in a condition for appeal and examination should be reopened. See page 3 of the petition.

In response to patent owner's arguments that the examiner failed to address the patent owner's non-enablement argument, the director finds there are not good and sufficient reasons to reopen examination.

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. See MPEP 2272. Second, the completeness of the Office action, particularly a Final Office action, must be weighed and analyzed on a case-by-case basis, with particular attention to the evidence on record before the examiner at the time the Final Office action was written and mailed. Third, it is well settled that a prior art reference must be enabled in order to be applied under 35 U.S.C. § 102(b). The dispositive test can be found in the court's decision in *Elan Pharms., Inc. v. Mayo Found.*, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003), where it states that "Enablement requires that 'the prior art reference must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.'" (citing *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1301, 64 USPQ2d 1270, 1278 (Fed. Cir. 2002). This test has its basis in the enablement requirement of 35 U.S.C. § 112, 1st paragraph. Fourth, since patent owner has not properly addressed the enablement argument, the argument is considered to be one of applicability of the prior art, and is therefore properly an appealable matter rather than a petitionable matter.

Turning to the facts in this proceeding, in the first Office action of June 26, 2008, the examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Nitschmann. The Final rejection of March 6, 2009 maintained this rejection and addressed patent owner's arguments presented in the response filed August 26, 2008. One of these arguments, that the Nitschmann reference was not enabled, can be found at pages 7-8 of the response filed August 26, 2008 as follows (in pertinent part):

> . . .it is respectfully asserted that the Examiner's interpretation of Nitschmann and reliance on a fragment of a figure is not enabled.. . .Not does Nitschmann enable one of skill in the art to have the rivets of the saw chain traverse a linear and curvilinear path. . . .the entire Nitschmann patent teaches the exact opposite, i.e., having some working links that pivot away from a linear and/or curvilinear path. . . .Thus, Nitschmann simply does not enable one of skill in the art to practice the invention of claim 1 of Applicant's patent.

This is the extent of the enablement argument before the examiner at the time of the writing and mailing of the Final Office action. Patent owner did not see fit, at that time, to expound upon this argument further than a few lines. A further review of this argument reveals that it is not really an argument based upon enablement, which requires that the person arguing that a

reference is not enabled demonstrate that one of ordinary skill in the art could not make or carry out the invention without undue experimentation. *See Elan Pharms., Inc. v. Mayo Found.*, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). The "invention" to which this test is referring is not the invention being claimed that is under examination: it is the invention of the patent being applied to the claims. Thus, if patent owner wished to demonstrate that Nitschmann was not enabled, he would need to prove that the *Nitschmann* invention, not the invention of the '783 patent, could not be carried out without undue experimentation. In essence, the test isolates the prior art reference being applied from the claims under examination and asks whether the invention of the prior art reference can be carried out. Patent owner did not submit this proof. Instead, patent owner's arguments, as quoted above, point toward an argument that Nitschmann does not meet the claimed limitations. The examiner completely and squarely addressed this argument in the Final Office action at pages 4-6.

The petition arguments go into considerably more detail regarding the efficacy of the Nitschmann reference. For example, at page 9 of the petition, patent owner argues that Nitschmann does not teach or mention configuring the bottom tang portions to mate with the rounded bottoms of the gullets because 1) the thinking at the time was that a gap was required and 2) Nitschmann is not focused on the tang engagement with the sprocket gullets, but rather is entirely focused on the top art of the cutter or safety link being extended outward. Patent owner has also provided a number of declarations to support these arguments (see the Hille declarations, filed April 22, 2009 and May 6, 2009 and the Lewis declaration, filed April 24, 2009). However, neither these expanded arguments nor the supporting declarations were before the examiner at the time of the writing and mailing of the Final Office action. Assuming *arguendo*, that these arguments had been before the examiner at the time of the writing and mailing of the Final Office action, the expanded arguments presented in the petition also appear to be arguments about whether the Nitschmann reference meets the claimed limitations. Patent owner has again failed to apply the test set forth by the court in *Elan Pharms., Inc. v. Mayo Found.* to Nitschmann alone. Patent owner has not demonstrated that the invention of *Nitschmann* cannot be carried out without undue experimentation. Instead, patent owner has improperly and consistently attempted to apply this test to Nitschmann in view of the limitations of claim 1 of the '783 patent. See, for example, the argument at pages 10-11 or at page 13 of the petition. As is stated many times above, Nitschmann must be considered and analyzed for enablement *in isolation from* claim 1 of the '783 patent. Whether or not Nitschmann has all of the elements recited in claim 1 of the '783 patent is irrelevant to an argument that Nitschmann is not enabled. Patent owner has not met the burden of establishing that Nitschmann is not enabled.

As can be seen from the discussion above, patent owner's argument is properly considered an argument about the applicability of the Nitschmann reference. As such, determinations of whether Nitschmann meets the claimed limitations are appealable matters, rather than petitionable matters (see MPEP 1002 and 2101 for guidance).

Upon review of the entire record, the examiner appropriately reviewed and addressed the arguments presented in the response filed August 26, 2008. Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 to reopen prosecution is denied.

2. It is noted that a response after the Final Office action was filed on May 6, 2009. The examiner will review this response in due course and consider the arguments presented therein.

3. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Andres Kashnikow

Gregory A. Morse
Director, Central Reexamination Unit

acting for

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P.O. Box 1450
Alexandria, VA 22313-1450
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Schwabe, Williamson & Wyatt, P.C.
Pacwest Center, Suite 1900
1211 SW Fifth Avenue
Portland, OR 97204

For Patent Owner

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JUL 23 2009

CENTRAL REEXAMINATION UNIT

William O. Gerry
Chernoff, Vilhauer, McClung & Stenzel, LLP
601 SW Second Ave., Suite 1600
Portland, OR 97204-3157

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,989
Filed: January 14, 2008
For: U.S. Patent No. 5,136,783

DECISION ON PETITION
FILED UNDER 37 CFR 1.181

The above noted reexamination proceeding is before the Director of the Central Reexamination Unit for consideration of the petition titled "Request For Reconsideration of Patentee's 37 CFR §1.181 Petition To Reopen Reexamination" that was filed by patent owner on June 3, 2009. There is no fee for this petition.

The petition is hereby **dismissed as being moot** as prosecution on the merits in the instant reexamination proceeding was reopened *sua sponte* by the examiner as is evidenced by the non-final Office action mailed June 25, 2009.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary 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.
90/008,990	04/15/2008	6151332	TAN-2-1400.01.RX	4743

24374 7590 03/31/2010

VOLPE AND KOENIG, P.C.
DEPT. ICC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2010

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Volpe and Koenig, P.C.
Dept. ICC
United Plaza
Suite 1600
30 South 17th Street
Philadelphia, PA 19103

MAILED

MAR 31 2010

CENTRAL REEXAMINATION UNIT

In re Thomas E. Gorsuch et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/008,990 : **GRANTING**
Filed: January 5, 2008 : **PETITION UNDER**
For: U.S. Patent No. 6,151,332 : **37 CFR 1.137(b)**

This is a decision on the February 17, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated reexamination ("the February 17, 2010 patent owner petition to revive").

The February 17, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The February 17, 2010 patent owner petition to revive is **granted**.

The February 3, 2010 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an Appeal Brief is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*

*

(d) *Terminal disclaimer.*

*

*

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

37 CFR 1.550 provides, in pertinent part:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the

prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

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

*

*

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

37 CFR 41.33 provides, in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37may be admitted as provided in § 1.116 of this title.

37 CFR 41.37 provides, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

MPEP 2274 provides, in pertinent part:

I. AMENDMENT

> Where the appeal brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the claims of the patent under reexamination in a patentable condition, the amendment may be entered.
> *
> *
> IV. FAILURE TO TIMELY FILE APPEAL BRIEF
>
> Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. ... The reexamination prosecution is then terminated, and a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), the instant reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the June 12, 2009 final Office action. Although patent owner filed a Notice of Appeal on October 13, 2009, patent owner failed to follow-up the Notice of Appeal with either (i) an Appeal Brief in accordance with 37 CFR 41.37(a)(1) or (ii) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the proceeding in condition for issuance of a reexamination certificate by making all pending claims patentable, as provided in 37 CFR 41.33(a) and MPEP 2274(I).

Patent owner submitted an Appeal Brief and paid the corresponding fee of $540.00 on February 17, 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 February 17, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the February 17, 2010 patent owner petition to revive is **granted**.

The February 3, 2010 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an Appeal Brief is **withdrawn**.

CONCLUSION

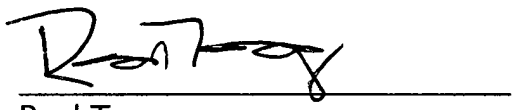
1. The February 17, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. The February 3, 2010 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an Appeal Brief is **withdrawn**.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992, for treatment in due course of the February 17, 2010 Appeal Brief.

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 the undersigned at (571) 272-7728.



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.
90/008,993	03/20/2008	6560047	1938.1056REX	3387

21171 7590 01/08/2010

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LINDSAY S. ADAMS
DAY PITNEY LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

Date:

MAILED

JAN 08 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008993
PATENT NO. : 6560047
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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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

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JAN 08 2010

CENTRAL REEXAMINATION UNIT

LINDSAY S. ADAMS
DAY PITNEY LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

(For Third Party Requester)

In re Choi et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,993
Filed: March 20, 2008
For: U.S. Patent No. 6,560,047 B2

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 1.182**

This is a decision on the December 8, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182."

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

The petition is **dismissed as premature**.

BACKGROUND

- On January 15, 2008, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,993 ("the '8993 proceeding"), and subsequently was assigned a filing date of March 20, 2008, the date of compliance with the filing date requirements.

- Prosecution progressed until, on September 10, 2009, a final Office action was issued by the Office.

- On November 9, 2009, an advisory action was mailed by the Office, refusing entry of after-final amendment filed on October 30, 2009, and setting a time period for response to run 2 months from the date of the final Office action.

- On November 10, 2009, patent owner filed a request for extension of time and an evidence submission composed of two affidavits.

- On November 28, 2009, a second advisory action was mailed by the Office, refusing entry of the November 10, 2009 evidence submission.

- On December 2, 2009, the Office mailed a decision denying the November 9, 2009 petition for extension of time, setting a response date of December 10, 2009.

- On December 8, 2009, patent owner filed three petitions:

    - A petition entitled "PETITION UNDER 37 CFR 1.181," requesting entry and consideration of the November 10, 2009 evidence submission.

    - The instant petition entitled "PETITION UNDER 37 CFR 1.182," requesting continued prosecution of the reexamination, including entry and consideration of the November 10, 2009 evidence submission.

    - A petition entitled "PETITION UNDER 37 CFR 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On December 10, 2009, patent owner filed a Notice of appeal to the Board of Patent Appeals and Interferences.

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.

DECISION

A Petition Under 37 CFR 1.182 Will Not Be Granted Where Another Rule Applies

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding.

In this instance, the patent owner has concurrently pursued alternative avenues of relief via a 37 C.F.R. § 1.181 and 37 C.F.R. § 1.182 petition to obtain entry of the evidence submission filed November 10, 2009. Since the concurrently filed December 8, 2009 petition under 37 C.F.R. § 1.181 to request entry of the evidence submission filed November 10, 2009 has not yet been decided, it cannot be stated that relief is not available by another rule. Accordingly, the present § 1.182 petition to request continued reexamination filed to seek entry of the November 10, 2009 submission filed after final rejection is premature, and is dismissed as such.

Note that the relief requested in the petition under 37 C.F.R. § 1.182 would be moot, should relief be granted under 37 C.F.R. § 1.181. Since the entry of the November 10, 2009 submission is currently in the process of being addressed through 37 C.F.R. § 1.181, consideration of this situation under 37 C.F.R. § 1.182 would be premature. Patent owner retains the option of filing a renewed petition under 37 C.F.R. § 1.182, if at some future date relief has not been granted under 37 C.F.R. § 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 C.F.R. § 1.182.

If a renewed petition requesting continuation of the reexamination proceeding under 37 C.F.R. § 1.182 is subsequently filed, it should focus on how entry of the November 10, 2009 submission would further the prosecution of the reexamination proceeding, by reducing issues, to define the issues for appeal, or the issuance of a reexamination certificate, and why it was not apparent until the issuance of the final rejection that the specifics of the November 10, 2009 submission would be needed do so.

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

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.

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

- The Central Reexamination Unit will consider the December 8, 2009 petition under 37 C.F.R. § 1.181 in due course.

- 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

Kenpet7/
1-7-10

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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.
90/008,993	03/20/2008	6560047	1938.1056REX	3387

21171 7590 02/01/2010

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
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DATE MAILED: 02/01/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LINDSAY S. ADAMS
DAY PITNEY LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

Date:
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008993
PATENT NO. : 6560047
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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CENTRAL REEXAMINATION UNIT

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

LINDSAY S. ADAMS
DAY PITNEY LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

(For Third Party Requester)

In re Choi et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,993
Filed: March 20, 2008
For: U.S. Patent No. 6,560,047 B2

: **DECISION**
: **GRANTING PETITION**
: **UNDER § 1.183**

This is a decision on the December 8, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.183."

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

The petition under 37 CFR § 1.183 to request for rule waiver and an extension of time is **granted** as to the underlying relief desired to the extent that the time for to file an Appeal Brief is extended to run 45 days from the mailing date of this decision, pursuant to 37 CFR § 41.37(e) and 37 CFR § 1.550(c).

FEES

The requisite petition fee for a petition under 37 CFR § 1.183 is $400.00 pursuant to 37 CFR § 1.17(f), and the $400.00 fee is being charged to petitioner's Deposit Account No. 19-3935 as authorized on page 3 of the petition.

BACKGROUND

- On January 15, 2008, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,993 ("the '8993 proceeding"), and subsequently was assigned a filing date of March 20, 2008, the date of compliance with the filing date requirements.

- The proceeding progressed until, on September 10, 2009, a final Office action was issued by the Office.

- On November 9, 2009, an advisory Office action was mailed by the Office, refusing entry of after-final amendment filed on October 30, 2009, and setting a time period for response to run 2 months from the date of the final Office action.

- On November 10, 2009, patent owner filed a request for extension of time and an evidence submission composed of two affidavits.

- On November 28, 2009, a second advisory Office action was mailed by the Office, refusing entry of the November 10, 2009 evidence submission.

- On December 2, 2009, the Office mailed a decision denying the November 9, 2009 petition for extension of time, setting a response date of December 10, 2009.

- On December 8, 2009, patent owner filed three petitions:

    - A petition entitled "PETITION UNDER 37 CFR 1.181," requesting entry and consideration of the November 10, 2009 evidence submission.

    - A petition entitled "PETITION UNDER 37 CFR 1.182," requesting continued prosecution of the reexamination, including entry and consideration of the November 10, 2009 evidence submission.

    - A petition entitled "PETITION UNDER 37 CFR 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On December 10, 2009, patent owner filed a Notice of appeal to the Board of Patent Appeals and Interferences.

- On January 8, 2010, the Office issued a decision dismissing the December 8, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.183 states:

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

37 CFR § 41.37 states, 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.
>
> (e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings**. (emphasis added)

37 CFR § 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

The present patent owner petition for an extension of time was filed on December 8, 2009, prior to the patent owner filing of a Notice of Appeal on December 10, 2009. Patent owner filed the instant petition under § 1.183 for "waiver of the prohibition of an extension of time for filing an appeal brief." Petition at 2. Under 37 CFR § 41.66(a), the time for filing an appellant's brief may not be extended; however, § 41.66(a) applies only to *inter partes* reexamination proceedings. The time for filing an appeal brief in *ex parte* reexamination proceedings is controlled instead through the provisions of 37 CFR § 41.37(e). Upon filing a Notice of Appeal, by operation of rule 37 CFR § 41.37(e), patent owner has a two month time period within which to file an Appeal Brief that may be extended through the provisions of § 1.550(c). For this reason, the instant request for extension of time will be considered pursuant to 37 CFR § 1.550(c) rather than pursuant to 37 CFR § 1.183.

In the present proceeding, the time for patent owner petitioner to file an Appeal Brief is due to expire on February 10, 2009. The concurrently filed petition under 37 CFR § 1.182 has been dismissed as premature in a decision mailed January 8, 2010. The outstanding petition under 37 CFR § 1.181 for supervisory review, which was concurrently received on December 8, 2009, is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petitions under 37 CFR § 1.181 and 37 CFR § 1.182. A decision on the 37 CFR § 1.181 petition has not yet been rendered. In the event patent owner were to have filed an appeal brief to keep the proceeding pending to obtain the result of the petition under § 1.181 in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under

37 CFR § 1.181 be granted or prosecution otherwise be reopened. Therefore, sufficient cause exists to extend the time for response for a reasonable time.

Under the current facts and circumstances of the proceeding, an extension of time under 37 CFR § 1.550(c) is granted to the extent that patent owner petitioner's time period to submit an Appeal Brief is extended to run 45 days from the mailing date of this decision.

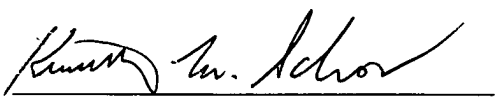
If the petition under 37 CFR § 1.181 has not yet been decided at the point where the time for patent owner to file an Appeal Brief becomes less than one month prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review. Any such petition should be filed under 37 CFR § 1.550(c).

CONCLUSION

1. The patent owner petition for extension of time filed December 8, 2009 for filing an Appeal Brief is **granted to the extent stated above.**

2. The time for to file an Appeal Brief is extended to run **45 days** from the mailing date of this decision.

3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.



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

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

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ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LINDSAY S. ADAMS
DAY PITNEY LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

Date:

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008993
PATENT NO. : 6560047
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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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, NW
WASHINGTON DC 20005

(For Patent Owner)

LINDSAY S. ADAMS
DAY PITNEY LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

(For Third Party Requester)

In re: Choi *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/008,993
Deposited: 20 March 2008
For: U.S. Patent No.: 6,560,047 B2

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on 08 December 2009. The petition is entitled "PETITION UNDER 37 CFR 1.181" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to (1) withdraw the Final rejection and reopen prosecution for entry of the Declarations filed under 37 CFR 1.132 on 10 November 2009, or alternatively (2) enter said Declarations for consideration for purposes of appeal.

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 08 December 2008 is denied-in-part and dismissed-in-part. To the extent petitioner is requesting continuing prosecution, the petition is dismissed as it is a question appropriate for 37 CFR § 1.182, not section § 1.181.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,560,047 issued on 06 May 2003.

- A request for *ex parte* reexamination proceeding, assigned control No. 90/008,993 was filed by a third party requester and was assigned a filing date of 20 March 2008, the date of compliance with the filing date requirements.

- *Ex parte* reexamination was ordered and progressed until, on 10 September 2009, a final Office action was issued.

- On 30 October 2009, the Patent owner filed an after-final amendment.

- On 09 November 2009, an Advisory Action was mailed, refusing entry of the above after-final amendment and setting a time period for response of 2 months from the final Office action.

- On 10 November 2009, the Patent owner submitted a request for extension of time and an evidence submission composed of the two declarations at issue in the instant petition.

- On 28 November 2009, a second Advisory Action was mailed, refusing entry of the above evidence submission.

- On 02 December 2009, the Office issued a decision denying the 09 November 2009 request for extension of time, setting a response date of 10 December 2009.

- On 08 December 2009, the Patent Owner filed three petitions:

    - The instant petition entitled "PETITION UNDER 37 CFR 1.181" requesting entry and consideration of the 10 November 2009 evidence submission.

    - A petition entitled "PETITION UNDER 37 CFR 1.182" requesting continued prosecution of the reexamination, including entry and consideration of the 10 November 2009 evidence submission.

- A petition entitled "PETITION UNDER 37 CFR 1.183" requesting a waiver of the rule prohibiting an extension of time to file an appeal brief.

- On 10 December 2009, the Patent owner filed a Notice of Appeal to the Board of Patent Appeals and Interferences.

- On 08 January 2010, the Office issued a decision dismissing as premature the petition entitled "PETITION UNDER 37 CFR 1.182" filed 08 December 2009.

- On 01 February 2010, the Office issued a decision granting the petition entitled "PETITION UNDER 37 CFR 1.183" filed 08 December 2009.

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 . . . .

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).

DECISION

The patent owner [hereinafter "petitioner"] states that the examiner erred in deciding not to enter the declarations filed on 10 November 2009 after the Final rejection. Petitioner explains that the proceeding was docketed to a different examiner after the Non-final rejection was issued, and the new examiner in the Final rejection set forth a modified rationale for combining the references. Therefore it was not until after the Final rejection that petitioner had the opportunity to respond to the modified rejections, and the declarations are necessary to show non-obviousness in light of the modified rationale. Petitioner also states that the subject matter of the declarations was discussed in an interview with the new examiner on 22 October 2009, therefore the declarations do not raise any new issues. Petitioner requests the withdrawal of the final rejection and reopening of prosecution for entry of the declarations, or in the alternative, entry of the declarations for the purposes of appeal.

First, as to the propriety of the Final rejection, petitioner does not appear to argue that the Final rejection itself is flawed, i.e. that the action should not have been made final. Petitioner mentions, almost in passing, that "the patent owner was deprived of the opportunity to adequately respond to the new grounds of rejection," Petition p. 5, but does not explain if this is a reason for withdrawing the finality of the action. It is well settled that an action may be made final despite a new ground of rejection if the new ground is necessitated by an amendment. See MPEP 706.07(a). Here, the claims were indeed amended, and petitioner does not argue whether or not the allegedly new ground was based on the amendment. Instead, it appears the argument for withdrawing the Final rejection and reopening prosecution is based on the argument concerning lack of continuing prosecution in reexamination. See Petition pp. 6 and 7-8. This issue is not appropriate for this decision, as discussed below under the "Due Process Argument" section. The petitioner is therefore not persuasive that the Final rejection should be withdrawn.

In response to patent owner's arguments that the examiner erred in deciding not to enter the declarations, the director finds there are not good and sufficient reasons to enter the declarations. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings are 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, petitioner amended the claims after the Non-final rejection, adding new claims and additional limitations to the independent claims. In the Final rejection, the examiner maintained the same statutory basis and the same references in rejecting the amended original claims. In the 10 November 2009 submission, petitioner stated that the declarations were not earlier presented because petitioner believed the prior amendment was sufficient in distinguishing the claims from the art of record. Petitioner further stated that the subject matter of the declarations was discussed at the 22 October 2009 interview. Petitioner also stated the declarations were necessary to place the proceeding in better form for consideration on 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 generic "to place the proceeding in better form for appeal" cannot be a good and sufficient reason; if that were all that was required, the rule would have no meaning, as any applicant could state their evidence to be necessary for such purpose. The 10 November 2009 submission did not provide any other explanation as to why the evidence is necessary, nor any elaboration as to how they might place the proceeding in better form for appeal, therefore the submission fails this prong of the rule.

As to why it was not earlier presented, the fact that petitioner thought the earlier amendment was enough to ensure allowability of the claims is not a good and sufficient reason for entry. Petitioner could not have known whether the amendments would be sufficient or not. The statutory mandate for special dispatch requires a patent owner to fully respond to the first office action with all evidence, not to pursue piecemeal prosecution by submitting evidence only when other submissions are unsuccessful. In this regard, petitioner was warned in the order granting reexamination, mailed 15 May 2008:

> In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to the first Office action on the merits (which does not result in a close of prosecution). Submissions after the second Office action on the merits, which is intended to be a final action, will be governed by the requirements of 37 CFR § 1.116 . . . which will be strictly enforced.

The declarations further include evidence of market trends and technical expertise of the inventor regarding the applied references; such evidence could have been useful earlier in the proceeding. They could have, and should have, been submitted in response to the first action on the merits.

Finally, it is immaterial that the examiner who issued the Final rejection differed from the examiner who issued the prior action. It is also immaterial that the subject matter of the declarations may have been discussed at the 22 October 2009 interview—indeed the interview

itself was also after the Final rejection. The only question is whether the examiner properly refused to enter the after-final declarations, and the examiner correctly enforced the requirements of rule § 1.116.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the declarations should not be entered. Petitioner has not shown good and sufficient reasons why the declarations are necessary and why they were not earlier presented. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the declarations of 10 November 2009.

Accordingly, good and sufficient reasons to reopen prosecution or enter the declarations have not been provided and the patent owner's petition is denied.

Due Process Argument

Petitioner argues that the lack of a mechanism for continuing prosecution in reexamination proceedings violates due process and runs counter to the mandate of 35 U.S.C. § 305, which permits amendment of the claims. Petition pp. 7-8. The propriety of the Final rejection itself was discussed above, and the examiner complied with the regulations and Office policies in making that action final and not entering the subsequent declarations. Regarding the lack of continuing prosecution in reexamination, petitioner is arguing for a mechanism that is not provided for in the regulations, a question that is appropriate for a petition under section § 1.182.

As noted above, petitioner already filed a petition under § 1.182, which was dismissed as being premature because the instant petition had not yet been decided. Now that the instant petition has been decided, the rule § 1.182 question is ripe for decision. Petitioner may file a renewed petition under 37 CFR § 1.182 requesting continuing reexamination.

Accordingly, to the extent petitioner is requesting continuing prosecution, the petition is dismissed as it is a question appropriate for 37 CFR § 1.182, not section § 1.181.

ADDITIONAL DISCUSSION

In a decision mailed 01 February 2010 on the section § 1.183 petition, Patent owner was granted an additional 45 days to file an Appeal Brief so that Patent owner could receive the results of the instant petition. The decision further stated that Patent owner could file an additional petition for extension of time in the event that the instant petition was decided less than one month prior to the deadline. Because the instant decision was decided less than one month prior to the deadline,

and opens the possibility for filing a renewed petition under section § 1.182, Patent owner may wish to file an additional extension of time if a renewed petition is filed. As stated in the 01 February 2010 decision, the consideration by the Office of an Appeal Brief would cause an unnecessary waste of resources if any such renewed petition were to be decided in Patent owner's favor. It is to be understood, however, that until such time that an additional petition for extension of time is filed and granted, the time period for filing the Appeal Brief remains as set forth in the 01 February 2010 decision.

CONCLUSION

1. The petition under 37 CFR § 1.181 for reconsideration of the entry of the declarations filed 10 November 2009 is denied-in-part and dismissed-in-part.

2. Patent owner is advised that a renewed petition under 37 CFR § 1.182 requesting continuing reexamination may be filed. See the guidance in the decision mailed 08 January 2010.

3. In accordance with the decision mailed 01 February 2010 granting additional time for filing an Appeal Brief, Patent owner may wish to file a petition for an additional extension of time.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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21171 7590 05/18/2010

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

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EXAMINER	

LINDSAY S. ADAMS
DAY PITNEY LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,993	03/20/2008	6560047	1938.1056REX	3387

21171 7590 05/18/2010

EXAMINER

DARBY & DARBY P.C.
805 THIRD AVENUE
NEW YORK, NY 10022

ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2010

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

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Darby & Darby P.C.
805 Third Avenue
New York, NY 10022

(For patent owner)

Lindsay S. Adams
Day Pitney LLP
7 Times Square
New York, NY 10036-7311

(For third party requester)

MAILED

MAY 18 2010

CENTRAL REEXAMINATION UNIT

Staas & Halsey LLP
Suite 700
1201 New York Avenue, N.W.
Washington, D.C. 20005

(Courtesy copy)

In re Woon Ha Choi et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,993
Filed: March 20, 2008
For: U.S. Patent No. 6,560,047

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

This is a decision on the March 31, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated reexamination ("the March 31, 2010 patent owner petition to revive").[1]

The March 31, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The March 31, 2010 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the September 10, 2009 final Office action.

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.113 provides, in pertinent part:

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

37 CFR 1.137 provides, in pertinent part:

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

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

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

37 CFR 41.33 provides, in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37may be admitted as provided in § 1.116 of this title.

37 CFR 41.37 provides, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

MPEP 2274 provides, in pertinent part:

I. AMENDMENT

Where the appeal brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the claims of the patent under reexamination in a patentable condition, the amendment may be entered.

*

*

IV. FAILURE TO TIMELY FILE APPEAL BRIEF

Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. ... The reexamination prosecution is then terminated, and a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), the instant reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the September 10, 2009 final Office action. Although patent owner timely filed a Notice of Appeal on December 10, 2009, patent owner failed to follow-up the Notice of Appeal with either (i) an Appeal Brief in accordance with 37 CFR 41.37(a)(1) or (ii) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the proceeding in condition for issuance of a reexamination certificate by making all pending claims patentable, as provided in 37 CFR 41.33(a) and MPEP 2274(I).

Patent owner submitted an Appeal Brief and paid the corresponding fee of $540.00 on March 31, 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 31, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the March 31, 2010 patent owner petition to revive is **granted**.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,560,047 patent file is that of Darby & Darby P.C., 805 Third Avenue, New York, NY 10022.

As a courtesy, this decision is being mailed to the address of Staas & Halsey LLP, Suite 700, 1201 New York Avenue, N.W., Washington, D.C. 20005, in view of the March 24, 2008 Power of Attorney in the file of the '8993 reexamination proceeding.

The address of Darby & Darby P.C., 805 Third Avenue, New York, NY 10022, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '047 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The March 31, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being retained in OPLA for treatment in due course of the March 17, 2010 Renewed Petition Under 37 CFR 1.182.

3. The address of Darby & Darby P.C., 805 Third Avenue, New York, NY 10022, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '047 patent file is made in accordance with 37 CFR 1.33(c).

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Minh Nguyen, of CRU Art Unit 3992, at (571) 272-1748.

5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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90/008,993	03/20/2008	6560047	1938.1056REX	3387

21171 7590 06/16/2010

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/16/2010

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LINDSAY S. ADAMS
DAY PITNEY LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

Date:
MAILED

JUN 16 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008993
PATENT NO. : 6560047
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DARBY & DARBY PC
805 THIRD AVENUE
NEW YORK, NY 10022

Date: **MAILED**

JUN 16 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008993
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United States Patent and Trademark Office

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JUN 16 2010

CENTRAL REEXAMINATION UNIT

Darby & Darby P.C.
805 Third Avenue
New York, NY 10022

(For patent owner)

Lindsay S. Adams
Day Pitney LLP
7 Times Square
New York, NY 10036-7311

(For third party requester)

Staas & Halsey LLP
Suite 700
1201 New York Avenue, N.W.
Washington, D.C. 20005

(Courtesy Copy)

In re Woon Ha Choi et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,993
Filed: March 20, 2008
For: U.S. Patent No. 6,560,047

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 C.F.R. § 1.182**

This is a decision on the March 17, 2010 patent owner petition entitled "RENEWED PETITION UNDER 37 CFR 1.182."

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

The petition is **dismissed**.

BACKGROUND

- On January 15, 2008, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,993 ("the '8993 proceeding"), and subsequently was assigned a filing date of March 20, 2008, the date of compliance with the filing date requirements.

- Prosecution progressed until, on September 10, 2009, a final Office action was issued by the Office.

- On November 9, 2009, an advisory action was mailed by the Office, refusing entry of after-final amendment filed on October 30, 2009, and setting a time period for response to run 2 months from the date of the final Office action.

- On November 10, 2009, patent owner filed a request for extension of time and an evidence submission composed of two affidavits.

- On November 28, 2009, a second advisory action was mailed by the Office, refusing entry of the November 10, 2009 evidence submission.

- On December 2, 2009, the Office mailed a decision denying the November 9, 2009 petition for extension of time, setting a response date of December 10, 2009.

- On December 8, 2009, patent owner filed three petitions:

    - A petition entitled "PETITION UNDER 37 CFR 1.181," requesting entry and consideration of the November 10, 2009 evidence submission.

    - A petition entitled "PETITION UNDER 37 CFR 1.182," requesting continued prosecution of the reexamination, including entry and consideration of the November 10, 2009 evidence submission.

    - A petition entitled "PETITION UNDER 37 CFR 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On December 10, 2009, patent owner filed a Notice of appeal to the Board of Patent Appeals and Interferences.

- On January 8, 2010, the Office mailed a decision dismissing, as premature, the December 8, 2009 "PETITION UNDER 37 CFR 1.182."

- On February 1, 2010, the Office mailed a decision granting the December 8, 2009 "PETITION UNDER 37 CFR 1.183," extending the time to file an appeal brief to run until 45 days from the February 1, 2010 decision.

- On March 16, 2010, the Office mailed a decision dismissing-in-part and denying-in-part the December 8, 2009 "PETITION UNDER 37 CFR 1.181."

- On March 17, 2010, patent owner filed the instant petition entitled "RENEWED PETITION UNDER 37 CFR 1.182," requesting continued prosecution of the reexamination, including entry and consideration of the November 10, 2009 evidence submission.

- On March 31, 2010, patent owner filed a petition entitled "PETITION UNDER 37 CFR 1.137(B)"and an appeal brief.

- On May 18, 2010, the Office mailed a decision granting patent owner's March 31, 2010 petition under 37 CFR 1.137(b).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

After the times for filing the statement and reply provided for by section 304 of this title [35 U.S.C.S § 304] 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 [35 U.S.C.S §§ 132 and 133]. 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 . . . or in response to a decision adverse to the patentability of a claim of a patent. All reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office. [Emphasis added]

35 U.S.C. § 132(a) states:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

35 U.S.C. § 132(b), codifying section 4403 of the Intellectual Property and Communications Omnibus Reform Act of 1999, states, in pertinent part:

The Director shall prescribe regulations to provide for the continued examination of **applications** for patent at the request of the applicant. [Emphasis added]

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.

37 CFR 1.114 states, in pertinent part:

(a) If prosecution in an **application** is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth under § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;
(2) Abandonment of the application; or
(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141 or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

...

(e) The provisions of this section do not apply to:

...

(5) A patent under reexamination.

[Emphasis added in bold]

DECISION

Patent owner seeks continued examination of the '8993 *ex parte* reexamination proceeding under 37 C.F.R. § 1.182. Patent owner further contends that such continued examination is mandated under 35 U.S.C. § 305 and 35 U.S.C. § 132(b), and pursuant to the requirements of due process.

I. The Instant Petition Fails to Meet the "Special Dispatch" Requirement of 35 U.S.C. § 305

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, until a continued reexamination procedure would be implemented by the Office, 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. A procedure for continued reexamination was never in-fact implemented by the Office, and was never issued as a proposed rule making notice; however, the transitional statement of the Notice was never withdrawn.

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

By filing such a § 1.182 petition, as discussed in the Notice, 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, limited relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. 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 make a showing of the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the showing in a petition for continuation of the reexamination prosecution is to identify the issue that the submission is intended to address, and explain how the issue arose at a point of the prosecution (here, the final Office action) such that patent owner had no earlier opportunity to address the issue. The above showings are critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 unequivocally mandates that reexamination proceedings must be conducted "with special dispatch within the Office." [2] If a patent owner desires a remedy not provided by rule to obtain entry of a submission in a reexamination proceeding and thereby delay the proceeding, equity requires that a petition for such remedy must balance that delay with a showing that patent owner supported the Office's unequivocal statutory mandate to carry out an *ex parte* reexamination proceeding with special dispatch.

In this instance, patent owner's response includes a submission directed towards the entry of evidence submission comprising declarations purporting to present secondary considerations of nonobviousness.[3] Patent owner's petition does not present an explanation, nor do the facts of this proceeding make it clear, how the submission addresses an issue that arose at a point of the prosecution such that patent owner had no earlier opportunity to address the issue. The proposed evidence submissions are alleged to traverse a combination of references ("APA" or "Webster" in view of "JP'405") that were first applied in a rejection in the first Office action in the

---

[2] In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit pointed out that:

"Special dispatch" is not defined in the statute. However, "a fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning." *Perrin v. United States*, 444 U.S. 37, 42, 62 L. Ed. 2d 199, 100 S. Ct. 311 (1979); *see LSI Computer Systems, Inc. v. United States Int'l Trade Comm'n*, 832 F.2d 588, 590, 4 USPQ2d 1705, 1707 (Fed.Cir. 1987). According to Webster's New World Dictionary, special means distinctive, unique, exceptional, or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary, and common meaning of special dispatch envisions some type of unique, extraordinary, or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that "reexamination proceedings will be 'special' throughout their pendency" in the office, and provides for an accelerated schedule. MPEP § 2261. (*Ethicon*, at 1426.)

[3] Petition at 4.

proceeding.[4] Following that Office action, patent owner was provided with the opportunity to present a full response to that combination of references, including affidavits or other evidence submissions. And, patent owners have been placed on notice in MPEP 2272 of the opportunity and necessity for early presentation of evidence as soon as an issue arises during prosecution.[5] Despite the fact that patent owner was notified in the first Office action that the claims at issue were rejected as obvious over the applied "APA" or "Webster" and "JP'405" references, and patent owner had an opportunity to address the issues prior to the final Office action,. The proposed amendments are not in response to newly raised issues; rather, the record does not indicate that patent owner began to seek evidence to address issues that arose with the first Office action and continued with diligence thereafter.[6] The patent owner simply does not present reasons, nor does the history of the proceedings show, how the issues that the submission addresses arose at a point of the prosecution such that patent owner had no earlier opportunity to address the issues.

It is further pointed out that the petition does not address how entry of the declarations would advance the prosecution by addressing an issue newly presented in the final rejection or after it; the petition merely states that entry of the declarations would "further defin[e] the issues for appeal . . . to show nonobviousness."[7] Looking to the remarks filed with the November 10, 2009 submission of the declarations, patent owner stated only that the declarations were presented "in order to traverse the rejections." In neither the petition nor elsewhere in the prosecution record has patent owner set forth with specificity the manner in which the evidence submission would advance prosecution towards issuance of a reexamination certificate or towards appeal by addressing a newly raised issue at the earliest point possible. Irrespective of the merits of the evidence submission, which has not been reviewed as to its substantive content, the instant petition fails to clearly show how the submission is a *bona fide* effort to address a newly raised issue as to the rejections of the claims so as to define the issues for appeal, or the issuance of a reexamination certificate. Reopening of the prosecution to consider this evidence submission, absent a showing of such a *bona fide* effort, would instead validate the patent owner's unnecessary delay in presenting the instant amendment in this proceeding contrary to the requirement of "special dispatch within the Office."

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's submission does not provide the requisite *bona fide* effort to advance the prosecution

---

[4] Office action of January 21, 2009. In the patent owner response of November 6, 2009 to the final Office action of September 10, 2009, patent owner provided arguments similar to the content of the proposed evidence submission, stating that threw was no motivation for combining the "APA and JP'405" or "Webster and JP'405".

[5] MPEP 2272 clearly sets forth after-final procedure for *ex parte* proceedings, and states that after-final amendments "will be governed by the strict standards of 37 CFR 1.116" and that "the patent owner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR 1.53(b), or 1.53(d), and with no opportunity to file a request for continued examination under 37 CFR 1.114." MPEP 2272 further states that evidence submissions should be filed before final action.

[6] With respect to petitioner's contention that the final rejection contained new grounds of rejection, patent owner has not contended that the declarations proposed for entry address any issue not first raised in the initial Office action of January 21, 2009. *See also* the Office decision of March 23, 2010, dismissing patent owner's petition under 37 C.F.R. § 1.181, in which the petition would found to lack good and sufficient reasons why the declarations were necessary and not earlier presented.

[7] Petition at 4.

towards issuance of a reexamination certificate, or simplify matters, in a manner consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office." Therefore, the unequivocal mandate for the Office to conduct *ex parte* reexamination proceedings with special dispatch precludes reopening of prosecution at this stage of the proceeding.

II. No Legal Authority Provides For Continued Examination in Reexamination Proceedings

Patent owner argues that continued examination during a reexamination proceeding is authorized by the mandatory language of 35 U.S.C. 305 that "reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title." Patent owner contends that 35 U.S.C. § 132(b), providing for continued examination of applications for patent upon the request of the applicant, is a procedure established for initial examination, and therefore mandates § 132(b) continued examination during reexamination proceedings.

Statutory authority providing for continued examination arises solely from 35 U.S.C. § 132(b), which states that "the Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant." The language of 35 U.S.C. § 132(b) is directed only to applications; the language of 35 U.S.C. § 132(b) is not directed to reexamination proceedings, which are proceedings carried out in granted patents, and are not applications for patents (not applications to obtain patent grants). Therefore, any authority providing for continued examination of reexamination proceedings must be provided for elsewhere. Petitioner takes the position that 35 U.S.C. § 305 is the source of such authority, by virtue of the clause stating that "reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title." The discussion below will show that such a position is not supported by either the text or the intent of 35 U.S.C. § 305. The text of 35 U.S.C. § 305 states that the procedures for initial examination set forth in § 132 will apply to reexamination proceedings; no mention of continued examination is made in § 305. As to intent, at the time of the enactment of § 305 in 1980, 35 U.S.C 132 concerned only initial examination (e.g., rejection and response by applicant); i.e., those initial examination procedures now set forth in § 132(a). The intent of enactment of § 305 for *ex parte* reexamination was to provide a speedy alternative to litigation of issued patents, with § 305 explicitly stating that reexamination proceedings are to be conducted with special dispatch, and a lengthy continued full examination for reexamination proceedings on issued patents runs contrary to § 305 (which petitioner is relying on). *Ex parte* reexamination was directed to what is now § 132(a), and there is nothing in the legislative history of the enactment of § 132(b) to indicate that its provision (stated to be directed to an application) would be added to reexamination. Further, the enactment of § 132(b), the Intellectual Property and Communications Omnibus Reform Act of 1999, also included an enactment of *inter partes* reexamination, which again statutorily provided for special dispatch for the new *inter partes* reexamination option, while nowhere in the 1999 act or its legislative history is a discussion of lengthening reexamination by inclusion of a request for continued examination. If Congress had wanted to include a lengthy continued full examination for reexamination proceedings, it could

have done so at that time, since the enactment also included modifications of *ex parte* reexamination, such as appeal and revival (i.e., reexamination as a whole was looked at by Congress).

The below discussion will show, in some detail, that neither the text of 35 U.S.C. § 132(b) nor its legislative history supports an establishment of § 132(b) continued examination for reexamination proceedings. The plain language of 35 U.S.C. § 132(b) is directed towards applications, not reexaminations. The part of the Act which promulgated § 132(b) is specifically limited only to applications, as set forth in section 4405 of the Act; therefore, the continued examination provisions are only empowered for applications and not reexamination proceedings. Furthermore, the discussion will show that § 132(b) was enacted, *inter alia*, to provide patent term relief for applicants, which is not applicable to reexamination proceedings. Finally, continuation of prosecution as a matter of right has never been applicable to reexamination proceedings, and extension of continued examination to reexamination proceedings would constitute a substantial change to delay the proceedings, lacking legislative comment.

A. Neither the text nor the intent of 35 U.S.C. § 305 supports continued examination for patent reexamination proceedings.

The text of 35 U.S.C. § 305 contains language that permits patent owner to "propose an amendment to his patent specification or claims, as well as propose a new claim or claims." To establish the procedures by which such amendments could be effected, § 305 states that "reexamination will be conducted according to the procedures established for **initial** examination under the provisions of sections 132 and 133 of this title." [Emphasis added] The text of § 305 lacks any mention of "continued" examination. To the contrary, the text of § 305 explicitly states that reexamination proceedings are to be conducted with special dispatch.

Furthermore, interpreting § 305 to include continued examination would read the term "initial" out of the statute, since such an interpretation would incorporate all features of examination into § 305. As all terms in a statute must be given meaning, the term "initial" must limit the reach of § 305. For this reason, the principles of statutory construction do not support any reading of § 305 that would authorize continued examination in reexamination proceedings.

35 U.S.C. § 305 contains a provision authorizing the "initial" examination procedures set forth in 35 U.S.C. § 132 to be used in conducting reexamination. At the time of the enactment of § 305 in 1980, § 132 concerned only initial examination, i.e., procedures for an applicant for a patent to respond to an initial rejection by the Office with a response that would then be considered by the examiner. The entirety of § 132 as it existed in 1980 was later amended to become, in its entirety, § 132(a). By its terms alone, section (a) of 35 U.S.C. 132 addresses initial examination of an application; e.g., those procedures for notifying applicant of an initial rejection and for receiving applicant's response.

Looking to its legislative history, 35 U.S.C. § 305 was enacted in 1980 by "An Act to Amend the Patent and Trademark Laws," which established for the first time procedures for reexamination of issued patents. The purpose of the Act was to "strengthen[] investor confidence in the certainty of patent rights by creating a system of administrative reexamination of doubtful

patents." Reexamination was designed to "review the efficacy of a patent . . . on the basis of new information" in order to "permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation." Absent in the legislative history of 35 U.S.C. § 305 is any intention to provide continued or extended examination. To the contrary, the expressed desire for efficient resolution, coupled with the explicit provision requiring proceedings to be "conducted with special dispatch," exhibits intent for rapid and compact reexamination proceedings. Continued examination would therefore be contrary to the expressed intent of the legislature.

The intent of § 305 to establish initial examination procedures is thus fully embodied by § 132(a), which does not provide for any continued examination procedures. Both the text and the legislative history of § 305 lack support for, and are contrary to, an interpretation that provides for continued examination of reexamination of patents.

B. Neither the text nor the intent of 35 U.S.C. § 132(b) supports continued examination for patent reexamination proceedings.

1. The plain language and legislative history of 35 U.S.C. § 132(b) are directed only towards applications, not reexaminations.

Continued examination of applications for patent was first authorized by the enactment of 35 U.S.C. § 132(b), which codified section 4403 of the Intellectual Property and Communications Omnibus Reform Act of 1999. The text of § 132(b) states that regulations for "continued examination of **applications** for patent" shall be prescribed. [Emphasis added]. The text makes no mention of reexamination proceedings, which are not applications for patent, and accordingly no regulations for § 132(b) continued examination were promulgated for reexamination proceedings. It is to be noted that there were no comments to the § 132(b) continued examination arguing with the Office's implied interpretation of § 132(b) (contemporaneously with the statute), when regulations for § 132(b) continued examination were promulgated only for applications, and not for reexamination proceedings.

The purpose of section 4403 was stated to be:

> to permit an applicant to request that an examiner continue the examination of an application following a notice of "final" rejection by the examiner. New section 132(b) authorizes the Director to prescribe regulations for the continued examination of an **application** notwithstanding a final rejection, at the request of the applicant. (Emphasis added)

The legislative record thus shows that § 132(b) was directed towards "applications" and not reexamination proceedings.

At the time of its enactment in 1999, reexamination had been in place since 1982. Therefore, if the legislation was meant to cover reexamination of patents, Congress would have explicitly written the text of § 132(b) to include reexamination proceedings, rather than restricting § 132(b)

to "applications for patent," especially since reexamination was being looked at in detail and addressed by the same Act, both as to adding a new option for *inter partes* reexamination and revising *ex parte* reexamination. At the very least, Congress could have provided some comment showing an intent to apply § 132(b) to reexamination proceedings. However, neither the text nor the legislative history makes any reference to applying § 132(b) to reexamination proceedings, even though such a reference would be expected. For this reason, the language of the 1999 Act does not support any interpretation authorizing continued examination to reexamination proceedings.

2. The effective date provisions of the Act promulgating 35 U.S.C. § 132(b) are applicable to applications, but inapplicable to reexaminations of patents.

Section 4405 of the Intellectual Property and Communications Omnibus Reform Act of 1999 set an effective date for the provisions of section 4403 (§ 132(b)). Pursuant to section 4405, § 132(b) applies only to any application filed on or after a certain date. The provision of § 305 enabling reexaminations to be conducted pursuant to § 132 must be read in view of later-enacted section 4405. Since section 4405 states that only applications are subject to § 132(b), and reexamination proceedings are not applications, reexaminations are not subject to § 132(b). Section 4405 clearly expresses the intent of Congress, and the scope of § 132(b), to extend continued examination only to applications.

Note that a request for "continued reexamination of a patent," as argued by patent owner, would be incapable of meeting the provisions for continued examination pursuant to§ 132(b), since the reexamination proceeding is not "[an] application[] filed under section 111(a) of title 35, United States Code, on or after June 8, 1995, [or an] application[] complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after June 8, 1995" as required by section 4405.

In contrast, where the effective date provision for § 132(b) applies only to an application- the effective date provision of the Act enabling § 305 states that its provisions apply to "patents then in force or issued thereafter" (emphasis added). The term "patents" was deliberately used by Congress to apply the statute to reexamination proceedings. Since Congress chose to use language in the effective date provision enabling § 132(b) limiting the scope to "applications," the continuing examination provisions of § 132(b) were explicitly and deliberately written so as not to apply to reexamination of patents. Therefore, the 1999 Act, by its plain text, fails to authorize continued examination for reexamination proceedings.

3. 35 U.S.C. § 132(b) was enacted, inter alia, to provide patent term relief for applicants, a purpose inapplicable to reexamination of a patent.

35 U.S.C. § 132(b) codified section 4403, which was presented in Subtitle D, entitled the "Patent Term Guarantee Act." A purpose of the subtitle D provisions was stated to be to "compensate patent applicants for certain reductions in patent term that are not the fault of the applicant. . . . Only those who purposely manipulate the system to delay the issuance of their patents will be penalized under subtitle D, a result that the Conferees believe entirely appropriate." For example, section 4402 under subtitle D ensures that applicants' time spent in continued

examination as set forth in section 4403 shall not be considered a delay for patent term adjustment purposes. This rationale is clearly inapplicable to reexamination of issued patents, which are not subject to patent term adjustment due to, *e.g.*, delays in the reexamination process. For this reason also, application of § 132(b) to reexaminations would not further the purpose of the statute and is thus not consistent with the legislative intent.

4. Extension of continued examination to reexamination on the basis of § 132(b) would result in a substantial change in policy with no foundation for such change.

At the time of enactment of § 305, Congress incorporated the language of § 132 to establish the procedures for conducting reexamination. At that time, no provision for continued examination existed, in § 132 or elsewhere. Prosecution of applications could be continued at that time by filing a new continuation application; no analogous statutory provision existed for continuation of reexamination proceedings. In 1997, the Office created a Continuing Prosecution Application practice (i.e., CPA practice) for continuing prosecution via a streamlined process for the filing of a continuing application; no analogous provision was created for reexamination proceedings. In 1999, § 132(b) was enacted, which authorized the Office to prescribe regulations to provide for the continued examination of applications at the request of the applicant. The Office implemented this provision by creating a request for continued examination (RCE) practice in 37 CFR 1.114. RCE practice caused CPA practice to be "largely redundant", and CPA practice was subsequently eliminated for utility and plant applications in 2003.

The history of reexamination practice thus contains no procedure for § 132(b)-like continued examination (adding a complete second iteration to the process, at applicant's option/choice), either through continuation pursuant to § 120 or through CPA practice, the precursor to RCE practice. Unlike applications, which have historically enjoyed avenues for § 132(b)-like continuation of prosecution, reexaminations have not historically granted patent owners such a statutory or regulatory right. Were § 132(b) to be read as affording such a right to patent owners, this would represent a substantial change in longstanding practice, which could extend the reexamination process indefinitely, at the patent owner's option. Note that the filing of multiple RCEs in an application works to an applicant's disadvantage, since the term of the patent from its grant to expiration is shortened based on the "20-years from filing" expiration of the patent. On the other hand, the filing of multiple RCEs in a reexamination proceeding serves only to delay the resolution of the substantial question of patentability in the reexamination proceeding, without any loss of patent term. A patent owner faced with an adverse decision as to patent claims could keep a reexamination proceeding pending indefinitely by the filing of multiple RCEs, if such was (at patent owner's desire) available. And, *Ethicon v. Quigg,* 849 F.2d 1422, 1426, 7 USPQ2d 1152, 1155 (Fed. Cir. 1988) provides: "Whatever else special dispatch means, it does not admit of an indefinite suspension of reexamination proceedings pending conclusion of litigation. If it did, one would expect to find some intimation to that effect in the statute, for it would suggest the opposite of the ordinary meaning. But there is none." It is to be noted that a patent owner in a reexamination proceeding has a limited avenue for seeking further examination for entry of one amendment (or a single evidence submission), as discussed above in Part I of this decision, but that avenue is strictly controlled by the Office to advance prosecution to further the requirement of special dispatch (e.g., by resolving issues on appeal by further limiting the claims or defining terms). A procedure for § 132(b)-like continued examination (adding a

complete second iteration to the process, at applicant's option/choice) was simply never envisioned by Congress, the courts, or the Office.

Where change is legislated by Congress without comment, and a proposed reading of such legislative change could be made to cause substantial change in longstanding practice, such a reading has been held to be unpersuasive. As § 132(b) was enacted well after § 305, Congress is presumed to have known that § 305 would incorporate into reexamination proceedings any procedure for "initial examination" set forth in § 132 as amended. However, the legislative record refers only to finally rejected applications; no mention appears in the record of a desired change in reexamination procedure. There is therefore no indication in the legislative history that § 132(b) was conceived as applicable to reexaminations. The reading of § 132 most consistent with legislative intent is that § 132(a) is directed towards initial examination and that § 132(b) is directed instead towards continued examination.

For the above reasons, neither the plain text, nor the legislative history, of § 132(b) supports the establishment of procedures for the conduct of reexamination proceedings, and thus continued examination in reexamination proceedings is not provided for by statute.

III. Patent Owner's Due Process Argument is Not Persuasive

Patent owner argues that "the current rules essentially limit the patent owner to a single opportunity to amend the claims or submit Declarations under 37 CFR 1.132, depriv[ing] the patent owner of its rights under the patent statute and rules, and to due process." Patent owner cites *Patlex v. Mossinghoff*, 771 F.2d 480 (Fed. Cir. 1985) in support of patent owner's argument.

However, the decision of the Federal Circuit in *Patlex* does not support patent owner's arguments. In *Patlex*, the patent owner argued that the 37 C.F.R. § 1.530(a), which bars participation by the patent owner prior to the determination of whether a substantial new question of patentability exists in a request for *ex parte* reexamination, deprives the patent owner of the opportunity to be heard at that stage of the proceeding, thus violating due process. The Federal Circuit held that the patent owner's due process rights had not been violated. In finding no violation of due process, the Federal Circuit stated that "the general rule is that "the demands of due process do not require a hearing, at the initial stage or at any particular point or at more than one point in an administrative proceeding so long as the requisite hearing is held before the final order becomes effective."[8]

Contrary to patent owner's argument, *Patlex* does not support the proposition that a patent owner is entitled to multiple opportunities to submit evidence in a reexamination proceeding. Rather, *Patlex* stands for the proposition that a patent owner need only have an opportunity to present a response prior to the final disposition, including appeals, of a reexamination proceeding. In this instance, patent owner requests entry of affidavits traversing a combination of references ("APA" or "Webster" in view of "JP'405") that was first applied in a rejection in the first Office

[8] *Patlex v. Mossinghoff*, 771 F.2d at 485 (*quoting Opp Cotton Mills, Inc. v. Administrator, 312 U.S. 126, 152-53 (1941)).*

action in the proceeding.[9] Following that Office action, patent owner was provided with the opportunity to present a full response to that combination of references, including affidavits or other evidence submissions. Indeed, patent owners are placed on notice (as discussed above) of the opportunity and necessity for early presentation of evidence as soon as an issue arises during prosecution.[10]

As a final point regarding the argument that "the current rules essentially limit the patent owner to a single opportunity to amend the claims or submit Declarations under 37 CFR 1.132, there are many statutory and regulatory provisions that provide parties with one opportunity to take action. If this opportunity is not taken advantage of, rights are lost. See, for example, 35 U.S.C. § 314(b)(2), which provides that:

> 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. [Emphasis added]

In this instance, the patent owner had an opportunity to take action, failed to make use of it, and the Office's mandate for special dispatch dictates that the new question of patentability raised in this proceeding now move forward, without backing up the proceeding.

For the above reasons, patent owner's allegations of a lack of due process, based upon patent owner's reading of *Patlex v. Mossinghoff*, are not persuasive.

In view of the above and the facts and circumstances of the instant proceeding, the petition is dismissed.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,560,047 patent file is that of Darby & Darby P.C., 805 Third Avenue, New York, NY 10022.

As a courtesy, this decision is being mailed to the address of Staas & Halsey LLP, Suite 700, 1201 New York Avenue, N.W., Washington, D.C. 20005, in view of the March 24, 2008 Power of Attorney in the file of the '8993 reexamination proceeding.

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[9] Office action of January 21, 2009.

[10] MPEP 2272 clearly sets forth after-final procedure for *ex parte* proceedings, and states that after-final amendments "will be governed by the strict standards of 37 CFR 1.116" and that "the patent owner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR 1.53(b), or 1.53(d), and with no opportunity to file a request for continued examination under 37 CFR 1.114." MPEP 2272 further states that evidence submissions should be filed before final action.

The address of Darby & Darby P.C., 805 Third Avenue, New York, NY 10022, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '047 patent file is made in accordance with 37 CFR 1.33(c).

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

June 15, 2010
Kenpet8

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.
90/008,995	01/17/2008	6699205	END5431USREX3	3743

27805 7590 10/27/2009

THOMPSON HINE L.L.P.
Intellectual Property Group
P.O. BOX 8801
DAYTON, OH 45401-8801

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Douglas R Hanscom
JONES, TULLAR & COOPER, P.C.
P.O. BOX 2266 EADS STATION
Arlington, VA 22202

Date:
MAILED
OCT 27 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008995
PATENT NO. : 6699205
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

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.
90/008,995	01/17/2008	6699205	END5431USREX3	3743

27805 7590 10/27/2009

EXAMINER	
ART UNIT	PAPER NUMBER

WELSH & FLAXMAN LLC
2000 DUKE STREET, SUITE 100
ALEXANDRIA VA 22314

DATE MAILED: 10/27/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WELSH & FLAXMAN LLC
2000 DUKE STREET, SUITE 100
ALEXANDRIA VA 22314

(For Patent Owner)

DOUGLAS R. HANSCOM
JONES, TULLAR & COOPER, P.C.
P.O. BOX 2266 EADS STATION
ARLINGTON, VA 22202

(For 3rd Party Requester)

MAILED

OCT 27 2009

CENTRAL REEXAMINATION UNIT

THOMPSON HINE L.L.P.
INTELLECTUAL PROPERTY GROUP
P.O. BOX 8801
DAYTON, OH 45401-8801

(Courtesy Copy)

In re Richard E. Fulton III et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,995
Filing Date: January 17, 2008
For: U.S. Patent No. 6,699,205

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

This is a decision on the July 30, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION AND IN THE ALTERNATIVE UNDER § 1.181 AND/OR § 1.183 FOR ENTRY OF THE PATENT OWNER'S RESPONSE FILED JULY 8, 2009." The present petition is treated as a petition under 37 CFR 1.182 to request continued reexamination of the above captioned proceeding and entry of the response after final Office action and accompanying declarations filed on July 8, 2009. The alternative petition under 37 CFR 1.181 to request entry of the patent owner's response filed on July 8, 2009 will not be addressed for reasons explained below.

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

The present petition is **dismissed** for reasons set forth below.

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 July 30, 2009.

BACKGROUND

1. On March 2, 2004, the Office issued U.S. Patent No. 6,699,205 (the '205 patent) to Fulton, III et al.

2. On January 17, 2008, a request for *ex parte* reexamination of the '205 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/008,995 ("the '8995 proceeding").

3. On February 12, 2008, the Office issued a notice of the filing of the '8995 *ex parte* reexamination with a filing date of January 17, 2008.

4. On March 7, 2008, the Office issued an order granting the '8995 *ex parte* reexamination request.

5. On June 12, 2008, a first Office action on the merits issued, rejecting claims 1-7, 9-17, 19-26, 28, and 29 as unpatentable. Claims 8, 18, and 27 were not subject to reexamination.

6. On August 12, 2008, patent owner filed a response retaining original claims 1-7, 9-17, 19-26, 28, and 29 as unamended and adding new claims 30 and 31. With respect to 35 U.S.C. 103 rejections over Foerster in view of Ginde or Schmitt which were set forth in the first Office Action, patent owner pointed out the deficiencies of the secondary references applied. With respect to the 35 U.S.C. 103 rejections over Anderson in view of Ginde or Schmitt set forth in the first Office Action, patent owner argued, in addition to the deficiencies of the secondary references, that Anderson did not teach a method of performing a breast biopsy.

7. On November 6, 2008, a second non-final Office action was issued in the '8995 proceeding withdrawing all the rejections of the claims in the first Office action and setting forth new grounds of rejections for the claims 1-7, 9-17, 19-26, and 28-31 under 35 U.S.C. 103 over Foerster in view of Nabai et al. and Anderson et al. The examiner stated that patent owner's arguments were persuasive with respect to the rejections in the first Office action in that Anderson did not teach a method of performing a breast biopsy and that the Ginde and Schmitt references did not clearly provide the secondary teaching of providing a bioabsorbable body for use as an implant that swells when placed inside a patient.

8. On January 6, 2009, patent owner filed a response without amending any claims and provided remarks alleging patentability over the prior art of record.

9. On March 9, 2009, a final Office action was issued in the '8995 proceeding maintaining the prior art rejections of claims 1-7, 9-17, 19-26, and 28-31 set forth in the previous Office action.

10. On April 23, 2009, patent owner filed a petition for a one-month extension of time to respond to the final Office action mailed March 9, 2009.

11. On April 27, 2009, the Office mailed a decision granting a one-month extension of time for filing a response to the final Office action mailed March 9, 2009.

12. On June 3, 2009, patent owner filed a petition for a second one-month extension of time to respond to the final Office action mailed March 9, 2009.

13. On June 5, 2009, the Office mailed a decision granting the second one-month extension of time to respond to the final Office action mailed March 9, 2009.

14. On July 8, 2009, patent owner filed a response after final Office action containing a declaration under 37 CFR 1.132 by William A. Bernie and a declaration under 37 CFR 1.132 by Revor Speeg.

15. On July 17, 2009, the Office issued an advisory Office action stating that the July 8, 2009 declarations under 37 CFR 1.132 will not be entered because they were not timely and patent owner did not present any reasons why the declarations were not presented earlier (e.g., after the first time the same rejections were applied to the claims).

16. On July 30, 2009, patent owner filed the present petition entitled "PETITION UNDER 37 C.F.R. 1.182 FOR CONTINUED REEXAMINATION AND IN THE ALTERNATIVE UNDER 1.181 AND/OR 1.183 FOR ENTRY OF THE PATENT OWNER'S RESPONSE FILED JULY 8, 2009" to request continued reexamination of the subject patent and entry of the response after final and accompanying declarations filed on July 8, 2009.

17. On September 8, 2009, patent owner filed a Notice of Appeal.

DECISION

A. Dismissal of Petition under 37 CFR 1.182:

Petitioner has filed the present petition under 37 CFR 1.182, and in the alternative under 37 CFR 1.181 and/or 1.183, and makes the following requests for relief:

> 1) Primary request for relief: "Pursuant to 37 C.F.R. § 1.182...the patent owner seeks continued reexamination of the subject patent and entry of the response after final and accompanying declarations filed July 8, 2009."[1]
>
> 2) Alternative request for relief: "[T]he patent owner petitions the Director under § 1.181 or § 1.183 for entry of the response filed July 8, 2009 under § 1.116." [2]

37 CFR 1.4(c) provides:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be

[1] Petition at page 1.
[2] Petition at pages 2 and 5.

> contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. As pointed out above, the present petition includes two requests. (1) The request for continued reexamination of the present proceeding and entry of the response after final and accompanying declarations filed on July 8, 2009 under 37 CFR 1.182 is addressed in the Office of Patent Legal Administration (OPLA). (2) The request under 37 CFR 1.181 for entry of the response filed July 8, 2009 under 37 CFR 1.116 is addressed in the CRU by the CRU Director.

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

B. Additional discussion:

The following is advisory in nature as to the aspect of the petition that would be addressed by OPLA, in the absence of a petition under 37 CFR 1.181 for entry of the response. In the aspect of the July 8, 2009 petition that is a request under 37 CFR 1.182, patent owner requests that the Office grant continued reexamination of the '8995 proceeding and enter the response after final and accompanying declarations filed on July 8, 2009.

In March of 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."[3] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Accordingly, relief in the form of a continuation of the *ex parte* reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

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

[3] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

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 must 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, petitioner asserts that it was only after the Examiner had responded to the patent owner's arguments in the March 9, 2009 final Office action did the patent owner consider the submission of additional data and testimony to be warranted.[4] In the amendment filed on January 6, 2009, the patent owner traversed the new grounds of rejection set forth in the second non-final Office action based upon the combination of Foerster, Nabai and Anderson by arguing the relevance of the asserted references and why a person of ordinary skill in the art would not combine the asserted references as proposed by the Examiner.[5] The declarations of William A. Bernie and Trevor Speeg filed on July 8, 2009, respectively attest to the fact that GELFOAM absorbable gelatine sponge is not swellable and set forth numerous reasons why the Nabai and Anderson references are not likely to lead a person of ordinary skill in the art to modify Foerster's biopsy marker to arrive at a method for marking a breast biopsy site that employs a swellable bioresorbable body having a radiopaque marker carried by the bioresorbable body.[6] Petitioner argues that the patent owner cannot know with certainty whether arguments will be successful when considered on their own merits, or whether the patent owner will need to buttress those arguments with additional data and/or testimony.[7]

Petitioner also argues that given the time and expense involved in retaining an expert and/or a laboratory, the patent owner cannot reasonably be expected to incur these costs in response to an Office action when it is reasonable for the patent owner to believe that the merits and logic of the arguments themselves will be sufficient since, in the prosecution of this reexamination, the patent owner was able to overcome the rejections in the first Office action without submitting additional evidence under § 1.132.[8] Finally, petitioner states that the costs and substantial efforts that have gone into preparing these declarations have impeded the patent owner's ability to submit such declarations at an earlier date.[9]

The petitioner's arguments for granting the requested extraordinary relief appear to imply that a request for the granting of the request for continued reexamination under these circumstances is in accord with Office policy. However, the granting of equitable relief under ordinary circumstances where the petitioner was in control of the prosecution of the proceeding in the

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[4] Petition at page 4.
[5] Petition at page 4.
[6] Petition at pages 4-5.
[7] Petition at page 3.
[8] Petition at page 3.
[9] Petition at page 5.

normal course of examination, particularly after the second non-final Office action, when the petitioner failed to submit sufficient declaratory evidence to rebut the second non-final Office action on the merits is completely contrary to Office policy as it would undermine the policy intent of the relevant Office rule, *e.g.* 37 CFR 1.116(e).[10] 37 CFR 1.116(e) permits the submission of an affidavit or other evidence after a final rejection in an *ex parte* reexamination, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. It is noted that the examiner neither changed nor added a basis or grounds of rejection in terms of prior art rejections (i.e., neither shifted from the obviousness grounds of rejection nor added new prior art references into the grounds of rejection). It was reasonably foreseeable that the examiner would not be persuaded by attorney argument and would maintain the rejection; an attorney's argument is not always found persuasive.

Given the statutory mandate of 35 U.S.C. 305 for special dispatch in reexamination, patent owner could have, and should have, submitted declaratory evidence regarding this finding of fact to support the argument made (and further special dispatch by placing everything before the examiner in the response) after the second action non-final, but patent owner chose not to do so. The actions taken by the examiner (i.e., responding to the patent owner's arguments in the final Office action and maintaining all of the previous prior art rejections) were not unforeseeable, and patent owner's argument that it was only after the Examiner had responded to patent owner's arguments did the patent owner consider the submission of additional data and testimony to be warranted is not persuasive. Also, any argument patent owner wishes to make as to this matter independent of the evidence could have gained entry if filed after final rejection without relying on proffered evidence, and such argument can be made on appeal. Furthermore, petitioner's argument that the patent owner had reasonable expectation that arguments without the submission of additional evidence would be sufficient to overcome prior art rejections based on previous such success is unpersuasive. In response to petitioner's arguments that the costs and substantial efforts that have gone into preparing these declarations have impeded the patent owner's ability to submit such declarations at an earlier date, it is noted that patent owner does not appear to have made any efforts to submit additional evidence until after the final Office action was mailed. In any event, such an argument goes to the § 1.181 aspect of the petition, as to why the evidence could not have been submitted sooner, and specifics of the delay would be required to support such a showing.

Based on the facts and circumstances of the present case, the granting of the present petition for continued reexamination of the instant proceeding is inconsistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent and (2) the '8995 proceeding. The current correspondence address of record **in the patent file** is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c),

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

and it is that of WELSH & FLAXMAN LLC, 2000 DUKE STREET, SUITE 100, ALEXANDRIA, VA 22314. Accordingly, all future correspondence will be directed to WELSH & FLAXMAN LLC, 2000 DUKE STREET, SUITE 100, ALEXANDRIA, VA 22314, unless patent owner changes the correspondence address of record in the patent (the same address should be explicitly made of record in the reexamination proceeding).

As a one-time courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of WELSH & FLAXMAN LLC, 2000 DUKE STREET, SUITE 100 ALEXANDRIA, VA 22314, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. The July 30, 2009 petition is dismissed.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, for processing of the September 8, 2009, Notice of Appeal.

3. 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.

4. Any inquiry concerning this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth M. Schor

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

Kenpet7\RCR
10-27-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,995	01/17/2008	6699205	END5431USREX3	3743

27805 7590 12/18/2009

THOMPSON HINE L.L.P.
Intellectual Property Group
P.O. BOX 8801
DAYTON, OH 45401-8801

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/18/2009

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

Douglas R Hanscom
JONES, TULLAR & COOPER, P.C.
P.O. BOX 2266 EADS STATION
Arlington, VA 22202

Date:

MAILED

FEB 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008995
PATENT NO. : 6699205
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THOMPSON HINE L.L.P.
INTELLECTUAL PROPERTY GROUP
P.O. BOX 8801
DAYTON, OH 45401-8801

(For Patent Owner)

MAILED
DEC 18 2009
EXAMINATION UNIT

DOUGLAS R. HANSCOM
JONES, TULLAR & COOPER, P.C.
P.O. BOX 2266 EADS STATION
ARLINGTON, VA 22202

(For Third Party Requester)

In re Richard E. Fulton III et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,995
Filing Date: January 17, 2008
For: U.S. Patent No. 6,699,205

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

This is a decision on the November 4, 2009 patent owner petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION." The present renewed petition requests continued reexamination of the above-captioned proceeding and provides explanation regarding why patent owner feels that the patent owner July 8, 2009 declarations, filed after the final Office action, could not have been earlier presented and why they are believed to advance the prosecution of the present reexamination proceeding.

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

The present renewed petition is **dismissed** for the reasons set forth below.

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 July 30, 2009 for the original petition under 37 CFR 1.182. A fee is not required for the present renewed petition.

BACKGROUND

1. On March 2, 2004, the Office issued U.S. Patent No. 6,699,205 (the '205 patent) to Fulton, III et al.

2. On January 17, 2008, a request for *ex parte* reexamination of the '205 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/008,995 ("the '8995 proceeding").

3. On February 12, 2008, the Office issued a notice of the filing of the '8995 *ex parte* reexamination with a filing date of January 17, 2008.

4. On March 7, 2008, the Office issued an order granting the '8995 *ex parte* reexamination request.

5. On June 12, 2008, a first Office action on the merits issued, rejecting claims 1-7, 9-17, 19-26, 28, and 29 as unpatentable. Claims 8, 18, and 27 are not subject to reexamination.

6. On August 12, 2008, patent owner filed a response retaining original claims 1-7, 9-17, 19-26, 28, and 29 as unamended and adding new claims 30 and 31. With respect to 35 U.S.C. 103 rejections over Foerster in view of Ginde or Schmitt applied in the first Office action, patent owner pointed out the asserted deficiencies of the secondary references applied. With respect to the 35 U.S.C. 103 rejections over Anderson in view of Ginde or Schmitt applied in the first Office action, patent owner argued, in addition to the deficiencies of the secondary references, that Anderson did not teach a method of performing a breast biopsy.

7. On November 6, 2008, a second non-final Office action was issued in the '8995 proceeding withdrawing all the rejections of the claims in the first Office action and setting forth new grounds of rejections for claims 1-7, 9-17, 19-26, and 28-31 under 35 U.S.C. 103 over Foerster in view of Nabai et al. and Anderson et al. The examiner stated that patent owner's arguments were persuasive with respect to the rejections in the first Office action in that (a) Anderson did not teach a method of performing a breast biopsy and (b) the Ginde and Schmitt references did not clearly provide the secondary teaching of providing a bioabsorbable body for use as an implant that swelled when placed inside a patient.

8. On January 6, 2009, patent owner filed a response to the November 6, 2008 Office action in which no claim was amended. The response provided remarks alleging patentability over the applied prior art of record.

9. On March 9, 2009, a final Office action was issued in the '8995 proceeding maintaining the prior art rejections of claims 1-7, 9-17, 19-26, and 28-31 set forth in the previous Office action.

10. On April 23, 2009, patent owner filed a petition for a one-month extension of time to respond to the final Office action mailed March 9, 2009.

11. On April 27, 2009, the Office mailed a decision granting a one-month extension of time for filing a response to the final Office action mailed March 9, 2009.

12. On June 3, 2009, patent owner filed a petition for a second one-month extension of time to respond to the final Office action mailed March 9, 2009.

13. On June 5, 2009, the Office mailed a decision granting the second one-month extension of time to respond to the final Office action mailed March 9, 2009.

14. On July 8, 2009, patent owner filed a response after final Office action containing a declaration under 37 CFR 1.132 by William A. Bernie and a declaration under 37 CFR 1.132 by Revor Speeg.

15. On July 17, 2009, the Office issued an advisory Office action stating that the July 8, 2009 declarations under 37 CFR 1.132 will not be entered because they were not timely, and patent owner did not present any reasons why the declarations were not presented earlier (e.g., after the first time the same rejections were applied to the claims).

16. On July 30, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. 1.182 FOR CONTINUED REEXAMINATION AND IN THE ALTERNATIVE UNDER 1.181 AND/OR 1.183 FOR ENTRY OF THE PATENT OWNER'S RESPONSE FILED JULY 8, 2009" to request continued reexamination of the subject patent and entry of the response after final and accompanying declarations filed on July 8, 2009.

17. On September 8, 2009, patent owner filed a Notice of Appeal.

18. On October 27, 2009, the Office mailed a decision dismissing the July 30, 2009 patent owner petition.

19. On October 30, 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 November 4, 2009, patent owner filed the present petition entitled "RENEWED PETITION UNDER 37 C.F.R § 1.182 FOR CONTINUED REEXAMINATION."

21. On November 6, 2009, the Office mailed a decision granting a one-month extension of time to file an appeal brief.

RELEVANT REGULATIONS AND EXAMINING PROCEDURE

37 CFR 1.116(e) provides:

> 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.

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 714.12 states in pertinent part:

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal **may be** entered. Also, amendments filed after a final rejection, but before or on the date of filing an appeal, complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). Amendments filed after the date of filing an appeal may be entered if the amendment complies with 37 CFR 41.33. See MPEP § 1206. **Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § 1206. An affidavit or other evidence filed after a final rejection, but before or on the same date of filing an appeal, may be entered upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e).** (emphases added).

MPEP 716.07 (INOPERABILITY OF REFERENCES) states in pertinent part:

Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability (*Metropolitan Eng. Co. v. Coe*, 78 F.2d 199, 25 USPQ 216 (D.C.Cir. 1935), examiners should not express any opinion on the operability of a patent. Affidavits or declarations attacking the operability of a patent cited as a reference must rebut the presumption of operability by a preponderance of the evidence. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969). It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. *In re Michalek*, 162 F.2d 229, 74 USPQ 107 (CCPA 1947); *In re Reid*, 179 F.2d 998, 84 USPQ 478 (CCPA 1950).

MPEP 2266.01 states in pertinent part:

Amendments after final rejection are approved for entry only if they place the proceeding in condition for issuance of a reexamination certificate or in better form for appeal. Otherwise,

they are not approved for entry. See MPEP § 714.12 and § 714.13. Thus, an amendment after final rejection should be denied entry if some point necessary for a complete response under 37 CFR 1.113 was omitted, even where the omission was through an apparent oversight or inadvertence. Where a submission after final Office action (e.g., an amendment filed under 37 CFR 1.116) does not place the proceeding in condition for issuance of a reexamination certificate, the period for response continues to run until a response under 37 CFR 1.113(i.e., a Notice of Appeal or an amendment that places the proceeding in condition for issuance of a reexamination certificate) is filed. Where a submission after appeal (e.g., an amendment filed under 37 CFR 41.33) does not place the proceeding in condition for issuance of a reexamination certificate, the period for filing an appeal brief continues to run until an appeal brief or an amendment that places the proceeding in condition for issuance of a reexamination certificate is filed. The nature of the omission is immaterial. The examiner cannot give the patent owner a time period to supply the omission. **The examiner has the authority to enter the response, withdraw the final Office action, and issue a new Office action, which may be a final Office action, if appropriate, or an action closing prosecution in an otherwise allowable application under *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11 (Comm'r Pat. 1935), if appropriate. This course of action is within the discretion of the examiner.** However, the examiner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR 1.53(b) or 1.53(d) in order to continue prosecution nor to file a request for continued examination under 37 CFR 1.114. Thus, where the time has expired for response and the amendment submitted would place the proceeding in condition for issuance of a reexamination certificate except for an omission through apparent oversight or inadvertence, the examiner should follow this course of action. (emphases added)

MPEP 2265, Section II. (EXTENSIONS OF TIME TO SUBMIT AFFIDAVITS AFTER FINAL REJECTION) states in pertinent part:

Frequently, patent owners request an extension of time, stating as a reason therefor that more time is needed in which to submit an affidavit. When such a request is filed after final rejection, the granting of the request for extension of time is without prejudice to the right of the examiner to question why the affidavit is now necessary and why it was not earlier presented. If the patent owner's showing is insufficient, the examiner may deny entry of the affidavit, notwithstanding the previous grant of an extension of time to submit it. The grant of an extension of time in these circumstances serves merely to keep the prosecution of the proceeding from becoming terminated while allowing the patent owner the opportunity to present the affidavit or to take other appropriate action. Moreover, prosecution of the reexamination to save it from termination must include such timely, complete and proper action as required by 37 CFR 1.113. **The admission of the affidavit for purposes other than allowance of the claims, or the refusal to admit the affidavit, and any proceedings relative, thereto, shall not operate to save the prosecution of the proceeding from termination. Implicit in the above practice is the fact that affidavits submitted after final rejection are subject to the same treatment as amendments submitted after final rejection.** See *In re Affidavit Filed After Final Rejection*, 152 USPQ 292, 1966 C.D. 53 (Comm'r Pat. 1966). (emphases added)

DECISION

CONTINUATION OF PROSECUTION UNDER 37 CFR 1.182

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

There exists no statutory basis for continued examination in reexamination proceedings as a matter of right. A petition under 37 CFR 1.182 can provide relief for patent owners only in an instance where further examination after final Office action, to address a new amendment or newly proffered evidence, would serve to advance prosecution to further the requirement of special dispatch. The proffered amendment or evidence for which entry is requested via the § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it. This is critical in the *ex parte* reexamination setting, where 35 U.S.C. 305 mandates that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the case without the amendment or evidence), since these are key factors in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution must explain why the patent owner 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 for reexamination.

In response to the October 27, 2009 Office decision dismissing the July 30, 2009 patent owner petition for continued reexamination, the present renewed petition states that additional arguments are provided in support of the petition for continued reexamination, namely, additional explanation regarding why the patent owner's two declarations (i.e., declarations of William A. Bernie and Trevor Speeg) could not have been earlier presented and why they would advance the prosecution of the present reexamination proceeding.[2]

Patent owner explains in the present renewed petition that, in response to the final Office action, patent owner obtained a sample of the GELFOAM material to see if there was anything about that material that might reinforce the patent owner's argument (made in the response filed on

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

January 6, 2009 prior to the final Office action) that the Nabai reference would not lead a person of ordinary skill in the art to modify Foerster.[3] Patent owner states that it was not until after receiving the second non-final and final rejection, when Mr. Speeg tested the GELFOAM material, that the patent owner discovered that GELFOAM did not in fact swell.[4] The patent owner argues that this discovery could not reasonably have been anticipated by or expected to have been discovered by the patent owner earlier, since the Nabai patent expressly characterizes the sponge used in its skin biopsy as being swellable and that GELFOAM is the only example of a swellable sponge disclosed in the Nabai reference.[5] The patent owner states that given the sworn nature of U.S. patent applications, it was reasonable for the patent owner to rely upon this express teaching of the Nabai reference as true in responding to the second non-final action initially citing Nabai.[6]

What the petition does not explain, is why Mr. Speeg did not test the GELFOAM material immediately after the issuance of the second non-final Office action, to address the issue with special dispatch. While petitioner patent owner states that it was reasonable for the patent owner to rely upon this express teaching of the Nabai reference as true in responding to the second non-final action, it is not clear why it became unreasonable for the patent owner to rely upon this express teaching of the Nabai reference as true – *only* after final Office action. Thus, the petition does not present a persuasive reason why the need for the declarations could not have been earlier anticipated. As such, the petition again fails for want of a persuasive explanation of why the patent owner did not anticipate the need for the new evidence earlier in the prosecution.

Furthermore, the patent owner states that examiner in the advisory action 1) denied entry of the Speeg declaration, and 2) stated that the declaration was not persuasive because the response did not establish a nexus between the isotonic solution in which Mr. Speeg tested the GELFOAM and the claimed subject matter, namely, a method for performing a breast biopsy.[7] The patent owner argues that the Nabai reference may not be enabling as to what is a swellable sponge and that granting this petition would give the patent owner the opportunity to respond to the position the Examiner has taken in the advisory action and to develop the record regarding the Nabai teachings would advance the prosecution of the reexamination.[8] Patent owner alleges that the teaching of the Nabai reference is clearly in dispute and should be resolved in an orderly fashion through continued reexamination.[9] These arguments however, are directed to the correctness of the examiner's "nexus" determination stated in the examiner's denial of entry of the declaration, and the propriety of the examiner's denial of entry of the declaration. Such arguments would be directed to a 37 CFR 1.181 petition.[10] Such arguments are directed to why patent owner believes the declarations should have been entered after final Office action; such arguments are not

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[3] Petition at page 4.
[4] Petition at page 4.
[5] Petition at page 4.
[6] Petition at page 4.
[7] Petition at page 4. As pointed out by the examiner in the advisory Office action, the Speeg declaration only provided evidence that GELFOAM immersed in saline did not swell and that the claims did not pertain to having the material immersed in a saline solution, but instead the material was placed in a biopsy site within a human body. Therefore, the examiner concluded that the Speeg declaration did not establish a nexus between the evidence and the claims.
[8] Petition at page 5.
[9] Petition at page 5.
[10] And since patent owner is advancing argument directed to a 37 CFR 1.181 petition, there is a rule under which patent owner believes relief to be available; thus, 37 CFR 1.182 cannot be available.

directed to why the proceeding should be "backed-up" by reopening of the prosecution for continued reexamination. As pointed out above, patent owner could have tested the GELFOAM material prior to responding to the second non-final Office action to see if there was anything about the material that might reinforce the patent owner's argument, in response to the second non-final Office action, that the Nabai reference would not lead a person of ordinary skill in the art to modify Foerster. Patent owner's explanation that he relied on the "sworn" nature of the teaching of the Nabai reference in responding to the second non-final Office action is unpersuasive, with respect to the furthering of the statutory requirement for reexamination in the Office. If the "sworn" nature of the teaching of the Nabai reference was deemed unreliable after final Office action, it would have been deemed just as unreliable after second nonfinal Office action – nothing in the final Office action has been shown to suddenly address the reliability of the "sworn" nature of the teaching of the Nabai reference. As discussed at page 6 of the October 27, 2009 Office decision, given the statutory mandate of 35 U.S.C. 305 for special dispatch in reexamination, patent owner could have, and should have, submitted declaratory evidence regarding this finding of fact to support the argument made (and further special dispatch by placing everything before the examiner in the response) after the second action non-final, but patent owner chose not to do so.

It is noted that patent owner comments at page 3 of the present renewed petition that although the advisory action denied entry of the patent owner's declarations, the Examiner considered the declarations. Specifically, the examiner stated in the advisory action that even if the declarations had been timely filed the declarations would not have overcome the rejections. Again, such would be an argument directed to a 37 CFR 1.181 petition. A 37 CFR 1.181 petition is the place to address the examiner's position that since the declaration evidence was not timely filed after the final Office action, does not place the claims in condition for allowance, and does not simplify issues for appeal, it is at the discretion of the examiner whether to enter the evidence as set forth in the sections of MPEP 714.12 and 2266.01 reproduced above (also, as stated in the pertinent section of MPEP 2265, which is reproduced above, affidavits submitted after final rejection are subject to the same treatment as amendments submitted after final rejection). Any such 37 CFR 1.181 petition would need to address the examiner's citation in the advisory action to an article of record by Dr. Ongkasuwan, which provides evidence, consistent with the teaching of the Nabai reference, that when GELFOAM is used in a human body, it swells. The Nabai reference is a U.S. Patent, and all U.S. Patents are presumed valid. It is very high bar to show that a U.S. Patent is not enabled. In any event, the present renewed petition is not the proper vehicle to provide a showing by arguments alone regarding the operability of a U.S. patent. See MPEP 716.07.

In conclusion, petitioner patent owner has not provided a persuasive showing that granting the present renewed petition for continued reexamination of the instant proceeding would be consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

CONCLUSION

1. The present renewed petition under 37 CFR 1.182 is dismissed.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993.

3. 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.

4. Any inquiry concerning this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth M. Schor

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

Kenpet7/RCR
12-16-09

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THOMPSON HINE L.L.P.
INTELLECTUAL PROPERTY GROUP
P.O. BOX 8801
DAYTON, OH 45401-8801

(For Patent Owner)

MAILED

JUN 17 2010

DOUGLAS R. HANSCOM
JONES, TULLAR & COOPER, P.C.
P.O. BOX 2266 EADS STATION
ARLINGTON, VA 22202

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re Richard E. Fulton III et al.
Ex Parte Reexamination Proceeding
Control No.: 90/008,995
Filing Date: January 17, 2008
For: U.S. Patent No. 6,699,205

: **DECISION**
: **DENYING**
: **PETITION**

This is a decision on the December 24, 2009 patent owner petition under 37 CFR 1.182 entitled "REQUEST FOR RECONSIDERATION OF THE DECISION ON RENEWED PETITION FOR CONTINUED EX-PARTE REEXAMINATION PROCEEDING," requesting reconsideration of the December 18, 2009 decision dismissing the November 4, 2009 patent owner renewed petition for continued reexamination of the above-captioned proceeding to provide for entry and consideration of a post final Office action proposed response and accompanying declarations.

Patent owner's petition for reconsideration is before the Office of Patent Legal Administration.

SUMMARY

Petitioner patent owner's request for reconsideration is granted to the extent that the prior decision has been reconsidered but is denied as to the underlying relief requested, for the reasons set forth below. Prosecution of the present *ex parte* reexamination proceeding is not being reopened by this decision, and the July 8, 2009 post final Office action submissions will not be entered.

35 U.S.C. § 305 mandates that "[a]ll reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. The conscious choice by

patent owner not to seek evidence until after the examiner had responded to the patent owner's arguments in the final Office action (and did not accept the arguments) does not represent an effort that is consistent with conducting the present proceeding with special dispatch. The decision on a petition under 37 CFR 1.182 to continue reexamination, despite a patent owner's failure to comply with 37 CFR 1.116, is a decision based on equity. And, in this instance, the equities do not favor patent owner.

This decision is a final agency action within the meaning of 5 U.S.C. § 704.

REVIEW OF FACTS

1. On March 2, 2004, the Office issued U.S. Patent No. 6,699,205 (the '205 patent) to Fulton, III et al.

2. On January 17, 2008, a request for *ex parte* reexamination of the '205 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/008,995 (hereinafter '8995).

3. On February 12, 2008, the Office issued a notice of the filing of the '8995 *ex parte* reexamination with a filing date of January 17, 2008.

4. On March 7, 2008, the Office issued an order granting the '8995 *ex parte* reexamination request.

5. On June 12, 2008, a first Office action on the merits issued, rejecting claims 1-7, 9-17, 19-26, 28, and 29. Claims 8, 18, and 27 were not and are not subject to reexamination.

6. On August 12, 2008, patent owner filed a response retaining original claims 1-7, 9-17, 19-26, 28, and 29 as not amended and adding new claims 30 and 31.

7. 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 1-7, 9-17, 19-26, and 28-31.

8. On January 6, 2009, patent owner filed a response to the November 6, 2008 Office action in which no claim was amended.

9. On March 9, 2009, a final Office action was issued, maintaining the prior art rejections of claims 1-7, 9-17, 19-26, and 28-31 set forth in the previous Office action.

10. On April 23, 2009, patent owner filed a petition for a one-month extension of time to respond to the final Office action mailed March 9, 2009, and the April 27, 2009 Office decision granted the requested one-month extension.

11. On June 3, 2009, patent owner filed a petition for a second one-month extension of time to respond to the final Office action mailed March 9, 2009, and the June 5, 2009 Office decision granted the requested second one-month extension.

12. On July 8, 2009, patent owner filed a submission as a proposed response to the final Office action, the proposed response being accompanied by a declaration under 37 CFR 1.132 by William A. Bernie and a declaration under 37 CFR 1.132 by Trevor Speeg.

13. On July 17, 2009, the Office issued an advisory Office action stating that the July 8, 2009 declarations under 37 CFR 1.132 would not be entered because they were not timely, and patent owner did not present any reasons why the declarations were not presented earlier (e.g., after the first time the same rejections were applied to the claims).

14. On July 30, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION AND IN THE ALTERNATIVE UNDER § 1.181 AND/OR § 1.183 FOR ENTRY OF THE PATENT OWNER'S RESPONSE FILED JULY 8, 2009" to request continued reexamination of the subject patent and entry of the response after final and accompanying declarations filed on July 8, 2009.

15. On September 8, 2009, patent owner filed a Notice of Appeal.

16. On October 27, 2009, the Office mailed a decision dismissing the July 30, 2009 patent owner petition.

17. On October 30, 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.

18. On November 4, 2009, patent owner filed a petition entitled "RENEWED PETITION UNDER 37 C.F.R § 1.182 FOR CONTINUED REEXAMINATION."

19. On November 6, 2009, the Office mailed a decision granting a one-month extension of time to file an appeal brief.

20. On December 2, 2009, patent owner filed a request for an additional one-month extension of time pursuant to 37 CFR 1.550(c) for filing an appeal brief, and the December 7, 2009 Office decision granted the requested additional one-month extension. The due date of the appeal brief was extended to January 8, 2010.

21. On December 18, 2009, the Office mailed a decision dismissing the November 4, 2009 renewed patent owner petition.

22. On December 24, 2009, patent owner filed the present petition for reconsideration of the December 18, 2009 decision dismissing the renewed petition for continued *ex parte* reexamination.

23. On January 8, 2010, patent owner timely filed an appeal brief.

24. On January 27, 2010, the Office mailed a Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in *Ex Parte* Reexamination.

25. On February 11, 2010, patent owner filed a corrected appeal brief.

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

The present petition requests reconsideration of the Office's December 18, 2009 decision dismissing patent owner's November 4, 2009 renewed petition for continued reexamination of the instant proceeding. In order to give the full context of the present petition, this decision is organized as follows: Section I provides the background for the present petition and discusses (1) the relevant Office actions and patent owner responses, (2) the patent owner's July 30, 2009 petition under 37 CFR 1.182 for continued reexamination, (3) the October 27, 2009 dismissal of patent owner's July 30, 2009 petition, (4) the patent owner's November 4, 2009 renewed petition under 37 CFR 1.182 for continued reexamination, and (5) the December 18, 2009 dismissal of the November 4, 2009 patent owner petition. Section II discusses the present patent owner petition for reconsideration of the December 18, 2009 dismissal. Finally, Section III discusses the analysis and findings on the present petition for reconsideration.

I. BACKGROUND FOR PETITION REQUESTING CONTINUED REEXAMINATION

1. Relevant Office Actions and Patent Owner Responses

On November 6, 2008, a second non-final Office action was issued in the '8995 proceeding. The action withdrew all prior art rejections made in the first non-final Office action and set forth new

grounds of rejections for claims 1-7, 9-17, 19-26, and 28-31. The claims were rejected under 35 U.S.C. § 103 over Foerster in view of Nabai et al (a newly cited reference by the examiner) and Anderson et al.

On January 6, 2009, patent owner filed a response to the November 6, 2008 second non-final Office action *in which no claim was amended and no evidence was provided.* The response provided arguments alleging patentability of the rejected claims over the applied prior art of record.

On March 9, 2009, a final Office action was issued, maintaining the prior art rejections for claims 1-7, 9-17, 19-26, and 28-31 initially set forth in the November 6, 2008 second non-final Office action. No new ground of rejection was made in the final Office action.

On July 8, 2009, after being granted two "one-month extensions of time" to respond to the final Office action, patent owner filed a response that was accompanied by a declaration under 37 CFR 1.132 by William A. Bernie and a declaration under 37 CFR 1.132 by Trevor Speeg.

On July 17, 2009, the Office issued an advisory Office action stating that the July 8, 2009 declarations under 37 CFR 1.132 would not be entered because they were not timely, and patent owner did not present any reasons why the declarations were not presented earlier (*e.g.*, after the first time the same rejections were applied to the claims).

2. Patent Owner's July 30, 2009 Petition to Request Continued Reexamination

In its July 30, 2009 petition to request continued reexamination and entry and consideration of the response after final and accompanying declarations filed on July 8, 2009, patent owner asserted that it was only after the examiner had responded to the patent owner's arguments in the March 9, 2009 final Office action did the patent owner consider the submission of additional data and testimony to be warranted.[1] Accordingly, patent owner filed the Bernie and Speeg declarations with the post-final response on July 8, 2009.[2] Patent owner stated that Speeg's declaration attested to the fact that GELFOAM absorbable gelatine sponge, the hemostat used in the Nabai reference in the performance of a skin biopsy, was not swellable.[3] Patent owner asserted that the Bernie declaration gave numerous reasons why the Nabai and Anderson references were not likely to lead a person of ordinary skill in the art to modify Foerster's biopsy marker to arrive at a method for marking a breast biopsy site that employed a swellable bioresorbable body having a radiopaque marker carried by the bioresorbable body.[4] Patent owner argued, as a basis for granting its petition, that patent owner could not know with certainty (when response was made to the second non-final Office action) whether arguments would be successful when considered on their own merits, or whether the patent owner would need to buttress those arguments with additional data and/or testimony.[5]

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[1] July 30, 2009 petition at page 4.
[2] July 30, 2009 petition at page 4.
[3] July 30, 2009 petition at page 4.
[4] July 30, 2009 petition at pages 4-5.
[5] July 30, 2009 petition at page 3.

Patent owner also argued that given the time and expense involved in retaining an expert and/or a laboratory, the patent owner could not reasonably be expected to incur these costs in response to an Office action, since it was reasonable for the patent owner to believe that the merits and logic of the arguments themselves would be sufficient. The basis for this belief was stated to be that, in the prosecution of the present reexamination proceeding, the patent owner was able to overcome the prior art rejections in the June 12, 2008 first non-final Office action without submitting additional evidence under § 1.132.[6] Finally, patent owner explained that the *costs and substantial efforts* that went into preparing these declarations impeded the patent owner's ability to submit such declarations at an earlier date.[7]

3. Dismissal of the July 30, 2009 Petition to Request Continued Reexamination

In its October 27, 2009 dismissal of patent owner's July 30, 2009 petition for continued reexamination, the Office stated that the petition included two separate requests:[8] (1) The request under 37 CFR 1.182 for continued reexamination of the present proceeding; and (2) The assertion under 37 CFR 1.181 that the July 8, 2009 post-final submissions should have been entered under 37 CFR 1.116. The decision dismissed the combined petition, pursuant to 37 CFR 1.4(c), which requires different matters raised in a given proceeding be raised in separate papers. The first request was subject to decision by the Office of Patent Legal Administration, and the second, by the Central Reexamination Unit. In advisory comments, the decision addressed the aspect of the petition directed to the request under 37 CFR 1.182 for continued reexamination.

The October 27, 2009 decision stated that granting the equitable relief sought would be contrary to Office policy as it would undermine the policy intent of the relevant Office rule, *e.g.* 37 CFR 1.116(e).[9] 37 CFR 1.116(e) permits the submission of an "affidavit or other evidence" after a final Office action in an *ex parte* reexamination if (1) the evidence is submitted before or on the same date of filing an appeal, and (2) it is accompanied by a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented. In this instance, the examiner's final Office action neither changed nor added a basis or grounds of rejection in terms of prior art rejections (i.e., neither shifted from the obviousness grounds of rejection nor added new references into the grounds of rejection). When patent owner responded to the action preceding the final rejection, it was reasonably foreseeable (by patent owner) that the examiner would not be persuaded by attorney argument and would maintain the rejection; it is not uncommon for an examiner to find attorney arguments not persuasive. Patent owner's decision to see how things "turned out," rather than timely filing evidence in response to the second non-final Office action, was its own choice, and did not support the unequivocal requirement for the Office to carry out an *ex parte* reexamination proceeding with special dispatch.

The decision indicated, on page 6, that given the Office's statutory mandate of 35 U.S.C. § 305 for special dispatch in reexamination, patent owner could have, and should have, submitted declaratory evidence regarding this finding of fact to support the argument made (and further special dispatch by placing everything before the examiner in the response) after the second

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[6] July 30, 2009 petition at page 3.
[7] July 30, 2009 petition at page 5.
[8] October 27, 2009 decision at page 4.
[9] October 27, 2009 decision at pages 5-6.

action non-final, but patent owner chose not to do so. The actions taken by the examiner (i.e., responding to the patent owner's arguments in the final Office action and maintaining all of the previous prior art rejections) were not unforeseeable, and patent owner's argument that it was only after the examiner had responded to patent owner's arguments did the patent owner consider the submission of additional data and testimony to be warranted was found unpersuasive.

In response to patent owner's explanation that the costs and substantial efforts that went into preparing the § 1.132 declarations impeded the patent owner's ability to submit such declarations at an earlier date, the decision pointed out that it appeared that patent owner did not make any efforts to submit additional evidence until after the final Office action was mailed.[10] The patent owner to date has not taken issue with the Office's determination regarding patent owner's lack of effort to seek evidence prior to the final Office action. The decision also pointed out that such an argument went to the § 1.181 aspect of the petition, as to why the evidence could not have been submitted sooner, and specifics of the delay would be required to support such a showing.[11]

4. Patent Owner's Renewed Petition of November 4, 2009 for Continued Reexamination

In its November 4, 2009 renewed petition for continued reexamination, patent owner stated that additional arguments were provided in support of the petition for continued reexamination, namely, additional explanation regarding why patent owner's two declarations (i.e., declarations of William A. Bernie and Trevor Speeg) could not have been earlier presented and why they would advance the prosecution of the present reexamination proceeding.[12]

Patent owner explained in the renewed petition that, *in response to the final Office action*, patent owner obtained a sample of the GELFOAM material to see if there was anything about that material that might *reinforce* the patent owner's argument (made in the January 6, 2009 response to the second non-final Office action) that the Nabai reference would not lead a person of ordinary skill in the art to modify Foerster.[13] Patent owner stated in the renewed petition that it was not until after receiving the second non-final action and final rejection, when Mr. Speeg tested the GELFOAM material, that the patent owner discovered that GELFOAM did not in fact swell.[14] The patent owner argued that this discovery could not reasonably have been anticipated by or expected to have been discovered by the patent owner earlier, since the Nabai patent expressly characterized the sponge used in its skin biopsy as being swellable and that GELFOAM was the only example of a swellable sponge disclosed in the Nabai reference.[15] The patent owner further contended that given the sworn nature of U.S. patent applications, it was reasonable for the patent owner to rely upon this express teaching of the Nabai reference as true in responding to the second non-final action initially citing Nabai.[16]

In addition, the patent owner stated that the examiner in the advisory action (1) denied entry of

[10] October 27, 2009 decision at page 6.
[11] October 27, 2009 decision at page 6.
[12] Renewed petition at page 2.
[13] Renewed petition at page 4.
[14] Renewed petition at page 4.
[15] Renewed petition at page 4.
[16] Renewed petition at page 4.

the Speeg declaration, and (2) stated that the declaration was not persuasive because the response did not establish a nexus between the isotonic solution in which Mr. Speeg tested the GELFOAM and the claimed subject matter, namely, a method for performing a breast biopsy.[17] The patent owner argued that the Nabai reference may not be enabling as to what was a swellable sponge and that granting the petition would give the patent owner the opportunity to respond to the position the Examiner had taken in the advisory action and to develop the record regarding the Nabai teachings in order to advance the prosecution of the reexamination.[18] Patent owner alleged that the teaching of the Nabai reference was clearly in dispute and should be resolved in an orderly fashion through continued reexamination.[19]

5. Decision of December 18, 2009 Dismissing the Renewed Petition

In its December 18, 2009 dismissal of patent owner's renewed petition under 37 CFR 1.182 to request continued reexamination, the Office stated the following:[20]

> What the petition does not explain, is why Mr. Speeg did not test the GELFOAM material immediately after the issuance of the second non-final Office action, to address the issue with special dispatch. While petitioner patent owner states that it was reasonable for the patent owner to rely upon this express teaching of the Nabai reference as true in responding to the second non-final action, it is not clear why it became unreasonable for the patent owner to rely upon this express teaching of the Nabai reference as true – *only* after final Office action. Thus, the petition does not present a persuasive reason why the need for the declarations could not have been earlier anticipated. As such, the petition again fails for want of a persuasive explanation of why the patent owner did not anticipate the need for the new evidence earlier in the prosecution.

The dismissal further stated that if the "sworn" nature of the teaching of the Nabai reference was deemed unreliable (by the patent owner) after final Office action, it would have been deemed just as unreliable after the second non-final Office action – nothing in the final Office action was shown to suddenly address the reliability of the "sworn" nature of the teaching of the Nabai reference. The dismissal reiterated that given the statutory mandate of 35 U.S.C. § 305 for special dispatch in reexamination, patent owner could have, and should have, submitted declaratory evidence regarding this finding of fact to support the argument made (and further special dispatch by placing everything before the examiner in the response) after the second action non-final, but patent owner chose not to do so.[21]

With respect to patent owner's argument in the renewed petition that the Nabai reference may

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[17] Renewed petition at page 4. As pointed out by the examiner in the advisory Office action, the Speeg declaration only provided evidence that GELFOAM immersed in saline did not swell and that the claims did not pertain to having the material immersed in a saline solution, but instead the material was placed in a biopsy site within a human body. Therefore, the examiner concluded that the Speeg declaration did not establish a nexus between the evidence and the claims.

[18] Renewed petition at page 5.

[19] Renewed petition at page 5.

[20] December 18, 2009 decision at page 7.

[21] December 18, 2009 decision at page 8.

not be enabling as to what was a swellable sponge and that granting the petition would give the patent owner the opportunity to respond to the position the examiner had taken in the advisory action,[22] the Office's position was that such arguments regarding the correctness of examiner's actions were not appropriate under a 37 CFR 1.182 petition.[23] Rather, such arguments may be presented for appeal. The decision at page 8 provided advisory comments on this § 1.181 aspect of the petition as follows:

> The Nabai reference is a U.S. Patent, and all U.S. Patents are presumed valid. It is very high bar to show that a U.S. Patent is not enabled. In any event, the present renewed petition is not the proper vehicle to provide a showing by arguments alone regarding the operability of a U.S. patent. See MPEP 716.07.

II. Patent Owner's Present Petition filed December 24, 2009 for Reconsideration of the December 18, 2009 Dismissal of the Renewed Petition

In its present petition for reconsideration, patent owner's arguments are directed to (1) reasons for not questioning the teachings of the Nabai reference earlier and (2) circumstances under which a request for continued reexamination (by filing a petition under 37 CFR 1.182) is warranted as set forth in the Notice of March 1, 2005 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."[24]

1. The Nabai Reference

With respect to patent owner's reasons for not questioning the teachings of the Nabai reference earlier, patent owner asserts the following:[25]

> The patent owner did not know, and based on the express teachings of Nabai, the patent owner had no reason to suspect that the GELFOAM material would not swell as expressly represented in the Nabai reference.

Therefore, patent owner argues that it did not choose not to seek evidence earlier and in fact did not make any choice.[26]

Patent owner further argues at page 2 of the present petition that "the same policies that justify a 'very high bar to show that a U.S. Patent is not enabled' should also explain the patent owner's failure to even consider questioning the accuracy of the technical underpinnings of the Nabai reference (i.e., the swellability of the GELFOAM material)."[27] Patent owner also asserts that the failure of a respondent to a non-final rejection to "not have in his or her possession information

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[22] Renewed petition at page 5.

[23] Insofar as the petition continues to argue as to the propriety of the examiner's action, this is subject to either supervisory review under 37 CFR 1.181 or substantive review by way of appeal. Relief under 37 CFR 1.182 is not available for either of these situations and thus, these arguments will not be addressed here.

[24] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

[25] Petition for reconsideration at pages 1-2.

[26] Petition for reconsideration at page 1.

[27] Petition for reconsideration at page 2.

enabling him or her to challenge the express teachings of a reference cannot *per se* constitute a failure to act with 'special dispatch' and preclude consideration of newly discovered information - especially when the express disclosure in the reference indicates that such information should not, in fact, exist."[28] Patent owner alleges that the December 18, 2009 Office decision appears to be internally inconsistent in that "[o]n the one hand, the Decision indicates that the Office places issued patents on a pedestal such that it is a 'very high bar to show that a U.S. Patent is not enabled,' but on the other hand this pedestal is ignored and is of no probative value or justification when it comes to challenging the accuracy of express teachings in a U.S. Patent reference."[29]

2. The March 1, 2005 Notice Regarding RCR

With respect to the Notice of March 1, 2005, the patent owner alleges that it is being denied access to the process outlined in the Notice regarding continued reexamination and that the present situation is exactly the situation contemplated by the Notice for which continued reexamination is warranted.[30] Specifically, patent owner asserts that the "Notice only mentions situations in which response after final has been denied entry as would be the case with analogous RCE in standard prosecution," and "[a]ccordingly, the patent owner submits it is not correct to deny it access to continued reexamination when the Notice contemplates that responses not enterable under 37 CFR § 1.116 will be considered via continued reexamination."[31]

The patent owner requests that if the Office is changing its practice and abandoning the Notice of March 1, 2005, the Office should inform the patent bar. The patent owner cites and includes as support for this allegation, a petition under § 1.182 for continued reexamination, which was accompanied by a declaration, that was granted in a July 18, 2006 decision in the 90/006,802 (hereinafter '6802) reexamination proceeding. The patent owner alleges that the petition there was granted without any scrutiny into why the declaration had not been submitted earlier. The patent owner also points out that, in the '6802 proceeding, the patent owner of that proceeding had responded to a final rejection without the declaration whereas in the present reexamination proceeding, the patent owner has been more diligent than the patent owner in '6802 proceeding in that the declaration was submitted in response to the final action.[32]

The patent owner questions why there is "a grantable basis for continuing reexamination to consider evidence that the patent owner did not even get around to submitting in response to the final action in" the '6802 proceeding, whereas there is not a grantable basis in the present proceeding "where the patent owner submitted the evidence in response to the final action."[33] The patent owner alleges that, while the Office may not be bound by its action in the '6802, that a basic rule of fairness seems to be violated.[34] The patent owner believes that the purpose of the

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[28] Petition for reconsideration at page 2.
[29] Petition for reconsideration at pages 1-2.
[30] Petition for reconsideration at page 2.
[31] Petition for reconsideration at pages 2-3.
[32] Petition for reconsideration at page 3.
[33] Petition for reconsideration at page 3.
[34] Petition for reconsideration at page 3.

Notice appears to have been implemented in the '6802 proceeding whereas in the present situation, it is being superseded "by excruciating inquiry into issues relating to Rule 116 from which the Notice was expressly intended to provide relief."[35]

III. ANALYSIS AND FINDINGS

1. Patent Owner's Arguments for not Questioning the Teachings of the Nabai Reference Earlier

With respect to patent owner's arguments in the present request for reconsideration regarding why the declaration evidence was not earlier submitted, patent owner's response again fails to explain why patent owner began to question the enablement of the teachings of the Nabai reference only after the final Office action was issued; no new grounds of rejection were made in the final rejection and the issue was not newly raised in that action (or even discussed there). It is noted that page 14 of patent owner's remarks filed on January 6, 2009 *in response to the second non-final Office action* stated "[w]hile it may be correct that GELFOAM is known to swell, where is it taught that the specific percentages desired by the method of Applicant are to be employed in any of the cited reference?" There, patent owner, in response to the second non-final Office action, did not question the correctness of whether the GELFOAM material actually swelled, but instead questioned the specific percentage of swelling taught by the prior art. The subsequent final Office action did not raise any new issues that could have prompted the patent owner to question the reliability of the teachings of the Nabai reference.

As stated by patent owner in its July 30, 2009 petition, it was only after the examiner had responded to the patent owner's arguments in the March 9, 2009 final Office action that patent owner considered the submission of additional data and testimony to be warranted [36] – clearly by this statement, patent owner chose not to consider submitting the 37 CFR 1.132 declarations until after the examiner was not persuaded by patent owner's arguments and issued a final Office action.

Although patent owner disagrees that submitting the evidence later was a "choice," the evidence submitted to overcome the rejections made in the November 6, 2008 second non-final Office action, was not made in patent owner's next responsive reply, but rather was presented only after a final rejection was issued. MPEP 2272 states (in pertinent part):

> It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. . . . Accordingly, both the examiner and the patent owner should identify and develop all issues prior to the final Office action, including the presentation of evidence under 37 CFR 1.131 and 1.132.

In 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. Patent owner argues that the "very high bar to show that a U.S. Patent is not enabled" should also explain its failure to even consider

[35] Petition for reconsideration at page 3.
[36] July 30, 2009 petition at page 4.

questioning the accuracy of the technical teaching of the Nabai reference;[37] however, this is unpersuasive. Given that patent owner should have been aware of both the high threshold requirement to show that a patent is not enabled and the Office's mandate for special dispatch, patent owner should have began rigorously seeking to obtain evidence challenging the Nabai reference sooner (i.e., before final Office action) rather than later (i.e., after final Office action). This particular argument only distracts from the issue at hand - that patent owner's evidence after final was not responsive to any new ground of rejection made or new issues raised in the final Office action. The statement in the December 18, 2009 Office decision regarding the very high bar to show that a U.S. patent is not enabled was not the basis of that decision, but instead was an advisory comment on a position that should have been asserted via a § 1.181 petition, rather than in the petition being addressed.

Patent owner had explained in its July 30, 2009 petition that the *costs and substantial efforts* that went into preparing these declarations impeded the patent owner's ability to submit such declarations at an earlier date.[38] However, the October 27, 2009 Office decision stated that it appeared that the patent owner did not make any efforts to seek evidence until after the final Office action was mailed.[39] Patent owner has not returned to this argument nor rebutted the Office's determination regarding patent owner's lack of effort to at least begin the process of obtaining evidence prior to the final Office action.

As such, the petition again 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 Office's need for special dispatch in reexamination.

2. Patent Owner's Arguments for Situations Warranting Continued Reexamination Contemplated in the March 1, 2005 Notice

As an initial matter, the Request for Continued Reexamination (RCR) analogous rule package contemplated and referred to in the Notice was never promulgated, even as a proposed rule. A review of the March 1, 2005 Notice shows that the intent of the Notice is to advise patent owners to use "the petition procedure under 37 CFR 1.182;" i.e., the currently existing procedure set forth for "situations not specifically provided for" in the regulations. The Notice does not provide its own specialized new petition procedure. For this reason, each petition submitted under § 1.182 seeks its own individualized relief based on the equities of the individualized fact situation, and decisions on such petitions do not create any body of generalized expectations that could be applied to any individual petition submission.

The grant of relief for such a § 1.182 petition is strictly controlled by the Office so as 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.

---

[37] Petition for reconsideration at page 2.
[38] July 30, 2009 petition at page 5.
[39] October 27, 2009 decision at page 6.

Prosecution may be furthered by reducing issues, by better defining the issues for appeal (not raising new ones), or by placing the claims in condition for the issuance of a reexamination certificate. In support of the relief requested, a patent owner is to set forth reasons why the submission could not have been presented at an earlier point in the proceeding.

With respect to the ability of the submission to further the prosecution by its entry, patent owner fails to provide specific rationale explaining how entry of the July 8, 2009 declarations would act to better define the issues for appeal, or the issuance of a reexamination certificate. Patent owner only states that without the entry of the Bernie declaration, "the issues relating to the Nabai reference cannot be resolved."[40] In neither the petition, nor elsewhere in the prosecution record, has patent owner set forth with specificity the manner in which the evidence submission would advance prosecution towards issuance of a reexamination certificate or towards appeal. Irrespective of the merits of the evidence submission, the instant petition fails to clearly show how the submission is a *bona fide* effort to address the rejections of the claims so as to define the issues for appeal, or the issuance of a reexamination certificate. Reopening of the prosecution to consider the declarations absent a showing of a *bona fide* effort to advance prosecution by better defining the issues for appeal or the issuance of a reexamination certificate would validate the patent owner's unnecessary delay in presenting the declarations in this proceeding, contrary to the statutory requirement for "special dispatch within the Office."

Patent owner argues in the present request for reconsideration that the Office has violated a basic rule of fairness by granting the April 19, 2006 petition for continued reexamination filed in the '6802 proceeding (see the July 18, 2006 Office decision in the '6802 proceeding attached to the December 24, 2009 petition), but not granting the § 1.182 petition for continued reexamination in the present proceeding. In response, the facts and circumstances that were considered in support of continued reexamination in the '6802 proceeding are different from the facts and circumstances of the present proceeding. In the '6802 proceeding, patent owner submitted a proposed after-final amendment and accompanying declaration in response to new grounds of rejection that applied a newly cited reference in the final Office action.[41] In contrast, the final Office action here did not include a new ground of rejection and did not rely on a new reference. It was only after the examiner issued the same rejections twice, and did not accept the patent owner's arguments in response to the November 6, 2008 non-final Office action that patent owner elected to submit evidence in response to the final Office action where no new grounds of rejection were made. In this case, patent owner failed to seasonably submit evidence, 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. That failure is particularly stark here, where the final Office action did not differ from the second non-final Office action. Therefore, contrary to patent owner's allegations in the present petition, the July 18, 2006 decision in the '6802 proceeding is not on point. Simply put, in the instant proceeding, patent owner in this instance failed to prosecute the proceeding in a manner that would support the unequivocal mandated of 35 U.S.C. § 305 for the Office to carry out an *ex parte* reexamination proceeding with special dispatch, And, the requested reopening of the prosecution to consider declarations that were not submitted at the earliest possible point in the proceeding would be contrary to the Office's mandate for special dispatch. Aside from these points, each situation

[40] Petition for reconsideration at page 3.

[41] September 27, 2005 final Office action, newly applying the Wardlaw reference, in the '6802 proceeding at page 11.

under § 1.182 stands on its own merits; and, as stated above, the equities here are not the same as there.

For the reasons set forth above, the patent owner's arguments and explanations regarding why the July 8, 2009 response after final accompanied by the §1.132 declarations could not have been presented earlier are not persuasive.

Accordingly, patent owner's December 24, 2009 petition requesting reconsideration of the dismissal of the November 4, 2009 renewed petition requesting continued reexamination of the present reexamination proceeding is denied as to the underlying relief requested. Further, given the extensive treatment of this issue (this is the third decision on the matter), the decision is designated a **final agency action** within the meaning of 5 U.S.C. § 704.

CONCLUSION

1. The present petition for reconsideration is granted to the extent that the prior decision has been reconsidered, but it is denied as to the underlying relief requested. The prosecution of the present *ex parte* reexamination proceeding is not being reopened for continued reexamination to consider the July 8, 2009 after final response and declarations.

2. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

3. Further correspondence with respect to this matter should be addressed as follows:

   By mail: Mail Stop
   Commissioner for Patents
   Post Office Box 1450
   Alexandria, VA 22313-1450

4. Jurisdiction over the proceeding is returned to the Central Reexamination Unit

5. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or, in her absence, to Kenneth M. Schor, Senior Legal Advisor at (571) 272-7710.

Brian E. Hanlon
Director
Office of Patent Legal Administration

6-17-10
Kenpet8

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.
90/008,999	01/24/2008	5495435	04068PTRX	5695

21874 7590 10/16/2008

EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

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

William L. Brooks
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON MA 02205

(For Patent Owner)

MAILED

OCT 16 2008

CENTRAL REEXAMINATION UNIT

John J Patti
STORM, LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

(For Third Party Requester)

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

In re: Sugahara
Ex Parte Reexamination Proceeding
Control No. 90/008,999
Deposited: 30 January 2008
For: US Patent No. 5,495,435

This is a decision on the 8 October 2008, petition for "Petition and Request for Extension of Time Under 37 CFR § 1.550(c) and § 1.17(g)," requesting that the time for responding to the Final Office action, mailed 19 September 2008 be extended by thirty (30) days.

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

The petition is Dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Final Office action mailed 19 September 2008, which set a one-month date for filing a response thereto. The patent owner petitions the director of the Central Reexamination Unit requesting the time to respond to the Final Office action be extended to thirty (30) days. Since the petitioner has failed to provide "sufficient cause" for granting an extension of time, the petition is dismissed.

37 CFR 1.550 (c) states:

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

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

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

Analysis and Findings

The patent owner petitions the director if the Central reexamination unit for an extension of time of thirty (30) days for which to submit a response to the Final Office action. The petitioner notes that the assignee is a Japanese corporation and that the inventor is a Japanese citizen. The petitioner further notes that the reference must be translated in to Japanese for the single rejection of the claims.

When considering a petition for extension of time consideration must be given for the patent owner to be given opportunity to present a complete response versus the need for special dispatch in the instant proceeding. It is for these reasons that one must always determine whether there is "sufficient cause" to support an extension for time in a reexamination proceeding.

While it is noted that the assignee is a Japanese corporation and that the reference rejecting the claims is a US English language patent. It is also noted that this is the same reference applied in the first Office action on the merits. One must presume that the inventor had

sufficient understanding of the reference to respond fully to the non-final Office action and further to accept the patent owner's response to the first Office action on the merits as complete. Thus one must assume that there is not "sufficient cause" to require a new translation of the same reference. In consideration of the fact pattern set forth by the patent owner it is determined that no additional time may be granted for the reasons set forth in the petition. The petition is dismissed.

In dismissing the petition for extension of time, the patent owner may resubmit the petition without the requirement of an additional petition fee.

The petition request is hereby **Dismissed**.

Conclusion

1. The patent owner's petition for extension of thirty (30) days time in which to file a response to the Final Office action dated 19 September 2008 is **dismissed**.

2. The Final Office action mailed set a one-month response time for which to respond will end on **19 October 2008**.

3. The patent owner may resubmit the petition without the requirement of an additional petition fee.

4. Future correspondence may be submitted as follows:

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

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, Supervisory Patent Examiner, Art Unit 3992, at 571-272-4929 may be contacted.

/Mark Reinhart/

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,001	01/28/2008	6,870,964	SBC-9001	6080

84033 7590 05/01/2009

JOSEPH P. KRAUSE
5205 Washington Street, Suite 103
Downers Grove, IL 60515

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/01/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PAULE PETERSEN & ERICKSON
2800 WEST HIGGINS ROAD
SUITE 365
HOFFMAN ESTATE, IL 60169

Date MAILED
MAY 01 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009001
PATENT NO. : 6870964
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

Joseph P. Krause (For Patent Owner)
5205 Washington Street
Suite 103
Downers Grove, IL 60515

MAILED

MAY 01 2009

CENTRAL REEXAMINATION UN

Mark D. Swanson (For Third Party Requester)
Pauley, Peterson & Erickson
2800 W. Higgins Road
Suite 365
Hoffman Estates, IL 60169

In re Carl Cooper :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/009,001 : **DISMISSING AS MOOT**
Filed: January 28, 2008 : **PETITION**
For: U.S. Patent No. 6,870,964 :

This is a decision on the March 31, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present reexamination prosecution ("the March 31, 2009 patent owner petition to revive").

The March 31, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

Subsequent to the March 31, 2009 patent owner petition to revive, the Office issued an Ex Parte Reexamination Advisory Action on April 8, 2009, in response to patent owner's March 27, 2009 response to the January 30, 2009 final Office action. The April 8, 2009 Advisory Action extends the period for response to the January 30, 2009 final Office action to three months. Therefore, patent owner's March 31, 2009 corrected response to the January 30, 2009 final Office action is timely, and the March 31, 2009 patent owner petition to revive is **dismissed** as moot.

Patent owner's petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the March 31, 2009 petition to revive was refunded on April 28, 2009.

CONCLUSION

1. The March 31, 2009 patent owner petition to revive is **dismissed** as moot.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for processing of the March 31, 2009 Amendment and Request for Reconsideration Under 37 CFR § 1.530 –Corrected-.

3. 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.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,004	01/28/2008	RE39406	10335-8051	2029

7590 03/24/2009

SAMUEL C. MILLER III
BURNS, DOANE, SWECKER & MATHIS LLP
P.O. BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2009

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

C. BRANDON RASH
FINNEGAN, HENDERSON, FARABOW, GARRETT 7 DUNNER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001-4413

Date: MAILED

MAR 2 4 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009004
PATENT NO. : RE39406
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 DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90009004	1/28/08	RE39406 ET AL.	10335-8051

Cahn & Samuels, LLP
1100 17th Street, N.W.
Suite 401
Washington, DC 20036

EXAMINER
JAMES R. MATTHEWS

ART UNIT	PAPER
3999	20090324

DATE MAILED: MAILED

MAR 2 4 2009

CENTRAL REEXAMINATION UNIT

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

Commissioner for Patents

Courtesy Copy

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Samuel C. Miller III
Burns, Doane, Swecker & Mathis LLP
P.O. Box 1404
Alexandria, VA 22313-1404

(For Patent Owner)

MAILED

MAR 24 2009

CENTRAL REEXAMINATION UNIT

C. Brandon Rash
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, N.W.
Washington, D.C. 20001-4413

(For Requester)

Cahn & Samuels, LLP
1100 17th Street, N.W.
Suite 401
Washington, D.C. 20036

(Courtesy Copy)

In re Pinhas Shpater
Ex Parte Reexamination Proceeding
Control No. 90/009,004
Filed: January 28, 2008
For: U.S. Patent No. RE39,406

: **DECISION**
: **GRANTING**
: **PETITIONS UNDER**
: **37 CFR 1.137(b) and 1.182**

This is a decision on (i) the March 23, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination[1] and (ii) the March 23, 2009 patent owner petition under 37 CFR 1.182 to obtain expedited review of (i) (collectively, "the March 23, 2009 patent owner petitions").

The appropriate petition fees of $400.00 and $810.00 set forth in 37 CFR 1.17(f) and 37 CFR 1.17(m), respectively, for the March 23, 2009 patent owner petitions have been paid.

The March 23, 2009 patent owner petitions are 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 prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a response under 37 CFR 1.550(b) to the December 22, 2008 Office action.

The March 23, 2009 patent owner petitions are herein treated together as a petition to revive. The 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 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
>
> *
>
> (d) *Terminal disclaimer.*
>
> *
>
> *
>
> (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

*

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the March 23, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a response to the December 22, 2008 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a response to any Office action. The December 22, 2008 Office action set a two-month period for response. A response to the December 22, 2008 Office action was not filed until March 23, 2009, which was untimely. However, for the purpose of evaluating whether the March 23, 2009 patent owner petition to revive is a grantable petition, the submission of the March 23, 2009 response to the December 22, 2008 Office action satisfies item (1).[2]

Accordingly, the March 23, 2009 patent owner petition to revive is **granted**.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Samuel C. Miller III, Burns, Doane, Swecker & Mathis LLP, P.O. Box 1404, Alexandria, VA 22313-1404.

The March 23, 2009 Statement of Responsibility states that the firm of Cahn & Samuels, LLP, of 1100 17th Street, N.W., Suite 401, Washington, D.C. 20036, is the party responsible for prosecution of the present reexamination proceeding. As a courtesy, this decision is being mailed to both the Burns Doane and Cahn Samuels addresses.

The address of Samuel C. Miller III, Burns, Doane, Swecker & Mathis LLP, P.O. Box 1404, Alexandria, VA 22313-1404, will be the sole address used in future correspondence, until a change in correspondence address in the patent and the reexamination is made in accordance with 37 CFR 1.33(c).

---

[2] This decision is not directed to the persuasiveness and propriety of the arguments presented in the March 23, 2009 response as to each of the rejections set forth in the December 22, 2008 Office action; such is the examiner's province.

CONCLUSION

1. The March 23, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Patent owner is required to file an appropriate change of correspondence address of record in the patent (the same should be done for the reexamination proceeding), if the current address is not correct.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for processing of the March 23, 2009 Amendment Under 37 CFR 1.530.

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Roland Foster, of CRU Art Unit 3992, at (571) 272-7538.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,006	01/29/2008	6871150	6270-208/SPL-0148	5846

46260 7590 04/16/2010

BRINKS HOFER GILSON & LIONE/PML
PO BOX 10395
CHICAGO, IL 60610

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Charles F. O'Brien, Esq.
CANTOR COLBURN LLP
20 Church Street, 22nd Floor
Hartford, CT 06103

MAILED

APR 16 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,006*.

PATENT NO. *6871150*.

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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Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, Illinois 60610

(For Patent Owner)

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APR 16 2010

CENTRAL REEXAMINATION UNIT

Charles F. Obrien, Esq.
Cantor Colburn LLP
20 Church Street, 22nd Floor
Hartford, Connecticut 06103

(For Third Party Requester)

In re: Benedikt T. Huber et al.	:	**DECISION GRANTING**
Ex parte Reexamination Proceeding	:	**PETITION TO REPLACE**
Control No: 90/009,006	:	**PROTECTED DOCUMENT**
Filing Date: January 29, 2008	:	**SUBMITTED JULY 27, 2009**
For: U.S. Patent No.: 6,871,150	:	**WITH REDACTED VERSION**

This is a decision on the patent owner's April 9, 2010 petition paper entitled "Petition to Return and Replace Paper Pursuant to 37 C.F.R. §1.182" (the "Petition") and patent owner's April 12, 2010 paper entitled "Supplement to Petition to Return and Replace Paper Pursuant to 37 C.F.R. §1.182."

The papers are before the Office of Patent Legal Administration.

The petition is **granted**. The redacted form of the Bingham report filed April 9, 2010, and the substitute form PTO-1449 reflecting the redaction are accepted for entry into the reexamination proceeding and the version of the Bingham report (subject to protective order) submitted July 27, 2009 and the accompanying form 1449 are being expunged from the record.

DECISION

On July 27, 2009, patent owner filed an information disclosure statement which cited and provided a copy of a document referred to as the "Bingham Report" and denoted as item D89 on an accompanying form PTO-1449.

In related reexamination proceedings 90/009,028 and 90/009,039, third party requester (E.I. Electronics) filed a paper requesting the expungement of pages 57-71 of the Bingham report, and, to support its request, provided a decision by the United States District Court for the Northern District of Illinois, Eastern Division issued December 14, 2009. The December 14, 2009 decision granted relief from asserted violations of a protective order that had been issued in the

ongoing litigation[1] and directed that the above-mentioned document be expunged from a list of Office proceedings - including the present '9006 reexamination proceeding.,

The protective order and the December 14, 2009 order of the court are not of record in the present proceeding. However, as the order is of record in the 90/009,028 and 90/009,039 related proceedings, the Office is aware of its content the Office and is issuing this decision in order to facilitate the special dispatch required (by statute) in reexamination. Patent owner is required, pursuant to 37 CFR 1.565(a), to submit copies of the protective order and the December 14, 2009 order of the court to provide same for the record in this proceeding.

On February 9, 2010, patent owner, in order to comply with the court order, filed a petition requesting expungement from the record, without consideration by the examiner, of pages 57-71 of a document that was submitted as part of a July 27, 2009 information disclosure statement, and denoted as D89 on the accompanying form PTO-1449. Patent owner proposed to effect the expungement by means of replacing the originally submitted version of the Bingham report with a version that eliminates the pages that are subject to the protective order (pages 57-71). In the petition, patent owner stated that:

i) the replacement copy of the Bingham Report is identical to "the originally submitted document except for the removal of pages 57-71,"

ii) the substitute Form 1449 is identical except that the annotation of D89 has been changed to reflect that only specific pages are now included, and

iii) the removed pages of the Bingham report are not material to patentability.

On February 12, 2010, patent owner supplemented the petition by a further filing in which petitioner stated that the information is subject to a protective order, the information had not been made public, and petitioner committed to retain the information for the period of the patent.

In view of the terms of the protective order, the irreparable harm to the litigation defendants that would be caused by public disclosure of the protected materials, and the facts and circumstances in this instance as set out above, the petition to replace the document subject to protective order with a version that is not subject to the protective order is granted.

ADDITIONAL DISCUSSION

This decision does not relieve patent owner of the duty to disclose to the Office information patent owner is aware of which is material to patentability pursuant to 37 CFR 1.555, regardless of whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete a patent file wrapper as possible insofar as "material" information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary information, and information subject to a protective order. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose.

---

[1] *Square D Company v. EI Electronics, Inc.*, 1:06-cv-5079 (N.D. Ill.)

Should a situation arise where the duty to disclose is in conflict with the protective order (i.e. if the disclosure of protected information would be needed in order to comply with patent owner's duty), patent owner should approach the court for relief from the protective order.

CONCLUSION

1. The relief requested in the petition to (a) expunge the July 27, 2009 Bingham report identified as item D89 on the accompanying form 1449 and (b) accept a replacement (submitted April 9, 2010) redacted to eliminate the protected material **is granted**.

2. The relief requested in the petition to replace the July 27, 2009 Form 1449 (listing the submitted documents) with the April 9, 2010 Form 1449 **is granted**.

3. As the documents to be expunged have already been made part of the Image File Wrapper (IFW) system and cannot be physically returned, expungement is effected by permanently sealing the documents identified above by closing the documents and marking them as non-public.

4. Patent owner is required to submit a copy of the protective order in the related litigation and a copy of the December 14, 2009 order of the court directing expungement of pages 57-71 of the Bingham report in order to ensure a complete record in this proceeding.

5. Jurisdiction over the proceeding is returned to the Central Reexamination Unit.

6. Inquires regarding the present decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or, in his absence, to the undersigned at (571) 272-7710.

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

4-15-09
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,009	02/26/2008	7206809	063330-5095US	1145

24341 7590 04/09/2009

MORGAN, LEWIS & BOCKIUS, LLP. (PA)
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA 94306

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/09/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TAWNI WILHELM
SHOOK, HARDY & BACON, L.L.P.
2555 GRAND BLVD.
KANSAS CITY, MO 64108-261

Date: MAILED

APR 09 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009009
PATENT NO. : 7206809
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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CENTRAL REEXAMINATION UNIT

SHOOK, HARDY & BACON LLP
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD
KANSAS CITY, MO 64108-2613

(For Requester)

In re Ludwig *et alia*
Reexamination Proceeding
Control No. 90/009,009
For: U.S. Patent No. 7,206,809

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the June 20, 2008 paper entitled "PETITION TO DIRECTOR UNDER 37 C.F.R. §§ 1.515(C) AND 1.181 SEEKING REVIEW OF DENIAL OF REQUEST FOR REEXAMINATION". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

The petition is **DENIED** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 7,206,809 (hereinafter, the '809 patent) issued on April 17, 2007 to Ludwig *et alia.*

2. On February 1, 2008, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/009,009 (hereinafter, the '9009 proceeding).

3. On February 13, 2008, the office mailed a NOTICE OF FAILURE TO COMPLY WITH *EX PARTE* REEXAMINATION REQUEST FILING REQUIREMENTS.

4. On February 26, 2008, the third party requester deposited a corrected request for *ex parte* reexamination. The corrected requested was granted a filing date.

5. An order denying the request for ex parte reexamination was mailed on May 22, 2008.

6. On June 20, 2008, the present petition was filed.

DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '9009 reexamination proceeding has petitioned seeking relief from the examiner's May 22, 2008 Order denying *ex parte* reexamination.

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has

been made as to whether the February 26, 2008 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '809 patent filed in the '9009 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

II. *De Novo* Review of the Request for Reexamination - Findings and Analysis

The '809 patent matured from application number 10/721,343 (the '343 application). The office rejected all pending claims with prior art rejections in the non-final office action mailed February 6, 2006. In response to the prior art rejections, the '343 application was amended on August 7, 2006, with supplemental amendments filed September 21, 2006 and October 2, 2006. Each of the independent claims (originally numbered 1, 14, and 29 and later renumbered as 1, 13, and 25 at allowance) were amended, adding the following limitations:

"registering the service capabilities of at least one of the communications devices associated with at least one user" and using their respective communications devices "based on their registered service capabilities"

In the Notice of Allowance, mailed January 24, 2007, the office stated the reasons for allowance as follows:

"With regard to each independent claim, the prior art of record does not disclose a system as claimed that registers the service capabilities for each user and establishes communications between the users based on the registered service capabilities in combination with all the other recited claim features."

The corrected request for *ex parte* reexamination deposited February 26, 2008 alleges that a substantial new question of patentability is raised as follows on page 9:

"it is respectfully submitted that the Rapport Multimedia Conferencing System discloses a method of real-time communication between a plurality of users each with respective communication devices having associated displays, the method comprising registering the service capabilities of at least one of the communications devices associated with at least one user and enabling real-time communication between the first and second users using their respective communication devices based on their registered service capabilities, as recited in claim 1. *See Ensor,* p. 581-82; *see also Ahuja '90,* pp. 240, 241,244 and FIG. 1; *Ahuja '88,* p. 3.

The same passages are cited in for independent claims 13 (see page 10) and 25 (see page 18) in the substantial new question of patentability portion of the request. Specific passages on those pages are cited in the detailed explanation of the pertinency and manner of applying the cited prior art section of the request as follows:

The Rapport Multimedia Communication System as described in Ensor and Ahuja '88, Ahuja '90 discloses a method of real-time communication between a plurality of users comprising registering the service capabilities of the user's communication device:

> Rapport meeting participants may exchange information through voice, video, and data .... " [Ensor, p. 582]
>
> "The Rapport multimedia communication system [Ah 88] allows people to hold long-distance discussions, sharing voice, video, and program displays in real-time .... Rapport also allows meeting participants to see common program displays on their computer monitors." [Ensor, p. 581]
>
> "Meetings are initiated by dialing a person's telephone number or specifying a the name of the person to be called .... Meetings can be started as multimedia calls and voice-only meetings can grow to include information sharing in additional media." [Ensor, p. 581]

The Rapport Multimedia Communication System as described in Ensor and Ahuja '88, Ahuja '90 discloses a method of real-time communication between a plurality of users comprising enabling real-time communication between the first and second users:

> "The Rapport multimedia communication system [Ah 88] allows people to hold long-distance discussions, sharing voice, video, and program displays in real-time .... Meeting participants with appropriate monitors can see each other through video feeds and share displays of other video-based information. Rapport also allows meeting participants to see common program displays on their computer monitors." [Ensor, p. 581]
>
> "A 10 Mbit Ethernet is used to transmit data among the workstations, and separate networks are used to transmit voice and control signals. This collection of networks mimics the
> channels of ISDN and has been used in our development to aid migration to that network standard." [Ahuja '90, p. 241]
>
> "Conferees using workstations running UNIX and the X window system are able to see a number of common displays, which are produced by various applications programs. Each shared application produces an identical display on each conferee's screen; therefore the displays are similar to a blackboard or slide presentation in a face to face meeting. However, these applications programs are active entities, and conferees may use them to produce and modify data during the meeting." [Ahuja '88, p. 3]

The *de novo* review of the request reveals that the cited passages in the three references are not on point to the claim limitations that distinguished the allowed claims over the applied prior art during the prosecution of the '343 application. Specifically, there is no "registering of the

service capabilities of at least one of the communications devices associated with at least one user" and there is no using the respective communications devices "based on their registered service capabilities". The discussion of participants exchanging information via voice, video and additional media does not address registering capabilities and the request noticeably omits the second limitation (using their respective communications devices based on their registered service capabilities) in the discussion. Therefore, the teachings in *Ensor, Ahuja '88, Ahuja '90* are cumulative to the prior art that was before the examiner and applied to the claims during prosecution of the '343 application (before the claims were amended).

Therefore, the request did not establish that the references contained new technical teachings that would have been important to a reasonable examiner in determining the patentability of at least one claim.

The petition appears to concede that the corrected request, filed February 26, 2008, does not properly address these limitations. There are no arguments that the above-cited passages teach the critical limitations. Instead, petitioner cites a new passage in *Ahuja '88* to allegedly teach "the claimed registering of service capabilities of a device associated with a user and enabling real-time communication with a second user based on the service capabilities." (see the bottom of page 4 and top of page 5 of the request). Petitioner cannot persuasively bootstrap a new discussion of the *Ahuja '88* into establishing a SNQ in the request for reexamination in the '009 proceeding by now, for the first time in the record, making arguments directed to this particular teaching via the present petition. If requester wishes to attempt to assert *Ahuja '88* in a manner that differs from its prior use, requester is free to do so in a new filing of a reexamination request. However, a review of the newly cited passage indicates that this passage does not provide a new technological teaching regarding "the claimed registering of service capabilities of a device associated with a user and enabling real-time communication with a second user based on the service capabilities" either.

The petition also addresses the examiner's stated position that *Ensor and Ahuja '88, Ahuja '90* do not teach "allowing the first user to establish communication by selecting a displayed second user's identifier". The petition notes that this teaching was before the examiner during prosecution of the '343 application. Notably, the examiner cited and applied, in a prior art rejection, Baumgartner (US Patent Number 5,195,086) to address this limitation. Therefore, even if *Ensor and Ahuja '88, Ahuja '90* had taught this limitation, such a teaching would be cumulative to the prior art that was before the examiner (i.e. Baumgartner) with respect to this limitation.

The *de novo* review on the record of the request for reexamination in the '009 reexamination proceeding, undertaken in light of the arguments presented in the present petition compels the conclusion that the request for reexamination in the '009 reexamination proceeding does not raise a new SNQ with respect to the claims of the '809 patent for which reexamination was requested. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 7,206,809 has been presented in the corrected request filed February 26, 2008 by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,012	02/22/2008	7,185,054	063330-5094US	4083

24341 7590 04/09/2009

MORGAN, LEWIS & BOCKIUS, LLP. (PA)
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA 94306

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/09/2009

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SHOOK,HARDY & BACON L.L.P.
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

Date MAILED
APR 09 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009012
PATENT NO. : 7185054
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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2 PALO ALTO SQUARE
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PALO ALTO, CA 94306

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CENTRAL REEXAMINATION UNIT

SHOOK, HARDY & BACON LLP
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD
KANSAS CITY, MO 64108-2613

(For Requester)

In re Ludwig *et alia*
Reexamination Proceeding
Control No. 90/009,012
For: U.S. Patent No. 7,185,054

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the June 20, 2008 paper entitled "PETITION TO DIRECTOR UNDER 37 C.F.R. §§ 1.515(C) AND 1.181 SEEKING REVIEW OF DENIAL OF REQUEST FOR REEXAMINATION". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

The petition is **DENIED** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 7,185,054 (hereinafter, the '054 patent) issued on February 27, 2007 to Ludwig *et alia.*

2. On February 1, 2008, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/009,012 (hereinafter, the '9012 proceeding).

3. On February 15, 2008, the office mailed a NOTICE OF FAILURE TO COMPLY WITH *EX PARTE* REEXAMINATION REQUEST FILING REQUIREMENTS.

4. On February 29, 2008, the third party requester deposited a corrected request for *ex parte* reexamination. The corrected requested was granted a filing date.

5. An order denying the request for ex parte reexamination was mailed on May 20, 2008.

6. On June 20, 2008, the present petition was filed.

DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '9012 reexamination proceeding has petitioned seeking relief from the examiner's May 20, 2008 Order denying *ex parte* reexamination.

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has

been made as to whether the February 29, 2008 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '054 patent filed in the '9012 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

II. *De Novo* Review of the Request for Reexamination - Findings and Analysis

The '054 patent matured from application number 09/702,737 (the '737 application). On appeal, a rejection of all claims over Baumgartner (US Patent Number 5,195,086) in view of Marshak and Rangan was affirmed. Subsequently, a Request for Continued Examination (RCE) was filed. The same references were applied in a non-final rejection. Then applicant amended to overcome the prior art rejections. The following was added to the independent apparatus claim:

> (c) a graphical rolodex displayed on a participant's video display device and including a scrollable listing of entries of video-enabled potential participants; and (d) a quick dial list, listing icons representing video-enabled potential participants copied from the graphical rolodex, wherein the system is configured to allow an initiating participant to (i) initiate collaboration by selecting at least one participant listed in at least one of the graphical rolodex and quick dial list, and (ii) automatically establishing one of a plurality of communication types, with selected participants upon a communication type being selected or by default when the participant is selected

Similarly, the independent method claim was amended to recite:

> displaying a graphical rolodex on a participant's video display device, including a scrollable listing of entries of video-enabled potential participants; (b) displaying a quick dial list on the participant's video display device and listing icons representing video-enabled potential participants copied from the graphical rolodex (c) allowing an initiating participant to initiate collaboration by selecting at least one participants listed in at least one of the graphical rolodex and quick dial list; and (d) automatically establishing one of a plurality of communication types with a selected participant upon a communication type being selected or by default when the participant is selected

The corrected request for *ex parte* reexamination deposited February 22, 2008 concurs with the analysis of the prosecution history of the '737 application (see page 7 of the request):

"In the final Amendment submitted on December 1, 2005, Applicant argued that the cited prior art failed to disclose a graphical rolodex and quick dial list listing icons representing video-enabled potential participants copied from the graphical rolodex and that this limitation was present in all pending claims. Applicant further argued that the cited prior art failed to show two ways in which communication of a defined type can occur using the two directories and that these occur automatically. Subsequent to receiving the amendment, the Examiner allowed all pending claims. As such, it was apparently the position of the Office that the prior art did not show one or both of these features of the claims."

The request alleges that a substantial new question of patentability is raised as follows on pages 7 and 8:

"Requester respectfully submits that the Rapport Multimedia Conferencing System discloses a graphical rolodex displayed on a participant's video display device and including a scrollable listing of entries of video-enabled potential participants, as recited in claim 1. *See Ensor,* p. 581; *see also Ahuja '88,* p. 2-3 and *Ahuja '90,* FIG. 1. The Rapport Multimedia Conferencing System also discloses a quick dial list listing icons representing video-enabled potential participants copied from the graphical rolodex, wherein the system allows an initiating participant to initiate collaboration by selecting at least one participant listed in the graphical rolodex and/or the quick dial list and automatically establishing one of a plurality of communication types, the selected participant's communication type being selected or by default when the participant is selected, as recited in claim 1. *See Ensor,* p. 581; *see also Ahuja '90,* FIG. 1."

The same passages are cited in for independent claim 10 (see page 8) in the substantial new question of patentability portion of the request. Specific passages on those pages are cited in the detailed explanation of the pertinency and manner of applying the cited prior art section on pages ii-iv and xi-xiii of Appendix I.

The *de novo* review of the request reveals that the cited passages in the three references are not on point to the critical claim limitations that distinguished the allowed claims over the applied prior art during the prosecution of the '737 application. Specifically, the cited sections do not disclose a graphical rolodex with a scrollable listing of entries, and therefor do not disclose the subsequent recitations that rely upon the graphical rolodex with a scrollable listing of entries (i.e., a quick dial list copied from the scrollable graphical rolodex and selection from a graphical rolodex or quick dial list copied from the scrollable graphical rolodex). The request points to the faces at the top of Figure 1 of Ahuja '90 to allegedly teach a scrollable graphical rolodex. However, there is no indication that this is scrollable. In fact, it appears that it is not scrollable. Also, the request contradicts itself as to whether selections are made via these pictures. There does not appear to be any support in the references for such an assertion (as alleged by the

request in one section). However, the request also alleges that the meetings are initiated by dialing a person's phone number. This dialing would appear to be done by dialing in the number pad at the lower right of Figure 1 and that the pictures towards the top of Figure 1 are not "selection icons" but rather an indication of who has already been selected via the dialing method.

To supply some of the missing teachings in *Ensor, Ahuja '88, and Ahuja '90* from the request, the petition turns to the teachings in Baumgartner. However, Baumgartner was applied to the claims during the prosecution of the '737 application and is not part of the request. The fact that Baumgartner is closer to the claimed invention than the teachings of *Ensor, Ahuja '88, and Ahuja '90* from the request underscores the propriety of the denial of the request filed February 22, 2008. Accordingly, the teachings in *Ensor, Ahuja '88, Ahuja '90* are cumulative to the prior art that was before the examiner and applied to the claims during prosecution of the '737 application.

Petitioner has not identified a new, non-cumulative technological teaching that was not previously considered and discussed on the record in an earlier Office examination of the '054 patent. Therefore, the request did not establish that the references contained new technical teachings that would be important to a reasonable examiner in determining the patentability of at least one claim.

The petition appears to concede the corrected request, filed February 22, 2008, does not properly address these limitations. Instead, petitioner cites another reference (Hayden) that was not part of the filed request to provide additional teachings. Petitioner then turns to additional references in the footnotes on pages 13 and 14 of the petition to provide a teaching of the scrollable feature. Petitioner cannot persuasively bootstrap new references (Baumgartner, Hayden, and other references) into establishing a SNQ in the request for reexamination in the '9012 proceeding by now, for the first time in the record, bringing in new references and new discussions of old references directed to these particular teachings via the present petition. If requester wishes to attempt to assert Baumgartner, Hayden, and other references, requester is free to do so in a new filing of a reexamination request.

The *de novo* review on the record of the request for reexamination in the '9012 reexamination proceeding, undertaken in light of the arguments presented in the present petition compels the conclusion that the request for reexamination in the '9012 reexamination proceeding does not raise a new SNQ with respect to the claims of the '054 patent for which reexamination was requested. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 7,185,054 has been presented in the corrected request filed February 22, 2008 by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,017	03/17/2008	6881571	50146/004005	5593

21559 7590 03/18/2009

EXAMINER

King & Spalding LLP
P.O. Box 889
Belmont, CA 94002-0889

ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,017	03/17/2008	6881571	50146/004005	5593

21559 7590 03/18/2009

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2009

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www.uspto.gov

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110

(for Patent Owner)

King & Spalding LLP
P.O. Box 889
Belmont, CA 94002-0889

(for Third Party Requester)

MAILED

MAR 18 2009

CENTRAL REEXAMINATION UNIT

In re Schweighoffer et al
Reexamination Proceeding
Control No.: 90/009,017
Filed: March 17, 2008
For: U.S. Patent 6,881,571

King & Spalding LLP
P.O. Box 889
Belmont, CA 94002-0889

(for Third Party Requester)

In re Schweighoffer et al
Reexamination Proceeding
Control No.: 90/009,249
Filed: September 9, 2008
For: U.S. Patent 6,881,571

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, 881,571 which issued April 19, 2005, is the subject of Reexamination Control Nos. 90/009,017 and 90/009,249.

2. A first request for reexamination, assigned Reexamination Control No. 90/009,017, was filed March 17, 2008. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed device and method or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/009,017 on May 1, 2008.

4. No Patent Owner statement has been received.

5. A subsequent request for re-examination, assigned Reexamination Control No. 90,00009,249, was filed September 9, 2008. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed device and method or are so close as to establish a case of obviousness.

6. Reexamination was ordered for 90/009,249 on October 8, 2008.

7. No Patent Owner statement has been received.

8. No Office action has been issued in either of the reexamination 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 90/009,017 and 90/009,249 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."
Since there has been no amendments in either proceeding, the requirement for a "housekeeping" amendment is waived.

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. 90/009,017 and 90/009,249 as:

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/009,917 and 90/009,249 as:

King & Spalding LLP
P.O. Box 889
Belmont, CA 94002-0889

CONCLUSION

Reexamination Control Nos. 90/009,917 and 90/009,249 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.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,028	02/11/2008	6751562	31171/10001C/SPL-0146	5638

46260 7590 11/27/2009

BRINKS HOFER GILSON & LIONE/PML
PO BOX 10395
CHICAGO, IL 60610

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/27/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JEREMY D. PROTAS
MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER
CHICAGO, IL 60606

Date:

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NOV 27 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009028
PATENT NO. : 6751562
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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Brinks Hofer Gilson & Lione (For Patent Owner)
P.O. Box 10395
Chicago, Illinois 60610

Jeremy D. Protas
Marshal, Gerstein & Borun, LLP (For Third Party Requester)
233 South Wacker Drive
Suite 6300 Sears Tower
Chicago, Illinois 60606

In re: Andrew W. Blackett et al.	:	**DECISION ON PETITION**
Ex parte Reexamination Proceeding	:	**UNDER 37 CFR 1.59(B) AND**
Control No: 90/009,028	:	**PROVISIONALLY SEALING**
Filing Date: February 11, 2008	:	**A DOCUMENT SUBMITTED**
For: U.S. Patent No.: 6,751,562	:	**JULY 27, 2009**

This is a decision on the November 2, 2009 patent owner petition under 37 C.F.R. § 1.59(b) and MPEP 724.05(I) to expunge information inadvertently not submitted under seal pursuant to MPEP 724.02.

The papers are before the Office of Patent Legal Administration.

The petition is **DISMISSED**. However, the document in question will be provisionally sealed for a period of FIFTEEN (15) DAYS to provide an opportunity for statements from any interested party, including the assignee of record and the third party requester, explaining why the identified paper should not be unsealed, and thereby made part of the public record. Absent a satisfactory response, the document(s) will be unsealed and made part of the permanent public record.

DECISION

I. Patent Owner's petition to Expunge

Petitioner requests that pages 57-71 of a document submitted as part of an information disclosure statement submitted July 27, 2009 and denoted as D89 on the accompanying form 1449 be expunged from the record. Petitioner states that the information is subject to a protective order,[1] the information has not been made public, and petitioner commits to retain the information for the period of the patent. The petition fee set forth in 37 CFR 1.17(g) has been paid.

[1] The petition does not identify the source of the protective order or provide a copy.

A petition to expunge information will only be granted if the information is determined not be material to examination. The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." After the examiner has issued a determination on the issue of importance of the identified information in an Office action on the merits, the petition to expunge may be renewed by patent owner. No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. In addition, any party who has an interest in preserving the confidentiality of the specific documents submitted July 27, 2009 may **call up the petition under 37 CFR 1.59 for reconsideration by the Office prior to the point at which the file is forwarded for issuance of a reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the identified information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue a Reexamination Certificate is issued. A failure to timely call up the petition to expunge will result in the document containing the information asserted to be confidential being unsealed and made of record in the examination file and thus becoming open to the public.**

II. Order Provisionally Sealing Paper

This is an Order provisionally sealing of a document filed by patent owner in this reexamination proceeding. The paper identified above will be provisionally sealed for an additional period of FIFTEEN (15) DAYS from this decision to provide an opportunity for statements from any interested party, including the assignee of record and the third party requester, explaining why the identified papers should not be unsealed, and thereby made part of the public record. **Absent a satisfactory response, the document(s) will be unsealed and made part of the permanent public record**.

In a telephone conversation with patent owner's representative, on November 9, 2009, the Office informed the parties that upon learning of the petition to expunge alleging that the documents were subject to a protective order, the Office had, *sua sponte*, temporarily "administratively sealed" the documents at issue by making them unavailable for public viewing in order to allow the parties to file appropriate paperwork with the Office to address the alleged Court Order.

Patent owner was advised that expungement was not available in these circumstances[2] and was advised to immediately file a petition to seal the offending document along with two copies of

[2] The Office does not expunge portions of a submission nor portions of a single document; Furthermore, in this instance the documents were already public and thus a petition to seal is the appropriate vehicle for relief.

the document: (1) a complete replacement copy submitted under seal as per MPEP 724.02 (for the examiner's review), (2) a redacted copy eliminating the confidential portions (for immediate entry into the public portion of the file), and (3) a petition under 37 CFR 1.59 to expunge the document submitted under seal pursuant to the procedures of MPEP 724.02.

To date, no paper directed to addressing the alleged Court Order have been filed in the reexamination proceeding.

Patent Owner is called upon to:

> (1) provide a copy of the protective order that allegedly protects pages 57-71 of the document listed as D89 on the form 1449 submitted July 27, 2009 and to provide detailed evidence that disclosure of the information/documents in the IDS at issue would violate the court's protective order;
>
> (2) submit a petition under 37 CFR 1.182 to seal the document in question and replace same with a true and complete copy submitted[3] under seal, thus preserving the completeness and integrity of the reexamination file wrapper. Such petition must be accompanied by the petition fee under 1.17(f) and a redacted copy of the document for immediate entry into the public file record;
>
> (3) at the close of prosecution as discussed above, patent owner is cautioned to file a petition under 37 CFR 1.59 to expunge the document submitted under seal from the record if it is found not to be material to examination. [4]

The Office has provisionally sealed the subject document submitted July 27, 2009, by marking those documents as "non-public." FIFTEEN (15) DAYS from the date of mailing or issuance of the present Order, the Office intends to unseal the provisionally sealed document, unless Patent Owner makes a *bona fide* effort to comply with this Order and files paperwork consistent with the direction set out above.

If no response by patent owner is received to the present Order within FIFTEEN (15) DAYS from the mailing or issuance of the present Order, the Office intends to unseal the provisionally sealed document absent any filings in opposition to unsealing filed by other interested parties.

CONCLUSION

1. The petition to expunge paged 57-71 of the identified documents submitted on July27, 2009 is

---

[3] If the court order, and or agreement of the parties, does not permit the re-submission of the entire document under seal, then a petition to provisionally seal until completion of prosecution may be submitted.

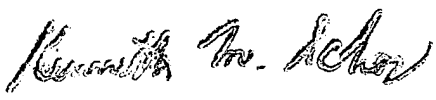
[4] This may be done as a reconsideration of the Petition of November 2, 2009 without the need for an additional petition fee. However, the petition should clearly identify the paper that is the subject of the renewed petition to expunge.

dismissed as premature.

2 The Office has provisionally sealed the subject document submitted July 27, 2009, by marking those documents as "non-public." FIFTEEN (15) DAYS from the date of mailing or issuance of the present Order, the Office intends to unseal the provisionally sealed document, unless Patent Owner makes a *bona fide* effort to comply with this Order and files paperwork consistent with the direction set out above.

3. If a replacement document is submitted under seal as per the directions outlined above, Patent owner may submit a petition to expunge the sealed information once the issue of materiality of the information is resolved. All other interested parties are cautioned to call up the petition under 37 CFR 1.59 for reconsideration by the Office prior to the point at which the file is forwarded for issuance of reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue a Reexamination Certificate is issued. **A failure to timely call up the petition to expunge will result in the information provided under seal being unsealed and made of record in the examination file and thus becoming open to the public.**

4. Inquires regarding the present decision and Order may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or, in his absence, to the undersigned at (571) 272-7710.



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

11-27-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,028	02/11/2008	6751562	31171/10001C/SPL-0146	5638

46260 7590 04/12/2010

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PO BOX 10395
CHICAGO, IL 60610

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/12/2010

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JEREMY D. PROTAS
MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER
CHICAGO, IL 60606

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APR 12 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,028*.

PATENT NO. *6751562*.

ART UNIT *3992*.

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

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

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P.O. Box 10395
Chicago, Illinois 60610

(For Patent Owner)

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APR 12 2010

CENTRAL REEXAMINATION UNIT

Jeremy D. Protas
Marshal, Gerstein & Borun, LLP
233 South Wacker Drive
Suite 6300 Sears Tower
Chicago, Illinois 60606

(For Third Party Requester)

In re: Andrew W. Blackett et al.	:	**DECISION GRANTING**
Ex parte Reexamination Proceeding	:	**PETITION TO REPLACE**
Control No: 90/009,028	:	**PROTECTED DOCUMENT**
Filing Date: February 11, 2008	:	**SUBMITTED JULY 27, 2009**
For: U.S. Patent No.: 6,751,562	:	**WITH REDACTED VERSION**

This is a decision on the patent owner's petition filed on April 9, 2010 entitled "Petition to Return and Replace Paper Pursuant to 37 C.F.R. §1.182" (the "Petition") and addressing the third party requester's communications filed on December 11 and 17, 2009.

The papers are before the Office of Patent Legal Administration.

The petition is **granted**. The redacted form of the Bingham report filed April 9, 2010, and the substitute form PTO-1449 reflecting the redaction are accepted for entry into the reexamination proceeding and the version of the Bingham report (subject to protective order) submitted July 27, 2009 and the accompanying form 1449 are being expunged from the record.

DECISION

On November 2, 2009, patent owner petitioned under 37 C.F.R. § 1.59(b) and MPEP 724.05(I) to expunge information inadvertently not submitted under seal pursuant to MPEP 724.02.

Petitioner requested that pages 57-71 of a document submitted as part of an information disclosure statement submitted July 27, 2009, and denoted as D89 on the accompanying form 1449 be expunged from the record. Petitioner stated that the information is subject to a protective order, the information had not been made public, and petitioner committed to retain the information for the period of the patent.

On November 27, 2009, the Office dismissed the petition to expunge and issued an order provisionally sealing the document in question and provided and additional period of FIFTEEN (15) DAYS from the mailing of the decision to provide an opportunity for statements from any

interested party, including the assignee of record and the third party requester, explaining why the identified papers should not be unsealed. The decision also provided guidance to patent owner as to the procedures to follow to have the documents/information considered and then expunged if not material.

On December 11, 2009, the third party requester filed a paper responsive to the aforementioned order. Requester submitted that the identified paper should not be unsealed because it contains "highly-confidential, competitively-sensitive information of the Requester" that was subject to a protective order in the pending litigation. Requester provided a copy of a "Motion for Relief From Square D's Violations of the Stipulated Protective Order," including a copy of the protective order as an exhibit thereto.

On December 17, 2009, the third party requester filed a paper requesting the expungement of pages 57-71 of the Bingham report and provided a decision by The United States District Court for the Northern District of Illinois, Eastern Division granting the relief from the asserted violations of the protective order which directed that the document be expunged.

On February 9, 2010, patent owner, in order to comply with the court order, filed a petition to effect the expungement by means of replacing the originally submitted version of the Bingham report with a version that eliminates the pages that are subject to the protective order (pages 57-71). In the petition, patent owner states that:

i) the replacement copy of the Bingham Report is identical to "the originally submitted document except for the removal of pages 57-71,"

ii) the substitute Form 1449 is identical except that the annotation of D89 has been changed to reflect that only specific pages are now included, and

iii) the removed pages of the Bingham report are not material to patentability.

In view of the terms of the protective order, the irreparable harm to the litigation defendants that would be caused by public disclosure of the protected materials, and the facts and circumstances in this instance as set out above, the petition to replace the document subject to protective order with a version that is not subject to the protective order is granted.

ADDITIONAL DISCUSSION

This decision does not relieve patent owner of the duty to disclose to the Office information patent owner is aware of which is material to patentability pursuant to 37 CFR 1.555, regardless of whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete a patent file wrapper as possible insofar as "material" information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose. Should a situation arise where the duty to disclose is in conflict with the protective order, patent owner should approach the court for relief from the protective order as the Office can not prosecute an application or conduct a reexamination when information material to patentability is withheld.

CONCLUSION

1. The petition to expunge the Bingham report submitted on July 27, 2009, and identified as item D89 on the accompanying form 1449 and to accept a replacement (submitted April 9, 2010) redacted to eliminate the protected material is **granted**.

2. The patent owner petition to replace the July 27, 2009 Form 1449 (listing the submitted documents) with the April 9, 2010 Form 1449 is granted.

3. As the documents to be expunged have already been made part of the Image File Wrapper (IFW) system and cannot be physically returned, expungement is effected by permanently sealing the documents identified above by closing the documents and marking them as non-public.

4. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

5. Inquires regarding the present decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or, in his absence, to the undersigned at (571) 272-7710.

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

4-12-09

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,029	02/08/2008	7158050		5242

46260 7590 03/24/2010

BRINKS HOFER GILSON & LIONE/PML
PO BOX 10395
CHICAGO, IL 60610

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2010

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
H.M. BEDINGFIELD, ESQ.
CANTOR COLBURN LLP
20 CHURCH STREET, 22ND FLOOR
HARTFORD, CT 06103

Date: MAILED
MAR 24 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009029
PATENT NO. : 7158050
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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ALEXANDRIA, VA 22313-1450
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Brinks Hofer Gilson & Lione/PML
P.O. Box 10395
Chicago, IL 60610

(For Patent Owner)

MAILED

MAR 24 2010

CENTRAL REEXAMINATION UNIT

Cantor Colburn LLP
20 Church Street
22nd Floor
Hartford, CT 06103-3207

(Third Party Requester)

In re Simon H. Lightbody et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,029
Filed: February 8, 2008
For: U.S. Patent No. 7,158,050

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

This is a decision on the January 25, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination[1] ("the January 25, 2010 patent owner petition to revive").

The January 25, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The January 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 ...

[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 June 12, 2009.

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.113 provides, in pertinent part:

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

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *
> (d) *Terminal disclaimer.*
> > *
> > *
> > (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

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

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

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Patent owner submitted a Notice of Appeal and paid the corresponding fee of $540.00 on January 25, 2010, thereby satisfying item (1).[2]

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the January 25, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[3]

Accordingly, the January 25, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The January 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 further processing in view of the January 25, 2010 Notice of Appeal.

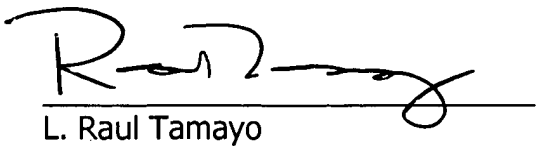
3. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time period is extendable under the provisions of 37 CFR 1.550(c). See 37 CFR 41.37(e).

---

[2] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[3] *See*: 37 CFR 1.137(d)(3).

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Tuan Nguyen, of CRU Art Unit 3992, at (571) 272-1694.

5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.



L. Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,034	03/31/2008	5440749	0081-011X1	3309

40972 7590 09/23/2009

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RAMAN N. DEWAN
JACKSON WALKER, L.L.P.
100 CONGRESS AVENUE, SUITE 1100
AUSTIN, TX 78701

Date:
MAILED
SEP 24 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009034
PATENT NO. : 5440749
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
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.
90/009,389	01/16/2009	5440749	0081-011X2	9206

40972 7590 09/23/2009

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2009

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

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United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEPOLIS, MN 55440-1022

Date: MAILED

SEP 242009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009389
PATENT NO. : 5440749
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,520	04/30/2009	5440749	0081-011X3	9626

40972 7590 09/23/2009

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2009

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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
WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

Date:
MAILED
SEP 24 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010520
PATENT NO. : 5440749
ART UNIT : 3992

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

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

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United States Patent and Trademark Office
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MAILED
SEP 24 2009
CENTRAL REEXAMINATION UNIT

HENNEMAN & ASSOCIATES, PLC (For Patent Owner)
70 N. MAIN ST.
THREE RIVERS MI 49093

RAMAN N. DEWAN (For Third Party Requester)
JACKSON WALKER, L.L.P.
100 CONGRESS AVENUE
SUITE 1100
AUSTIN, TX 78701

FISH & RICHARDSON P.C. (For Third Party Requester)
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

WHITE & CASE LLP (For Third Party Requester)
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

In re Moore *et alia* : DECISION *SUA SPONTE*
Reexamination Proceeding : MERGING
Control No. 90/009,034 : REEXAMINATION
For: U.S. Patent No. 5,440,749 : PROCEEDINGS

In re Moore *et alia* :
Reexamination Proceeding :
Control No. 90/009,389 :
For: U.S. Patent No. 5,440,749 :

In re Moore *et alia* :
Reexamination Proceeding :
Control No. 90/010,520 :
For: U.S. Patent No. 5,440,749 :

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. 5,440,749 (hereinafter, the '749 patent), issued to Moore *et alia*, on August 8, 1995.

2. On March 31, 2008, a corrected request for *ex parte* reexamination of the '749 patent was filed. The reexamination proceeding was assigned Control Nos. 90/009,034 (hereinafter, the '9034 proceeding).

3. On June 3, 2008, the reexamination order granting the request in the '9034 proceeding was mailed. There were amendments to the claims in '9034 proceeding.

4. On January 16, 2009, a third party deposited a request for *ex parte* reexamination of the '749 patent. The reexamination proceeding was assigned Control No. 90/009,389 (hereinafter, the '9389 proceeding).

5. On April 8, 2009, the reexamination order granting the request in the '9389 proceeding was mailed. There are no amendments in the '9389 proceeding.

6. On April 30, 2009, a third party deposited a request for *ex parte* reexamination of the '749 patent. The reexamination proceeding was assigned Control No. 90/010,520 (hereinafter, the '10520 proceeding).

7. On July 24, 2009, the reexamination order granting the request in the '10520 proceeding was mailed. There are no amendments in the '10520 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 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 '9034, '9389 and '10520 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, claims have been amended in the '9034 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/009,034, 90/009,389 and 90/010,520 are **merged**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

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

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,039	02/12/2008	7191076	6270-209	6386

46260 7590 11/27/2009

BRINKS HOFER GILSON & LIONE/PML
PO BOX 10395
CHICAGO, IL 60610

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/27/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CHARLES F. O'BRIEN
CANTOR COLBURN LLP
20 CHURCH STREET, 22ND FLOOR
HARTFORD, CT 06103

Date:

MAILED

NOV 27 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009039
PATENT NO. : 7191076
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, Illinois 60610

(For Patent Owner)

MAILED

NOV 27 2009

CENTRAL REEXAMINATION UNIT

Charles F. Obrien, Esq.
Cantor Colburn LLP
20 Church Street, 22nd Floor
Hartford, Connecticut 06103

(For Third Party Requester)

In re: Benedikt T. Huber et al.	:	**DECISION ON PETITION**
Ex parte Reexamination Proceeding	:	**UNDER 37 CFR 1.59(B) AND**
Control No: 90/009,039	:	**PROVISIONALLY SEALING**
Filing Date: February 12, 2008	:	**A DOCUMENT SUBMITTED**
For: U.S. Patent No.: 7,191,076	:	**JULY 27, 2009**

This is a decision on the November 2, 2009 patent owner petition under 37 C.F.R. § 1.59(b) and MPEP 724.05(I) to expunge information inadvertently not submitted under seal pursuant to MPEP 724.02.

The papers are before the Office of Patent Legal Administration.

The petition is **DISMISSED**. However, the document in question will be provisionally sealed for a period of FIFTEEN (15) DAYS to provide an opportunity for statements from any interested party, including the assignee of record and the third party requester, explaining why the identified paper should not be unsealed, and thereby made part of the public record. Absent a satisfactory response, the document(s) will be unsealed and made part of the permanent public record.

DECISION

I. Patent Owner's petition to Expunge

Petitioner requests that pages 57-71 of a document submitted as part of an information disclosure statement submitted July 27, 2009 and denoted as D89 on the accompanying form 1449 be expunged from the record. Petitioner states that the information is subject to a protective order,[1] the information has not been made public, and petitioner commits to retain the information for the period of the patent. The petition fee set forth in 37 CFR 1.17(g) has been paid.

[1] The petition does not identify the source of the protective order or provide a copy.

A petition to expunge information will only be granted if the information is determined not be material to examination. The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." After the examiner has issued a determination on the issue of importance of the identified information in an Office action on the merits, the petition to expunge may be renewed by patent owner. No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. In addition, any party who has an interest in preserving the confidentiality of the specific documents submitted July 27, 2009 may **call up the petition under 37 CFR 1.59 for reconsideration by the Office prior to the point at which the file is forwarded for issuance of a reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the identified information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue a Reexamination Certificate is issued. A failure to timely call up the petition to expunge will result in the document containing the information asserted to be confidential being unsealed and made of record in the examination file and thus becoming open to the public.**

II. Order Provisionally Sealing Paper

This is an Order provisionally sealing of a document filed by patent owner in this reexamination proceeding. The paper identified above will be provisionally sealed for an additional period of FIFTEEN (15) DAYS from this decision to provide an opportunity for statements from any interested party, including the assignee of record and the third party requester, explaining why the identified papers should not be unsealed, and thereby made part of the public record. **Absent a satisfactory response, the document(s) will be unsealed and made part of the permanent public record**.

In a telephone conversation with patent owner's representative, on November 9, 2009, the Office informed the parties that upon learning of the petition to expunge alleging that the documents were subject to a protective order, the Office had, *sua sponte*, temporarily "administratively sealed" the documents at issue by making them unavailable for public viewing in order to allow the parties to file appropriate paperwork with the Office to address the alleged Court Order.

Patent owner was advised that expungement was not available in these circumstances[2] and was advised to immediately file a petition to seal the offending document along with two copies of

[2] The Office does not expunge portions of a submission nor portions of a single document; Furthermore, in this instance the documents were already public and thus a petition to seal is the appropriate vehicle for relief.

the document: (1) a complete replacement copy submitted under seal as per MPEP 724.02 (for the examiner's review), (2) a redacted copy eliminating the confidential portions (for immediate entry into the public portion of the file), and (3) a petition under 37 CFR 1.59 to expunge the document submitted under seal pursuant to the procedures of MPEP 724.02.

To date, no paper directed to addressing the alleged Court Order have been filed in the reexamination proceeding.

Patent Owner is called upon to:

(1) provide a copy of the protective order that allegedly protects pages 57-71 of the document listed as D89 on the form 1449 submitted July 27, 2009 and to provide detailed evidence that disclosure of the information/documents in the IDS at issue would violate the court's protective order;

(2) submit a petition under 37 CFR 1.182 to seal the document in question and replace same with a true and complete copy submitted[3] under seal, thus preserving the completeness and integrity of the reexamination file wrapper. Such petition must be accompanied by the petition fee under 1.17(f) and a redacted copy of the document for immediate entry into the public file record;

(3) at the close of prosecution as discussed above, patent owner is cautioned to file a petition under 37 CFR 1.59 to expunge the document submitted under seal from the record if it is found not to be material to examination. [4]

The Office has provisionally sealed the subject document submitted July 27, 2009, by marking those documents as "non-public." FIFTEEN (15) DAYS from the date of mailing or issuance of the present Order, the Office intends to unseal the provisionally sealed document, unless Patent Owner makes a *bona fide* effort to comply with this Order and files paperwork consistent with the direction set out above.

If no response by patent owner is received to the present Order within FIFTEEN (15) DAYS from the mailing or issuance of the present Order, the Office intends to unseal the provisionally sealed document absent any filings in opposition to unsealing filed by other interested parties.

CONCLUSION

1. The petition to expunge paged 57-71 of the identified documents submitted on July27, 2009 is

[3] If the court order, and or agreement of the parties, does not permit the re-submission of the entire document under seal, then a petition to provisionally seal until completion of prosecution may be submitted.

[4] This may be done as a reconsideration of the Petition of November 2, 2009 without the need for an additional petition fee. However, the petition should clearly identify the paper that is the subject of the renewed petition to expunge.

dismissed as premature.

2 The Office has provisionally sealed the subject document submitted July 27, 2009, by marking those documents as "non-public." FIFTEEN (15) DAYS from the date of mailing or issuance of the present Order, the Office intends to unseal the provisionally sealed document, unless Patent Owner makes a *bona fide* effort to comply with this Order and files paperwork consistent with the direction set out above.

3. If a replacement document is submitted under seal as per the directions outlined above, Patent owner may submit a petition to expunge the sealed information once the issue of materiality of the information is resolved. All other interested parties are cautioned to call up the petition under 37 CFR 1.59 for reconsideration by the Office prior to the point at which the file is forwarded for issuance of reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue a Reexamination Certificate is issued. **A failure to timely call up the petition to expunge will result in the information provided under seal being unsealed and made of record in the examination file and thus becoming open to the public.**

4. Inquires regarding the present decision and Order may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or, in his absence, to the undersigned at (571) 272-7710.

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

11-27-09

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,039	02/12/2008	7191076	6270-209	6386

46260 7590 02/17/2010

BRINKS HOFER GILSON & LIONE/PML
PO BOX 10395
CHICAGO, IL 60610

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
CHARLES F. O'BRIEN
CANTOR COLBURN LLP
20 CHURCH STREET, 22ND FLOOR
HARTFORD, CT 06103

Date:
MAILED
FEB 17 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009039
PATENT NO. : 7191076
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(For Patent Owner)

MAILED
FEB 17 2010
CENTRAL REEXAMINATION UNIT

Cantor Colburn LLP
20 Church Street
22nd Floor
Hartford, CT 06103-3207

(Third Party Requester)

In re Benedikt T. Huber et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,039
Filed: February 12, 2008
For: U.S. Patent No. 7,191,076

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

This is a decision on the December 17, 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[1] ("the December 17, 2009 patent owner petition to revive").

The December 17, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The December 17, 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 May 27, 2009.

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.113 provides, in pertinent part:

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

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *
> (d) *Terminal disclaimer.*
> > *
> > *
> > (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

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 December 17, 2009, thereby satisfying item (1).[2]

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the December 17, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[3]

Accordingly, the December 17, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The December 17, 2009 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992, for further processing in view of the December 17, 2009 Notice of Appeal, and for treatment of the December 17, 2009 Response To Notice Of Defective Paper In *Ex Parte* Reexamination in due course.

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

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[2] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[3] *See*: 37 CFR 1.137(d)(3).

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, Zoila Cabrera, of CRU Art Unit 3992, at (571) 272-3738.

5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

L. Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,039	02/12/2008	7191076	6270-209	6386

46260 7590 04/13/2010

BRINKS HOFER GILSON & LIONE/PML
PO BOX 10395
CHICAGO, IL 60610

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CHARLES F. O'BRIEN
CANTOR COLBURN LLP
20 CHURCH STREET, 22ND FLOOR
HARTFORD, CT 06103

Date:

MAILED

APR 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009039
PATENT NO. : 7191076
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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Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, Illinois 60610

(For Patent Owner)

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APR 13 2010

CENTRAL REEXAMINATION UNIT

Charles F. Obrien, Esq.
Cantor Colburn LLP
20 Church Street, 22nd Floor
Hartford, Connecticut 06103

(For Third Party Requester)

In re: Benedikt T. Huber et al.	:	**DECISION GRANTING**
Ex parte Reexamination Proceeding	:	**PETITION TO REPLACE**
Control No: 90/009,039	:	**PROTECTED DOCUMENT**
Filing Date: February 12, 2008	:	**SUBMITTED JULY 27, 2009**
For: U.S. Patent No.: 7,191,076	:	**WITH REDACTED VERSION**

This is a decision on the patent owner's petition filed on April 9, 2010 entitled "Petition to Return and Replace Paper Pursuant to 37 C.F.R. §1.182" (the "Petition") and addressing the third party requester's communications filed on December 11 and 18, 2009.

The papers are before the Office of Patent Legal Administration.

The petition is **granted**. The redacted form of the Bingham report filed April 9, 2010, and the substitute form PTO-1449 reflecting the redaction are accepted for entry into the reexamination proceeding and the version of the Bingham report (subject to protective order) submitted July 27, 2009 and the accompanying form 1449 are being expunged from the record.

DECISION

On November 2, 2009, patent owner petitioned under 37 C.F.R. § 1.59(b) and MPEP 724.05(I) to expunge information inadvertently not submitted under seal pursuant to MPEP 724.02.

Petitioner requested that pages 57-71 of a document submitted as part of an information disclosure statement submitted July 27, 2009, and denoted as D89 on the accompanying form 1449 be expunged from the record. Petitioner stated that the information is subject to a protective order, the information had not been made public, and petitioner committed to retain the information for the period of the patent.

On November 27, 2009, the Office dismissed the petition to expunge and issued an order provisionally sealing the document in question and provided and additional period of FIFTEEN (15) DAYS from the mailing of the decision to provide an opportunity for statements from any interested party, including the assignee of record and the third party requester, explaining why

the identified papers should not be unsealed. The decision also provided guidance to patent owner as to the procedures to follow to have the documents/information considered and then expunged if not material.

On December 11, 2009, the third party requester filed a paper responsive to the aforementioned order. Requester submitted that the identified paper should not be unsealed because it contains "highly-confidential, competitively-sensitive information of the Requester" that was subject to a protective order in the pending litigation. Requester provided a copy of a "Motion for Relief From Square D's Violations of the Stipulated Protective Order," including a copy of the protective order as an exhibit thereto.

On December 18, 2009, the third party requester filed a paper requesting the expungement of pages 57-71 of the Bingham report and provided a decision by The United States District Court for the Northern District of Illinois, Eastern Division granting the relief from the asserted violations of the protective order which directed that the document be expunged.

On February 9, 2010, patent owner, in order to comply with the court order, filed a petition to effect the expungement by means of replacing the originally submitted version of the Bingham report with a version that eliminates the pages that are subject to the protective order (pages 57-71). In the petition, patent owner states that:

i) the replacement copy of the Bingham Report is identical to "the originally submitted document except for the removal of pages 57-71,"

ii) the substitute Form 1449 is identical except that the annotation of D89 has been changed to reflect that only specific pages are now included, and

iii) the removed pages of the Bingham report are not material to patentability.

In view of the terms of the protective order, the irreparable harm to the litigation defendants that would be caused by public disclosure of the protected materials, and the facts and circumstances in this instance as set out above, the petition to replace the document subject to protective order with a version that is not subject to the protective order is granted.

ADDITIONAL DISCUSSION

This decision does not relieve patent owner of the duty to disclose to the Office information patent owner is aware of which is material to patentability pursuant to 37 CFR 1.555, regardless of whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete a patent file wrapper as possible insofar as "material" information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose. Should a situation arise where the duty to disclose is in conflict with the protective order, patent owner should approach the court for relief from the protective order as the Office can not prosecute an application or conduct a reexamination when information material to patentability is withheld.

CONCLUSION

1. The petition to expunge the Bingham report submitted on July 27, 2009, and identified as item D89 on the accompanying form 1449 and to accept a replacement (submitted April 9, 2010) redacted to eliminate the protected material is **granted**.

2. The patent owner petition to replace the July 27, 2009 Form 1449 (listing the submitted documents) with the April 9, 2010 Form 1449 is granted.

3. As the documents to be expunged have already been made part of the Image File Wrapper (IFW) system and cannot be physically returned, expungement is effected by permanently sealing the documents identified above by closing the documents and marking them as non-public.

4. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

5. Inquires regarding the present decision may be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or, in his absence, to the undersigned at (571) 272-7710.

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

4-12-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,043	02/15/2008	6082422		6282

7590 05/10/2010

GEORGE W. WASSON
3123 INDIAN WAY
LAFAYETTE, CA 94549

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/10/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LAUSON & TARVER LLP
880 APOLLO STREET
SUITE 301
EL SEGUNDO, CA 90245

Date:
MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009043
PATENT NO. : 6082422
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 DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90009043	2/15/08	6082422	

Scott T. Kaminski
C/O Storus Corporation
12919 Alcosta Blvd.
Suite 1
San Ramon, CA 94583

EXAMINER	
Jeffrey Gellner	
ART UNIT	**PAPER**
3993	20100510

DATE MAILED:

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Commissioner for Patents

This is a courtesy copy of the petition mailed 05/10/10.

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

George W. Wasson
3123 Indian Way
Lafayette, CA 94549

(For patent owner)

Lauson & Tarver LLP
880 Apollo Street
Suite 301
El Segundo, CA 90245

(For third party requester)

MAILED

MAY 10 2010

Scott T. Kaminski
c/o Storus Corporation
12919 Alcosta Blvd.
Suite 1
San Ramon, CA 94583

(Courtesy Copy)

CENTRAL REEXAMINATION UNIT

In re Scott T. Kaminski
Ex Parte Reexamination Proceeding
Control No. 90/009,043
Filed: February 15, 2008
For: U.S. Patent No. 6,082,422

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

This is a decision on the October 13, 2009 patent owner petition under 37 CFR 1.137(b) to revive the present terminated reexamination ("the October 13, 2009 patent owner petition to revive").

The October 13, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The October 13, 2009 patent owner petition to revive is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
>
> *
>
> (d) *Terminal disclaimer.*
>
> > *
> >
> > *
> >
> > (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

> (b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.
>
> *

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Dismissed

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

The October 13, 2009 petition fails to satisfy, *inter alia*, the third criteria required under 37 CFR 1.137(b), *i.e.*, the criterion of submitting the requisite response required by the outstanding non-final Office action has not been satisfied

The instant reexamination proceeding was terminated due to the failure to timely submit a response to the February 6, 2009 non-final Office action pursuant to 37 CFR 1.550(b). In a reexamination proceeding terminated for failure to reply to a non-final Office action, the reply required for consideration of a petition to revive must be an argument or an amendment under 37 CFR 1.111.[1]

Patent owner has not submitted an argument or an amendment under 37 CFR 1.111 in response to the February 6, 2009 non-final Office action. Therefore, the October 13, 2009 petition is incomplete.

In addition, it is noted that the October 13, 2009 petition does not at all identify the instant reexamination proceeding, *i.e.*, reexamination Control No. 90/009,043 ("the '9043 proceeding"). Instead, the October 13, 2009 petition identifies itself as being a petition to revive application No. 09/087,658. The instant decision has been issued as a courtesy, in view of the statement in the transmittal letter accompanying the October 13, 2009 petition, which states "RE: Petition 137b to Revive Reexamination for Pat. 6,082,422 ...." In any future correspondence related to the instant reexamination proceeding, patent owner is advised to clearly identify the '9043 proceeding in all submitted papers.

Accordingly, the October 13, 2009 patent owner petition to revive is **dismissed**.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,082,422 patent file is that of George W. Wasson, 3123 Indian Way, Lafayette, CA 94549.

As a courtesy, this decision is being mailed to Scott T. Kaminski, c/o Storus Corporation, 12919 Alcosta Blvd., Suite 1, San Ramon, CA 94583.

The address of George W. Wasson, 3123 Indian Way, Lafayette, CA 94549, will be the sole patent owner correspondence address used in future correspondence, unless a change in correspondence address in the '422 patent file is made in accordance with 37 CFR 1.33(c).

---

[1] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(a).

CONCLUSION

1. The October 13, 2009 patent owner petition under 37 CFR 1.137(b) is **dismissed**.

2. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

L. 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,047	02/19/2008	6629940	0080-0220P	6565

7590 01/02/2009

EXAMINER	

BIRCH STEWART KOLASCH & BIRCH LLP
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

ART UNIT	PAPER NUMBER

DATE MAILED: 01/02/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CLEMENT CHENG
LAW OFFICE OF S.J. CHRISTINE YANG
17220 NEWHOPE STREET, SUITE 102
FOUNTAIN VALLEY, CA 92708

Date:

MAILED

JAN 02 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009047
PATENT NO. : 6629940
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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BIRCH STEWART KOLASCH & BIRCH LLP
P.O. BOX 747
FALLS CHURCH VA 22040-0747

(For Patent Owner)

MAILED

JAN 02 2009

CENTRAL REEXAMINATION UNIT

Clement Cheng
Law Offices of S.J. Christine Yang
17220 Newhope Street, Suite 102
Fountain Valley, CA 92708

(For Requester)

In re Shimizu
Reexamination Proceeding
Control No. 90/009,047
For: U.S. Patent No. 6,629,940

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

This is a decision on the December 30, 2008 "EXTENSION FOR TIME REQUEST UNDER 37 §CFR 1.550(c)" requesting that the time to submit an appeal brief be extended two weeks "to expire on **January 17, 2008** (sic, presumably January 17, 2009)."

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

The petition is **granted** and a two-week extension of time is granted for the reasons set forth below.

DECISION

The Patent Owner requests an extension of time in which to a response to the office action mailed November 3, 2008. The present petition for extension of time was timely filed on December 30, 2008, together with authorization to charge the petition fee required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor ....

The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

The request notes the actions that have taken place to date and that, in spite of those actions, additional time is needed. 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 Patent Owner response. An extension of time of two weeks is considered sufficient.

Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

CONCLUSION

1. Petitioner's request is **granted**. The period during which Patent Owner may file a response has been extended to January 17, 2009.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

Eric Keasel for
Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Lerner, David, Littenberg, Krumholz & Mentlik (For Patent Owner)
600 South Avenue West
Westfield, NJ 07090

David R. Bailey (For 3rd Party Requester)
Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891

MAILED

SEP 04 2008

CENTRAL REEXAMINATION UNIT

Amy E. Allen Hinson (For 3rd Party Requester)
Nexsen Pruet, LLC
201 W. McBee Avenue, Suite 400
Greenville, SC 29603

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

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CENTRAL REEXAMINATION UNIT

OHLANDT, GREELEY,
RUGGIERO & PERLE, LLP
ONE LANDMARK SQUARE, 10TH FLOOR
STAMFORD, CT 06901

: FOR PATENT OWNER

BRUCE L. ADAMS, ESQ.
ADAMS & WILKS
17 BATTERY PLACE - SUITE 1231
NEW YORK, NY 10004

: FOR THIRD PARTY REQUESTER

In re Ito et al.

Reexamination Proceeding
Control No. : 90/009,051
Filed : May 16, 2008
Patent No. 6,706,370

: DECISION ON PATENT OWNER'S PETITION FOR EXTENSION OF TIME

This is a decision addressing Patent Owner's petition for a one month extension of time, filed November 4, 2009.

The request for extension of time is DISMISSED.

Patent Owner requests an extension of time under 37 CFR 1.550(c). A final rejection setting a two month period for response was mailed August 21, 2009. Patent Owner filed an amendment after final on October 7, 2009. An advisory action extending the period of response until November 21, 2009 was mailed October 16, 2009. A second response after final was filed November 4, 2009, accompanied by the instant petition.

MPEP 2265 states, in part:

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is

> submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

Patent Owner has not provided an accounting of diligent behavior, nor is there any explanation of why an extension of time is necessary. Moreover, in view of the fact that a timely response was filed on the same date as the petition, no extension of time is required.

Patent Owner's request is DISMISSED.

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
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.
90/009,052	02/25/2008	5,513,101	18902-035RX1	3999

959 7590 06/19/2008

LAHIVE & COCKFIELD, LLP
ONE POST OFFICE SQUARE
BOSTON, MA 02109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GREG GARDELLA
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Date:
MAILED

JUN 19 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009052
PATENT NO. : 5513101
ART UNIT : 3993

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

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

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JUN 19 2008

CENTRAL REEXAMINATION UNIT

Lahive & Cockfield, LLP
One Post Office Square
Boston, MA 02109-2127

(For Patent Owner)

Fish & Richardson P.C.
PO Box 1022
Minneapolis, MN 55440-1022

(For Third Party Requester)

In re Pinsky *et alia*
Reexamination Proceeding
Control No. 90/010,027
Request Deposited: September 14, 2007
For: U.S. Patent No. 5,513,101

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

In re Pinsky *et alia*
Reexamination Proceeding
Control No. 90/009,052
Request Deposited: February 25, 2008
For: U.S. Patent No. 5,513,101

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. 5,513,101 (hereinafter, the '101 patent), issued to Pinsky *et alia*, on April 30, 1996.

2. On September 14, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '101 patent. The reexamination proceeding was assigned Control No. 90/010,027 (hereinafter, the '10027 proceeding).

3. The Reexamination Order was granted in the '10027 proceeding on December 6, 2007.

4. There are currently no amendments in the '10027 proceeding.

Copied from 90010027 on 06/25/2008

5. On February 25, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '101 patent. The reexamination proceeding was assigned Control No. 90/009,052 (hereinafter, the '9052 proceeding).

6. The Reexamination Order was granted in the '9052 proceeding on April 11, 2008.

7. There are currently no amendments in the '9052 proceeding.

8. The '10027 and '9052 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 '10027 and the '9052 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.

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CONCLUSION

1. Reexamination Control Nos. 90/010,027 and 90/009,052 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

Copied from 90010027 on 06/25/2008

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04-08-09

TO SPE OF : ART UNIT 3991

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/009054 Patent No.: 6008231 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Angela Green 703-756-1541
Certificates of Correction Branch
703-756-1814

Thank You For Your Assistance

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

☒ **Approved**	All changes apply.
☐ **Approved in Part**	Specify below which changes **do not** apply.
☐ **Denied**	State the reasons for denial below.

Comments: _____

DEBORAH D. JONES
CRU SPE-AU 3991

SPE Art Unit 3991

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.
90/009,055	04/15/2008	4915435		5753

21918 7590 07/21/2008

DOWNS RACHLIN MARTIN PLLC
199 MAIN STREET
P O BOX 190
BURLINGTON, VT 05402-0190

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2008

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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Kendrew H. Colton
FITCH EVEN TABIN & FLANNERY, One Lafayette Centere
1120 20th St., NW, Suite 750 South
Washington, DC 20036

Date:
MAILED

JUL 21 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009055
PATENT NO. : 4915435
ART UNIT : 3993

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

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

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www.uspto.gov

Jackson & Jones
17592 Irvine Blvd.
Tustin, CA 92680

(For Patent Owner)

MAILED

JUL 21 2008

CENTRAL REEXAMINATION UNIT

Kendrew H. Colton
Fitch Even Tabin & Flannery
One Lafayette Centre
1120 20th Street, NW
Suite 750 South
Washington, DC 20036

(For Third Party Requester)

In re: Tractus Medical Inc.
Ex Parte Reexamination Proceeding
Control No. 90/009,055
Request Deposited: February 25, 2008
For: US Patent No. 4,915,435

: DECISION ON
: PETITION

This is a decision on the third party requester petition entitled "REQUESTOR'S PETITION UNDER 37 C.F.R. §1.181, §1.182 and §1.183" filed on April 16, 2008.

The reexamination control number 90/009,055 and the April 16, 2008 petition papers have been forwarded to the Office of Patent Legal Administration for consideration.

PETITION FEE

A single petition fee of $400.00, the fee under 37 CFR 1.17(f) for a petition filed under either 37 CFR 1.182 or 37 CFR 1.183, will be charged to Deposit Account No. 06-1135. Authority for charging the necessary petition fees appears at page 13 of the present petition.

REVIEW OF FACTS

1. U.S. Patent No. 4,915,435 ("the '435 patent"), issued to Brian M. Levine, on April 10, 1990.

2. On February 25, 2008, a third party requester deposited a request for *ex parte* reexamination of claims 1-35 (*i.e.*, all of the claims) of the '435 patent. The reexamination proceeding was assigned Control No. 90/009,055 ("the '055 reexamination proceeding").

3. On March 4, 2008, a "Notice of Reexamination Request Filing Date" was mailed for the '055 reexamination proceeding. The notice stated the filing date of the request for reexamination to be February 25, 2008.

4. On April 2, 2008, third party requester filed by facsimile transmission a petition requesting that Exhibits C1 and C2, attached to the petition, be entered into the electronic Image File Wrapper (IFW) record of the '055 reexamination proceeding as part of the original request for reexamination and be accorded the February 25, 2008 date.

5. A review of the papers of record in the '055 reexamination proceeding necessitated by the filing of the April 2, 2008 petition showed that service of the original request for reexamination had not been made in the manner required by 37 CFR 1.510.

6. As a result of the lack of service as required by 37 CFR 1.510, the Office vacated the filing date for the '055 reexamination, *sua sponte*, and on April 11, 2008, the Office mailed a Decision so advising patent owner and third party requester.

7. The April 2, 2008 petition could not be acted upon due to the lack of a filing date compliant proceeding in which to grant the requested relief. However it was noted in the April 11, 2008 decision that the Exhibits C1 and C2, as attached to the petition, would be entitled to a new filing date together with the other papers comprising the request for reexamination of the '435 patent if third party requester seasonably cured the deficient service and a new filing date was accorded to the '055 reexamination proceeding.

8. On April 11, 2008, third party requester filed papers showing that service of the '055 reexamination request papers had been perfected in accordance with the requirements of 37 CFR 1.510.

9. Further papers were filed by third party requester on April 14, 2008 and April 15, 2008 in which additional information regarding patent owner addresses and the original service of the February 25, 2008 request papers on patent owner was supplied.

10. A review of the papers filed by third party requester on April 11, 2008 showed that the request papers had been served on patent owner in the manner required by the 37 CFR 1.510 as of that date.

11. On April 21, 2008, the Office mailed a Notice to patent owner and to third party requester that the '055 reexamination proceeding had been accorded a filing date of April 15, 2008.

12. The '435 patent is the subject of pending litigation involving patent owner and third party requester. [1]

13. The present petition was filed on April 16, 2008, but had not reached the record at the time that the papers were reconsidered and the April 21, 2008 Notice was mailed to the parties.

14. Reexamination for claims 1-35 of the '435 patent was ordered on July 3, 2008.

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[1] The litigation is styled as *Mobile Medical International Corporation v. Advanced Mobile Hospital Systems, Inc. and Tractus Medical Inc.*, Docket No. 2:07-cv-231 (D.Vt). The litigation is a declaratory judgment action filed by the third party requester in the '055 reexamination proceeding naming patent owner Tractus Medical, Inc. as a co-defendant.

RELEVANT AUTHORITY

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

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

37 CFR 1.510 provides, in part:

> (b) Any request for reexamination must include the following parts:
>
> ...
>
> (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."
>
> ...
>
> (c) If the request does not include the fee for requesting *ex parte* reexamination required by paragraph (a) of this section and meet all the requirements by paragraph (b) of this section, then the person identified as requesting reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *ex parte* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.
>
> (d) The filing date of the request for ex *parte* reexamination is the date on which the request satisfies all the requirements of this section.

37 CFR 1.33(c) provides, in part:

> (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.
>
> (d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

DECISION

A review of the record of the '055 reexamination proceeding shows that third party requester originally deposited papers to request reexamination of the '435 patent on February 25, 2008. Although the request papers were originally accorded a filing date of February 25, 2008, it was subsequently determined that service of those papers did not technically comply with the requirements of 37 CFR 1.510(b)(5), which requires service "...on the patent owner at the address as provided for in § 1.33(c)." The certificate of service included in the February 25, 2008 request papers indicated that the request papers were served on the patent owner by delivering the papers via overnight carrier to:

Mr. Kenyon Mark Lee
1700 south El Camino Real, Suite 505
San Mateo, California 94402

and to:

R. Bradford Fawley
Downs Rachlin Martin PPLC
199 Main Street
P.O. Box 190
Burlington, VT 05042

The certificate of service identified Mr. Lee as being "the attorney (agent) who has been acting for Tractus Medical Inc., and Advanced Mobile Hospital Systems Inc., who sent correspondence regarding the '435 patent in and who is listed in the PTO PAIR system as the attorney for Tractus in connection with a recorded assignment of the '435 patent." The certificate of service identified Mr. Fawley as being "the lead counsel appearing for Defendants, Advanced Mobile Hospital Systems Inc. ('AMoHS') and Tractus Medical Inc." in copending litigation involving the '435 patent.

However, the record of the IFW of the '435 patent showed that the power of attorney is in favor of Harold L. Jackson (Registration. No. 17,766) and Stanley R. Jones (Registration. No. 22,659), at the following correspondence address of record:

Jackson & Jones
17592 Irvine Boulevard
Tustin, California 92680

Therefore, the original service of the request papers deposited on February 25, 2008 did not comply with the requirements provided by 37 CFR 1.510(b). Accordingly, upon initial review of the papers as deposited, the Office should have mailed a Notice (1) advising the patent owner and the third party requester that the request papers as filed were not entitled to a filing date due to the lack of proper service of the request on patent owner, and (2) setting a time for correction of the deficiency. Accordingly, the Office mailed a Decision on April 11, 2008 vacating the February 25, 2008 filing date of the '055 request for reexamination, and providing the parties with notice of the same. Further, the April 11, 2008 Decision provided guidance to the third party requester as to how the deficiency could be cured and the time limit for filing papers showing that third party requester had served the request papers in accordance with the regulations. The parties were informed in the Decision that the filing date of the '055

reexamination proceeding would be the date that the Office was informed that proper service had been accomplished by third party requester.

The April 11, 2008 Decision also pointed out that although third party requester's service of the request papers that were originally deposited on February 25, 2008 was not compliance with the rules, the records of the USPTO Office of Enrollment and Discipline (OED), (available on the USPTO website), showed that Mr. Jackson's current address and Mr. Jones' current address were no longer as stated in the '435 patent file. Thus, assignee of record (*i.e.*, patent owner) should have taken steps to update that address. Further, it was also pointed out that if one or both of these practitioners no longer have power of attorney with respect to the '435 patent, the assignee (*i.e.*, patent owner) should have taken steps to update both the correspondence address and the power of attorney in the '435 patent file. See MPEP §§ 402.07 and 403, and the rules cited therein. The Office also sent a copy of the April 11, 2008 Decision to both Messrs. Jackson and Jones at their current OED addresses, as well as to the parties that requester had originally served on February 25, 2008 as being legal representatives of patent owner.

The record now shows that on April 21, 2008, the Office accorded a filing date of April 15, 2008 to the '055 reexamination proceeding. The April 15, 2008 filing date reflects the information provided in papers filed by third party requester on April 11, 2008, April 14, 2008 and April 15, 2008. These papers show that third party requester had taken steps to serve the request papers on counsel of record in the IFW of the '435 patent, both at their address of record in the IFW and at their OED correspondence address. [2] The record also shows that reexamination of the '435 patent was ordered on July 3, 2008.

Third party requester filed the present petition on April 16, 2008, requesting the exercise of supervisory authority under 37 CFR 1.181, and/or relief under 37 CFR 1.182 that is not otherwise provided by the regulations, and/or waiver pursuant to 37 CFR 1.183 of such regulations as may be necessary, in order to obtain a filing date of February 25, 2008 for the '055 reexamination proceeding. In the petition, third party requester points out that third party requester in fact served representatives of patent owner with the original request papers on February 25, 2008, although it is clear that service did not technically comply with the requirements of the filing date regulations. Third party requester also points out that had third party requester in fact complied with the requirements of the filing date regulations and served the February 25, 2008 request papers on the practitioners having power of attorney at the correspondence address of record in the IFW of the '435 patent, such service would have been ineffective because the practitioners of record were no longer at the correspondence address, no longer represent patent owner, and patent owner had taken no steps to update the power attorney and correspondence address in the '435 patent file.

Third party requester's petition also provides important information regarding the concurrent litigation between third party requester and patent owner concerning the '435 patent. It appears that in the concurrent litigation involving the '435 patent, third party requester moved to stay discovery while the Office proceeds with the '055 reexamination proceeding, and the motion was denied (without prejudice) by the district court in view of the vacatur of the

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[2] It appears upon inspection of these papers that the filing date for the '055 reexamination proceeding should properly have been April 11, 2008, because on that date service was made at the address for the now defunct Jackson and Jones firm. The information provided by third party requester in the papers filed on April 14, 2008 and April 15, 2008 is supplemental information that completes the record but was unnecessary with respect to satisfaction of the filing date requirements of 37 CFR 1.510(b) and 37 CFR 1.33(c).

February 25, 2008 filing date. It further appears that the district court would reconsider its decision regarding a stay of discovery if third party requester renews its motion. [3]

In view of the request for supervisory authority under 37 CFR 1.181, prior to June 23, 2008, the Director of the Central Reexamination Unit (CRU) was consulted in this matter. Given the unique circumstances presented by the facts in this proceeding, CRU Director Lissi Marquis had no objection to the grant of the relief requested by third party requester, namely the restoration of the original filing date of February 25, 2008, provided that in so doing the Office would not fail to satisfy the requirement of 35 U.S.C. § 303(a) that an order be mailed within three (3) months of the filing date of the request for *ex parte* reexamination. In addition, in view of the papers filed on April 2, 2008 presenting Exhibits C1 and C2 as originally filed on February 25, 2008 and an itemized filing receipt therefor, CRU Director Marquis approved of the request to properly scan into the (IFW) copies of Exhibits C1 and C2 as attached to the April 2, 2008 papers.

While it appears that third party requester did not comply with the filing date requirements of 37 CFR 1.510(b) when the request for reexamination of the '435 patent was originally deposited on February 25, 2008, it also appears that patent owner had failed to comply with the procedural and regulatory requirements for maintaining a current correspondence address in the '435 patent file. Thus, even if third party requester had complied with the filing date requirements, the '055 reexamination proceeding could well have been delayed if the need to perfect service on patent owner was subsequently requested by patent owner. It further appears that the vacatur of the February 25, 2008 has prejudiced third party requester with respect to the motion to stay discovery. Although third party requester did not comply with the requirements of 37 CFR 1.510(b)(5) when filing the February 25, 2008 request for reexamination, it appears that third party requester did so innocently in light of the knowledge regarding counsel who are currently representing patent owner in the matter of the '435 patent.

Accordingly, it is deemed appropriate, in this instance, to provide relief pursuant to 37 CFR 1.182 and to waive the filing date requirements of 37 CFR 1.510(b) pursuant to 37 CFR 1.183 to the extent that the '055 reexamination proceeding will prospectively, from the date of this Decision, be treated as February 25, 2008. This relief is granted in light of the extraordinary circumstance that arose from the failure of patent owner to comply with the requirements of 37 CFR 1.33(c), coupled with the further circumstance that third party requester had knowledge of the name and address of counsel currently representing patent owner in matters regarding the '435 patent.

ADDITIONAL DISCUSSION

The parties are hereby advised that service of papers in this proceeding must continue to be made at the correspondence addresses currently of record in the '435 reexamination proceeding. The parties are further advised that the Office will no longer undertake to conduct dual correspondence in this matter.

Further, it is to be noted that the present Decision is directed to the rather unique facts and circumstances that exist in this proceeding and their effect on the copending litigation regarding the patent be reexamined, as discussed above. Therefore, the present Decision should not be taken as precedent that the same or similar relief will be granted in the future in any reexamination proceeding.

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[3] See "Requestor's Petition ...", April 16, 2008, at page 10.

CONCLUSION

1. **The filing date** assigned to the request papers for *ex parte* reexamination proceeding Control No. 90/009,055 is hereby prospectively reinstated to be February 25, 2008.

2. Exhibits C1 and C2 as attached to the papers filed on April 2, 2008, have been entered into the image file wrapper.

3. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-1535, or in his absence, to the undersigned at (571) 272-7710.

Kenneth M Schor
Senior Legal Advisor
Office of Patent Legal Administration

sm
July 17, 2008

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CENTRAL REEXAMINATION UNIT

Downs Rachlin Martin PLLC (For Patent Owner)
199 Main Street
P.O. Box 190
Burlington, Vermont 05402-0190

Fitch Even Tabin & Flannery (For Requester)
One Lafayette Centre
1120 20th St., NW, Suite 750 South
Washington, DC 20036

In re Brian M. Levine :
Reexamination Proceeding : **DECISION**
Control No.: 90/009,055 : **DISMISSING AND**
Filed: April 15, 2008 : **EXPUNGING**
For: U.S. Patent No.: 4,915,435 : **PETITION**

This is a decision on the April 29, 2009 third party requester petition entitled "Petition to Temporarily Suspend Proceedings of Reexamination 90/009,055 In Order to Consider Reexamination Request 90/010,466 and to Merge Reexamination Proceedings."

The petition is before the Office of Patent Legal Administration.

The petition is **dismissed**.

The third party requester petition paper is an improper paper. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the third party requester. Thus, the present petition paper is **expunged** from the record by marking it "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

BACKGROUND

1. Patent number 4,915,435 (the '435 patent) issued on April 10, 1990.

2. A request for reexamination, assigned control No. 90/009,055 (the '9055 proceeding), was filed on April 15, 2008, by a third party requester.[2]

3. On July 3, 2008, an order granting the '9055 reexamination request was mailed.

4. On February 27, 2009, the Office mailed an Office action in the reexamination proceeding.

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[1] See MPEP 2267.

[2] A request for reexamination that was not filing date compliant was deposited on February 25, 2008. In response to notification by the Office, requester submitted a compliant filing on April 15, 2008.

5. On March 26, 2009, patent owner timely responded to the Office action of February 27, 2009.

6. On April 25, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the '9055 proceeding.

13. On April 29, 2009, third party requester filed the present petition entitled "Petition to Temporarily Suspend Proceedings of Reexamination 90/009,055 In Order to Consider Reexamination Request 90/010,466 and to Merge Reexamination Proceedings."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C § 304 provides:

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

37 CFR 1.535 Reply by third party requester in ex parte reexamination.

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

37 CFR 1. 550 Conduct of ex parte reexamination proceedings.

(a) All ex parte reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the ex parte reexamination order and expiration of the time for submitting any responses, **the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an ex parte reexamination certificate under § 1.570. [Emphasis added]

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 April 29, 2009 third party requester petition is filed under 37 CFR 1.183; however, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '9055 proceeding.

Waiver/suspension of the rules to permit the third party submission via the petition is not justified in view of the legislation and implementing rules which make reexamination under 35 U.S.C. §§ 302 - 307 an *ex parte* proceeding. See *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the Court said (paragraph bridging pages 1868 & 1869):

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

Pursuant to 35 U.S.C. § 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends either: (1) upon expiration of the patent owner's time

for filing a statement in response to the order for reexamination, or (2) if the patent owner files such a statement, upon expiration of the third party requester's time for filing a reply to the patent owner's statement (i.e., within two months from the date of service of the patent owner's statement).

On its face, the third party requester's April 29, 2009 petition paper is filed after the statutory statement and reply period ended in the '9055 proceeding. The statutory statement and reply period ended in the '9055 proceeding on September 3, 2008, upon expiration of the patent owner's period for filing a statement under 35 U.S.C. 304 and 37 CFR 1.530. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's April 29, 2009 petition paper. Therefore, the petition is **dismissed**.

CONCLUSION

1. The petition is **dismissed**.

2. The petition paper filed by the third party requester on April 29, 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 '9055 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."

3. No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.

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

5. Any inquiry concerning this decision should be directed to Pinchus M. Laufer., Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7710.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,056	02/27/2008	5655084	18902-036RX1	6205

959 7590 06/19/2008

LAHIVE & COCKFIELD, LLP
ONE POST OFFICE SQUARE
BOSTON, MA 02109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2008

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

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CENTRAL REEXAMINATION UNIT

Lahive & Cockfield, LLP
One Post Office Square
Boston, MA 02109-2127

(For Patent Owner)

Fish & Richardson P.C.
PO Box 1022
Minneapolis, MN 55440-1022

(For Third Party Requester)

In re Pinsky *et alia*
Reexamination Proceeding
Control No. 90/010,026
Request Deposited: September 14, 2007
For: U.S. Patent No. 5,655,084

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

In re Pinsky *et alia*
Reexamination Proceeding
Control No. 90/009,056
Request Deposited: February 27, 2008
For: U.S. Patent No. 5,655,084

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. 5,655,084 (hereinafter, the '084 patent), issued to Pinsky *et alia*, on August 5, 1997.

2. On September 14, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '084 patent. The reexamination proceeding was assigned Control No. 90/010,026 (hereinafter, the '10026 proceeding).

3. The Reexamination Order was granted in the '10026 proceeding on December 6, 2007.

4. There are currently no amendments in the '10027 proceeding.

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5. On February 27, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '084 patent. The reexamination proceeding was assigned Control No. 90/009,056 (hereinafter, the '9056 proceeding).

6. The Reexamination Order was granted in the '9056 proceeding on April 11, 2008.

7. There are currently no amendments in the '9056 proceeding.

8. The '10026 and '9056 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 '10026 and the '9056 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.

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CONCLUSION

1. Reexamination Control Nos. 90/010,026 and 90/009,056 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.
90/009,057	02/27/2008	6177932	R66344	7275

40401 7590 03/03/2010

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

WOLF GREENFIELD & SACKS, P.C.

600 ATLANTIC AVENUE

BOSTON, MA 02210-2206

MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,057*.

PATENT NO. *6177932*.

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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Abraham Hershkovitz
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

Robert M Abrahamsen
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

(For third party Requester)

In re: Galdes *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,057
Deposited on: 27 February 2008
For: US Patent No. 6,177,932

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 24 February 2010, "Petition for Extension of Time Under 37 CFR § 1.550(c)" requesting the response period be extended by one-month for responding to the Notice of Appeal submitted 24 December 2009. The petition submitted 24 February 2010 was timely filed with certificate of service.

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.

DISCUSSION

The Patent Owner's representative requests the period for response to be extended by one-month for responding to the Notice of Appeal submitted on 24 December 2009, which sets two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 24 February 2010, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.550(c) and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part.

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

The petitioner has demonstrated "sufficient cause" for granting-in-part the extension of time. The petitioner notes weather which forced the closing of the federal government in and around the Washington DC metropolitan area. Additionally the petitioner notes that an amendment to the claims was submitted for consideration by the examiner on 22 February 2010. The filing of an amendment does not stay the proceeding. However because of the closure of the government and the divergent responses the patent owner will peruse given the outcome of the amendment filed 22 February 2010, the petition is granted-in-part. On balance there is "sufficient cause" for granting-in-part the extension of time.

The petition request to extend the response time is hereby granted-in-part for a period of fourteen (14) days.

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the Notice of Appeal submitted 24 December 2010 is hereby **granted-in-part.**

2. The period for response is extended by fourteen (14) days.

3. The response is extended to **10 March 2010.**

4. All correspondence involving this proceeding may be addressed to the following:

By Mail to: Mail Stop *Inter Partes* 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 absence of Mark Reinhart calls may be directed to Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,058	02/28/2008	7012040	514413-3766.2	6515

20999 7590 03/30/2010

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/30/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KILPATRICK STOCKTON LLP
1001 WEST FOURTH STREET
WINSTON-SALEM, NC 27101

Date:
MAILED
MAR 3 0 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009058
PATENT NO. : 7012040
ART UNIT : 3991

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

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

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

: FOR PATENT OWNER

MAILED

MAR 3 0 2010

CENTRAL REEXAMINATION UNIT

FRANK W. LEAK, JR.
KILPATRICK STOCKTON LLP
1001 WEST FOURTH STREET
WINSTON-SALEM, NC 27101

: FOR THIRD PARTY
: REQUESTER

In re Hacker et al.

Reexamination Proceeding
Control No. : 90/009,058
Filed : February 28, 2008
Patent No. 7,012,040

: DECISION ON PATENT
: OWNER'S PETITION UNDER
: 37 CFR 1.181

This is a decision addressing Patent Owner's petition, filed November 2, 2009 under 37 CFR § 1.181, to withdraw finality of the Office action mailed September 11, 2009.

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

SUMMARY

Patent Owner's petition is DENIED.

BACKGROUND

1. On February 28, 2008, a request for *ex parte* reexamination was filed by a third party requester for claims 1-2, 6-10, 12, 14, 15, 17, 18, 20 and 22 of U.S. Patent Number 7,012,040; the resulting reexamination proceeding was given a filing date and assigned control number 90/009,058 ("the '058 proceeding").

2. On April 24, 2008, an Order granting reexamination of claims 1-2, 6-10, 12, 14, 15, 17, 18, 20 and 22 was mailed.

3. On August 10, 2008, a non-final Office action rejecting claims 1-2, 6-10, 12, 14, 15, 17, 18, 20 and 22 was mailed.

4. On October 10, 2008, Patent Owner submitted a timely response to the outstanding Office action (compliant amendment filed October 23, 2008), including amendments to claims 1, 2, 6, 14, 15, 17, 18, 19 and 22 and new Claims 23-48. Claims 12 and 20 were canceled.

5. A personal interview was held with Patent Owner's representatives on December 10, 2008.

6. On January 12, 2009, Patent Owner filed a supplemental response which further amended claims 1 and 18, amended new claims 23, 39, 43 and 45-48, and added new claims 49-56.

7. On September 11, 2009, a final Office action was mailed, confirming claims 13 and 22 and rejecting claims 1-11, 14-19, 22 and 23-56.

8. On November 2, 2009, the instant petition was filed by Patent Owner.

9. Patent Owner filed a notice of appeal on February 11, 2010.

DECISION

The final Office action of September 11, 2009 included rejections of claims which were not previously subject to reexamination. Patent Owner argues that these new grounds of rejection were not necessitated by amendment and could have been made in the previous Office action, and therefore it was not proper to make the action final. This argument is not persuasive.

Claims of the '040 patent were drawn to combinations of herbicides and methods for their use. Claims 1 and 14 recited a combination which included a broad spectrum herbicide selected from genus A and a second herbicide selected from genus B. Genus A was further split into glufosinate compounds (A1), glyphosate compounds (A2) and other subgenera. The prior art cited in the Request is directed to glyphosate compounds, and reexamination was not requested for claims limited to glufosinate compounds. When a reexamination is ordered, "the primary source of patents and printed publications used in making the determination are those relied on in the request" (MPEP 2244). Accordingly, the examiner's search was limited to subgenus A2, and claims limited to combinations containing subgenus A1 were not subject to reexamination. In Patent Owner's responses, claims 1 and 14 have been amended to require a compound from subgenus A1, with subgenus A2 compounds now optional ingredients. New claims 23-28, 30-38, 41-43 and

49-52 also require a compound from subgenus A1. Thus Patent Owner's amendments required search and examination of subgenus A1. MPEP 2243 states, "The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts and situation of each individual case. If the Office chooses to reexamine any claim for which reexamination has not been requested, it is permitted to do so." Now that Patent Owner's actions have broadened the scope of the '058 proceeding to include claims requiring subgenus A1, it was proper to include claims which were not previously subject to reexamination in the rejections.

CONCLUSION

1. Patent Owner's petition filed November 2, 2009 is **DENIED** for the reasons discussed above.

2. Patent Owner's appeal brief is due April 11, 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
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,058	02/28/2008	7012040	514413-3766.2	6515

20999 7590 06/29/2010

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/29/2010

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JUN 29 2010

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Frank W. Leak
The Law Office of Frank W. Leak, PLLC
301 N. Main St., Suite 2400
Winston-Salem, NC 27101

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,058*.

PATENT NO. *7012040*.

ART UNIT *3991*.

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

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

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The Law Office of Frank W. Leak, PLLC
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P.O. Box 1450
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www.uspto.gov

Frommer, Lawrence & Haug
745 Fifth Avenue, 10th Floor
New York, NY 10151

(For Patent Owner)

Frank W. Leak, Jr.
Kilpatrick Stockton LLP
1001 West Fourth Street
Winston-Salem, NC 27101

(For Requester)

MAILED

JUN 29 2010

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/009,058
Filed: February 28, 2008
For: US Patent No. 7,012,040

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

This is a decision on the petition filed November 2, 2009 to request a three-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated September 11, 2009.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated September 11, 2009. The Office action is a non-Final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

A complete and timely response to the outstanding Office action of September 11, 2009 was received on November 12, 2009. The petition is therefore moot and is herein dismissed.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated September 11, 2009 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,058	02/28/2008	7012040	514413-3766.2	6515

20999 7590 07/09/2010

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745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

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ART UNIT	PAPER NUMBER

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Frank W. Leak, Jr.
Kilpatrick Stockton LLP
1001 West Fourth Street
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,058*.

PATENT NO. *7012040*.

ART UNIT *3991*.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Frank W. Leak, Jr.
Kilpatrick Stockton LLP
1001 West Fourth Street
Winston-Salem, NC 27101

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PATENT NO. *7012040*.

ART UNIT *3991*.

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

United States Patent and Trademark Office

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

(For Patent Owner)

FRANK W. LEAK, JR.
KILPATRICK STOCKTON LLP
1001 WEST FOURTH STREET
WINSTON-SALEM, NC 27101

(For Requester)

MAILED
JUL 09 2010
CENTRAL REEXAMINATION UNIT

In re Hacker *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/009,058
Filed: April 12, 2010
For: U.S. Patent No. 7,012,040 B2

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the April 12, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. 1.182 FOR ENTRY OF AMENDMENT IN 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

1. On March 14, 2006, U.S. Patent Number 7,012,040 B2 was issued to Hacker *et al.*, having 21 claims.

2. On February 28, 2008, a request for *ex parte* reexamination of claims 1-2, 6-10, 12, 14, 15, 17, 18, 20, and 22 was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/009,058 ("the '9058 proceeding").

3. On April 24, 2008, *ex parte* reexamination of claims 1-2, 6-10, 12, 14, 15, 17, 18, 20, and 22 was ordered.

4. On August 10, 2008, *the Office issued an action rejecting* claims 1-2, 6-10, 12, 14, 15, 17, 18, 20, and 22.

5. On October 10, 2008, and supplemented on October 23, 2008, and further supplemented on January 12, 2009, patent owner filed an amendment adding new claims 23-56 and cancelling claims 12 and 20.

6. On September 11, 2009, a final Office action was issued, confirming claims 13 and 22, and rejecting claims 1-11, 14-19, 21, and 23-56.

7. On November 2, 2009, patent owner filed a petition under 37 C.F.R. § 1.181 to request removal of the finality of the September 11, 2009 Office action.

8. On November 12, 2009, patent owner submitted claim amendments and remarks in response to the final Office action. On December 11, 2009, patent owner submitted a second response to the final Office action proposing to cancel claims 1-56 and present new claims 57-126.

9. On January 12, 2010, the Office conducted an additional interview with patent owner's representative, in which the examiner suggested an amendment removing certain compounds from the claim recitations.

10. On January 14, 2010, the Office mailed an advisory Office action denying entry of the claim amendments submitted on November 12, 2009 and December 11, 2009.

11. On February 4, 2010, the Office conducted an additional interview with patent owner's representatives, in which the examiner again discussed an amendment removing certain compounds from the claim recitations.

12. On February 11, 2010, patent owner filed a Notice of Appeal.

13. On March 30, 2010, the Office issued a decision denying patent owner's November 2, 2009 petition under 37 C.F.R. § 1.181 requesting removal of the finality of the September 11, 2009 Office action.

14. On April 12, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. 1.182 FOR ENTRY OF AMENDMENT IN REEXAMINATION," requesting entry of an amendment, cancelling claims 1-56 and adding new claims 57-120, and remarks filed concurrently with the petition. Proposed new claims 57-95 are in accord with the examiner's suggestions given in the interview of January 12, 2010. Proposed new claims 96-120 were asserted by patent owner to be "also allowable and at the very least would greatly simplify matters for appeal;"[1] these claims are not in accord with the examiner's suggestions given in the interview of January 12, 2010.

15. On April 12, 2010, and supplemented with a properly signed copy on April 13, 2010, patent owner filed an Appeal Brief.

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[1] Patent Owner remarks of April 12, 2010, at 20.

APPLICABLE REGULATION

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). (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 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 C.F.R. § 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 should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier;

---

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

thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

In this instance, patent owner's petition includes a submission directed towards the entry of accompanying claim amendments and remarks. These amendments have not been addressed by, or denied entry by, the examiner. The amendments cancel the existing claims and add one set of claims (57-95)[3] alleged to be in accord with the examiner's suggestions given in the interview of January 12, 2010, and a second set of new claims (96-120) that are asserted by patent owner to be "also allowable and at the very least would greatly simplify matters for appeal;"[4] however, these claims have not been shown to be in accord with the examiner's suggestions given in the interview of January 12, 2010.

As to why a petition for entry of the January 23, 2009 amendment is required at this stage of the proceeding, patent owner provides specific arguments as to how the new claims simplify and define the issues for appeal, would address the rejections under 35 U.S.C. § 112, would incorporate the examiner's suggestions for allowable subject matter for new claims 57-95, and would present new claims that better define issues for appeal while not requiring further search and consideration. The petition also sets forward arguments that the patent owner's petition under 37 C.F.R. § 1.181 was incorrectly decided; in particular, due to the fact that the rejections were "significantly different" in the non-final and final Office actions.

With respect to the proferred amendment, the amendments to claims 57-95, which purport to amend the claims in line with the examiner's suggestions for allowability, entry of an amendment directed only to such amendments would be enterable, as the amendment would be responsive to the suggestions made by the examiner, and would be a *bona fide* effort to put the proceeding in condition for issuance of a notice of intent to issue a reexamination certificate. However, as amendments are not be entered in part, the ability of the proffered amendment to advance the proceeding must also consider the effect of entry of the amendments to claims 96-120, which are not alleged and shown to be in accordance with the examiner's explicit suggestions. The following analysis will therefore specifically address the effect of entry of the amendments to claims 96-120 on the instant reexamination proceeding.

MPEP 2272 clearly sets forth after-final procedure for *ex parte* proceedings, and states that after-final amendments "will be governed by the strict standards of 37 CFR 1.116" and that "the patent owner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR 1.53(b), or 1.53(d), and with no opportunity to file a request for continued examination under 37 CFR 1.114." Therefore, patent owner was clearly on notice of the after-final procedure for *ex parte* proceedings.

Patent owner's petition alleges that the proposed amendments address an issue that arose only after to the final Office action. Specifically, patent owner alleges that (1) the examiner for the

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[3] Although patent owner groups claim 96 in the second set of claims as comprising a combination of glufosinate and sulfosulfuron, upon cursory review, claim 96 appears to fit with the first set of claims. The decision on the instant petition, however, will follow the groupings as alleged by patent owner.

[4] Patent Owner remarks of April 12, 2010, at 20.

first time in the January 12, 2010 interview stated that certain subject matter was allowable, and (2) that the final rejection included new grounds of rejection for claims 11 or 21 not present in the first Office action. With respect to the first allegation, this applies only to claims 57-95, but not to claims 96-120. Therefore, the first allegation is not persuasive as to why the newly presented claims 96-120 address a newly raised issue. With respect to the second allegation, the proposed new claims 96-120 are not alleged to be amended in response to the rejections of claims 11 and 21 in the final Office action. Therefore, according to the rationale set forth in the petition, the proposed new claims address issues first raised in the first Office action, and not issues newly raised in the final Office action or subsequent interviews with the Office. For these reasons, patent owner has not persuasively shown that the submission of proposed new claims addresses any issue not present prior to the close of prosecution.

Furthermore, patent owner has not identified how the newly presented claims 96-120 would specifically overcome the rejections set forth in the final Office action. On the contrary, the petition admits that "claims 96-116 cover herbicide combination and methods include (sic) (B) herbicide which Examiner Turner has, to date, rejected."[5] Therefore, the petition does not allege that the newly presented claims 96-120 would overcome the applied rejections. Rather, the petition alleges that the new claims present discrete groupings that "will facilitate clear and concise arguments . . . should an appeal be necessary."[6]

While an amendment that has the sole effect of putting the claims into better form for appeal may, in some cases, support entry of such amendment, the instant submission reorganizes the claimed subject matter to such an extent that considerable effort and time would be expended in redrafting the rejections to match the new claim scheme, and reviewing for compliance with 35 U.S.C. 112. As set forth in the petition, the newly added claims 96-120 are not stated to merely simplify the previously submitted claims. Except for claims 117-120, which alter specific claims, the examiner would need to determine how the previously made rejections would apply to new claims 96-116. Following that determination, the patent owner would then need to formulate a new response, which might disagree with the examiner's determination of how previously applied art would apply to the new claims 96-116. At the current stage of the proceeding, the application of the prior art to the claims has been made in at least the final rejection, and discussed at least in the patent owner's appeal brief. In view of the advanced stage of the proceeding, the currently formulated claims that have been thoroughly discussed by the Office and by patent owner, and the extent of the effort needed to address the proposed new claim formulations by the Office and the patent owner, the potential for advantages in clarity and conciseness of the proposed new claims does not outweigh the accompanying delay to evaluate and discuss the proposed new claims. Reopening of the prosecution to consider this amendment would therefore hinder the Office in carrying out its statutory mandate of conducting *ex parte* 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.

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[5] Petition at 6.
[6] Petition at 7.

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

July 9, 2010
Kenpet8

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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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

MAILED

SEP 10 2008

CENTRAL REEXAMINATION UNIT

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/008,768 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,063	02/29/2008	7069988	2065.007376	9634

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

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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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,064	02/29/2008	7096937	2065.007476	1347

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.

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10333 Richmond, Suite 1100
Houston, TX 77042

(For Patent Owner)

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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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,587	04/12/2007	6103286	235722000230	6489

25225 7590 09/26/2008

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

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

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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

MAILED

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.

for Deborah Jones

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

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

CENTRAL REEXAMINATION UNIT

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

(for Third Party)

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

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P.O. Box 1450
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
www.uspto.gov

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
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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

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.

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.
90/008,593	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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUN 19 2009

CENTRAL REEXAMINATION UNIT

DO NOT USE IN PALM PRINTER

(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

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

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.: 90/008,593
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

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.
90/009,069	03/03/2008	5313511	0019-31	3468

2101 7590 02/25/2009

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

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
AMERICAN SCIENCE AND ENGINEERING, D. INC.
829 MIDDLESEX TURNPIKE
BILLERICA, MA 01821

Date: MAILED
FEB 25 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009069
PATENT NO. : 5313511
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

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON MA 02110-1618

For Patent Owner

ERNEST D. BUFF
ERNEST D. BUFF AND ASSOCIATES, LLC.
231 SOMERVILLE ROAD
BEDMINSTER, NJ 07921

For Requester

MAILED

FEB 25 2009

CENTRAL REEXAMINATION UNIT

In re Reexamination of USP 5313511
Cont. No.: 90/009,069
Request Deposited: March 03, 2008
For: **X-RAY IMAGING PARTICULARLY ADAPTED FOR LOW Z MATERIALS**

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petitions under 37 CFR 1.59(b), filed October 24, 2008 (with a refiling on October 27, 2008) and January 7, 2009, to expunge information from the above identified application.

The petitions are granted.

Petitioner requests that documents entitled

AV Expert Report of Thomas G. Matheson Regarding United States Patent Nos. 5,313,511 and 6,546,072, 9/18/08, in *AS&E, Inc. v. Autoclear, LLC et al.*, U.S. District Court for the Eastern District of Virginia, C-2:07-cv-00415-RAJ-FB S.

AW Rebuttal Expert Report of Robert G.A. Zamenhof, Ph.D., F.A.A.P.M., 10/13/08, in *AS&E, Inc. v. Autoclear, LLC et al.*, U.S. District Court for the Eastern District of Virginia, C-2:07-cv-00415-RAJ-FB S.

filed October 24, 2008 (with a refiling on October 27, 2008), and

AX- Supplemental Expert Report of Thomas G. Matheson in Response to Dr. Zamenhof's October 13, 2008 Rebuttal Report, 10/21/08, in AS&E, Inc. v. Autoclear, LLC et al., U.S. District Court for the Eastern District of Virginia, C-2:07-cv-00415-RAJ-FBS.

filed January 7, 2009, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been removed from the official file.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090618

DATE : June 18, 2009

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 5,313,511 C2

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

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

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

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

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

☒ **Approved** **All** changes apply.

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

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

Comments:

Office mistake in Ex Parte Reexamination Certificate (6873rd) US 5,313,511 C2

SPE: Eric Keasel **Art Unit** 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,071	03/07/2008	5,340,594	L111 7000	3515

22442 7590 11/04/2008

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SUSAN SHAW McBEE
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
8065 LEESBURG PIKE 4th FLOOR
TYSONS CORNER, VA 22182

Date:

NOV 14 2008

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009071
PATENT NO. : 5340594
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
www.uspto.gov

NOV 14 2008

Gary J. Connell
SHERIDAN ROSS
1560 Broadway
Suite 1200
Denver, CO 80202

For Patent Owner

Susan Shaw McBee
WOMBLE CARLYLE SANDRIDGE
& RICE, PLLC
8065 Leesburg Pike 4th Floor
Tysons Corner, VA 22182

For Requestor

Ex Parte Reexamination Proceeding
Control No. 90/009,071
Filed: March 7, 2008
For: US Patent No. 5,340,594

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

This is a decision on the petition filed November 3, 2008 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated September 3, 2008.

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

The petition is granted for one month for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated September 3, 2008, which set a two-month period for response thereto. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be 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 response to the above-referenced office action was completed in preparation for an interview with the Examiners on October 30, 2008. As a result of the interview, Patent Owner and representatives now believe that additional information, including declaratory statements from one or more experts, would be required to present a full response to the outstanding issues. A one-month extension of time is requested.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why an extension of time should be granted. 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 314(c) that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a one-month extension of time in which to file a response to the outstanding Office action. Accordingly, the response is due on December 3, 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.

1. The Patent Owner's petition for extension of time in which to file response to the outstanding Office action is granted for one month.

2. The Patent Owner's response is due December 3, 2008.

3. Response may be submitted as follows:

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

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

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

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

/Deborah Jones/

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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SEP 17 2008

CENTRAL REEXAMINATION UNIT

Joseph A. Sawyer, Jr.
Benman Collins & Sawyer
620 Hansen Way
Suite A
Palo Alto, CA 94304

(For Patent Owner)

Justin M. Sobaje
Foley & Lardner LLP
2029 Century Park East
Suite 3500
Los Angeles, CA 90067

(For Requester)

David M. Quinlan
32 Nassau Street
Suite 300
Princeton, NJ 08542

(Courtesy Copy)

In re Lewis
Ex Parte Reexamination Proceeding
Control No. 90/009,075
Filed: March 12, 2008
For: U.S. Patent No. 5,564,001

: **DECISION DISMISSING**
: **AND EXPUNGING PETITION**
: **AND ACCOMPANYING**
: **PAPERS**
:

This is a decision on the July 9, 2008 patent owner petition under 37 CFR 1.181 to vacate the May 15, 2008 order granting the request for reexamination in *ex parte* reexamination proceeding 90/009,075, on the grounds that it is *ultra vires* ("the July 9, 2008 patent owner petition").

This decision also addresses the July 23, 2008 requester opposition to the July 9, 2008 patent owner petition ("the July 23, 2008 requester opposition").

The July 9, 2008 patent owner petition under 37 CFR 1.181, the July 23, 2008 requester opposition, and the record as a whole are before the Office of Patent Legal Administration.

SUMMARY

The July 9, 2008 patent owner petition under 37 CFR 1.181 to vacate the May 15, 2008 order is **dismissed**.

The July 9, 2008 patent owner petition, including the declaration of Scott W. Lewis and accompanying exhibits 1-7, are **improper**, and **will be expunged** from the official file by closing these papers in the Office's Image File Wrapper (IFW) database.

REVIEW OF FACTS

- On October 8, 1996, U.S. Patent No. 5,564,001 ("the '001 patent") issued to Scott W. Lewis.

- On March 12, 2008, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/009,075 ("the '9075 proceeding").

- On May 15, 2008, an order granting the request for *ex parte* reexamination was mailed.

- On July 9, 2008, the patent owner filed the instant petition under 37 CFR 1.181 to vacate the May 15, 2008 order granting the request for reexamination ("the July 9, 2008 patent owner petition"). The July 9, 2008 patent owner petition is accompanied by a declaration of Scott W. Lewis, including exhibits 1-7.

- On July 23, 2008, the requester filed an opposition to the July 9, 2008 patent owner petition ("the July 23, 2008 requester opposition"). The July 23, 2008 requester opposition is accompanied by a declaration of Victor De Gyarfas.

- Office records fail to reveal that a patent owner's statement pursuant to 37 CFR 1.530(b) and (c) has been filed in response to the July 9, 2008 order.

- No first Office action on the merits has been mailed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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.

35 U.S.C. 303 provides:

> (a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.
> (b) A record of the Director 's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.
> (c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

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.

35 U.S.C. 311 provides:

(a) IN GENERAL. — Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS. — The request shall —
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an *inter partes* reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.
(c) COPY. — The Director promptly shall send a copy of the request to the owner of record of the patent.

35 U.S.C. 312 provides:

(a) REEXAMINATION. — Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.
(b) RECORD. — A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.
(c) FINAL DECISION. — A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the *inter partes* reexamination fee required under section 311.

35 U.S.C. 313 provides:

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for *inter partes* reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314.

35 U.S.C. 315(c) provides:

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

35 U.S.C. 317 provides:

(a) ORDER FOR REEXAMINATION. — Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION. — Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.181 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.

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

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

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

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

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

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 2242 III provides:

POLICY WHERE A FEDERAL COURT DECISION HAS BEEN ISSUED ON THE PATENT

A. Final Holding of Validity by the Courts.

When the initial question as to whether the prior art raises a substantial new question of patentability as to a patent claim is under consideration, the existence of a final court decision of claim *validity* in view of the same or different prior art does not necessarily mean that no new question is present, because of the different standards of proof employed by the Federal District Courts and the Office. While the Office may accord deference to factual findings made by the district court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, because it is not controlling on the Office.

B. Nonfinal Holding of Invalidity or Unenforceability by the Courts.

A *nonfinal* holding of claim *invalidity* or unenforceability will not be controlling on the question of whether a substantial new question of patentability is present.

C. Final Holding of Invalidity or Unenforceability by the Courts.

A *final* holding of claim *invalidity* or unenforceability, after all appeals, is controlling on the Office. In such cases, a substantial new question of patentability would *not* be present as to the claims finally held invalid or unenforceable.
As to *A.* - *C.* above, see *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).
Any situations requiring clarification should be brought to the attention of the Office of Patent Legal Administration.

MPEP 2246 II provides, in pertinent part:

PETITION TO VACATE THE ORDER GRANTING REEXAMINATION

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 . . .

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).

As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted. See the discussion in MPEP § 2242 subsection II.A. as to the criteria for vacating a reexamination order in view of the decision.

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 Request for Reexamination is Valid Under 35 U.S.C. 302

The patent owner urges the Office to vacate the order granting the request for reexamination in the '9075 proceeding, on the grounds that it is an *ultra vires* action on the part of the Office, because the patent owner believes that the request is not valid under 35 U.S.C. 302. This belief is stated to be based on *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320 (Fed. Cir. 2008).

In *Nasalok*, the court held that the defendant, against whom a default judgment of trademark infringement had been rendered in an earlier trademark infringement suit, was estopped from later asserting a claim of invalidity in a trademark cancellation proceeding before the Trademark Trial and Appeal Board (TTAB). In the present case, the patent owner has obtained a default judgment for damages in a suit for patent infringement in the United States District Court for the District of Nevada. See *1st Technology LLC v. Rational Enterprises, Ltda., Rational Poker School Limited, Bodog Entertainment Group S.A., Bodog.net, Bodog.com, and Futurebet Systems, Ltd.*, Case No. 2:06-cv-01110-RLH-GWF (D. Nev. 2007). Because the patent owner believes that the defendants in *1st Technology* are the real party in interest in the present reexamination, the patent owner urges the Office to vacate the order granting reexamination on the basis of "defendant preclusion" in light of *Nasalok*. The requester replies that the real party in interest in this case is not the same as the defendants in *1st Technology*.[1] **This decision does not address this issue.** This decision determines that the order granting *ex parte* reexamination in the '9075 proceeding is valid under 35 U.S.C. 302 even if the requester(s), i.e., the real party in interest, are the defendants in *1st Technology*, for the reasons discussed *infra*.[2]

The patent owner urges that the facts of the instant case are similar to those in *Nasalok*, and that the statutory language of 35 U.S.C. 302, i.e., "*any person at any time* may file a request for reexamination," is limited by the *Nasalok* decision to exclude requesters against whom a prior judgment has been rendered.[3] The facts of the present case, however, can easily be distinguished from *Nasalok*. *Nasalok* involves an appeal from a decision from the TTAB in a trademark cancellation proceeding. Trademark cancellation proceedings are ***inter partes*** proceedings.[4] The present '9075 reexamination proceeding, however, is an ***ex parte*** proceeding for the

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[1] See the last paragraph of page 2 of the July 23, 2008 requester opposition.

[2] **The "requester" in *ex parte* reexamination is the real party in interest.** The name and address of the legal representative of the requester is commonly placed in box no. 2 of the Request for *Ex Parte* Reexamination Transmittal Form PTO/SB/57, however, since the identity of the real party in interest is not required in *ex parte* reexamination.

[3] See the first sentence of the first full paragraph on page 3, the sentence bridging pages 6 and 7, and the sentence bridging pages 7 and 8 of the July 9, 2008 patent owner petition.

[4] See 15 U.S.C. 1064 and 1092.

reexamination of an issued patent. There are no "defendant preclusion" estoppel provisions in the *ex parte* reexamination statute.[5] On the other hand, Congress specifically provided for such estoppel provisions in 35 U.S.C. 315(c) and particularly, in 35 U.S.C. 317,[6] of the *inter partes* reexamination statute.[7] If "defendant preclusion" was applicable to reexamination, then there would have been no need for Congress to expressly provide for such estoppel provisions in the *inter partes* reexamination statute. Also, the fact that Congress provided for the estoppel provision for *inter partes* reexamination via The American Inventors Protection Act (AIPA), signed into law on November 29, 1999,[8] while not doing so for *ex parte* reexamination,[9] shows an intent of Congress that "defendant preclusion" does not apply to *ex parte* reexamination.

The patent owner, in the present petition, emphasizes that it does not base the instant petition on whether the request for reexamination raises a substantial new question of patentability; rather, the patent owner urges that whether or not a substantial new question of patentability is raised, the requester is estopped from asserting, in the '9075 proceeding, that the claims are unpatentable.[10] Attention, however, is drawn to *In re Swanson*, 2008 U.S. App. LEXIS 18928 (Fed. Cir. Sept. 4, 2008). In *Swanson*, the Federal Circuit affirmed the holding of the Board of Patent Appeals and Interferences ("the Board") that a prior district court judgment adverse to the third party reexamination requester did not prevent the United States Patent and Trademark Office ("the Office") from determining that a substantial new question of patentability had been raised by the prior art, even though a federal court previously considered the validity of the same asserted claims of the patent over the same prior art.[11]

While the holding of *Swanson* specifically relates to issue preclusion, rather than to claim preclusion, which is at issue here, the facts of *Swanson* are of particular interest. In *Swanson*, the third party requester, Syntron Bioresearch, Inc., filed a request for *ex parte* reexamination of certain claims of the patent **after** a district court holding[12] against the requester/defendant, Syntron, that the same patent claims were not invalid over the same prior art[13] raised in the reexamination, **after** the Federal Circuit affirmed, on appeal, the district court's decision that the

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[5] See generally 35 U.S.C. 302-307.

[6] 35 U.S.C. 317 of the *inter partes* reexamination statute specifically provides, in pertinent part:

> "Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action . . . and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter".

[7] See generally 35 U.S.C. 311-318.

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

[9] Compare the provisions of 35 U.S.C. 302-307 of the *ex parte* reexamination statute, which are silent with respect to the issue of estoppel, with those of the *inter partes* reexamination statute, particularly, 35 U.S.C. 315(c) and 35 U.S.C. 317.

[10] See the first full paragraph of page 8 of the July 9, 2008 patent owner petition.

[11] Citing, with approval, *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit agreed with the Office's position, set forth in MPEP 2242, that "Congress did not intend a prior court judgment upholding the validity of a claim to prevent the PTO from finding a substantial new question of patentability regarding an issue that has never been considered by the PTO."

[12] See *Abbott Labs. v. Syntron Bioresearch, Inc.*, 2001 U.S. Dist. LEXIS 25125 (S.D. Cal. Oct. 12, 2001).

[13] The prior art at issue in *Swanson* and *Abbott Labs* was the Deutsch reference, U.S. Patent 4,094,647.

same patent claims were not invalid, and **after** the Federal Circuit rendered a judgment of infringement against the requester/defendant Syntron as to these claims.[14]

The *Swanson* court's silence with respect to defendant preclusion (even though the reexamination requester was the defendant in the litigation), coupled with the *Swanson* court's approval of the Office's position on issue preclusion, clearly implies that the Office may issue an order granting *ex parte* reexamination involving any issue that the requester raised or could have raised in earlier litigation of the patent under reexamination, in which a prior judgment of validity and/or infringement against the requester/defendant has been rendered by a federal court.

It is noted that the Federal Circuit's earlier judgment of infringement against defendant Syntron, on appeal, was not a final decision.[15] However, a requester may file a request for *ex parte* reexamination even after a final judgment that the patent claims are not invalid. The *Swanson* court expressly agreed with the Office's current position (set forth in MPEP 2242 III A):

> "[The Office] instruct[s] examiners that a final court decision of a claim's validity will not preclude a finding of a substantial new question of validity based on the same art 'because of the different standards of proof employed by the Federal District Court and the Office,' MPEP § 2242. We agree with the PTO's current position."

MPEP 2242 III A provides, in pertinent part (emphasis added):

> ". . . the existence of a final court decision of claim *validity* in view of the same or different prior art does not necessarily mean that no new question is present, because of the different standards of proof employed by the Federal District Courts and the Office. While the Office may accord deference to factual findings made by the district court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, because it is not controlling on the Office."

Contrary to patent owner's position, therefore, the request for *ex parte* reexamination in the '9075 proceeding is valid under 35 U.S.C. 302, and is nowhere precluded by law.

For the reasons given above, the July 9, 2008 patent owner petition under 37 CFR 1.181 to vacate the order granting the request for reexamination in the '9075 proceeding, on the grounds that it is an *ultra vires* action on the part of the Office, is dismissed.

Return of Improper Papers

The July 9, 2008 patent owner petition was accompanied by the declaration of Scott W. Lewis, as well as exhibits 1-7. These papers, however, include issues that are not within the scope of reexamination, such as conduct issues. See MPEP 2258.

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[14] See *Abbott Labs. v. Syntron Bioresearch, Inc.*, 334 F.3d 1343; 2003 U.S. App. LEXIS 13825; 67 USPQ2d 1337 (Fed. Cir. 2003).

[15] The Federal Circuit reversed the district court's holding of noninfringement as to the asserted claims, and remanded as to those claims.

Exhibits 2-6 include issues relating to the conduct of the requester, such as the alleged strategy inside court (e.g., the reference to "corporate shell games" in exhibit 2) and outside of court (e.g., the reference to articles or blogs allegedly boasting of a certain strategy, providing advice regarding discovery subpoenas, or even accusations of violating the criminal code in exhibits 3-5). Exhibit 6, which is a non-merit decision on a motion for sanctions, clearly involves conduct issues, and is expressly listed in the MPEP as an example of a litigation paper which "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." See MPEP 2282. Furthermore, the entirety of the declaration of Scott W. Lewis summarizes, and in some cases elaborates on, the conduct issues contained in the exhibits. Finally, the July 9, 2008 patent owner petition, itself, also makes improper reference to alleged conduct issues such as "corporate shell games," advice regarding discovery subpoenas, sanctions, and accusations of violating the criminal code.[16] Exhibits 1, 2, and 7, which are copies of the default judgment for infringement, a complaint for patent infringement, a hearing on a motion to set aside the default judgment, and the notice of appeal of the default judgment, are litigation papers which ordinarily would not be entered into the public file, because they are not directed to the merits (again see MPEP 2282).

For the reasons given above, the July 9, 2008 patent owner petition, including the declaration of Scott W. Lewis, and accompanying exhibits 1-7, are improper, and will be expunged from the official file by closing these papers in the Office's Image File Wrapper (IFW) database. Papers which have been closed in the Office's IFW system are not part of the official file, and are not available to the public.

If the patent owner wishes that a copy of the July 9, 2008 patent owner petition be made of record in the official file, it must submit an identical copy of the July 9, 2008 patent owner petition, from which the paragraph bridging pages 2 and 3, footnote 1, and any parenthetical expressions referring to the declaration of Scott W. Lewis and/or the accompanying exhibits, have been redacted. An identical copy of exhibit 1, from which the complaint for patent infringement has been redacted, and an identical copy of exhibit 7, in its entirety, will also be made of record in the official file, if resubmitted with the above-described redacted copy of the July 9, 2008 patent owner petition, since they form the basis, albeit erroneous, for the present July 9, 2008 patent owner petition. The declaration of Scott W. Lewis and exhibits 2-6, if resubmitted, will not be entered since the entirety of these papers are directed to issues not within the scope of reexamination.

If any paper, including a petition, that contains issues not within the scope of reexamination, and particularly any paper, including a petition, that contains conduct issues, is submitted by either party in the future, that paper may not be entered into the file, and may be expunged from the patent file by closing these papers in the Office's IFW database if they were entered before discovery of their nature.

A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. David M. Quinlan. In the absence of a change of power of attorney listing Mr.

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[16] See the paragraph bridging pages 2 and 3, as well as footnote 1, of the July 9, 2008 petition.

Quinlan as an attorney of record and changing the correspondence address, 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 9, 2008 patent owner petition under 37 CFR 1.181 to vacate the order granting the request for reexamination in the '9075 proceeding is **dismissed**.

- The July 9, 2008 patent owner petition, including the declaration of Scott W. Lewis and accompanying exhibits 1-7, **will be expunged** from the official file, and will not be available to the public, by closing these papers in the Office's Image File Wrapper (IFW) system.

- Jurisdiction over the '9075 proceeding is being retained by the Office of Patent Legal Administration pending a response to this decision, or the expiration of time to respond to this decision.

Any 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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David M. Quinian
32 Nassau Street
Suite 300
Princeton, NJ 08542

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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CENTRAL REEXAMINATION UNIT

Joseph A. Sawyer, Jr.
Benman Collins & Sawyer
620 Hansen Way
Suite A
Palo Alto, CA 94304

(For Patent Owner)

Justin M. Sobaje
Foley & Lardner LLP
2029 Century Park East
Suite 3500
Los Angeles, CA 90067

(For Requester)

David M. Quinlan
32 Nassau Street
Suite 300
Princeton, NJ 08542

(Courtesy Copy)

In re Lewis
Ex Parte Reexamination Proceeding
Control No. 90/009,075
Filed: March 12, 2008
For: U.S. Patent No. 5,564,001

: **DECISION DISMISSING**
: **AND EXPUNGING PETITION**
: **AND ACCOMPANYING**
: **PAPERS**
:

This is a decision on the July 9, 2008 patent owner petition under 37 CFR 1.181 to vacate the May 15, 2008 order granting the request for reexamination in *ex parte* reexamination proceeding 90/009,075, on the grounds that it is *ultra vires* ("the July 9, 2008 patent owner petition").

This decision also addresses the July 23, 2008 requester opposition to the July 9, 2008 patent owner petition ("the July 23, 2008 requester opposition").

The July 9, 2008 patent owner petition under 37 CFR 1.181, the July 23, 2008 requester opposition, and the record as a whole are before the Office of Patent Legal Administration.

SUMMARY

The July 9, 2008 patent owner petition under 37 CFR 1.181 to vacate the May 15, 2008 order is **dismissed**.

The July 9, 2008 patent owner petition, including the declaration of Scott W. Lewis and accompanying exhibits 1-7, are **improper**, and **will be expunged** from the official file by closing these papers in the Office's Image File Wrapper (IFW) database.

REVIEW OF FACTS

- On October 8, 1996, U.S. Patent No. 5,564,001 ("the '001 patent") issued to Scott W. Lewis.

- On March 12, 2008, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/009,075 ("the '9075 proceeding").

- On May 15, 2008, an order granting the request for *ex parte* reexamination was mailed.

- On July 9, 2008, the patent owner filed the instant petition under 37 CFR 1.181 to vacate the May 15, 2008 order granting the request for reexamination ("the July 9, 2008 patent owner petition"). The July 9, 2008 patent owner petition is accompanied by a declaration of Scott W. Lewis, including exhibits 1-7.

- On July 23, 2008, the requester filed an opposition to the July 9, 2008 patent owner petition ("the July 23, 2008 requester opposition"). The July 23, 2008 requester opposition is accompanied by a declaration of Victor De Gyarfas.

- Office records fail to reveal that a patent owner's statement pursuant to 37 CFR 1.530(b) and (c) has been filed in response to the July 9, 2008 order.

- No first Office action on the merits has been mailed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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.

35 U.S.C. 303 provides:

> (a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.
> (b) A record of the Director 's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.
> (c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

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.

35 U.S.C. 311 provides:

(a) IN GENERAL. — Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS. — The request shall —
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an *inter partes* reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.
(c) COPY. — The Director promptly shall send a copy of the request to the owner of record of the patent.

35 U.S.C. 312 provides:

(a) REEXAMINATION. — Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.
(b) RECORD. — A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.
(c) FINAL DECISION. — A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the *inter partes* reexamination fee required under section 311.

35 U.S.C. 313 provides:

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for *inter partes* reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314.

35 U.S.C. 315(c) provides:

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

35 U.S.C. 317 provides:

(a) ORDER FOR REEXAMINATION. — Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION. — Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.181 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.

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

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

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

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

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

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 2242 III provides:

POLICY WHERE A FEDERAL COURT DECISION HAS BEEN ISSUED ON THE PATENT

A. Final Holding of Validity by the Courts.

When the initial question as to whether the prior art raises a substantial new question of patentability as to a patent claim is under consideration, the existence of a final court decision of claim *validity* in view of the same or different prior art does not necessarily mean that no new question is present, because of the different standards of proof employed by the Federal District Courts and the Office. While the Office may accord deference to factual findings made by the district court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, because it is not controlling on the Office.

B. Nonfinal Holding of Invalidity or Unenforceability by the Courts.

A *nonfinal* holding of claim *invalidity* or unenforceability will not be controlling on the question of whether a substantial new question of patentability is present.

C. Final Holding of Invalidity or Unenforceability by the Courts.

A *final* holding of claim *invalidity* or unenforceability, after all appeals, is controlling on the Office. In such cases, a substantial new question of patentability would *not* be present as to the claims finally held invalid or unenforceable.
As to *A.* - *C.* above, see *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).
Any situations requiring clarification should be brought to the attention of the Office of Patent Legal Administration.

MPEP 2246 II provides, in pertinent part:

PETITION TO VACATE THE ORDER GRANTING REEXAMINATION

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 . . .

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).

As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted. See the discussion in MPEP § 2242 subsection II.A. as to the criteria for vacating a reexamination order in view of the decision.

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.

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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 Request for Reexamination is Valid Under 35 U.S.C. 302

The patent owner urges the Office to vacate the order granting the request for reexamination in the '9075 proceeding, on the grounds that it is an *ultra vires* action on the part of the Office, because the patent owner believes that the request is not valid under 35 U.S.C. 302. This belief is stated to be based on *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320 (Fed. Cir. 2008).

In *Nasalok*, the court held that the defendant, against whom a default judgment of trademark infringement had been rendered in an earlier trademark infringement suit, was estopped from later asserting a claim of invalidity in a trademark cancellation proceeding before the Trademark Trial and Appeal Board (TTAB). In the present case, the patent owner has obtained a default judgment for damages in a suit for patent infringement in the United States District Court for the District of Nevada. See *1st Technology LLC v. Rational Enterprises, Ltda., Rational Poker School Limited, Bodog Entertainment Group S.A., Bodog.net, Bodog.com, and Futurebet Systems, Ltd.*, Case No. 2:06-cv-01110-RLH-GWF (D. Nev. 2007). Because the patent owner believes that the defendants in *1st Technology* are the real party in interest in the present reexamination, the patent owner urges the Office to vacate the order granting reexamination on the basis of "defendant preclusion" in light of *Nasalok*. The requester replies that the real party in interest in this case is not the same as the defendants in *1st Technology*.[1] **This decision does not address this issue.** This decision determines that the order granting *ex parte* reexamination in the '9075 proceeding is valid under 35 U.S.C. 302 even if the requester(s), i.e., the real party in interest, are the defendants in *1st Technology*, for the reasons discussed *infra*.[2]

The patent owner urges that the facts of the instant case are similar to those in *Nasalok*, and that the statutory language of 35 U.S.C. 302, i.e., "*any person at any time* may file a request for reexamination," is limited by the *Nasalok* decision to exclude requesters against whom a prior judgment has been rendered.[3] The facts of the present case, however, can easily be distinguished from *Nasalok*. *Nasalok* involves an appeal from a decision from the TTAB in a trademark cancellation proceeding. Trademark cancellation proceedings are ***inter partes*** proceedings.[4] The present '9075 reexamination proceeding, however, is an ***ex parte*** proceeding for the

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[1] See the last paragraph of page 2 of the July 23, 2008 requester opposition.

[2] **The "requester" in *ex parte* reexamination is the real party in interest.** The name and address of the legal representative of the requester is commonly placed in box no. 2 of the Request for *Ex Parte* Reexamination Transmittal Form PTO/SB/57, however, since the identity of the real party in interest is not required in *ex parte* reexamination.

[3] See the first sentence of the first full paragraph on page 3, the sentence bridging pages 6 and 7, and the sentence bridging pages 7 and 8 of the July 9, 2008 patent owner petition.

[4] See 15 U.S.C. 1064 and 1092.

reexamination of an issued patent. There are no "defendant preclusion" estoppel provisions in the *ex parte* reexamination statute.[5] On the other hand, Congress specifically provided for such estoppel provisions in 35 U.S.C. 315(c) and particularly, in 35 U.S.C. 317,[6] of the *inter partes* reexamination statute.[7] If "defendant preclusion" was applicable to reexamination, then there would have been no need for Congress to expressly provide for such estoppel provisions in the *inter partes* reexamination statute. Also, the fact that Congress provided for the estoppel provision for *inter partes* reexamination via The American Inventors Protection Act (AIPA), signed into law on November 29, 1999,[8] while not doing so for *ex parte* reexamination,[9] shows an intent of Congress that "defendant preclusion" does not apply to *ex parte* reexamination.

The patent owner, in the present petition, emphasizes that it does not base the instant petition on whether the request for reexamination raises a substantial new question of patentability; rather, the patent owner urges that whether or not a substantial new question of patentability is raised, the requester is estopped from asserting, in the '9075 proceeding, that the claims are unpatentable.[10] Attention, however, is drawn to *In re Swanson*, 2008 U.S. App. LEXIS 18928 (Fed. Cir. Sept. 4, 2008). In *Swanson*, the Federal Circuit affirmed the holding of the Board of Patent Appeals and Interferences ("the Board") that a prior district court judgment adverse to the third party reexamination requester did not prevent the United States Patent and Trademark Office ("the Office") from determining that a substantial new question of patentability had been raised by the prior art, even though a federal court previously considered the validity of the same asserted claims of the patent over the same prior art.[11]

While the holding of *Swanson* specifically relates to issue preclusion, rather than to claim preclusion, which is at issue here, the facts of *Swanson* are of particular interest. In *Swanson*, the third party requester, Syntron Bioresearch, Inc., filed a request for *ex parte* reexamination of certain claims of the patent **after** a district court holding[12] against the requester/defendant, Syntron, that the same patent claims were not invalid over the same prior art[13] raised in the reexamination, **after** the Federal Circuit affirmed, on appeal, the district court's decision that the

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[5] See generally 35 U.S.C. 302-307.

[6] 35 U.S.C. 317 of the *inter partes* reexamination statute specifically provides, in pertinent part:

> "Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action . . . and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter".

[7] See generally 35 U.S.C. 311-318.

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

[9] Compare the provisions of 35 U.S.C. 302-307 of the *ex parte* reexamination statute, which are silent with respect to the issue of estoppel, with those of the *inter partes* reexamination statute, particularly, 35 U.S.C. 315(c) and 35 U.S.C. 317.

[10] See the first full paragraph of page 8 of the July 9, 2008 patent owner petition.

[11] Citing, with approval, *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit agreed with the Office's position, set forth in MPEP 2242, that "Congress did not intend a prior court judgment upholding the validity of a claim to prevent the PTO from finding a substantial new question of patentability regarding an issue that has never been considered by the PTO."

[12] See *Abbott Labs. v. Syntron Bioresearch, Inc.*, 2001 U.S. Dist. LEXIS 25125 (S.D. Cal. Oct. 12, 2001).

[13] The prior art at issue in *Swanson* and *Abbott Labs* was the Deutsch reference, U.S. Patent 4,094,647.

same patent claims were not invalid, and **after** the Federal Circuit rendered a judgment of infringement against the requester/defendant Syntron as to these claims.[14]

The *Swanson* court's silence with respect to defendant preclusion (even though the reexamination requester was the defendant in the litigation), coupled with the *Swanson* court's approval of the Office's position on issue preclusion, clearly implies that the Office may issue an order granting *ex parte* reexamination involving any issue that the requester raised or could have raised in earlier litigation of the patent under reexamination, in which a prior judgment of validity and/or infringement against the requester/defendant has been rendered by a federal court.

It is noted that the Federal Circuit's earlier judgment of infringement against defendant Syntron, on appeal, was not a final decision.[15] However, a requester may file a request for *ex parte* reexamination even after a final judgment that the patent claims are not invalid. The *Swanson* court expressly agreed with the Office's current position (set forth in MPEP 2242 III A):

> "[The Office] instruct[s] examiners that a final court decision of a claim's validity will not preclude a finding of a substantial new question of validity based on the same art 'because of the different standards of proof employed by the Federal District Court and the Office,' MPEP § 2242. We agree with the PTO's current position."

MPEP 2242 III A provides, in pertinent part (emphasis added):

> ". . . the existence of a final court decision of claim *validity* in view of the same or different prior art does not necessarily mean that no new question is present, because of the different standards of proof employed by the Federal District Courts and the Office. While the Office may accord deference to factual findings made by the district court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, because it is not controlling on the Office."

Contrary to patent owner's position, therefore, the request for *ex parte* reexamination in the '9075 proceeding is valid under 35 U.S.C. 302, and is nowhere precluded by law.

For the reasons given above, the July 9, 2008 patent owner petition under 37 CFR 1.181 to vacate the order granting the request for reexamination in the '9075 proceeding, on the grounds that it is an *ultra vires* action on the part of the Office, is dismissed.

Return of Improper Papers

The July 9, 2008 patent owner petition was accompanied by the declaration of Scott W. Lewis, as well as exhibits 1-7. These papers, however, include issues that are not within the scope of reexamination, such as conduct issues. See MPEP 2258.

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[14] See *Abbott Labs. v. Syntron Bioresearch, Inc.*, 334 F.3d 1343; 2003 U.S. App. LEXIS 13825; 67 USPQ2d 1337 (Fed. Cir. 2003).

[15] The Federal Circuit reversed the district court's holding of noninfringement as to the asserted claims, and remanded as to those claims.

Exhibits 2-6 include issues relating to the conduct of the requester, such as the alleged strategy inside court (e.g., the reference to "corporate shell games" in exhibit 2) and outside of court (e.g., the reference to articles or blogs allegedly boasting of a certain strategy, providing advice regarding discovery subpoenas, or even accusations of violating the criminal code in exhibits 3-5). Exhibit 6, which is a non-merit decision on a motion for sanctions, clearly involves conduct issues, and is expressly listed in the MPEP as an example of a litigation paper which "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." See MPEP 2282. Furthermore, the entirety of the declaration of Scott W. Lewis summarizes, and in some cases elaborates on, the conduct issues contained in the exhibits. Finally, the July 9, 2008 patent owner petition, itself, also makes improper reference to alleged conduct issues such as "corporate shell games," advice regarding discovery subpoenas, sanctions, and accusations of violating the criminal code.[16] Exhibits 1, 2, and 7, which are copies of the default judgment for infringement, a complaint for patent infringement, a hearing on a motion to set aside the default judgment, and the notice of appeal of the default judgment, are litigation papers which ordinarily would not be entered into the public file, because they are not directed to the merits (again see MPEP 2282).

For the reasons given above, the July 9, 2008 patent owner petition, including the declaration of Scott W. Lewis, and accompanying exhibits 1-7, are improper, and will be expunged from the official file by closing these papers in the Office's Image File Wrapper (IFW) database. Papers which have been closed in the Office's IFW system are not part of the official file, and are not available to the public.

If the patent owner wishes that a copy of the July 9, 2008 patent owner petition be made of record in the official file, it must submit an identical copy of the July 9, 2008 patent owner petition, from which the paragraph bridging pages 2 and 3, footnote 1, and any parenthetical expressions referring to the declaration of Scott W. Lewis and/or the accompanying exhibits, have been redacted. An identical copy of exhibit 1, from which the complaint for patent infringement has been redacted, and an identical copy of exhibit 7, in its entirety, will also be made of record in the official file, if resubmitted with the above-described redacted copy of the July 9, 2008 patent owner petition, since they form the basis, albeit erroneous, for the present July 9, 2008 patent owner petition. The declaration of Scott W. Lewis and exhibits 2-6, if resubmitted, will not be entered since the entirety of these papers are directed to issues not within the scope of reexamination.

If any paper, including a petition, that contains issues not within the scope of reexamination, and particularly any paper, including a petition, that contains conduct issues, is submitted by either party in the future, that paper may not be entered into the file, and may be expunged from the patent file by closing these papers in the Office's IFW database if they were entered before discovery of their nature.

A courtesy copy of this decision will be mailed to the attorney who submitted the instant petition, Mr. David M. Quinlan. In the absence of a change of power of attorney listing Mr.

[16] See the paragraph bridging pages 2 and 3, as well as footnote 1, of the July 9, 2008 petition.

Quinlan as an attorney of record and changing the correspondence address, 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 9, 2008 patent owner petition under 37 CFR 1.181 to vacate the order granting the request for reexamination in the '9075 proceeding is **dismissed**.

- The July 9, 2008 patent owner petition, including the declaration of Scott W. Lewis and accompanying exhibits 1-7, **will be expunged** from the official file, and will not be available to the public, by closing these papers in the Office's Image File Wrapper (IFW) system.

- Jurisdiction over the '9075 proceeding is being retained by the Office of Patent Legal Administration pending a response to this decision, or the expiration of time to respond to this decision.

Any 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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Sawyer Law Group PC
2465 E. Bayshore Road
Suite No. 406
Palo Alto, CA 94303

(For Patent Owner)

MAILED

SEP 24 2009

CENTRAL REEXAMINATION UNIT

Foley & Lardner LLP
555 S. Flower Street
Suite 3500
Los Angeles, CA 90071
Attn.: Justin M. Sobaje

(For Requester)

In re Lewis
Ex Parte Reexamination Proceeding
Control No. 90/009,075
Filed: March 12, 2008
For: U.S. Patent No. 5,564,001

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

This is a decision on the November 3, 2008 renewed patent owner petition under 37 CFR 1.181 to vacate the May 15, 2008 order granting the request for reexamination in *ex parte* reexamination proceeding 90/009,075, on the grounds that it is *ultra vires* ("the November 3, 2008 renewed patent owner petition").

This decision also addresses the November 17, 2008 requester opposition to the November 3, 2008 renewed patent owner petition ("the November 17, 2008 requester opposition").

The November 3, 2008 renewed patent owner petition under 37 CFR 1.181, the November 17, 2008 requester opposition, and the record as a whole are before the Office of Patent Legal Administration.

SUMMARY

The November 3, 2008 renewed patent owner petition under 37 CFR 1.181 to vacate the May 15, 2008 order is **dismissed**.

REVIEW OF FACTS

- On October 8, 1996, U.S. Patent No. 5,564,001 ("the '001 patent") issued to Scott W. Lewis.

- On March 12, 2008, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/009,075 ("the '9075 proceeding").

- On May 15, 2008, an order granting the request for *ex parte* reexamination was mailed.

- On July 9, 2008, the patent owner filed a petition under 37 CFR 1.181 to vacate the May 15, 2008 order granting the request for reexamination ("the July 9, 2008 patent owner petition"). The July 9, 2008 patent owner petition is accompanied by a declaration of Scott W. Lewis, including exhibits 1-7.

- On July 23, 2008, the requester filed an opposition to the July 9, 2008 patent owner petition ("the July 23, 2008 requester opposition").

- On September 17, 2008, a decision dismissing and expunging the July 9, 2008 patent owner petition was mailed by the Office.

- On November 3, 2008, the patent owner filed the instant renewed petition under 37 CFR 1.181 to vacate the May 15, 2008 order granting the request for reexamination ("the November 3, 2008 renewed patent owner petition"). The November 3, 2008 renewed patent owner petition is accompanied by a redacted version of the July 9, 2008 patent owner petition, and redacted versions of the declaration of Scott W. Lewis and accompanying exhibits 1, 3, and 7, the originals of which were submitted on July 9, 2008.

- On November 17, 2008, the requester filed an opposition to the November 3, 2008 renewed patent owner petition ("the November 17, 2008 requester opposition").

- On November 21, 2008, a first Office action was mailed.

- The '9075 proceeding has progressed to the point where, on July 7, 2009, a final Office action was mailed.

- On September 2, 2009, the patent owner filed an amendment after final.

- On September 9, 2009, a supplemental amendment after final was mailed.

- On September 18, 2009, an advisory action was mailed in response to the September 2, 2009 after final amendment.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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.

35 U.S.C. 303 provides:

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.
(b) A record of the Director 's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.
(c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

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.

35 U.S.C. 311 provides:

(a) IN GENERAL. — Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS. — The request shall —
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an *inter partes* reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.
(c) COPY. — The Director promptly shall send a copy of the request to the owner of record of the patent.

35 U.S.C. 312 provides:

(a) REEXAMINATION. — Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.
(b) RECORD. — A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.
(c) FINAL DECISION. — A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the *inter partes* reexamination fee required under section 311.

35 U.S.C. 313 provides:

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for *inter partes* reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the *inter partes* reexamination conducted in accordance with section 314.

35 U.S.C. 315(c) provides:

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

35 U.S.C. 317 provides:

(a) ORDER FOR REEXAMINATION. — Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION. — Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.181 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.

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

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

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

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

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

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 2242 III provides:

POLICY WHERE A FEDERAL COURT DECISION HAS BEEN ISSUED ON THE PATENT

A. Final Holding of Validity by the Courts.

When the initial question as to whether the prior art raises a substantial new question of patentability as to a patent claim is under consideration, the existence of a final court decision of claim *validity* in view of the same or different prior art does not necessarily mean that no new question is present, because of the different standards of proof employed by the Federal District Courts and the Office. While the Office may accord deference to factual findings made by the district court, the

determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, because it is not controlling on the Office.

B. Nonfinal Holding of Invalidity or Unenforceability by the Courts.

A *nonfinal* holding of claim *invalidity* or unenforceability will not be controlling on the question of whether a substantial new question of patentability is present.

C. Final Holding of Invalidity or Unenforceability by the Courts.

A *final* holding of claim *invalidity* or unenforceability, after all appeals, is controlling on the Office. In such cases, a substantial new question of patentability would *not* be present as to the claims finally held invalid or unenforceable.

As to *A.* - *C.* above, see *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). Any situations requiring clarification should be brought to the attention of the Office of Patent Legal Administration.

MPEP 2246 II provides, in pertinent part:

PETITION TO VACATE THE ORDER GRANTING REEXAMINATION

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 . . .

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).

As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted. See the discussion in MPEP § 2242 subsection II.A. as to the criteria for vacating a reexamination order in view of the decision.

MPEP 2286, which provides, in pertinent part:

Note the following two Federal Circuit decisions involving reexamination proceedings where the court affirmed the Office's rejections even though parallel district court proceeding upheld the claims as valid and infringed. *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 83 USPQ2d 1835 (Fed. Cir. 2007) and *In re Translogic Technology*, Inc., 504 F.3d 1249, 84 USPQ2d 1929 (Fed. Cir. 2007).

In *Trans Texas*, the patent being reexamined was subject to an infringement suit, in which the district court had issued its claim construction ruling (in a district court opinion) as to the definition of a term. The parties ultimately reached a settlement before trial, and the district court issued an "Order of Dismissal with Prejudice." The patent owner relied on that district court claim construction ruling in a reexamination proceeding, and argued that the Office was bound by that district court claim construction ruling, under the doctrine of issue preclusion. The Federal Circuit stated that issue preclusion could not be applied against the Office based on a district court holding in an infringement proceeding, since the Office was not a party to that earlier infringement proceeding.

In *Translogic*, a district court infringement suit proceeded in parallel with a reexamination proceeding. The district court upheld the validity of the patent in the infringement suit, while the reexamination examiner found the claim combination to be obvious . The examiner's rejection was affirmed by the Board of Patent Appeals and
Interferences (Board). The defendant (the alleged infringer) of the infringement suit appealed the district court decision to the Federal Circuit, while the patent owner appealed the Board's decision to the Federal Circuit. The Federal Circuit consolidated the appeals, and then addressed only the patent owner's reexamination appeal from the Board. The Federal Circuit affirmed the examiner's conclusion of obviousness by relying upon and providing an extensive discussion of *KSR International Co. v. Teleflex Inc.*, 550 U.S.___, 82 USPQ2d 1385 (2007).

DECISION

The patent owner urges the United States Patent and Trademark Office ("the Office") to vacate the order granting the request for reexamination in the '9075 proceeding, on the grounds that it is an *ultra vires* action on the part of the Office, because the patent owner believes that the request is not valid under 35 U.S.C. 302.[1] This belief is stated to be based on *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320 (Fed. Cir. 2008).

In *Nasalok*, the court held that the defendant, against whom a default judgment of trademark infringement had been rendered in an earlier trademark infringement suit, was estopped from later asserting a claim of invalidity in a trademark cancellation proceeding before the Trademark Trial and Appeal Board (TTAB). In the present case, the patent owner has obtained a default judgment for damages in a suit for patent infringement in the United States District Court for the District of Nevada. See *1st Technology LLC v. Rational Enterprises, Ltda., Rational Poker School Limited, Bodog Entertainment Group S.A., Bodog.net, Bodog.com, and Futurebet Systems, Ltd.*, Case No. 2:06-cv-01110-RLH-GWF (D. Nev. 2007). Because the patent owner

[1] See page 7 of the November 3, 2008 renewed patent owner petition.

believes that the defendants in *1st Technology* are the real party in interest in the present reexamination, the patent owner urges the Office to vacate the order granting reexamination on the basis of "defendant preclusion" in light of *Nasalok*. The requester replies that the real party in interest in this case is not the same as the defendants in *1st Technology*.[2] This decision, however, does not address the issue of the identity of the real party in interest, because there is no requirement in the *ex parte* reexamination statute for the identification of the real party in interest. For this reason, the arguments of the parties as to who may or may not be the real party in interest are not relevant to this *ex parte* reexamination proceeding.[3] This decision determines that the order granting *ex parte* reexamination in the '9075 proceeding is valid under 35 U.S.C. 302 even if the requester(s), i.e., the real party in interest, are the defendants in *1st Technology*, for the reasons discussed *infra*.

The patent owner has emphasized that it does not base the present petition on whether the request for reexamination raises a substantial new question of patentability; rather, the patent owner urges that whether or not a substantial new question of patentability is raised, the requester is estopped from asserting, in the '9075 proceeding, that the claims are unpatentable.[4] The patent owner urges that the facts of the instant case are similar to those in *Nasalok*, and that the statutory language of 35 U.S.C. 302, i.e., "*any person at any time* may file a request for reexamination," is limited by the *Nasalok* decision to exclude requesters against whom a prior judgment has been rendered. The facts of the present case, however, can easily be distinguished from *Nasalok*.

Nasalok involves an appeal from a decision from the TTAB in a trademark cancellation proceeding. Trademark cancellation proceedings are *inter partes* Office proceedings.[5] The present '9075 reexamination proceeding, however, is an *ex parte* proceeding for the reexamination of an issued patent. There are no "claim preclusion" provisions in the *ex parte* reexamination statute.[6] On the other hand, Congress specifically provided for provisions in 35 U.S.C. 315(c) and particularly, in 35 U.S.C. 317, of the *inter partes* reexamination statute,[7] that include elements of both claim preclusion and issue preclusion.

The patent owner essentially argues that § 317 of the *inter partes* reexamination statute does not refer to the doctrine of claim preclusion.[8] The patent owner appears to assume that the provisions of 35 U.S.C. 317 refer only to the doctrine of issue preclusion. The *inter partes* reexamination statute, however, does not expressly incorporate either doctrine. It stands by itself. 35 U.S.C. 317(b) provides, in pertinent part (emphasis in bold italics added):

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[2] See pages 2-3 of the November 17, 2008 requester opposition.

[3] The "requester" in *ex parte* reexamination is the real party in interest. The name and address of the legal representative of the requester is commonly placed in box no. 2 of the Request for *Ex Parte* Reexamination Transmittal Form PTO/SB/57, since the identity of the real party in interest is not required in *ex parte* reexamination.

[4] See the first full paragraph of page 8 of the July 9, 2008 patent owner petition.

[5] See 15 U.S.C. 1064 and 1092.

[6] See generally 35 U.S.C. 302-307.

[7] See generally 35 U.S.C. 311-318.

[8] See the paragraph bridging pages 6 and 7 of the November 3, 2008 renewed patent owner petition.

> FINAL DECISION. — Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies ***raised or could have raised*** in such civil action . . . and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office . . . [9]

The statute incorporates elements of issue preclusion *and* of claim preclusion. "Claim preclusion refers to 'the effect of foreclosing any litigation of matters that *never have been litigated*, because of a determination that they *should have been advanced* in an earlier suit'." *Nasalok*, 522 F.3d at 1323 (emphasis added).[10] The principle distinction between claim preclusion and issue preclusion is that the former forecloses litigation of matters that have *never been litigated.*[11] 35 U.S.C. 317(b) clearly prohibits a requester from requesting, and the Office from maintaining, an *inter partes* reexamination of a patent claim on the basis of issues which the requester *raised, or could have raised*, in a civil action as defined in the statute. In other words, the statute forecloses *inter partes* reexamination on the basis of issues that *have been litigated* (i.e., *raised*), which is an element of issue preclusion. The statute also forecloses *inter partes* reexamination on the basis of issues that have not been litigated, but *should have been advanced* (i.e., *could have been raised*), which is the primary element of claim preclusion.

If the doctrine of claim preclusion was applicable to reexamination in general, then there would have been no need for Congress to expressly provide for the specific provisions of 35 U.S.C. 315(c) and 35 U.S.C. 317(b) of the *inter partes* reexamination statute. In addition, the fact that Congress provided for such provisions for *inter partes* reexamination via The American Inventors Protection Act (AIPA), signed into law on November 29, 1999,[12] while not doing so for *ex parte* reexamination,[13] shows an intent of Congress that the doctrine of claim preclusion in general, and the specific elements of claim preclusion set forth in the *inter partes* reexamination statute, do not apply to *ex parte* reexamination.

In essence, the patent owner argues that just as the defendant in *Nasalok* was estopped from later asserting a claim of invalidity in a trademark cancellation proceeding before the TTAB, because a default judgment of trademark infringement had been rendered against him in an earlier

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[9] See also 35 U.S.C. 315(c), which provides, in pertinent part (emphasis added):

> "CIVIL ACTION. — A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester ***raised or could have raised*** during the inter partes reexamination proceedings."

[10] See also *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1362; 55 USPQ2d 1854 (Fed. Cir. 2000), quoting *Migra v. Warren City School Dist. Bd. of Educ.*, 465 U.S. 75, 77 n.1, 104 S.Ct. 892 (1984).

[11] See, e.g., *Black's Law Dictionary,* definition of "claim preclusion", quoting Charles Alan Wright, *The Law of Federal Courts,* §100A, at 723.

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

[13] Compare the provisions of 35 U.S.C. 302-307 of the *ex parte* reexamination statute, which are silent with respect to prohibitions such as those set forth in 35 U.S.C. 317, with those of the *inter partes* reexamination statute, particularly, 35 U.S.C. 315(c) and 35 U.S.C. 317.

trademark infringement suit, the defendant/requester in the present reexamination proceeding is estopped from asserting that the claims are unpatentable, because a default judgment of patent infringement has been rendered against it in an earlier patent infringement suit..

One of the essential elements of claim preclusion (res judicata), however, is the involvement of the same parties, or parties in privity with the original parties.[14] "[A] second suit will be barred by claim preclusion if . . . there is identity of parties (or their privies) . . .". *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1362; 55 USPQ2d 1854 (Fed. Cir. 2000). In *Jet,* the court stated that the parties (Jet and SAS) were identical in both the earlier suit for infringement and in the later trademark cancellation proceeding. In an *ex parte* reexamination proceeding, however, the Office becomes a party to the proceeding once an *ex parte* reexamination request is properly filed. There is no identity of parties in the present case, because the Office was not a party to the earlier infringement suit. See *In re Trans Texas Holdings Corp.,* 498 F.3d 1290, 83 USPQ2d 1835 (Fed. Cir 2007), in which the court held that issue preclusion could not be applied against the Office based on a district court holding in an infringement proceeding, because the Office was not a party to the earlier infringement proceeding. See also *In re Swanson*, 540 F.3d 1368, 1375, 88 USPQ2d 1196 (Fed. Cir. 2008), in which the court stated (emphasis added):

> PTO examination procedures have *distinctly different* standards, *parties*, purposes, and outcomes *compared to civil litigation.*

Once a reexamination request is properly filed, the Office, which is authorized to protect the public from the existence of patents that do not meet the standards of patentability, becomes a party to the proceeding. See MPEP 2210,[15] which provides, in pertinent part:

> After the request for reexamination, including the entire fee for requesting reexamination, is received in the Office, no abandonment, withdrawal, or striking of the request is possible, regardless of who requests the same.

The Office is required by statute to proceed with the determination of whether a substantial new question of patentability is raised by the request, once the request is properly filed. See 35 U.S.C. 303(a) which provides, in pertinent part (emphasis added):[16]

> *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.

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[14] See *Hallco v. Foster*, 256 F.3d 2190, 59 USPQ2d 1346 (Fed. Cir. 2001): "Simply put, the doctrine of res judicata provides that when a final judgment has been entered on the merits of a case, 'it is a finality as to the claim or demand in controversy, concluding *parties and those in privity with them*, not only as to every matter which as offered and received to sustain or defeat the claim or demand, but as to any other admissible matter which might have been offered for that purpose'." (citations omitted) (emphasis added). See also the definition of "res judicata", *Black's Law Dictionary*, 7th Ed., (1999), quoting *Restatement (Second) of Judgments,* §§17, 24 (1982).

[15] A substantially identical statement appears in the *inter partes* reexamination chapter of the Manual of Patent Examining Procedure (MPEP), in MPEP 2610.

[16] See also 35 U.S.C. 312(a) of the *inter partes* reexamination statute.

If the Office determines that a substantial new question of patentability is raised by the request, the Office is required to proceed with reexamination. See 35 U.S.C. 304, which provides:[17]

> 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 retention of a reexamination after it is filed is a public right, and the Office, which serves to protect the rights of the public, is a party to the proceeding, which protects the public from an unjustified monopoly on claimed subject matter, when that subject matter is not patentable. "Reexamination is . . . neutral, the patentee and the public having an equal interest in the issuance and maintenance of valid patents." *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988), quoting *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4 (Fed. Cir. 1985) (emphasis added).[18]

Furthermore, *ex parte* reexamination does not involve any third party participation in the examination and appeal stages of the proceeding. *Ex parte* reexamination is solely a proceeding between the patent owner and the Office, with the Office protecting the public from the existence of patents that do not meet the statutory requirements for patentability. Thus, the public, who is represented by the Office, is truly the party to the proceeding whose interest is addressed in an *ex parte* reexamination.

It is to be noted that the Office is required by statute to participate in an appeal from the Board of Patent Appeals and Interferences ("the Board") to the Federal Circuit, when the appeal involves "any ex parte case or any reexamination case". See 35 U.S.C. 143,[19] which provides, in pertinent part:

> . . . In an ex parte case or any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

In other words, the Office *is a party* to an appeal of any Board decision *in any reexamination proceeding* to the Federal Circuit, whether the proceeding is *ex parte* or *inter partes*.[20] This

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[17] See also 35 U.S.C. 313 of the *inter partes* reexamination statute.

[18] The fact that reexamination is a vehicle for the protection of the public is underscored by the fact that even if reexamination of the '001 patent was never requested, the Office could order *ex parte* reexamination on its own initiative based on the same issues currently raised by the requester. This authority to protect the public was provided to the Office by Congress in 35 U.S.C. 303(a).

[19] 35 U.S.C. 143 also applies to normal *ex parte* appeals from, for example, a Board decision in a utility patent application, and is the provision that requires the Office to participate in such an appeal from the Board to the Federal Circuit.

[20] For example, even if an appeal is made by a third party requester of a Board decision in an *inter partes* reexamination proceeding, the only parties to the appeal may be the appellant/third party requester, *and the Office*. The patent owner need not be a party to the appeal. See 35 U.S.C. 315(a)(1), which provides that the patent owner "*may* be a party to any appeal taken by a third party requestor under subsection (b)." Thus, in an appeal by a third

clearly distinguishes a patent reexamination proceeding from a trademark cancellation proceeding, which is the subject of *Jet* and of *Nasalok*. Both *Jet* and *Nasalok* involved an appeal to the Federal Circuit of a decision by the TTAB. In both *Jet* and *Nasalok*, the Office was not one of the parties before the Federal Circuit. The defendant in the earlier trademark infringement suit, which asserted a claim of invalidity before the TTAB, however, was a party before the Federal Circuit. In an *ex parte* reexamination proceeding, however, the third party requester may not be a party to an appeal of a Board decision to the Federal Circuit; there is simply no statutory basis for the third party requester to be a party. On the other hand, in *any* reexamination proceeding, the Office is *required by statute* to be party to an appeal of a Board decision to the Federal Circuit. The provisions of the reexamination statute, therefore, are clearly distinguished from those of the trademark statute.

Thus, claim preclusion does not apply in the present case, because the Office was not a party, or in privy with a party, in the earlier infringement suit.

The patent owner urges that the statutory language of 35 U.S.C. 302, i.e., "*any person at any time* may file a request for reexamination," is limited by the *Nasalok* decision to exclude requesters against whom a prior judgment has been rendered, i.e., "adjudicated infringers." 35 U.S.C. 302 provides, in pertinent part:

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

The plain language of this reexamination statute is not construed to preclude the filing of a request for *ex parte* reexamination by an "adjudicated infringer". The patent owner has not pointed to any limitation of the statute that would even hint at this result. Looking to the case law, "[i]f the statutory language is unambiguous, in absence of a 'clearly expressed legislative intent to the contrary, that language must ordinarily be regarded as conclusive.'" *U.S. v. Turkette*, 452 U.S. 576, 580 (1981) (quoting *Consumer Product Safety Comm'n v. GTE Sylvania, Inc.*, 447 U.S. 102, 108 (1980). The patent owner has advanced no such "clearly expressed legislative intent" to preclude the filing of a request for *ex parte* reexamination by an "adjudicated infringer".

Furthermore, in *In re Swanson*, 540 F.3d 1368, 1375, 88 USPQ2d 1196 (Fed. Cir. 2008), the court stated (emphasis added):

> [T]he legislative history for both the original and amended reexamination statute suggest that Congress was concerned only with the consideration of issues in prior PTO

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party requester of a Board decision in an *inter partes* reexamination, 35 U.S.C. 315(a)(1) permits the patent owner to participate in the appeal by the third party requester, but does not require that participation. 35 U.S.C. 143, however, *requires the Office to participate* in such an appeal. Similarly, if an appeal is made by a patent owner of a Board decision in an *inter partes* reexamination proceeding, the third party requester may participate in the appeal, subject to the provisions of 35 U.S.C. 315(c), but is not required to participate. See 35 U.S.C. 315(b). The Office, however, is required to participate. Note, however, that the Office would not normally be a party to an appeal from an *inter partes* interference proceeding, because an interference proceeding is not an "ex parte case" or "any reexamination case", as specified by 35 U.S.C. 143.

> examinations, *not prior civil litigation*. For example, in passing the original reexamination statute, Congress stated that "this new procedure will permit *any party* to petition the patent office to review the efficacy of a patent . . ." Not once in the legislative history did Congress refer to references or issues addressed in prior civil litigation. See, e.g., H.R. Rep. NO. 120-107; H.R. Rep. No. 96-1307(I).

The Congressional intent of the reexamination statute, as noted by the *Swanson* court, is to permit *any party* to request reexamination. The patent owner has not pointed to any legislative history that would indicate that Congress intended to limit "any party" to a party who was not an adjudicated infringer. The *Swanson* court also confirmed that "any person" may file a request for reeexamination, to fulfill the intent of Congress to provide a "quality check" on patents: [21]

> Any person may file a request for an ex parte reexamination of an issued patent based on prior art patents or printed publications. *35 U.S.C. § 302*. Congress intended reexaminations to provide an important "quality check" on patents that would allow the government to remove defective and erroneously granted patents. H.R. Rep. No. 107-120 (2202); *see also In re Recreative Techs. Corp.*, 83 F.3d 1394, 1396-97 (Fed. Cir. 1996) ("The reexamination statute's purpose is to correct errors made by the government . . . and if need be to remove patents that never should have been granted." (quoting *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 604 (Fed. Cir.1985))).

The patent owner argues that a subsequent reexamination of the patent is precluded by an earlier default judgment of infringement by the district court, because the defendant in the earlier suit "could have raised" the defense of invalidity. However, even if there was a final holding in the earlier infringement suit that the claims were not invalid, this holding would not necessarily be inconsistent with a subsequent holding of claim invalidity by a federal court, or by a subsequent determination by the Office that the claims are not patentable. See, for example, *Swanson*, in which the court stated (internal citations omitted) (emphasis in original):[22]

> [C]ourts do not find patents "valid," only that the patent challenger did not carry the "burden of establishing invalidity in the *particular case* before the court. Therefore, "a prior holding of validity is not necessarily inconsistent with a subsequent holding of invalidity," and is not binding on subsequent litigation or PTO reexaminations.

See also *Ethicon v. Quigg*, 849 F.2d 1422, 1429 n.3 (Fed. Cir. 1988), in which the court stated that "[a] patent is not held valid for all purposes but, rather, not invalid on the record before the court." In a first suit, for example, a defendant may not have overcome the statutory presumption of invalidity; however, in a subsequent suit, the defendant may overcome it. The difference in outcome may be attributable to, for example, different prior art references or different records.[23] Thus, subsequent reexamination of the patent would not be precluded by an earlier court judgment that the claims are not invalid. The fact that the issue of invalidity was

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[21] *Swanson*, 540 F.3d at 1375.

[22] See *Swanson*, 540 F.3d at 1377, quoting *Ethicon v. Quigg*, 849 F.2d 1422, 1429 n.3 (Fed. Cir. 1988) and *Stevenson v. Sears Roebuck & Co.*, 713 F.2d 705, 710 (Fed. Cir. 1983).

[23] See *Stevenson*, 713 F.2d at 710.

not, but could have been litigated, is not relevant where, as here, reexamination would not have been barred even if the issue of invalidity was actually litigated in the earlier infringement suit. Even if the prior art references in the earlier infringement suit were identical to those in the subsequent reexamination proceeding and were cited against the same claims as those at issue in the earlier infringement suit, however, a prior final holding that the claims are not invalid would not bar reexamination, for the reasons discussed *infra*.

Claim preclusion acts to foreclose litigation of a matter that has never been litigated, because of a determination that it should have been advanced in an earlier suit.[24] The patent owner appears to argue, as noted by the requester in the November 17, 2008 opposition, that no patent upon which an infringement judgment has previously been based could ever be reexamined by the Office, because a determination by the Office that the claims are unpatentable would "conflict" with the infringement judgment. The patent owner urges that the patentability determination by the Office would conflict with the infringement judgment, because the defendant "could have advanced" the issue of invalidity in the earlier infringement suit. The determination of the patentability of the claims before the Office, however, could not have been "advanced" in an earlier suit, because the district court, in the earlier suit, would not have "examined" the claims for patentability using the standards employed by the Office. The standards of the Office in determining the patentability of patent claims differ from those used in the courts to determine invalidity. See *Ethicon v. Quigg*, 849 F.2d 1422, 1428 (Fed. Cir. 1988) (citations omitted):

> [C]hallenging validity in a court and requesting PTO reexamination are "concepts not in conflict".

See also *Swanson*, in which the court stated:[25]

> The focus on previous examinations rather than prior litigation follows from the fact that "reexamination[s are] conducted according to the procedures established for initial examination," *35 U.S.C. § 305*, and PTO examination procedures have distinctly different standards, parties, purposes, and outcomes compared to civil litigation, *In re Etter, 756 F.2d 852, 856 (Fed. Cir. 1985).*

In *Swanson,* the Federal Circuit affirmed the holding of the Board that a prior district court judgment adverse to the third party reexamination requester did not bar reexamination of the patent claims over prior art, even though a federal court previously considered the validity of the same asserted claims of the patent over the same prior art.[26] The *Swanson* court noted:

> In particular, "the two forums take different approaches in determining validity and on the same evidence could quite correctly come to different conclusions" (quoting *Ethicon v.*

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[24] See *Jet*, 223 F.3d at 1362, quoting *Migra v. Warren City School Dist. Bd. of Educ.*, 465 U.S. 75, 77 n.1, 104 S.Ct. 892 (1984).

[25] See *Swanson*, 540 F.3d at 1377.

[26] Citing, with approval, *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit agreed with the Office's position, set forth in MPEP 2242, that "Congress did not intend a prior court judgment upholding the validity of a claim to prevent the PTO from finding a substantial new question of patentability regarding an issue that has never been considered by the PTO."

> *Quigg,* 849 F.2d 1422, 1428 (Fed. Cir. 1988)) . . . In civil litigation, a challenger who attacks the validity of patent claims must overcome the presumption of validity with clear and convincing evidence that the patent is invalid. 35 U.S.C. § 282 . . . In PTO examinations and reexaminations, the standard of proof—a preponderance of evidence—is substantially lower than in a civil case . . . And unlike in district courts, in reexamination proceedings, "claims are given 'their broadest reasonable interpretation, consistent with the specification . . . "(citations omitted) . . . *See Ethicon*, 849 F.2d at 1427 ("[P]recise duplication of effort does not occur because the PTO and the courts employ different standards of proof when considering validity . . ."). [27]

If, pursuant to *Swanson*, reexamination is not barred when the invalidity of the same asserted claims over the same prior art had previously been litigated, then it follows that reexamination is not barred where, as here, the issue of invalidity of the same asserted claims over the same prior art was not, but could have been, litigated in the earlier infringement suit. The *Swanson* court also noted that because the standards used by the Office are distinct from those used in the courts, the Office is not even permitted to stay reexamination pending the outcome of litigation. Again see *Swanson*, quoting *Ethicon*, in which the court stated (internal citations omitted) (emphasis added):[28]

> In *Ethicon*, we held that because of these differences between reexaminations and court proceedings, the PTO did not have authority to stay a patent reexamination proceeding pending the outcome of a case in a district court . . . In reaching this holding, we noted that "*if the district court determines a patent is not invalid, the PTO should continue its reexamination because, of course, the two forums have different standards of proof for determining invalidity.*"

Thus, an "adjudicated infringer" is not precluded from coming to the Office to test the patent based on the different standards employed in the Office. Claim preclusion is not applicable in the present reexamination proceeding because the determination of the patentability of the claims under the standards employed by the Office could not have been "advanced" in the earlier suit for infringement.

It is further noted that issue preclusion may operate in a trademark cancellation proceeding if the "likelihood of confusion analysis" in a trademark infringement action is the same as that in the cancellation proceeding. See *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1366; 55 USPQ2d 1854 (Fed. Cir. 2000). In contrast, reexamination involving the same asserted claims over the same prior art that was previously litigated by a defendant/requester is not barred by issue preclusion because of the different standards employed by the Office in a reexamination proceeding, pursuant to *Swanson*. It is clear, therefore, that the provisions of the trademark statute cannot necessarily be construed in the same manner as the provisions of the reexamination statute. As stated by Judge Newman, in her concurring opinion in *Nasalok*:

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[27] *Swanson* at 1377-1378.
[28] Id. at 1378.

> Patent public policy and trademark public policy are not the same. The purpose of trademark law is not the advancement of science and technology, and the purpose of patent law is not to protect reputation and guard against consumer confusion.

Furthermore, an agency's interpretation of a statute that it administers is entitled to deference. See *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 844 (1984). The administrative construction of the statute must be consistent with the statutory mandate and not frustrate the policy that Congress sought to implement. *FEC v. Democratic Senatorial Campaign Committee*, 454 U.S. 27, 32 (1981). In this instance, the construction of the *ex parte* reexamination statute, 35 U.S.C. 302, does not frustrate a policy that Congress sought to implement, and is consistent with the statute's plain meaning, and with the subsequent action taken by Congress to limit the filing of a reexamination only in the *inter partes* reexamination arena.

The requester correctly states, in the November 17, 2008 opposition,[29] that the decision in *Nasalok* was predicated, in part, on the conclusion that the cancellation proceeding was a collateral attack on a district court judgment that would "undo" injunctive relief granted by the district court.[30] However, as also stated by the requester, the district court in the present case does not appear to have granted any injunctive relief. In any event, even if injunctive relief had been granted, reexamination would not have been precluded for the reasons given above.

The patent owner also urges that reexamination of the '001 patent "would constitute Executive Branch action that has the effect of reviewing and altering a final judgment entered by the Judicial Branch. . . Patentability review here would enable the Executive Branch to nullify a court judgment of *infringement*" (emphasis in original).[31] The patent owner calls attention to footnote 5 of Swanson, which states:

> In contrast, an attempt to reopen a final federal court judgment of infringement on the basis of a reexamination finding of invalidity might raise constitutional problems.

Footnote 5 of Swanson, however, is not applicable to the present case, as noted by the requester.[32] The present reexamination is clearly not a reopening of the court's holding of infringement. The issue of infringement is distinct from the issue of invalidity. And, as stated by the *Swanson* court, even if the district court had determined that the '001 patent is not invalid, "the PTO should continue its reexamination because, of course, the two forums have different standards of proof for determining invalidity".[33] In any event, the defendants in the earlier infringement suit could not have advanced in court the issue of the determination of the patentability of the claims by the Office, because the standards of evaluating the art with respect to the claims in the Office are distinct from those employed by the court.

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[29] See page 11 of the November 17, 2008 requester opposition.
[30] See *Nasalok*, 522 F.3d at 1328.
[31] See page 6 of the November 3, 2008 patent owner renewed petition.
[32] See pages 11-12 of the November 17, 2008 requester opposition.
[33] See *Swanson*, 540 F.3d at 1378

Finally, the commencement of reexamination proceedings after a final holding of infringement in a federal court is not without precedent, as noted by the requester.[34] See *In re Eis*, 1 USPQ2d 1418 (Com'r Pat.. & Trademarks 1986); *Amstar Corp. v. Envirotech Corp.*, 730 F.2d 1476 (Fed. Cir. 1984). The patent owner argues that in *Eis*, the holding of infringement was not final.[35] However, see *Amstar*, in which the court issued a judgment of infringement on March 27, 1984. The Supreme Court denied writ of certiorari on October 15, 1984.[36] On April 3, 1985, a request for reexamination of the patent in *Amstar* was filed.[37]

The patent owner argues that the facts of the present case can be distinguished from the facts of *Swanson*, because in the present case, a federal district court has issued a default judgment for damages in a suit for patent infringement, which is a final judgment,[38] while in *Swanson*, there was no final judgment of infringement as to the asserted claims.[39] In *Swanson*, however, there was a final judgment that the patent claims were not invalid.[40] In any event, even if a final judgment of infringement had been rendered prior to the commencement of the reexamination

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[34] See pages 6-9 of the November 17, 2008 requester opposition.

[35] See page 5, footnote 4 of the November 3, 2008 renewed patent owner petition.

[36] See *Envirotech Corp. v. Amstar Corp.*, 469 U.S. 924, 105 S.Ct. 906, 224 USPQ 6 (1984).

[37] See *Eis*.

[38] The Federal Circuit affirmed the district court's holding in *1st Technology LLC v. Rational Enterprises Ltda.. and Rational Poker School Limited, and Bodog Entertainment S.A., Bodog.net, and Bodog.com*, 296 Fed. Appx. 28; 2008 U.S. App. LEXIS 21721 (Fed. Cir. October 8, 2008).

[39] In *Swanson*, the Federal Circuit reversed the district court's holding of noninfringement as to the asserted claims, and remanded the issue of noninfringement as to those claims to the district court. The district court later rendered a stipulated order of dismissal with prejudice on January 19, 2005, in which the "entire action, including all claims and counterclaims" was dismissed with prejudice. See *Abbott Laboratories v. Syntron Bioresearch, Inc.*, Case No. 98-CV-2359H (S.D. Cal., January 19, 2005)(unpublished). A dismissal with prejudice is a judgment on the merits, which would preclude a challenge of validity in a suit for infringement of any device that is the same as the accused device which was the subject of the first infringement suit. See *Hallco v. Foster*, 256 F.3d 1290, 59 USPQ2d 1346 (Fed. Cir. 2001). A reexamination proceeding, however, is not a "later suit for infringement". See, e.g., *Joy Mfg. Co. v. National Mine Serv. Co.*, 810 F.2d 1127, 1 USPQ2d 1627 ((Fed. Cir. 1987), in which the court stated that "the filing of a request for reexamination in the PTO is not a suit in any United States court" and that "the injunction [from further proceeding in the reexamination] sought against [the requester] would have no effect on reexamination since . . . the request[e]r has no future role to play in that *ex parte* proceeding".[39] In any event, the January 19, 2005 dismissal in *Abbott Laboratories* did not prevent the Office from maintaining the ongoing reexamination of the asserted claims, and did not prevent the Board from later issuing a decision in the reexamination proceeding on May 29, 2007, which the Federal Circuit affirmed in *Swanson*. See also *In re Trans Texas Holdings Corp.*, 498 F. 3d 1290, 83 USPQ2d 1835 (Fed. Cir. 2007), in which the district court issued a ruling on claim construction, prior to issuing an order of dismissal with prejudice due to the settlement of the parties. The patent owner later argued in a reexamination proceeding of the same patent that the Office was bound by the district court's claim construction ruling, based on the doctrine of issue preclusion. The Federal Circuit held that issue preclusion could not be applied against the Office based on an earlier district court holding in an infringement suit, because the Office was not a party to the earlier infringement proceeding.

[40] In *Swanson*, the third party requester, Syntron Bioresearch, Inc., filed a request for *ex parte* reexamination of certain claims of the patent *after* a district court holding, against the requester/defendant, Syntron, that the same patent claims were not invalid over the same prior art raised in the reexamination, and *after* the Federal Circuit affirmed, on appeal, the district court's decision that the same patent claims were not invalid. See *Abbott Labs. v. Syntron Bioresearch, Inc.*, 2001 U.S. Dist. LEXIS 25125 (S.D. Cal. Oct. 12, 2001). The prior art at issue in *Swanson* and *Abbott Labs* was the Deutsch reference, U.S. Patent 4,094,647. See also *Abbott Labs. v. Syntron Bioresearch, Inc.*, 334 F.3d 1343; 2003 U.S. App. LEXIS 13825; 67 USPQ2d 1337 (Fed. Cir. 2003).

proceeding in *Swanson*, reexamination would not have been barred for all of the reasons given above. The *Swanson* court's silence with respect to defendant preclusion (even though the reexamination requester was the defendant in the litigation), coupled with the *Swanson* court's approval of the Office's position on issue preclusion, clearly implies that the Office may issue an order granting *ex parte* reexamination involving any issue that the requester raised or could have raised in earlier litigation of the patent under reexamination, in which a prior judgment of validity and/or infringement against the requester/defendant has been rendered by a federal court.

Accordingly, the November 3, 2008 renewed patent owner petition under 37 CFR 1.181 to vacate the order granting the request for reexamination in the '9075 proceeding, on the grounds that it is an *ultra vires* action on the part of the Office, is **dismissed**.

The redacted versions of the July 9, 2008 patent owner petition, and the redacted versions of the declaration of Scott W. Lewis and accompanying exhibits 1, 3, and 7, the originals of which were submitted on July 9, 2008, will be entered. The entry of these papers should not be construed as an opinion on the part of the Office as to their content.

CONCLUSION

- The November 3, 2008 renewed patent owner petition under 37 CFR 1.181 to vacate the order granting the request for reexamination in the '9075 proceeding is **dismissed**.

- The redacted versions of the July 9, 2008 patent owner petition, and the redacted versions of the declaration of Scott W. Lewis and accompanying exhibits 1, 3, and 7, the originals of which were submitted on July 9, 2008, will be entered. The entry of these papers should not be construed as an opinion on the part of the Office as to their content.

- Jurisdiction over the '9075 proceeding is being returned to the Central Reexamination unit for action.

- 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 communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

Kenneth M. Schor

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

09/22/09
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,076	03/12/2008	6320819	MEM001	3987

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.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,076	03/12/2008	6320819	MEM001	3987

4372 7590 11/14/2008

EXAMINER

Wen Liu
LIU & LIU
444 S. Flower Street, Suite 1750
Los Angeles, CA 90071

ART UNIT	PAPER NUMBER

DATE MAILED: 11/14/2008

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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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)

MAILED

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

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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.
90/009,083	04/18/2008	6629556	038569/340590	6059

71274 7590 11/12/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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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
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:
MAILED
NOV 12 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009083
PATENT NO. : 6629556
ART UNIT : 3991

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,434	01/29/2009	6629556	038569/340590	6529

71274 7590 11/12/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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BANK OF AMERICA PLAZA
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CHARLOTTE, NC 28280-4000

Date:
MAILED
NOV 12 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000434
PATENT NO. : 6629556
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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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BorgWarner Inc.
c/o Patent Central LLC
1401 Hollywood Boulevard
Hollywood Florida 33020-5237

(For Patent Owner)

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 2820-4000

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,083
Filed: April 18, 2008
For: U.S. Patent No. 6,629,556

Inter Partes Reexamination Proceeding
Control No. 95/000,434
Filing Date: January 29, 2009
For: U.S. Patent No. 6,629,556

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.

BACKGROUND

1. Patent number 6,629,556 (the '556 patent) issued on October 7, 2003, with claims 1-9.

2. The '556 patent is the subject of a concurrent proceeding styled *BorgWarner v. Honeywell International, Case No. 1:07CV184 MR-DLH (W.D.N.C.)*. The complaint was filed on May 30, 2007.

3. On April 18, 2008, a third party, Honeywell International, met the filing date requirements for a request for *ex parte* reexamination of claims 1-9 that was assigned control number 90/009,083 (the '9083 proceeding).

4. On May 28, 2008, reexamination was ordered in the '9083 proceeding for claims 1-9 of the '556 patent.

5. On January 29, 2009, a third party, Honeywell International, filed a request for *inter partes* reexamination of claims 1-9 that was assigned control no. 95/000,434 (the '434 proceeding).

6. On March 30, 2009, reexamination was ordered in the '434 proceeding for claims 1-9 of the '556 patent.

7. On April 13, 2009, patent owner filed a petition under 37 CFR §§ 1.181, 1.182, and 1.183, to suspend the '434 proceeding.

8. On April 23, 2009, third party requester filed a paper entitled "Requester's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination."

9. On August 7, 2009, the Office issued a decision dismissing patent owner's April 13, 2009 petition to suspend the '434 proceeding.

10. On August 18, 2009, patent owner filed a petition in the '434 proceeding, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987.

11. On September 1, 2009, third party requester filed a paper in the '434 proceeding entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination."

12. On October 27, 2009, the Office issued a decision denying patent owner's August 18, 2009 petition for suspension of the '434 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

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.

As evidenced by the above review of facts, both the '9083 and the '434 reexamination proceedings are currently pending. An order granting reexamination of claims 1-9 of the '556 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent

owner's statement has expired in the '9083 *ex parte* proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is appropriate at this time.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,434 and 90/009,083 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,434 and 90/009,083 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding.

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, Honeywell International has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1-9 of the '556 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

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(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 ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,434 and *ex parte* Reexamination Control No. 90/009,083 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 for the merged proceeding.

3. Any questions concerning this communication should be directed to Michael Cygan, Legal Advisor, at 571-272-7700.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,083	04/18/2008	6629556	038569/340590	6059

71274 7590 05/18/2010

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

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ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,083	04/18/2008	6629556	038569/340590	6059

71274 7590 05/18/2010

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 2820-4000

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2010

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CENTRAL REEXAMINATION UNIT

BorgWarner Inc.
c/o Patent Central LLC
1401 Hollywood Boulevard
Hollywood, Florida 33020-5237

(For Patent owner)

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 28280-4000

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,083
Filed: April 18, 2008
For: U.S. Patent No. 6,629,556

Inter Partes Reexamination Proceeding
Control No. 95/000,434
Filing Date: January 29, 2009
For: U.S. Patent No. 6,629,556

DECISION DISMISSING PETITION

This is a decision on the March 31, 2010 patent owner petition entitled "Petition to Suspend Rule 37 CFR § 1.943 Pursuant to the Provisions of 37 CFR § 1.183."

The patent owner 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 has been paid in the March 31, 2010 petition.

The petition is dismissed as moot.

BACKGROUND

1. U.S. Patent No. 6,629,556 (the '556 patent) issued on October 7, 2003, with claims 1-9.

2. On April 18, 2008, a third party requester, Honeywell International Inc., met the filing date requirements for a request for *ex parte* reexamination of claims 1-9 of the '556 patent that was assigned control number 90/009,083 (the '9083 proceeding).

3. On May 28, 2008, reexamination was ordered in the '9083 proceeding for claims 1-9 of the '556 patent.

4. On January 29, 2009, the same third party requester, Honeywell International Inc., filed a request for *inter partes* reexamination of claims 1-9 of the '556 patent that was assigned control no. 95/000,434 (the '434 proceeding).

5. On March 30, 2009, reexamination was ordered in the '434 proceeding for claims 1-9 of the '556 patent.

6. On November 12, 2009, the Office mailed a decision merging, *sua sponte,* the '434 and '9083 reexamination proceedings into a single, merged proceeding.

7. On January 22, 2010, the Office mailed a non-final Office action.

8. On February 16, 2010, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the January 22, 2010 non-final Office action.

9. On March 1, 2010, the Office mailed a decision granting the requested one-month extension, setting the response due date to April 22, 2010.

10. On March 31, 2010 patent owner filed a petition entitled "Petition to Suspend Rule 37 CFR § 1.943 Pursuant to the Provisions of 37 C.F.R. § 1.183."

11. On April 22, 2010 patent owner timely filed a response to the January 22, 2010 non-final Office action. On page 4 of the response, patent owner expressly renewed the petition of March 31, 2010, requesting that the 50 page limit pursuant to 37 CFR 1.943(b) be extended to 59 pages.

12. On April 23, 2010, patent owner filed a paper entitled "Submission of Exhibits by Patent Owner," to supplement the April 22, 2010 patent owner response.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP 2667(I), provides in pertinent part:

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

I. Patent Owner's Petition

In the instant petition, patent owner requests suspension of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, to permit patent owner to file a response to the January 22, 2010 non-final action, not to exceed 75 pages in length.[1] Pet. at 4. In support of waiver of the rule, patent owner indicates that "The Office Action comprises 45 separate paragraphs on 15 pages with 12 grounds of rejection, relying on many hundreds of pages of prior art, and incorporating by reference a further 15 pages of text from the Request for Reexamination, which for its part comprised a 34 page statement and 123 pages of reference material." Pet. at 2.

Patent owner further states that in order to adequately prepare a response, not only does each reference have to be addressed, but a discussion on the development of the turbocharger technology over time must also be presented since this is a highly specialized technology. Pet. at 3.

Patent owner submitted a response to the Office action on April 22, 2010, with two accompanying declarations under 37 CFR 1.132 by Dr. Baines. On April 23, 2010, patent owner submitted exhibits that were inadvertently omitted from the April 22, 2010 submission. Patent owner included in the remarks section of the April 22, 2010 response a request to renew the petition of the March 31, 2010 petition, which had not been decided yet by the Office. In the renewed petition request, patent owner requests waiver of the 50-page limit to allow a response of 59 pages.[2]

II. Analysis and Findings

---

[1] It is noted that on page 4 of the petition, patent owner requests waiver of the 50 page limit of up to 75 pages; however, also on page 4, at the end of the first full paragraph of the petition, patent owner requests 70 pages.

[2] Patent owner response at page 4.

The present petition under 37 CFR 1.183 has been fully considered. 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. In this instance, the petitioner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the response entitled "Response by Patent Owner Pursuant to 37 CFR 1.941" on April 22, 2010.

The April 22, 2010 patent owner response, as supplemented by the exhibits filed on April 23, 2010, is accompanied by the two declarations of Dr. Baines. The response includes a "Remarks" section that consists of 26 pages. The following sections of the "Remarks" section are not included in the page limit: the cover page, the two pages of claim appendices, the signature page, and the certificate of service page.

It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943(b). Thus, opinion evidence that goes beyond explaining the evidence - legal arguments, e.g. assertions of obviousness and anticipation, are counted as remarks, and are thus part of the 50-page limit of 37 CFR 1.943(b).

The first declaration by Dr. Baines entitled "Declaration under 37 CFR 1.132, Background" comprises 9 pages that do not count toward the page count as the declaration focuses on technological background and does not include any legal arguments. The second declaration by Dr. Baines, entitled "Declaration under 37 CFR 1.132 Patentability" comprises 34 pages. Of these 34 pages, 20 contain legal argument and thus are counted toward the page limit. Examples of legal arguments in the second declaration, which are not exhaustive, that count toward the page limit are: On page 7, paragraph 26 declarant states: "It is my opinion that this disclosure of Hofmeister would motivate one of ordinary skill in the art against using two or more die inserts per air passage." On page 12, paragraph 45, Dr. Baines states: "Further Fries directs the skilled person away from the claimed features." [3] The April 23, 2010 submission's exhibits comprising only drawing with no legal arguments, do not count toward the page limit. Therefore, a total of 46 pages of the patent owner response are counted toward the page-limit, which is within the 50 page limit of 37 CFR 1.943(b).

Accordingly, patent owner's petition under 37 CFR 1.183 is **dismissed as moot**, as the response of April 22, 2010 (as supplemented on April 23, 2010) to the January 22, 2010 non-final Office action is page-length compliant.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is **dismissed as moot**, as patent owner's April 22, 2010 response, as supplemented on April 23, 2010, to the January 22, 2010 non-final Office action is page-length compliant.

[3] Other examples of legal arguments are on pages 8, 11, 15-19, 21-30 and 33.

2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

Kenneth M. Schor

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

Kenpet8
5-17-10

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.
90/009,084	04/18/2008	6904949	03856/340605	6065

71274 7590 11/09/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2009

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www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:

MAILED

NOV 0 92009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009084
PATENT NO. : 6904949
ART UNIT : 3991

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,433	01/29/2009	6904949	038569/340605	9014

71274 7590 11/09/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2009

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CHARLOTTE, NC 28280-4000

Date:

MAILED

NOV 09 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000433
PATENT NO. : 6904949
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

BorgWarner Inc.
c/o Patent Central LLC
1401 Hollywood Boulevard
Hollywood Florida 33020-5237

(For Patent Owner)

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 2820-4000

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,084
Filed: April 18, 2008
For: U.S. Patent No. 6,904,949

Inter Partes Reexamination Proceeding
Control No. 95/000,433
Filing Date: January 29, 2009
For: U.S. Patent No.: 6,904,949

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.

BACKGROUND

1. Patent number 6,904,949 (the '949 patent) issued on June 14, 2005, with claims 1-14.

2. The '949 patent is the subject of a concurrent proceeding styled *BorgWarner v. Honeywell International, Case No. 1:07CV184 MR-DLH (W.D.N.C.)*. The complaint was filed on May 30, 2007.

3. On April 18, 2008, a third party, Honeywell International, met the filing date requirements for a request for *ex parte* reexamination of claims 1-14 that was assigned control number 90/009,084 (the '9084 proceeding).

4. On May 28, 2008, reexamination was ordered in the '9084 proceeding for claims 1-14 of the '949 patent.

5. On January 29, 2009, a third party, Honeywell International, filed a request for *inter partes* reexamination of claims 1-14 that was assigned control no. 95/000,433 (the '433 proceeding).

6. On March 18, 2009, reexamination was ordered in the '433 proceeding for claims 1-14 of the '949 patent.

7. On April 13, 2009, patent owner filed a petition under 37 CFR §§ 1.181, 1.182, and 1.183, to suspend the '433 proceeding.

8. On April 23, 2009, third party requester filed a paper in the '433 proceeding entitled "Requester's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination."

9. On August 7, 2009, the Office issued a decision dismissing patent owner's April 13, 2009 petition to suspend the '433 proceeding.

10. On August 18, 2009, patent owner filed a petition in the '433 proceeding, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987."

11. On September 1, 2009, third party requester filed a paper in the '433 proceeding entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination."

12. On October 27, 2009, the Office issued a decision denying patent owner's August 18, 2009 petition for suspension.

DECISION

I. MERGER OF PROCEEDINGS

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.

As evidenced by the above review of facts, both the '9084 and the '433 reexamination proceedings are currently pending. An order granting reexamination of claims 1-14 of the '949 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent owner's statement has expired in the '9084 *ex parte* proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is appropriate at this time.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,433 and 90/009,084 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,433 and 90/009,084 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding.

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, Honeywell International has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1-14 of the '949 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

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(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 ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,433 and *ex parte* Reexamination Control No. 90/009,084 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 for the merged proceeding.

3. Any questions concerning this communication should be directed to Michael Cygan, Legal Advisor, at 571-272-7700.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,084	04/18/2008	6904949	03856/340605	6065

71274 7590 05/19/2010

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:
MAILED

MAY 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009084
PATENT NO. : 6904949
ART UNIT : 3991

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,433	01/29/2009	6904949	038569/340605	9014

71274 7590 05/19/2010

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2010

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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:

MAILED

MAY 19 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000433
PATENT NO. : 6904949
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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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MAY 19 2010

CENTRAL REEXAMINATION UNIT

BorgWarner Inc.
c/o Patent Central LLC
1401 Hollywood Boulevard
Hollywood, Florida 33020-5237

(For Patent owner)

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 28280-4000

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,084
Filed: April 18, 2008
For: U.S. Patent No. 6,904,949

Inter Partes Reexamination Proceeding
Control No. 95/000,433
Filing Date: January 29, 2009
For: U.S. Patent No. 6,904,949

DECISION GRANTING-IN-PART PATENT OWNER PETITION AND *SUA SPONTE* WAIVING REQUESTER PAGE LIMIT

This is a decision on the March 31, 2010 patent owner petition entitled "Petition to Suspend Rule 37 CFR § 1.943 Pursuant to the Provisions of 37 CFR § 1.183." On April 22, 2010, patent owner filed a timely response to the January 22, 2010 non-final Office action. On April 23, 2010, patent owner filed a supplemental response to include exhibits that were inadvertently omitted.

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

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in a patent owner response is granted to the extent that the page limit for the patent owner response is extended to not exceed 56 pages in length, excluding amendment, appendices of claims, and reference materials such as prior art references.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the March 31, 2010 petition under 37 CFR 1.183 has been paid.

BACKGROUND

1. U.S. Patent No. 6,904,949 (the '949 patent) issued on June 14, 2005, with claims 1-14.

2. On April 18, 2008, a third party requester, Honeywell International Inc., met the filing date requirements for a request for *ex parte* reexamination of claims 1-14 of the '949 patent that was assigned control number 90/009,084 (the '9084 proceeding).

3. On May 28, 2008, reexamination was ordered in the '9084 proceeding for claims 1-14 of the '949 patent.

4. On January 29, 2009, the same third party requester, Honeywell International Inc., filed a request for *inter partes* reexamination of claims 1-14 of the '949 patent that was assigned control no. 95/000,433 (the '433 proceeding).

5. On March 18, 2009, reexamination was ordered in the '433 proceeding for claims 1-14 of the '949 patent.

6. On November 9, 2009, the Office mailed a decision merging, *sua sponte,* the '433 and '9084 reexamination proceedings into a single, merged proceeding.

7. On January 22, 2010, the Office mailed a non-final Office action.

8. On February 16, 2010, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the January 22, 2010 non-final Office action.

9. On March 1, 2010, the Office mailed a decision granting the requested one-month extension, setting the response due date to April 22, 2010.

10. On March 31, 2010 patent owner filed the instant petition entitled "Petition to Suspend Rule 37 CFR § 1.943 Pursuant to the Provisions of 37 C.F.R. § 1.183."

11. On April 22, 2010 patent owner timely filed a response to the January 22, 2010 non-final Office action. On page 5 of the response, patent owner expressly renewed the petition of March 31, 2010, requesting that the 50 page limit pursuant to 37 CFR 1.943(b) be extended to 59 pages.

12. On April 23, 2010, patent owner filed a paper entitled "Submission of Exhibits by Patent Owner," to supplement the April 22, 2010 patent owner response.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP 2667(I), provides in pertinent part:

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

I. Patent Owner's Petition

In the instant petition, patent owner requests suspension of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, to permit patent owner to file a response to the January 22, 2010 non-final action, not to exceed 75 pages in length.[1] Pet. at 4. In support of waiver of the rule, patent owner indicates that "the first Office Action is comprised of 64 separate paragraphs on 19 pages with 17 grounds of rejection, relying on many hundreds of pages of prior art, and incorporating by reference a further 17 pages of text from the Request for Reexamination, which for its part comprised a 48 page statement and 143 pages of reference material." Pet. at 2.

[1] It is noted that on page 5 of the petition, patent owner requests waiver of the 50 page limit of up to 75 pages; however, also on page 4, at the end of the first full paragraph of the petition, patent owner requests 70 pages.

Patent owner further states that in order to adequately prepare a response, not only does each reference have to be addressed, but a discussion on the development of the turbocharger technology over time must also be presented since this is a highly specialized technology. Pet. at 3.

Patent owner submitted a response to the non-final Office action on April 22, 2010, with two accompanying declarations under 37 CFR 1.132 by Dr. Baines. On April 23, 2010, patent owner submitted exhibits that were inadvertently omitted from the April 22, 2010 submission. Patent owner included in the remarks section of the April 22, 2010 response a request to renew the petition of the March 31, 2010 petition, which had not yet been decided by the Office. In the renewed petition request, patent owner requests waiver of the 50-page limit to allow a response of 59 pages.[2]

II. Analysis and Findings

The present petition under 37 CFR 1.183 has been fully considered. 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. In this instance, the petitioner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the response entitled "Response by Patent Owner Pursuant to 37 CFR § 1.941" on April 22, 2010.

The April 22, 2010 patent owner response, as supplemented by the exhibits filed on April 23, 2010, is accompanied by the two declarations of Dr. Baines. The response includes a "Remarks" section that consists of 32 pages. The following sections of the "Remarks" section are not included in the page limit: the cover page, the two pages of claim appendices, the signature page, and the certificate of service page.

It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943(b). Thus, opinion evidence that goes beyond explaining the evidence - legal arguments, e.g. assertions of obviousness and anticipation, are counted as remarks, and are thus part of the 50-page limit of 37 CFR 1.943(b).

The first declaration by Dr. Baines entitled "Declaration under 37 CFR 1.132, Background" comprises 9 pages that do not count toward the page count as the declaration focuses on technological background and does not include any legal arguments. The second declaration by Dr. Baines, entitled "Declaration under 37 CFR 1.132 Patentability" comprises 41 pages. Of these 41 pages, 24 contain legal argument and thus are counted toward the page limit. Examples of legal arguments in the second declaration, which are not exhaustive, that count toward the page limit are: On page 7, paragraph 25, declarant states: "It is my opinion that this disclosure of Hofmeister would motivate one of ordinary skill in the art against using two or more die inserts per air passage." On page 12, paragraph 42, Dr. Baines states: "The disclosure of Hyll is not

[2] Patent owner response at page 5.

relevant to the claims of the '949 Patent, so one of ordinary skill in the art would not look to Hyll for solutions to manufacture a compressor wheel."[3] The submission of the exhibits of April 23, 2010, comprising only drawing with no legal arguments, does not count toward the page limit.

It is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance, based on (a) the specific facts set forth in the petition under 37 CFR 1.183, (b) patent owner's showing in support of the request for waiver of the 50-page limit by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages), and (c) the individual facts and circumstances of this case,. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's April 22, 2010 response (as supplemented on April 23, 2010) which exceeds the 50-page limit by 6 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** to the extend that the page limit of 37 CFR 1.943(b) is waived as to **6 page**s of the portions of patent owner's April 22, 2010 response (as supplemented on April 23, 2010), which are included in the regulatory page count, that exceed the 50-page limit. This waiver makes the patent owner's response to the January 22, 2010 non-final Office action page-length compliant.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

This decision *sua sponte* waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 56 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins**. Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's April 22, 2010 response (as supplemented on April 23, 2010) page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

IV. Sua Sponte Waiver

As to the April 23, 2010 patent owner supplemental response entitled "Submission of Exhibits by Patent Owner," 37 CFR 1.945(b) is *sua sponte* waived, since the supplemental response is limited to exhibits missing from the April 22, 2010 patent owner response.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is granted-in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that the patent owner's April 22, 2010 response, as supplemented on April 23, 2010, is not to exceed 56 pages in length, excluding appendices of claims and reference materials, such as prior art references. This waiver makes the patent owner's response to the January 22, 2010 non-final Office action page-length compliant.

[3] Other examples of legal arguments are on pages 8, 9, 11, 14-15, 17, 22-37 and 39 of the second Baines declaration.

2. This decision *sua sponte* waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed after patent owner's response to the January 22, 2010 non-final Office action shall not exceed 56 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.**

3. Requester has **30 days from the mailing date of this decision** to file a comments paper pursuant to 37 CFR 1.947

4. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

Kenneth M. Schor

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

Kenpet8
5-17-10

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BORGWARNER INC.
C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD FL 33020-5237

MAILED
JAN 05 2009
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Donald M. Hill
Alston & Bird, LLP
Bank of America Plaza
101 South Tryon St., Suite 4000
Charlotte, NC 28280

(For Requester)

John C. James
Honeywell International, Inc.
23326 Hawthorne Blvd.
Suite 200
Torrance, CA 90505

(Courtesy Copy)

In re Decker *et al.*
Reexamination Proceeding
Control No.: 90/009,085
Filed: March 18, 2008
For: U.S. Patent No.: 6,663,347

DECISION DISMISSING AND EXPUNGING PETITION

This is a decision on the November 24, 2008 third party requester petition entitled "PETITION UNDER 37 CFR § 1.183."

The petition is before the Office of Patent Legal Administration.

The petition is **dismissed**.

The third party requester petition paper is an improper paper. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the third party requester. Thus, the present petition paper is **expunged** from the record by marking it "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

BACKGROUND

1. Patent number 6,663,347 (the '347 patent) issued on December 16, 2003.

2. A request for reexamination, assigned control No. 90/009,085 (the '9085 proceeding), was filed on March 18, 2008 by a third party requester.

[1] See MPEP 2267.

3. On May 16, 2008 the Office issued an order granting the '9085 reexamination request.

4. On October 10, 2008 the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC).

5. On October 17, 2008 the '9085 proceeding was forwarded to the Office of Publications.

6. On November 2, 2008, patent owner submitted a post NIRC IDS containing several documents from related proceedings (U.S. Federal Court and EPO Opposition documents) and prior art references along with a petition requesting entry of the post NIRC IDS and consideration of documents and references by the Office.

7. On November 24, 2008, patent owner submitted a second post NIRC IDS containing an additional document from a related proceeding and another prior art reference along with a second petition requesting entry of the second post NIRC IDS and consideration of document and reference by the Office.

8. On November 24, 2008, third party requester submitted a petition requesting entry of third party comments.

9. The '9085 proceeding is being processed for the printing of its reexamination certificate.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C § 304 provides:

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

37 CFR 1.183 provides:

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

DECISION

The November 24, 2008 third party requester petition is filed under 37 CFR 1.183; however, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '9085 proceeding.

Waiver/suspension of the rules to permit the third party submission via the petition is not justified in view of the legislation and implementing rules which make reexamination under 35 U.S.C. §§ 302 - 307 an *ex parte* proceeding. See *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the Court said (paragraph bridging pages 1868 & 1869):

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

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

On its face, the third party requester's November 24, 2008 petition paper is filed after the statutory statement and reply period ended in the '9085 proceeding. The statutory statement and reply period ended in the '9085 proceeding when the patent owner did not file a statement in response to the May 16, 2008 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 November 24, 2008 petition paper. Therefore, the petition is **dismissed**.

A courtesy copy of this decision will be mailed to Mr. John C. James, who is not of record in this reexamination proceeding. **In the absence of a change of power of attorney and correspondence address in the '9085 reexamination proceeding, listing Mr. James 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

1. The petition is **dismissed**.

2. The petition paper filed by the third party requester on October 1, 2008 is **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '8397 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."

3. No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.

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

5. Any inquiry concerning this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,087	05/07/2008	6433264	108071.010100	1771

23676 7590 12/01/2008

SHELDON MAK ROSE & ANDERSON PC
100 Corson Street
Third Floor
PASADENA, CA 91103-3842

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/01/2008

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,087	05/07/2008	6433264	108071.010100	1771

23676 7590 12/01/2008

EXAMINER	
ART UNIT	PAPER NUMBER

GREENBERG TRAURIG
2450 COLORADO AVENUE
SUITE 400E
SANTA MONICA, CA 90404

DATE MAILED: 12/01/2008

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

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

(For Patent Owner)

SHELDON MAK ROSE & ANDERSON PC
100 Corson Street
Third Floor
Pasadena, CA 91103-3842

(For Requester)

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

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CENTRAL REEXAMINATION UNIT

In re *Gimpel et al.*
Reexamination Proceeding
Control No. 90/009,087
Filed: May 7, 2008
For: U.S. Patent No. 6,433,264

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on July 30, 2008, styled as "REQUEST FOR REVIEW BY THE COMMISSIONER AND REPLY OF THIRD PARTY REQUESTER," is before the Director of the Central Reexamination Unit (CRU). The July 30, 2008 paper is treated as a petition under 37 CFR 1.181 (hereinafter "the petition"). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated June 30, 2008. 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. 6,433,264 (hereinafter, the '264 patent) issued on August 13, 2002.

2. On May 7, 2008, the third party requester deposited a corrected request[1] for *ex parte* reexamination for claims 1-29 of the '264 patent, and the resulting reexamination proceeding was assigned Control No. 90/009,087 (hereinafter, the '087 proceeding).

3. On June 30, 2008, an order denying the request for reexamination for claims 1-29 was issued.

4. On July 30, 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 that the examiner denied the request for reexamination based several errors. As best understood, the petitioner advances the following points:

1. The examiner incorrectly determined that the references do not teach the claimed invention based upon petitioner's interpretation of the claims. See page 2 of the petition.
2. The examiner incorrectly determined that that the Lojacono's unpublished abandoned applications were not prior art. See page 2 of the petition.
3. Reexamination must be granted in the interest of justice. See page 3 of the petition.

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 1-29 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 1-29 of the '264 patent. As will be discussed in further detail in section III.B. below, consideration is limited as to whether the cited patents raise a substantial new question of patentability (SNQ) to patent claims 1-29.

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[1] The original request for reexamination was filed on March 17, 2008. A Notice stating that request was incomplete was mailed on April 7, 2008.

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,[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. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination.[3]

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[2] Public Law 96-517, enacted on December 12, 1980.

[3] This requirement is not aplicable to Director ordered reexaminations.

Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

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."[4,5] 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.

Similarly, MPEP 2240, subsection II, states that in the situation where an ordered *ex parte* reexamination is pending, and another *ex parte* reexamination request is subsequently filed:

> "...reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different from that raised in the earlier pending reexamination. If the prior art cited raises the same substantial new question of patentability as that raised in the pending reexamination, the subsequent request should be denied."

If a substantial new question of patentability is not found, an order denying *ex parte* reexamination of the patent is issued. MPEP 2247 provides guidelines for such an order, and requires that the examiner's decision in the order state, 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.

---

[4] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

[5] For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

Further, the examiner is instructed that 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. In response to petitioner's argument that the examiner incorrectly determined that the references do not teach the claimed invention based upon petitioner's interpretation of the claims, it must first be determined if the request raises a substantial new question of patentability not considered in a prior examination or reexamination. In other words, do the Lojacono '956 and '910 patents, singly or together, raise an SNQ that is different from the technical teachings that were considered with respect to claim patentability in the prosecution of application number 09/199,747, which issued as the '264 patent.

The request for reexamination, dated May 7, 2008, stated that, e.g., claims 1-4, 10, 12-21, and 25-28 of the '264 patent are anticipated under 35 U.S.C. § 102 by both the Lojacono '956 and Locjacono '910 patents. See page 7 of the request. The request also states the other claims are anticipated or rendered obvious based on several Lojacono applications. The issues pertaining to the Lojacono applications will be addressed in Part III.B. below.

As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated May 7, 2008. As will be discussed in further detail below, consideration is limited as to whether the cited references raise a substantial new question of patentability (SNQ) to patent claims 1-29.

As stated in the order denying reexamination, the Lojacono '956 patent was used as the primary reference in several rejections during the prosecution of the application that issued as the '264 patent. Moreover, the Lojacono '910 patent was a continuation-in-part of the Lojacono '956 patent, and petitioner has not relied upon any new teachings in the Lojacono '910 patent that was not in the Lojacon '956 patent. See pages 2-4 of the order denying reexamination of June 30, 2008. Therefore, the teachings of the Lojacono '956 and '910 patents, as presented in the request, were previously considered in the previous examination of the '264 patent. Accordingly, the request must present an SNQ in the form of a new technical teaching (e.g., new information) not previously discussed or considered on the record in the previous proceedings, (i.e., the examination of the application that matured into the '264 patent) in order for a request for reexamination to be granted. The request may also present the teachings of the Lojacono '956 and '910 patents "in a new light" in order to raise a substantial new question of patentability in regards to these references that were already considered in previous examinations; presenting a previously considered teaching "in a new light" is considered to be the presentation of a new technical teaching.

As stated in the order denying reexamination, the request explains that the Lojacono '956 and '910 patents provide substantially the same teachings regarding the claimed subject matter. See the pages 2-4 and 6-9 of the order denying reexamination. In other words, the request fails to set forth any new technical teachings by the Lojacono '956 and '910 patents that is different than

that of considered in the previous examination. Accordingly, the Lojacono '956 and '910 patents, fail to provide any new teachings as presented in the request for reexamination dated May 7, 2008.

The new claim interpretation, as set forth in the request dated May 7, 2008, simply does not provide a new technical teaching by presenting the teachings of the Lojacono '956 and '910 patents in a new light. Accordingly, the request does not support ordering a request for reexamination. As stated above, in order for the Office to grant a reexamination proceeding, there is required to be a substantial new question of patentability. The request does not present sufficient evidence that the Lojacono '956 and '910 patents present the teachings considered in a previous examination in a new light, or otherwise provide any new technical teaching that was not previously discussed and considered on the record in a previous examination. As such, a reasonable examiner would not consider these teachings important in light of the entire record of the previous examination.

B. In response to petitioner's argument that the examiner incorrectly determined that Lojacono's unpublished abandoned applications were not prior art, U.S. Patent No. 6,583,346 and U.S. Patent Publication 2002/0078815 do not properly claim the benefit of applications 09/021,657; 08/934,524; 09/020,562; and 60/037,563 but only incorporate these applications by reference. Therefore, the prior art date of applications 09/021,657; 08/934,524; 09/020,562; and 60/037,563 is either (1) the publication dates of U.S. Patent No. 6,583,346 and U.S. Patent Publication 2002/0078815, or (2) September 4, 2001, the filing date of the application published as U.S. Patent No. 6,583,346 and U.S. Patent Publication 2002/0078815, in accordance with the law as set forth in MPEP 2127. Even if it is assumed that applications 09/021,657; 08/934,524; 09/020,562; and 60/037,563 have the prior art date of September 4, 2001,[6] this date is not prior to November 25, 1998, which is the filing date of the application that issued as the '264 patent. Accordingly, the teachings of applications 09/021,657; 08/934,524; 09/020,562; and 60/037,563 are not prior art and cannot be used to establish a substantial new question of patentability.

Specifically, MPEP 2127 states that:

> "An abandoned patent application may become evidence of prior art only when it has been appropriately disclosed, as, for example, when the abandoned patent [application] is reference[d] in the disclosure of another patent, in a publication, or by voluntary disclosure under [former Defensive Publication rule] 37 CFR 1.139." *Lee Pharmaceutical v. Kreps,* 577 F.2d 610, 613, 198 USPQ 601, 605 (9th Cir. 1978). An abandoned patent application becomes available as prior art only as of the date the public gains access to it. See 37 CFR 1.14(a)(1)(ii) and (iv). However, the subject matter of an abandoned application, including both provisional and nonprovisional applications, referred to in a prior art U.S. patent >or U.S. patent application publication< may be relied on in a 35 U.S.C. 102(e) rejection based on that patent

[6] This decision does not determine whether the prior art date is the publication dates or filing date of U.S. Patent No. 6,583,346 and U.S. Patent Publication 2002/0078815 because both the publication dates and the filing date are not prior to November 25, 1998.

>or patent application publication< if the disclosure of the abandoned application is actually included or incorporated by reference in the patent. Compare *In re Lund*, 376 F.2d 982, 991, 153 USPQ 625, 633 (CCPA 1967) (The court reversed a rejection over a patent which was a continuation-in-part of an abandoned application. Applicant's filing date preceded the issue date of the patent reference. The abandoned application contained subject matter which was essential to the rejection but which was not carried over into the continuation-in-part. The court held that the subject matter of the abandoned application was not available to the public as of either the parent's or the child's filing dates and thus could not be relied on in the 102(e) rejection.).

Regarding application 29/097,840, U.S. Patent No. 6,583,346 and U.S. Patent Publication 2002/0078815 properly claim the benefit[7] of application 29/097,840, which has a filing date of November 14, 1998. Therefore, subject matter in U.S. Patent No. 6,583,346 and U.S. Patent Publication 2002/0078815 that is supported by application 29/097,840, as required by 35 U.S.C. 112, has a prior art date of November 14, 1998. The teachings of application 29/097,840 that are relied upon in the request for reexamination, however, are cumulative to the teachings of Lojacono '956, which has been considered in a prior examination. See subsection III.A. above. See also pages 5-7 of the request for reexamination. In other words, the request fails to set forth any new technical teachings by application 29/097,840 that is different than that of considered in the previous examination. As such, a reasonable examiner would not consider these teachings important in light of the entire record of the previous examination. Therefore, application 29/097,840 does not raise a substantial new question of patentability.

Accordingly, the references cited in the request for the '087 reexamination proceeding fail to raise an SNQ as to claims 1-29 of the '264 patent.

C. In response to petitioner's argument that justice requires the Office to reexamine the '264 patent, as stated above, 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. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination. The Office is without authority to waive this statutory requirement, which is what is seemingly requested by the petition. Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

---

[7] U.S. Patent No. 6,583,346 and U.S. Patent Publication 2002/0078815 do not explicitly incorporate application 29/097,840 by reference. At the time of the filing of the application, which published as U.S. Patent No. 6,583,346 and U.S. Patent Publication 2002/0078815, there was no implicit incorporation by reference by claiming the benefit of an earlier-filed application. Whether or not application 29/097,840 was incorporated by reference is not determinative in this decision because the teachings of applications 29/097,840 have been deemed cumulative teachings.

Petitioner can still avail itself of an *ex parte* reexamination proceeding, provided that petitioner formulates and files a request for *ex parte* reexamination that brings forth some new technological information that was not considered in a previous examination. If a new request is filed, the new request should clearly set forth each SNQ, each proposed rejection that supports the SNQs, what claims each proposed rejection is applied to, and a clear, detailed explanation for how the references teach *every* claim limitation for *each* proposed rejection. The new request must not lump together the explanations of multiple, distinct proposed rejections. See MPEP 2214, 2216 and 2217.

As explained above, in accordance with MPEP 2240 and 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 '264 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). This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. 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.

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. The PETITION is DENIED.

2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, or Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929, or in their absence to the undersigned at (571) 272-3838.

Eric Keasel for

Gregory A. Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,088	03/20/2008	7231038	98225.986RXM	4587

20995 7590 06/11/2009

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FRANK MICHAEL WEYER
HECKER & HARRIMAN
1925 CENTURY PARK EAST SUITE 2300
LOS ANGELES, CA 90067

Date:

MAILED

JUN 11 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009088
PATENT NO. : 7231038
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

(For Patent Owner)

MAILED

JUN 11 2009

HECKER & HARRIMAN
SUITE 2300
1925 CENTURY PARK EAST
LOS ANGELES, CA 90067

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Warren
Reexamination Proceeding
Control No. 90/009,088
Request Deposited: March 20, 2008
For: U.S. Patent No. 7,231,038

: DECISION DISMISSING
: REQUEST TO STRIKE
: DETAILED REQUEST
: FOR REEXAMINATION

This is a decision on the 12 August 2008 patent owner petition requesting "the Request be stricken and removed from the patent file" and "the Order granting ex parte reexamination...be vacated". Although the petition is styled under 37 CFR 1.182, it is considered pursuant to 37 CFR 1.181.

The petition is **dismissed** for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 7,231,038 (hereinafter, the '038 patent), issued to Warren on June 12, 2007.

2. On March 20, 2008, a request was deposited requesting reexamination of the '038 patent.

3. On June 12, 2008, the order granting reexamination was mailed.

4. On August 12, 2008, the instant petition was filed.

ANALYSIS AND FINDINGS

Initially, it is noted that there is no indication of service of the instant petition on the third party requester. Petition is respectfully directed to 37 CFR 1.530(f), which states:

> The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

Although the present petition is considered, this should not be construed as a waiver for future submissions.

The '038 patent matured from application number 11/371,692 (the '692 application). Various references were made of record in the '692 application include a patent to Weyer. The request relies upon the Weyer patent to establish a substantial new question of patentability of the '038 patent. Petitioner argues that the language used in the request describing the submission of the Weyer reference during the '692 application "includes inflammatory, irrelevant factual allegations, erroneous implications, and improper innuendo regarding the Applicant's conduct".

Petitioner's requested relief that "the Request be stricken and removed from the patent file" is inappropriate as the request is not entered into the patent file, rather the request is reexamination control number 90/009,088. Petitioner's attention is also directed to MPEP 2258 IV H, which states, in part:

> If questions other than those indicated above (for example, questions of patentability based on public use or on sale, conduct issues, abandonment under 35 U.S.C. 102(c), etc.) are raised by the third party requester or the patent owner during a reexamination proceeding, the existence of such questions will be noted by the examiner in an Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved. Such questions could arise in a reexamination requester's 37 CFR 1.510 request or in a 37 CFR 1.535 reply by the requester. (emphasis added)

The examiner noted this is in the office action mailed March 11, 2009. However, this issue will not be resolved in the '9088 proceeding as 37 CFR 1.552 states, in part:

> Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such issues are raised by the patent owner or third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may consider the advisability of filing a reissue application to have such issues considered and resolved.

Therefore, petitioner's requested relief to have "the Request be stricken and removed from the patent file" and "the Order granting ex parte reexamination...be vacated" is **dismissed**.

CONCLUSION

1. The petition filed August 12, 2008 is **dismissed**.

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

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

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,092	03/25/2008	5,841,512	167160000007	9834

7590 07/02/2008

EXAMINER	
ART UNIT	PAPER NUMBER

SEAN A. LUNER, DOVEL & LUNER LLP
201 SANTA MONICA BLVD.
SUITE 600
SANTA MONICA, CA 90401

DATE MAILED: 07/02/2008

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

MORRISON & FOERSETER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

MAILED

JUL 0 2 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,092*.

PATENT NO. *5,841,512*.

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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SEAN A. LUNER
DOVEL & LUNER LLP
201 SANTA MONICA BLVD.
SUITE 600
SANTA MONICA CA 90401

(For Patent Owner)

MAILED

JUL 0 2 2008

CENTRAL REEXAMINATION UNIT

DAVID L. FEHRMAN
MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

(For Third Party Requester)

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

In re: Goodhill
Ex Parte Reexamination Proceeding
Control No. 90/007,996
Deposited: 5 April 2006
For U.S. Patent No. 5,841,512

In re: Goodhill
Ex Parte Reexamination Proceeding
Control No. 90/009,092
Deposited: 25 March 2008
For U.S. Patent No. 5,841,512

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,996 and the reexamination control number 90/009,092 pursuant to 37 C.F.R. § 1.565(c).

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

In accordance with 37 C.F.R. § 1.565(c), the reexamination proceedings identified by control numbers 90/007,996 and 90/009,092 are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

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

II. Conduct of Merged Proceeding.

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

Reexamination Control Nos. 90/007,996 and 90/009,092 are hereby **merged**. Since there are no amendments in either proceeding, no "housekeeping" amendment is necessary. The proceedings are thus returned to the examiner in charge of the proceedings for s first Office action on the merits.

CONCLUSION

1. Reexamination Control Nos. 90/007,996 and 90/009,092 are hereby **merged**.

2. The proceedings are thus returned to the examiner in charge of the proceedings for a first Office action on the merits.

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

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

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

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

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

MARK J. REINHART
CRU SPE-AU 3992

for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,094	03/28/2008	4922432	06816.0070.RXUS00	3207

24998 7590 07/22/2009

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,879	01/17/2006	4922432	8089.002	1132

24998 7590 07/22/2009

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,945	02/22/2006	4922432		4490

24998 7590 07/22/2009

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
VINCENT M. DELUCA
NOVAK DRUCE DELUCA & QUIGG LLP
1300 EYE ST., NW, SUITE 400 EAST TOWER
WASHINGTON, DC 20005

Date:

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007879
PATENT NO. : 4922432
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOWREY LLP
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

Date:

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009094
PATENT NO. : 4922432
ART UNIT : 3992

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

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Thomas J D'Amico
DICKSTEIN SHAPIRO MORIN
& OSHINSKY LLP
2101 L Street, NW
Washington, DC 20037

(For Patent Owner)

MAILED

JUL 22 2009

CENTRAL REEXAMINATION UNIT

Vincent M. DeLuca
NOVAK, DRUCE, DELUCA
& QUIGG, LLP
1300 Eye St. NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

Robert C Laurenson
HOWREY LLP-CA
C/O IP Docketing Department
2941 Fairview Park Drive
Suite 200
Falls Church, VA 22042-2924

(For Third Party Requester)

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/007,879
Deposited: 17 January 2006
For U.S. Patent No. 4,922,432

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/007,945
Deposited: 22 February 2006
For U.S. Patent No. 4,922,432

In re: Kobayashi *et alia*
Reexamination Proceeding
Control No. 90/009,094
Deposited: 28 March 2006
For U.S. Patent No. 4,922,432

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

This is a decision on the 17 July 2009, "Common Petition for Extension of Time to File Reply Brief and Request for Oral Hearing for Reexamination Control Numbers 90/007,879, 90/007,945 & 90/009,094 Under 37 CFR § 1.550(c)" requesting that the time for responding to the Examiner's Answer mailed 19 July 2009, be extended by one (1) month. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g). The petition indicates the required certificate of service.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time for response be extended in which to file a Reply Brief response to the Examiner's Answer mailed 19 June 2009. The petition for extension of time was timely filed on 17 July 2009, together with fee for the $200.00 petition fee as required by 37 CFR § 1.17 (g).

The extension of time is dismissed

37 CFR § 1.550 (c) states:

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

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

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

ANALYSIS AND FINDINGS

The patent owner's representative petition to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is

evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Examiner's Answer was mailed 19 July 2009. The petition notes that the extension of time is needed because the "references cited in the Examiner's Answer are technically complex and the Examiner's Answer itself quite lengthy..." The examiner's time between patent owner's responses and subsequent actions noted in the prosecution history are not germane to the issue of "sufficient cause" in the instant petition. Since the issues in the Final rejection mailed 24 September 2008 and the Examiner's Answer mailed 19 June 2009 are substantially the same there are no new issues that would require further consideration. It is noted that the patent owner further states that the offices will be closed 8-16 August 2009 for a holiday period. This time is not necessitated by any actions from the Office and could have been reasonably anticipated by the patent owner.

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

CONCLUSION

1. The patent owner's petition for extension of one (1) month time in which to file a response to the Examiner's Answer dated 16 June 2009 is hereby **dismissed**

2. The Patent Owner's response is due **16 August 2009.**

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

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that

needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/
for

_____

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,094	03/28/2008	4922432	06816.0070.RXUS00	3207

24998 7590 03/25/2010

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,879	01/17/2006	4922432	8089.002	1132

24998 7590 03/25/2010

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,945	02/22/2006	4922432		4490

24998 7590 03/25/2010

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
VINCENT M. DELUCA
NOVAK DRUCE DELUCA & QUIGG LLP
1300 EYE ST., NW, SUITE 400 EAST TOWER
WASHINGTON, DC 20005

Date:

MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007879
PATENT NO. : 4922432
ART UNIT : 3900

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

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

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

Date: MAILED
MAR 25 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007945
PATENT NO. : 4922432
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HOWREY LLP
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

Date:

MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009094
PATENT NO. : 4922432
ART UNIT : 3992

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

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

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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DICKSTEIN SHAPIRO LLP (For Patent Owner)
1825 EYE STREET NW
Washington DC 20006-5403

MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

NOVAK, DRUCE, DELUCA & QUIGG, LLP (For Requester)
1300 Eye St., NW
Suite 400 East Tower
Washington, DC 20005

HOWREY LLP-CA (For Requester)
C/O IP Docketing Department
2941 Fairview Park Drive
Suite 200
Falls Church, VA 22-42-2924

In re Kobayashi *et alia* : DECISION DISMISSING
Reexamination Proceeding : PETITION UNDER
Control No. 90/007,879 : 37 CFR 1.181
For: U.S. Patent No. 4,922,432 :

In re Kobayashi *et alia* :
Reexamination Proceeding :
Control No. 90/007,945 :
For: U.S. Patent No. 4,922,432 :

In re Kobayashi *et alia* :
Reexamination Proceeding :
Control No. 90/009,094 :
For: U.S. Patent No. 4,922,432 :

This is a decision on the January 20, 2010 paper entitled "COMMON PETITION UNDER 37 C.F.R. §1.181 REQUESTING FINDING "NEW GROUND OF REJECTION" IN SUPPLEMENTAL EXAMINER'S ANSWER" requesting "a ground of rejection set forth in the Supplemental Examiner's Answer be designated as a 'new ground of rejection'".

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

The petition is **dismissed** for the reasons set forth below.

DECISION

MPEP 1207.04 states, in part:

"There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection."

The final office action of September 24, 2008 and the examiner's answer of June 19, 2009 contain the same grounds of rejection. Specifically, claims 1-3, 6-8, and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski, T.J. et al., *The VLSI Design Automation Assistant." from Algorithms to Silicon,* IEEE Design and Test, Aug., 1985 (hereinafter "Kowalski '85") in view of Kowalski, T.J. et al., *The VLSI Design Automation Assistant: A Knowledge-Based Expert System,* PhD thesis, Dept. Electrical and Computer Eng., Carnegie-Mellon University, Pittsburgh, Pa, April 1984 (hereinafter "Kowalski '84"), and further in view of Dirkes, *E., A Module binder for the CMU- DA System,* masters thesis, Dept. Electrical and Computer Eng., Carnegie-Mellon University, Pittsburgh, Pa., April 1985 (hereinafter "Dirkes"). Claims 4, 5, and 9-12 are rejected as being obvious over the above three references and further in view of Baitinger.

In response to the reply brief filed August 19, 2009, the examiner issued a supplemental examiner's answer responding to new issues raised in the reply brief (citing 37 CFR 41.43(a)). No ground of rejection was included in the supplemental examiner's answer. The examiner restated the new issues set forth by appellant in the reply brief, followed by a response to those new issues. The positions by the examiner are summarized in a table on pages 6 and 7 of the supplemental examiner's answer. However, it appears that petitioner views this table as an entire new rejection of claim 13. This is not the case. The factual discussion of the references and rationale in support of the rejection is more extensive than the table on pages 6 and 7 of the supplemental examiner's answer. In the final office action of September 24, 2008, the discussion of claim 13 as being unpatentable over the two Kowalski articles and Dirkes spans pages 7-15. The same discussion spans pages 7-15 of the examiner's answer of June 19, 2009.

Petitioner presents a table on pages 3 and 4 of the petition allegedly illustrating the examiner's position set forth in the final rejection of claim 13. However, petitioner interjects his own comments into the table that do not appear in the 9 pages devoted to the rejection in the final office action and the examiner's answer. A detailed discussion of the discrepancies is outside the scope of the present decision as it would represent arguments related to the rejection of record (i.e. an appealable issue).

As the supplemental examiner's answer is limited to the examiner's response to new issues raised in the reply brief and does not include a new ground of rejection, the petition is **dismissed**.

CONCLUSION

1. Petitioner's request is **dismissed**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

4. This is not a final agency action. The decision is made without prejudice to a request for reconsideration or higher-level review.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FEB 13 2009

CENTRAL REEXAMINATION UNIT

Marcus J. Millet
LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

(For Patent Owner)

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

(For Third Party Requester)

Sanjeet K. Dutta
ORRICK HERRINGTON &
SUTCLIFFE, LLP
1000 MARSH ROAD
MENLO PARK, CA 94025

(For Third Party Requester)

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
[37 CFR § 1.565(c)]

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,485
Deposited: 9 February 2007
For: US Patent No. 6,133,627

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,696
Deposited: 11 June 2007
For: US Patent No. 6,133,627

In re: Khandros *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,096
Deposited: 7 April 2008
For: US Patent No. 6,133,627

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

BACKGROUND

1. Patent No. 6,133,627 issued on 17 October 2000.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,485 was requested by a third party requester deposited on 9 February 2007.

3. The Reexamination Order was granted in proceeding, control no. 90/008,485 on 19 April 2007.

4. *Ex Parte* Reexamination Proceeding, control no. 90/008,696 was requested by a third party requester deposited on 11 June 2007.

5. The Reexamination Order was granted in proceeding, control no. 90/008696 on 13 August 2007.

6. *Ex Parte* Reexamination Proceeding, control no. 90/009,096 was requested by a third party requester deposited on 7 April 2008.

7. The Reexamination Order was granted in proceeding, control no. 90/008696 on 2 May 2008.

8. *Ex Parte* proceedings 90/008,485 and 90/008,696 contain amendments.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

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

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/008,485; 90/008,696 and 90/009,096 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/008,485; 90008,696 and 90/009,096 are hereby merged.

2. The patent owner's representative is required to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory A. Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,097	04/01/2008	5745838	205_241	3819

26500 7590 11/02/2009

LAWRENCE P. TRAPANI, ESQ.
PO BOX 555
MANLIUS, NY 13104-0555

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/02/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LAWRENCE P. TRAPANI, ESQ. (For Patent Owner)
PO BOX 555
MANLIUS NY 13104-0555

MARJAMA MULDOON BLASIAK & SULLIVAN LLP (For Requester)
250 SOUTH CLINTON STREET
SUITE 300
SYRACUSE, NY 13202

In re Tresness *et alia*
Appl. No.: 90/009,097
Filed: April 01, 2008
For: **RETURN PATH FILTER**

DECISION ON PETITIONS UNDER 37 CFR 1.59

This is a decision on two petitions under 37 CFR 1.59(b), both filed December 15, 2008, to expunge information from the above identified proceeding.

The petitions are granted.

Petitioner requests that documents identified as Exhibits O, P, and Q in the IDS designated "Fifth" IDS and Exhibit 1 in the IDS designated "Sixth" IDS, both filed December 15, 2008, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

Patent Owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file and is being returned to Petitioner (i.e. Patent Owner) along with this paper. A copy of this paper (without attachments) is being mailed to Requester and will be made of record in the proceeding.

Eric Keasel
SPE, AU 3992

Enclosure: Exhibits O, P, and Q in the IDS designated "Fifth" IDS and Exhibit 1 in the IDS designated "Sixth" IDS, both filed December 15, 2008 (to Patent Owner only)

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 19 2008

CENTRAL REEXAMINATION UNIT

Eugene M. Cummings, P.C. (For Patent Owner)
One North Wacker Drive
Suite 4130
Chicage, IL 60606

Fish & Richardson P.C. (For Third Party Requester)
P.O. Box 1022
Minneapolis, MN 55440-1022

Perkins Coie LLP (For Third Party Requester)
Patent-Sea
P.O. Box 1247
Seattle, WA 98111-1247

In re Kavipurapu	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/008,106	: MERGING
Request Deposited: June 30, 2006	: REEXAMINATION
For: U.S. Patent No. 6,009,488	: PROCEEDINGS
In re Kavipurapu	:
Reexamination Proceeding	:
Control No. 90/008,196	:
Request Deposited: August 28, 2006	:
For: U.S. Patent No. 6,009,488	:
In re Kavipurapu	:
Reexamination Proceeding	:
Control No. 90/009,098	:
Request Deposited: March 26, 2008	:
For: U.S. Patent No. 6,009,488	:

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

Copied from 90008106 on 06/25/2008

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,009,488 (hereinafter, the '488 patent), issued to Kavipurapu, on December 28, 1999.

2. On June 30, 2006, patent owner deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,106 (hereinafter, the '8106 proceeding).

3. The Reexamination Order was granted in the '8106 proceeding on August 22, 2006.

4. On August 28, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/008,196 (hereinafter, the '8196 proceeding).

5. The Reexamination Order was granted in the '8196 proceeding on October 20, 2006.

6. The '8106 and the '8196 proceedings were merged on October 12, 2007.

7. A non-final office action was mailed on October 29, 2007.

8. A response was filed on December 27, 2007, and a supplemental response was filed on January 21, 2008, including an amendment to the claims.

9. On March 26, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '488 patent. The reexamination proceeding was assigned Control No. 90/009,098 (hereinafter, the '9098 proceeding).

10. The Reexamination Order was granted in the '9098 proceeding on May 15, 2008.

11. Patent Owner waived the right to file a statement under 37 CFR 1.530 on June 2, 2008.

DECISION

Under 37 C.F.R. § 1.565(c):

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

Copied from 90008106 on 06/25/2008

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8106, '8196, and '9098 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

As noted above, the claims have been amended in the '8106 and '8196 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

Copied from 90008106 on 06/25/2008

CONCLUSION

1. Reexamination Control Nos. 90/008,106, 90/008,196, and 90/009,098 are **merged**.

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

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

By Mail:
Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

Eric Keasel For

Lissi Mojica Marquis
Director, Central Reexamination Unit

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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.
90/009,102	04/02/2008	5,425,051		6470

23446 7590 08/22/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2008

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

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

23446 7590 08/22/2008

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

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

23446 7590 08/22/2008

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

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

23446 7590 08/22/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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AUG 22 2008

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

Howrey LLP-CA
C/O IP Docketing Department
2941 Fairview Park Drive, Suite 200
Falls Church, VA 22042-2924

(For Third Party Requester)

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

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

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

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

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

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

REVIEW OF RELEVANT FACTS

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

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

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

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

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

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

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

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

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

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

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

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

13. Patent Owner filed a statement waiving the right to file a Patent Owner's Statement on August 19, 2008.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8033, '8034, '8108 and the '9102 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,033, 90/008,034, 90/008,108, and 90/009,102 are **merged**.

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

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

By fax:	(571) 273-9900 Central Reexamination Unit
By Mail:	Mail Stop *Ex Parte* Reexam" Attn: Central Reexamination Unit Commissioner for Patents P. O. Box 1450 Alexandria VA 22313-1450
By hand:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany Street Alexandria, VA 22314

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

Eric Keasel For

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,103	04/04/2008	5819292	347155-29	5691

24267 7590 09/05/2008

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/05/2008

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Ronald L. Yin
DLA Piper US LLP
2000 University Avenue
East Palo Alto, CA 94303

MAILED

SEP 05 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,103*.

PATENT NO. *5819292*.

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
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SEP 05 2008

CENTRAL REEXAMINATION UNIT

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210

(For Patent Owner)

DLA Piper US LLP
2000 University Avenue
East Palo Alto, CA 94303

(For Third Party Requester)

In re Hitz *et alia*
Reexamination Proceeding
Control No. 90/008,903
Request Deposited: October 25, 2007
For: U.S. Patent No. 5,819,292

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

In re Hitz *et alia*
Reexamination Proceeding
Control No. 90/009,103
Request Deposited: April 4, 2008
For: U.S. Patent No. 5,819,292

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. 5,819,292 (hereinafter, the '292 patent), issued to Hitz *et alia*, on October 6, 1998.

2. On October 25, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '292 patent. The reexamination proceeding was assigned Control No. 90/008,903 (hereinafter, the '8903 proceeding).

3. The Reexamination Order was granted in the '8903 proceeding on March 18, 2008.

4. There are currently no amendments in the '8903 proceeding.

5. On April 4, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '292 patent. The reexamination proceeding was assigned Control No. 90/009,103 (hereinafter, the '9103 proceeding).

6. The Reexamination Order was granted in the '9103 proceeding on June 6, 2008.

7. There are currently no amendments in the '9103 proceeding.

8. The '8903 and '9103 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 '8903 and the '9103 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. 90/008,903 and 90/009,103 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,103	04/04/2008	5819292	112056-0499C1RX	5691

24267 7590 01/05/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2010

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

DLA PIPER US LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

Date:
MAILED

JAN 05 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009103
PATENT NO. : 5819292
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.
90/008,903	12/26/2007	5819292	112056-0499C1RX	4100

24267 7590 01/05/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2010

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

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RONALD L. YIN
DLA PIPER, US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

Date:
MAILED

JAN 05 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008903
PATENT NO. : 5819292
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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JAN 05 2010

CENTRAL REEXAMINATION UNIT

MICHAEL E. ATTAYA
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

:(for Owner)

RONALD YIN
DLA PIPER LLP (US)
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

:(for Requester)

In re Application of: Hintz et alia
Control No.: 90/008,903
Deposited: December 26, 2007
For: US Patent No. 5,819,292

DECISION ON PETITION
Under 37 CFR 1.59

In re Application of: Hintz et alia
Control No.: 90/009,103
Deposited: April 4, 2008
For: US Patent No. 5,819,292

This is a response to the petition under 37 CFR 1.59(b), filed on October 15, 2009 by which petitioners request to expunge information from the above identified proceeding.

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 fee of $ 200 required by 37 CFR 1.17(g) has been charged to Deposit Account No. 03-1237.

The petition is hereby dismissed.

REVIEW OF RELEVENT FACTS

1. On December 26, 2007 a third party requester requested *ex parte* reexamination of US Patent No. 5,819,292 which is identified under control no. 90/008,903.

2. On April 4, 2008 a third party requester requested *ex parte* reexamination of US Patent No. 5,819,292 which is identified under control no. 90/009,103.

3. Both requests were granted for *ex parte* reexamination and the two proceedings merged into a single proceeding on September 5, 2008.

4. Prosecution has continued and a final Office action was mailed on June 16, 2009.

5. On October 15, 2009 the instant petition with artifacts under seal were filed.

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(c) (in-part)

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

(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

Petitioner requests that two documents marked "Attorney's Eyes Only" and submitted as an artifact pursuant to a protective order entered on February 20, 2008 in related litigation be expunged from the record. These documents were filed October 15, 2009.

The petition is deficient because:

1) the petition does not contain a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information as required.

Petitioner may request reconsideration of the petition. Any such request must be resubmitted within two months of the mailing date of this decision and supply the omitted statement(s). No fee will be due with any request for reconsideration.

Any questions regarding this petition decision should be directed to Jessica Harrison, Supervisory Primary Examiner of AU 3992 at 571-272-4449.

PETITION DISMISSED.

/J. Harrison/

_____

Jessica J. Harrison
SPE AU 3992
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

MICHAEL E. ATTAYA
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

:(for Owner)

RONALD YIN
DLA PIPER LLP (US)
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

:(for Requester)

In re Application of: Hintz et alia
Control No.: 90/008,903
Deposited: December 26, 2007
For: US Patent No. 5,819,292

DECISION ON PETITION
Under 37 CFR 1.59

In re Application of: Hintz et alia
Control No.: 90/009,103
Deposited: April 4, 2008
For: US Patent No. 5,819,292

This is a response to the petition under 37 CFR 1.59(b), filed on October 15, 2009 by which petitioners request to expunge information from the above identified proceeding.

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 fee of $ 200 required by 37 CFR 1.17(g) has been charged to Deposit Account No. 03-1237.

The petition is hereby dismissed.

REVIEW OF RELEVENT FACTS

1. On December 26, 2007 a third party requester requested *ex parte* reexamination of US Patent No. 5,819,292 which is identified under control no. 90/008,903.

2. On April 4, 2008 a third party requester requested *ex parte* reexamination of US Patent No. 5,819,292 which is identified under control no. 90/009,103.

3. Both requests were granted for *ex parte* reexamination and the two proceedings merged into a single proceeding on September 5, 2008.

4. Prosecution has continued and a final Office action was mailed on June 16, 2009.

5. On October 15, 2009 the instant petition with artifacts under seal were filed.

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(c) (in-part)

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

(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

Petitioner requests that two documents marked "Attorney's Eyes Only" and submitted as an artifact pursuant to a protective order entered on February 20, 2008 in related litigation be expunged from the record. These documents were filed October 15, 2009.

The petition is deficient because:

1) the petition does not contain a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information as required.

Petitioner may request reconsideration of the petition. Any such request must be resubmitted within two months of the mailing date of this decision and supply the omitted statement(s). No fee will be due with any request for reconsideration.

Any questions regarding this petition decision should be directed to Jessica Harrison, Supervisory Primary Examiner of AU 3992 at 571-272-4449.

PETITION DISMISSED.

/J. Harrison/

Jessica J. Harrison
SPE AU 3992
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.
90/009,103	04/04/2008	5819292	112056-0499C1RX	5691

24267 7590 01/13/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

Date: MAILED

JAN 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009103
PATENT NO. : 5819292
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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,903	12/26/2007	5819292	112056-0499C1RX	4100

24267 7590 01/13/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RONALD L. YIN
DLA PIPER, US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

Date:
MAILED
JAN 13 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008903
PATENT NO. : 5819292
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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JAN 13 2010

CENTRAL REEXAMINATION UNIT

Michael E. Attaya
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

(For Patent Owner)

Ronald Yin
DLA PIPER LLP (US)
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

(For Third Party Requester)

In re Hitz et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,903
Filed: December 26, 2007
For: U.S. Patent No. 5,819,292

In re Hitz et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,103
Filed: April 4, 2008
For: U.S. Patent No. 5,819,292

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the October 9, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION."

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

The petition fee of $400.00 under 37 C.F.R. § 1.17(f) has been charged.

The petition is **dismissed**.

BACKGROUND

1. On December 26, 2007, a request for *ex parte* reexamination of claims 1-4 and 8-20 of U.S. Patent Number 5,819,292 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/008,903.

2. On March 18, 2008, an order granting reexamination of claims 1 and 4 of the '292 patent was mailed in the '8903 proceeding.

3. On April 4, 2008, a request for *ex parte* reexamination of claims 4, 8, 11-15, and 20 of U.S. Patent Number 5,819,292 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/009,103.

4. On June 6, 2008, an order granting reexamination of claims 4, 8, 11-15, and 20 of the '292 patent was mailed in the '9103 proceeding.

5. On August 5, 2008, a decision merging the '8903 and '9103 proceedings (hereinafter, the merged '8903/'9103 proceeding) was issued.

6. On August 26, 2008, a non-final Office action, in which all claims subject to reexamination (claims 1, 4, 8, 11-15, and 20) were rejected under multiple grounds based upon 35 U.S.C. § 102(b), was mailed in the merged '8903/'9103 proceeding.

7. On May 12, 2009, patent owner submitted a timely and compliant response to the outstanding Office action, including an amendment to claim 1 and new claims 21-24.

8. On June 16, 2009, a final rejection was mailed, finding claims 1, 21, and 22 patentable, and rejecting claims 4, 8, 11-15, 20 on grounds previously set forth in the August 26, 2008 rejection, and rejecting newly added claims 20, 23, and 24.

9. On August 17, 2009, patent owner submitted a timely submission as a response to the June 16, 2009 final rejection. The submission included amendments to claims 11, 15, 23, and 24. Rejected independent claim 4 was not sought to be amended.

10. On September 8, 2009, the Office issued an advisory action refusing entry to the claim amendments proposed in the August 17, 2009 patent owner submission, finding that the amendments neither simplified the issues for appeal nor placed the claims in condition for allowance/confirmation. Rather, the advisory action stated that the amendments would raise new issues requiring further consideration and/or search.

11. On October 9, 2009, the instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION" was filed seeking continuation of the reexamination proceeding and entry of the amendments and cancellations of the claims set forth in the August 17, 2009 patent owner paper.

12. On October 15, 2009, patent owner filed a Notice of appeal.

13. On December 15, 2009, the Office granted a December 11, 2009 petition under 37 C.F.R. § 1.550(c) granting an extension of time for filing an appeal brief until January 15, 2010.

PERTINENT REGULATIONS

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).

DECISION

The October 9, 2009 patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of an amendment previously denied entry. 37 C.F.R. § 1.182 provides for relief that is not currently provided by an existing rule. In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding **to seek entry of an amendment and/or evidence that was denied entry** after an action closing prosecution in an *inter partes* reexamination proceeding.

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. Therefore, 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. Furthermore, the filing of such a § 1.182 petition is strictly controlled by the Office to further the statutory mandate of 35 U.S.C. § 305 that "[a]ll reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. In keeping with the requirement of special dispatch, a petition under 37 C.F.R. § 1.182 for continued reexamination must show how granting the petition would further the prosecution of the reexamination proceeding. Prosecution may be furthered by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate.

On October 9, 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 reexamination, thereby meeting the "situations not specifically provided for" language in § 1.182. Second, the requirement set forth in the March, 2005 Notice that the amendment has been previously denied entry is deemed to have been met. The petition was filed after a final rejection in an *ex parte* reexamination proceeding to seek entry of an amendment that was previously denied entry in the September 8, 2009 advisory action.

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

Third, with respect to reasons why the need for the amendment could not have been anticipated earlier, patent owner states that the amendment was in response to "comments made by the Examiner for the first time in the Final Office Action" (for claim 15) and in response to Examiner comments made in a July 30, 2009 interview and in the September 8, 2009 advisory action (for claims 11 and 24), and because "the Examiner continues to **construe** [claim] terms more broadly than Patent Owner believes is correct" (for claim 23; bold emphasis added).

With respect to the above reasons given by the patent owner:

For claim 15, patent owner's rationale is based on the grounds that while the rejection has not changed, and while patent owner continues to disagree with the Examiner's interpretation, patent owner now amends the claims to advance prosecution. *See* page 7. This is not a statement that can be interpreted as submission of an amendment in response to a new condition raised in the final Office action; rather, this statement shows that patent owner continues to disagree with the original rejection made in the first non-final Office action of August 26, 2008. Patent owner's amendment to claim 15 is a tactical choice made "to advance prosecution," and was not occasioned by a change in the Examiner's position from the August 26, 2008 Office action, or in response to an unclear rejection being first sufficiently explained in a later Office action.[2] In this instance, based on the totality of the circumstances, the patent owner has failed to meet the burden of presenting evidence why the amendment to claim 15 is not one the need for which could not have been anticipated based upon the original rejection made in the first non-final Office action of August 26, 2008.[3]

For claims 11 and 24, patent owner's rationale is based on language in unamended, parent claim 8, the grounds for rejection of which has not changed. While patent owner continues to disagree with the Examiner's interpretation, patent owner now amends dependent claims 11 and 24 to advance prosecution. *See* page 8. Following the reasoning given above for claim 15, the amendment with respect to the language in claim 8, now suggested to be added to claims 11 and 24, is not one whose need could not have been anticipated based upon the original rejection made in the first non-final Office action of August 26, 2008. With regard to patent owner's statement that the instant amendment is responsive to suggestions made by the examiner in a July 30, 2009 interview, the examiner stated in the September 8, 2009 advisory action that no specific amendments were suggested to patent owner, and similarly does not show that the need for the amendment could not have been anticipated earlier.

Likewise, for claim 23, patent owner's rationale is based on the grounds that while patent owner continues to disagree with the Examiner's interpretation, patent owner now amends the claims to

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[2] Where a situation arises such that patent owner seeks relief from an erroneous closing of prosecution on the rationale that an unclear rejection was first sufficiently explained in a later Office action, a petition under § 1.181 is the sole proper vehicle for relief, not a petition under § 1.182.

[3] MPEP 706.02(b) sets forth four ways in which a rejection based on 35 U.S.C. § 102(b) may be overcome: persuasive argument, amendment that patentably distinguishes over the prior art, perfection of benefit under 35 U.S.C. § 120, and perfection of benefit under 35 U.S.C. § 119(e). A patent owner's argument may never be presumed to be persuasive prior to review by the examiner. One making an argument may be convinced of its correctness yet still anticipate that the audience may not be persuaded and that other avenues may be needed.

advance prosecution. *See* page 10. Patent owner takes issue with the examiner's initial claim construction of "file system information structure," an issue which did not first arise in the final Office action of June 15, 2009, but rather arose in the first Office action. Therefore, the amendment to claim 23 is one the need for which could have been anticipated based upon the original rejection made in the first non-final Office action of August 26, 2008. Therefore, the need for the submission is not one that could not have been anticipated earlier.

Fourth, the effect of entry of the amendment would not further the prosecution by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate. As at least independent claim 4 remains rejected, entry of the amendment, which does not amend claim 4 along with the other proposed amendments, or cancel claim 4, would not place the claims in condition for the issuance of a reexamination certificate. Furthermore, as the advisory action stated, the amendment did not attempt to amend claims in conformance with that deemed allowable by the examiner. For those reasons, entry of the amendment would not simplify the issues for appeal.

Taking into consideration the above discussion, the effect of entry of the amendment is not determined to be in accordance with conducting the proceeding with special dispatch. The intent of enactment of 35 U.S.C. § 305 for *ex parte* reexamination was to provide a speedy alternative to litigation of issued patents, with § 305 explicitly stating that reexamination proceedings are to be conducted with special dispatch, and a continuation of examination for reexamination proceedings on issued patents, absent strong reasons for such continuation, runs contrary to § 305. Any continuation of a reexamination proceeding must be weighed with the legislative history of the enactment of § 305, which expressed an intent for rapid and compact reexamination proceedings. [4]

The instant petition seeks entry of an amendment that would neither presented in a manner to resolve all of the issues in the proceeding such that the claims would be in condition for allowance/confirmation, nor in a manner to reduce the number of issues such that the proceeding would be handled more rapidly upon appeal. Entry of the August 17, 2009 amendment would therefore unduly prolong the reexamination proceeding in contravention of treatment of the proceeding with special dispatch.

In conclusion, a petition under 37 C.F.R. § 1.182, for relief not otherwise provided under the regulations, is of necessity a highly fact-specific inquiry. Based on the facts in this proceeding, it is found that continuation of examination through entry of the August 17, 2009 amendment would not 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 fail to satisfy the requirements set forth in the Notice.

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[4] A comprehensive discussion of the statutory mandate for special dispatch can be found in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).

CONCLUSION

- The petition is **dismissed**.
- 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

January 12, 2010
C:\Kiva\Kenpet7\RCR\

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FEB 27 2009

CENTRAL REEXAMINATION UNIT

Baker Botts L.L.P.
30 Rockefeller Plaza
44th Floor
New York, NY 10112-4498

(For Patent Owner)
(90/009,104)

Jackson & Co., LLP
6114 La Salle Avenue
507
Oakland, CA 94611-2802

(For Patent Owner)
(90/009,328)

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

(For 3rd Party Requester)

Reexam Control No.: 90/009,104
Filed : April 8, 2008
For U.S. Patent No. : 6,990,366

Reexam Control No.: 90/009,328
Filed : November 10, 2008
For U.S. Patent No. : 6,990,366

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. 90/009,104 was ordered in a decision mailed June 5, 2008 indicating that claims 1-4 would be reexamined. Prosecution has progressed to the point where an amendment was filed November 17, 2008, amending claim 1 and adding claims 5-9. A number of Information Disclosure Statements have been filed but no Office action has been issued that is responsive to the November 17, 2008 amendment.

Reexamination in application control No. 90/009,328 was ordered in a decision mailed December 9, 2008 indicating that claims 1 and 4 would be reexamined. Patent Owner did not file a patent owner's statement under 37 CFR §1.530". No Office action has been issued in this proceeding.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines.

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

As noted above, claims have been amended and added in the '9,104 reexamination proceeding by virtue of the amendment filed November 17, 2008. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in both files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-9 are the claims that are currently subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Dual Correspondence

Currently, patent owner appears to be represented by two different representatives. In reexamination proceeding control No. 90/009,104, patent owner is represented by the Baker Botts LLP law firm per the "Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address" paper filed July 24, 2008. In reexamination control No. 90/009,328, patent owner is represented by the law firm of Jackson & Co., LLP. 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. 90/009,104 and 90/009,328 are hereby merged. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in both files and to name but a single representative.** Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Andrew F. Bodendorf
McNEELY BODENDORF LLP
P.O. BOX 34175
Washington, DC 20043

Date:
MAILED

JUN 05 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009105
PATENT NO. : 5550156
ART UNIT : 3991

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

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

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Robert C. Lampe III
Hunton & Williams LLP
1900 K Street, N.W.
Suite 1200
Washington, DC 20006

For Patent Owner

MAILED

JUN 05 2009

CENTRAL REEXAMINATION UNIT

Andrew F. Bodendorf
McNeely Bodendorf LLP
P.O. Box 34175
Washington, DC 20043

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,105
Filed: April 14, 2008
For: US Patent No. 5,550,156

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

This is a decision on the petition filed June 4, 2009 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated February 5, 2009 and Advisory action dated April 17, 2009.

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

The petition is granted for one month for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action February 5, 2009 and Advisory action dated April 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

The petition for extension of time states that Patent owner and counsel conducted a personal interview on June 3, 2009 with the examiners associated with this proceeding. During the interview it was agreed that further declaratory evidence would be useful to more fully address the outstanding issues. An extension of time for one month is requested to prepare a complete and substantive response with adequate input from all parties.

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. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a one-month extension of time in which to file an Appeal Brief. Accordingly, the period of time is extended to July 6, 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 one-month extension of time in which to file a response to the Office action is **granted**.

2. The Patent Owner's response is due July 6, 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.

/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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,106	04/14/2008	5374657	REEP-057	9890

21967 7590 06/05/2009

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2009

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

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

Andrew F. Bodendorf
McNEELY BODENDORF LLP
P.O. BOX 34175
Washington, Dc 20036

Date: MAILED

JUN 05 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009106
PATENT NO. : 5374657
ART UNIT : 3991

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

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Robert C. Lampe III
Hunton & Williams LLP
1900 K Street, N.W.
Suite 1200
Washington, DC 20006

For Patent Owner

MAILED

JUN 05 2009

CENTRAL REEXAMINATION UNIT

Andrew F. Bodendorf
McNeely Bodendorf LLP
P.O. Box 34175
Washington, DC 20043

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,106
Filed: April 14, 2008
For: US Patent No. 5,374,657

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

This is a decision on the petition filed June 4, 2009 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated February 6, 2009 and Advisory action dated April 21, 2009.

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

The petition is granted for one month for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action February 6, 2009 and Advisory action dated April 21, 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

The petition for extension of time states that Patent owner and counsel conducted a personal interview on June 3, 2009 with the examiners associated with this proceeding. During the interview it was agreed that further declaratory evidence would be useful to more fully address the outstanding issues. An extension of time for one month is requested to prepare a complete and substantive response with adequate input from all parties.

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. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a one-month extension of time in which to file an Appeal Brief. Accordingly, the period of time is extended to July 6, 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 one-month extension of time in which to file a response to the Office action is **granted**.

2. The Patent Owner's response is due July 6, 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.

/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
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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.
90/009,107	04/14/2008	56858767	REEP-058	3290

21967 7590 11/04/2008

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

McNEELY BODENDORF LLP
P.O. BOX 34175
WASHINGTON, DC 20043

Date: NOV 14 2008

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009107
PATENT NO. : 5658767
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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Laurence H. Posorske
HUNTON & WILLIAMS LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006

For Patent Owner

NOV 14 2008

Andrew F. Bodendorf
McNEELY BODENDORF LLP
P.O. Box 19010
Washington, DC 20036

For Requestor

Ex Parte Reexamination Proceeding
Control No. 90/009,107
Filed: April 14, 2008
For: US Patent No. 5,658,767

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

This is a decision on the petition filed November 3, 2008 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated September 3, 2008.

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

The petition is granted for one month for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated September 3, 2008, which set a two-month period for response thereto. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be 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 response to the above-referenced office action is essentially ready for submission. A personal interview was held with the Examiners on October 28, 2008. As a result of the interview, Patent Owner and representatives now believe that additional information, including declaratory statements from one or more experts, would be required to present a full response to the outstanding issues. A one-month extension of time is requested.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why an extension of time should be granted. 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 314(c) that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a one-month extension of time in which to file a response to the outstanding Office action. Accordingly, the response is due on December 3, 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.

1. The Patent Owner's petition for extension of time in which to file response to the outstanding Office action is granted for one month.

2. The Patent Owner's response is due December 3, 2008.

3. Response may be submitted as follows:

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

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

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

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

Deborah Jones for
Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,107	04/14/2008	56858767	REEP-058	3290

21967 7590 03/11/2010

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/11/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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MAILED

Date: MAR 11 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
McNEELY BODENDORF LLP
P.O. BOX 34175
WASHINGTON, DC 20043

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009107
PATENT NO. : 5658767
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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Laurence H. Posorske
HUNTON & WILLIAMS LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006

For Patent Owner

MAILED

MAR 11 2010

CENTRAL REEXAMINATION UNIT

Andrew F. Bodendorf
McNEELY BODENDORF LLP
P.O. Box 19010
Washington, DC 20036

For Requestor

Ex Parte Reexamination Proceeding
Control No. 90/009,107
Filed: April 14, 2008
For: US Patent No. 5,658,767

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

This is a decision on the petition filed February 19, 2010 to request a one-month extension of time pursuant to 37 CFR 1.550 for submitting an Appeal Brief, currently due on February 21, 2010.

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

The petition is dismissed for the reasons set forth below.

Decision

A Notice of Intent to Issue a Reexamination Certificate was mailed on February 22, 2010. An Appeal Brief is not necessary. The request for additional time is moot and is herein dismissed.

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

/Deborah Jones/
Deborah Jones, SPE
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,108	04/11/2008	7017013	383681-105046	1804

2101 7590 09/18/2009

Sunstein Kann Murphy & Timbers LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/18/2009

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

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID B. COCHRAN
JONES DAY / NORTH POINT
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

Date:

MAILED

SEP 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009108
PATENT NO. : 7017013
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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Sunstein Kann Murphy & Timbers LLP
125 SUMMER STREET
BOSTON MA 02110-1618

(For Patent Owner)

MAILED

SEP 18 2009

CENTRAL REEXAMINATION UNIT

DAVID B. COCHRAN, ESQ
JONES DAY/,NORTH POINT
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

(For Requester)

In re Percival (US Patent Number 7,017,013)
Reexamination Cont. No.: 90/009,108
Filed: April 11, 2008
For: **METHOD AND SYSTEM FOR COHERENTLY CACHING I/O DEVICES ACROSS A NETWORK**

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petitions under 37 CFR 1.59(b), filed October 2, 2008 and June 22, 2009, to expunge information from the above identified proceeding.

The petitions are granted.

Petitioner requests that documents identified as AE-AJ, AL-AP, AR, AS, AW, and AX, filed October 2, 2008, and documents identified as FF and FG, filed June 22, 2009, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

Patent Owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file and is being returned to Patent Owner along with this paper. A copy of this paper (without attachments) is being mailed to Requester and will be made of record in the proceeding.

It is also noted the PTOL-469 mailed incorrectly listed claims 4, 5, 7, 8, 10, 11, 20, 21, 24, 27, and 28 as both confirmed and amended (including dependent on amended claims). All of those claims were amended (including dependent on amended claims), so none of those claims are confirmed.

Eric Keasel
SPE, AU 3992

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.
90/009,109	05/19/2008	6295075	024638-00000	8140

27538 7590 10/31/2008

GIBSON & DERNIER L.L.P.
900 ROUTE 9 NORTH
SUITE 504
WOODBRIDGE, NJ 07095

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/31/2008

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

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JULIANA HAYDOUTOVA
ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W. SUITE 400
WASHINGTON, D.C. 20036-5339

Date MAILED

OCT 31 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009109
PATENT NO. : 6295075
ART UNIT : 3992

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

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

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

Jeffrey I. Kaplan (Patent Owner)
Kaplan Gilman Gibson & Dernier L.L.P.
900 Route 9 North
Woodbridge, NJ 07095

MAILED

OCT 31 2008

CENTRAL REEXAMINATION UNIT

Juliana Haydoutova, Esq. (Requestor)
Arent Fox Kintner Plotkin & Kahn, PLLC
1050 Connecticut Ave, N.W., Suite 400
Washington, D.C. 20036

Inventors: Gad Janay, et al
Reexamination Proceeding
90/009,109
Filed: May 19, 2008
For: U. S. Patent 6,295,075
Title: Configurable Remote Terminal Capable Of Communicating With Various Remote Computers

: **DECISION ON**
: **§ 1.181 PETITION**

This is a decision on a September 4, 2008 petition pursuant to 37 C FR 1.181 seeking to vacate an order for *ex parte* reexamination dated August 6, 2008. An opposition by the third party requester to the patent owner's petition was received on September 22, 2008.[1] The petition alleges that the primary reference, upon which the finding of the substantial new questions of patentability was based, was not a publication. The petition is before the Office of Patent Legal Administration for consideration.

The § 1.181 petition is dismissed for the reasons set forth below.

Background

1) U.S. Patent number 6,295,075 issued September 25, 2001 with 10 claims.[2]

[1] The September 22, 2008 third party requester's Opposition was not submitted within two weeks of the September 4, 2008 service by the patent owner of its' petition on the third party requester. MPEP 2246. However, the Opposition will be treated in that the patent owner, as noted in the Opposition, did not provide service of the petition to the requester pursuant to § 1.248, but instead utilized electronic service. A patent owner's statement pursuant to § 1.530 has not yet been filed. MPEP 2249.

[2] The patent was recently enforced in an infringement decision, *Resqnet.com, Inc v. Lansa*, Inc. 533 F.Supp.2d 397 (S.D.N.Y. 2008) where Petitioner states defendant submitted the Flashpoint document and Murray declaration to the "District Court in its post judgment motions" (Petition, bridge of pages 1 and 2), which the court did not consider, at pate 414 (Petition, page 2).

A review of *Resqnet.com v. Lansa* reveals that the District Court addressed the issue of obviousness of the instant patent based on whether two Flashpoint documents were publications. The court noted that while the documents themselves bore dates, "no witness testified, nor was any evidence presented, that either of these documents was ever published or disseminated to the public." At page 414. The court then went on to hold that in the "absence of any evidence that the Flashpoint references were published prior to the critical date, Flashpoint cannot be considered prior art for the purpose of invalidating the '075 Patent."

2) A replacement third party request for *ex parte* reexamination was filed on May 19, 2008.

3) An order for reexamination was issued on August 6, 2008 based on the finding of two substantial new questions of patentability for:

- claims 1, 3 and 8, based on a Flashpoint TM Tutorial Version 3.04 (Flashpoint), and
- claims 1-10, based on Flashpoint in view of IBM Personal Communication 3270 Version 4.0.

4) The instant § 1.181 petition was filed on September 4, 2008 seeking to have the order for reexamination vacated. The petition raises objection to the use of Flashpoint as Flashpoint is argued not to be a publication.

5) An opposition by the third party requester to the patent owner's § 1.181 petition was filed on September 22, 2008

Third Party Request for Reexamination

The third party request for reexamination is based for the substantial new question of patentability, on a Flashpoint reference (advanced as a sole and a primary reference), which document is a tutorial on a Windows-based tool used to create certain graphical interfaces. [3] The Replacement Detailed Statement in Support of Request for *Ex Parte* Reexamination Pursuant to 37 C.F.R. § 1.510 makes reference (bridge of pages 3-4) to a concomitantly submitted Declaration of Jack Murray (Murray declaration) that is asserted to establish that Flashpoint was disseminated to the public and is therefore a publication and an appropriate document to base a request for reexamination on. Also submitted is the work experience for Jack Murray (Murray resume).

The Murray declaration states that:

1. The Flashpoint reference is "very familiar" to declarant.
2. Flashpoint "appears to be a document I used while employed at KnowledgeWare during the period 1993-94."
3. Documents "such as" Flashpoint "were distributed with the shipment of the Flashpoint software as a matter of course during the period of my employment at KnowledgeWare...."
4. Documents such as Flashpoint:
   a. "were routinely distributed after pre-sales demonstrations, and
   b. "were sent to prospective clients".
4. To the best of declarant's knowledge "there is no other purpose that the Flashpoint reference would have been created by KnowledgeWare, other than to have it distributed to customers with the Flashpoint software product, and to prospective customers of the

---

As held in *In re Swanson*, 20007-1534 (Fed. Cir. 2008) at page 16, "Congress did not intend a prior court judgment upholding the validity of a claim to prevent the PTO from finding a substantial new question of validity regarding an issue that has never been considered by the PTO." The court went on the state that the "a substantial new question can exist even if a federal court previously considered the question," which includes a review of the same prior art. At page 18.

[3] A copy was submitted with the request for reexamination. Page iii (ZEP 01091 - The page identifications of the reference as submitted contain an additional set of identifications to the page identifications of the documents as created that apparently correspond to exhibit pages).

Flashpoint software product."

The Murray resume identifies Murray as:

1. An employee of KnowledgeWare during 1993-94, and
2. Working in technical sales of Flashpoint.

Flashpoint Reference

A review of the 169 page Flashpoint reference reveals (page ZEP 01090):

1. That "Flashpoint is a trademark and KnowledgeWare is a registered trademark of KnowledgeWare, Inc."
2. The presence of the following statement:

   Confidential and proprietary material subject to license. Do not reproduce or disclose. The material is an unpublished work and is considered a trade secret belonging to the copyright holder.

Patent Owner's § 1.181 Petition to Vacate Order for Reexamination

The petition's sole ground to vacate the order for reexamination is based on the Flashpoint document not being a publication whereas reexamination is limited to patents or publications. 35 U.S.C. 301.

The patent owner's review of the document leads it to believe that Flashpoint "appears to be a confidential draft version of something, but there is no evidence of what, if anything, was ultimately published from this." Petition, page 2.

The patent owner believes that the Murray declaration and the Murray resume do not support the Flashpoint document being a publication in that:

1. It has been more than 14 years since Murray left the employee of the company that produced the Flashpoint document thereby:
   a. making any recollection regarding the matter at issue suspect; particularly in view of Murray's use of "appears to be" and patent owner's citation of *Ex parte Tankovich*, 1998 WL 1736175 (BPAI 1998) (plural declarations submitted more than five years after events cannot establish publication); *Ex parte Natale*, 11 USPQ2d 1222 (BPAI 1989) ('We hold that the examiner has no authority to engage in a fact finding endeavor to establish the existence of public use,' holding that is was reversible error to rely upon 'Requesters allegation' to establish publication);"
   b. making it unclear how Murray came to remember details of his experience with Flashpoint and whether parties for the third party requester reminded Murray of what he remembers.
2. The Murray declaration is not specific enough in regard:
   a. to exactly what version of the Flashpoint document Murray saw (and whether it contained among its 169 pages the material disclosure that the reexamination order is based upon);
   b. how long Murray worked at KnowledgeWare and worked with the Flashpoint document; and
   c. what portions of the Flashpoint document Murray worked with.
3. No information is supplied as to what was received by customers or others (*e.g.*, prospective customers).

4. Not a single party is identified as having received a copy of Flashpoint.
5. If any information was received, it was only under a confidentiality agreement which cannot amount to a publication to the public, *SRI International, Inc. v. Internet Sec. Systems, Inc.*, 511 F.3d 1186 (Fed. Cir. 2008); *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986), *Brukelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006), and *In re Wyer*, 655 F2d. 221, 227 (C.C.P.A. 1981).

It is also argued that as a reexamination provides no procedural mechanism for the patent owner to depose the declarant supporting Flashpoint as a publication, a reexamination should not be ordered based on a declaration obtained and submitted by an obviously biased third party.

Third Party Opposition to Vacating Order for Reexamination

The opposition characterizes the petition to vacate the order for reexamination as presenting two grounds, which grounds are argued to be insufficient to support vacating the order for reexamination. The petition to vacate is stated to:

(1) point to the failure of the District Court for the Southern District of New York to consider the Flashpoint document:

- the opposition argues that Federal court proceedings are irrelevant to the Office's determination of whether a substantial new question of patentability exists for purposes of the Reexamination Statute, *In re Swanson*, 2008 WL 4068691 (Fed. Cir. 2008) (a substantial new question of patentability refers to a question that has never been considered by the PTO; thus, a substantial new question can exist even if a federal court previously considered the question); and

(2) question the use of the Murray declaration to support a determination that the Flashpoint document is a publication:

- the opposition argues (page 3) that declarations "which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, [but any rejection must be based upon the prior art patent or printed publication as explained by the ... declarations ....]" Manuel of Patent Examining Procedure (MPEP) 2217 and 2258. [4]

Decision

The MPEP at 2246, 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. .... 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 be questioned with respect to vacating the order granting

[4] As noted in footnote 1, the opposition also raises an objection to the electronic method of service used by the patent owner to serve requester with the § 1.181 petition to vacate the order for reexamination as not compliant with the service alternatives set forth in § 1.248. In addition to a request for acceptance of the delayed opposition, the objection will also be viewed as notice to the patent owner that the patent owner should in the future comply with the provisions of § 1.248, and not rely on electronic service. The requester, however, is reminded that MPEP 2246 requests that a courtesy telephone call be made to alert the Office to the intent to file an opposition, which phone call has not been indicated to have been made.

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.

The MPEP does provide that:

> A petition under 37 CFR 1.181 may be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration will be entertained. (emphasis in original).

Accordingly, for the purpose of the instant petition it is not enough for the petitioner to in effect argue that there is an insufficient showing of publication of the Flashpoint document to sustain a *prima facie* rejection over that document. For petitioner to prevail, petitioner must establish that there is no basis at all for characterizing the Flashpoint document as a publication and that therefore the order for reexamination was an *ultra vires* act.

Standard for publication: MPEP 2128 informs that:

> A reference is proven to be a 'printed publication' 'upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence can locate it.' *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) ....

The instant issue of accessibility is directed towards whether the Flashpoint document has been disseminated rather than made available to be located. While making a document available does not include a requirement that anyone actually look at the document, dissemination requires receipt by the party disseminated to, *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644, 646 (Fed. Cir. 1986)("No evidence was presented as to the date of receipt of the mailer by any of the addresses.").

Dissemination of documents under a confidentiality or restriction of use agreement can offset what would otherwise be considered a publication. *Garret Corp. v. United States*, 422 F.2d 874, 164 USPQ 521, 524 (Ct. Cl. 1970) (finding a document distributed "to commercial companies without restriction on use" to be a publication because no restriction was found to be placed on the dissemination).

Standard for review of the order for reexamination: The gravamen of the instant petition is not whether it can be definitely established that Flashpoint is a publication, but only whether there is no colorable argument or no scintilla of evidence pointing to Flashpoint as a publication[5] so that the ordered reexamination cannot move forward. Only where there is no basis to believe that Flashpoint is a publication and therefore there is no basis for ordering reexamination could the petition to vacate be granted in view of an *ultra vires* act in ordering reexamination.[6] See *Heinl v. Godici*.[7]

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[5] Flashpoint is not a U.S. patent and therefore must be a printed publication for reexamination to be ordered.

[6] While the order for reexamination does not explicitly address the issue of whether Flashpoint can be considered a publication, it is presumed that the order relies on the Murray Declaration to establish Flashpoint as a publication, at least for the purpose of deciding whether there is a substantial new question of patentability based on Flashpoint.

Flashpoint as a publication: There is some evidence of record to conclude that Flashpoint was disseminated and is therefore a publication. The evidence is in the form of a declaration by an individual who states that declarant:

1. was an employee of the organization KnowledgeWare that produced the Flashpoint document,
2. used Flashpoint while employed at KnowledgeWare, and
3. was employed in the sales and Flashpoint was routinely disseminated as part of sales by:
    a. being sent to prospective clients, and
    b. distribution after pre-sales demonstrations.

Petitioner argues that a confidential document cannot be a publication citing to *SRI International, Inc. v. Internet Sec. Systems, Inc.*, 511 F.3d 1186 (Fed. Cir. 2008); *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986); *Brukelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006); and *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981).

The cited decisions are not on point as to the instant situation concerning a document containing an confidentiality statement, but are rather directed towards situations where the accessibility of a document is questioned based on the document: appearing on a web cite (*SRI*), having been submitted as a doctorial thesis (*Hall*), being an application in a foreign patent office containing information not in the published patent (*Brukelmyer*), or a foreign application having been classified and laid open to the public (*Wyer*).

Petitioner points out that the Flashpoint document itself negates the concept of Flashpoint being a publication in view of the confidentiality statement therein:

1. identifying the document as confidential and proprietary material subject to license,
2. prohibiting disclosure, and
3. holding the document to be an unpublished work that is considered a trade secret.

The confidentiality statement does not necessarily negate the Murray declaration evidence. Whatever the intent of the confidentiality statement, the confidentiality statement alone does not establish the impossibility of the actions of publication attested to by Declarant. Notwithstanding the confidentiality statement, there is some evidence of record that Flashpoint was disseminated by being sent to prospective clients and distributed after pre-sales demonstrations. Both such situations would inherently violate whatever (original) intent there was to maintain Flashpoint in confidence. There is no reason the believe that the

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[7] 143 F.Supp.2d 593, 601 (E.D. VA. 2001) (In a decision seeking termination of reexamination based on the absence of a new question of patentability 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. Matthews*, 563 F.2d 914, 920 (4th Cir. 1977), vacated on other grounds, 571 E.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."

While petitioner has not explicitly invoked the *ultra vires* petition exception to the normal appeal route for the application of prior art in a reexamination, it would appear that an *ultra vires* act would be the only basis upon which petitioner could rely on in seeking termination of the reexamination based on petitioner's theory that Flashpoint is not a publication.

mere presence of a notice of confidentiality somewhere in the 169 page Flashpoint document would cause a party not in privity with KnowledgeWare, by some form of sales agreement or signed confidentiality agreement, to hold the Flashpoint document in confidence once it was received. Any non-restricted distribution, such as at a pre-sales demonstration,, depending on how the distribution was made (*e.g.*, stacked on an unmanned table), may lead one receiving the document to believe that the confidentiality statement, if it is even noticed, would no longer apply.

Petitioner also argues that the Office should not rely upon a declaration, particularly as the sole basis for ordering reexamination, as there is no mechanism for the patent owner to depose the declarant and test the truthfulness of the statements made, particularly in view of a number of perceived deficiencies in the declaration.[8]

The Federal Circuit has recognized that in some circumstances unsupported oral testimony can prove knowledge, although it must be "regarded with suspicion and subject to close scrutiny." *Carella v. Starlight.*[9] Therefore, such a declaration can provide some evidence for what is purports to establish.

Petitioner further disparages reliance on the Muray declaration based on its execution 15 years after declarant's experience with the Flashpoint document relying on *Ex parte Tankovich*, 1998 WL 1736175 (BPAI 1998) (plural declarations submitted more than five years after events cannot establish publication).

Ex parte Tankovich, merely observed that a "substantial lapse of time between execution of the declaration and the seemingly innocuous act of distribution, [5.5 years] detracts from the credibility of the declarant" and cited to *In re Reuter*, 651 F.2d 751, 210 USPQ 249, 256 (CCPA 1981). *In re Reuter*, in evaluating a declaration believed to have been executed from memory without the existence of corroborating evidence, the court opined that a "ten-year lapse of time, due to the frailty of human memory, detracts from the credibility of the affiant." [10] While the treatment of declarations executed years from the events that are discussed in the declarations goes to the weight given to the declaration, the use of such a declaration is not barred.

Accordingly, while issues, such as how Declarant could remember 15 years later that a 169 page Flashpoint document being earlier distributed was the same as the instant Flashpoint document containing the teaching being relied upon to support a substantial new question of patentability, particularly where it is apparent that the Flashpoint document has undergone revisions by its reference to version 3.04., may ultimately be asserted (during the . examination and appeal stages of the present proceeding) to avoid or rebut a *prima facie* case of unpatentability, such issues are not currently sufficient to establish the existence of *ultra vires* action in ordering reexamination based on the Murray declaration evidence.

Petitioner also has cited to *Ex parte Natale*, 11 USPQ2d 1222 (BPAI 1989) ("We hold that the examiner has no authority to engage in a fact finding endeavor to establish the existence of public use," holding that it was reversible error to rely upon "Requesters allegations" to establish publication").

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[8] See Patent owner's Petition to Vacate Order for Reexamination, discussed *infra*.
[9] At page 646.
[10] F.n. 11.

Initially, it is pointed out that the matter in *Ex parte Natale* was resolved on appeal as a patentability issue; it was not resolved based on a lack of a substantial new question. Also, in *Ex parte Natale* the examiner attempted to introduce a public use during an ongoing reexamination and combine the public use with a publication. The recited language regarding engaging in fact finding was in regard to the public use where there were conflicting affidavits as to the public use. In regard to the separate issue of the existence of a publication, the Board held that the document in issue was not established to be a publication as the examiner merely relied upon the requester's allegations that the document "enjoyed wide distribution as advertising literature rather than proffer objective evidence...." The instant reexamination order, however, was based on a third party declaration by Murray, and patent owner will have an opportunity to address it during the examination stage of the proceeding.

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 or scintilla of evidence that Flashpoint, used to support both new questions of patentability, was published and that therefore the Office has acted in brazen disregard of the statutory mandate to only order reexaminations based on publications.

3. The instant reexamination proceeding, and jurisdiction thereover, is being transmitted to the Central Reexamination Unit, Art Unit 3992, to proceed further with the present reexamination proceeding, as appropriate.

4. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or in his absence, to the undersigned at (571) 272-7710.

/Kenneth M. Schor/

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

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,109	05/19/2008	6295075	024638-00000	8140

27538 7590 05/05/2009

GIBSON & DERNIER L.L.P.
900 ROUTE 9 NORTH
SUITE 504
WOODBRIDGE, NJ 07095

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2009

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

Jeffrey I. Kaplan
Kaplan, Gilman, Gibson & Dernier LLP
900 Route 9 North
Woodbridge, NJ 07095

(Patent Owner)

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MAY 0 5 2009

CENTRAL REEXAMINATION UNIT

Juliana Haydoutova, Esq.
Arent, Fox, Kintner, Plotkin & Kahn, PLLC
1050 Connecticut Ave., N.W., Suite 400
Washington, D.C. 20036

(Third Party Requester)

In re Janay et al.
Reexamination Proceeding
Control No.: 90/009,109
Filed: May 19, 2008
For: U.S. Patent No.: 6,295,075

DECISION
ON PETITION
UNDER 37 CFR 1.182

This is a decision on the February 24, 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 February 24, 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. 50-4711 in accordance with petitioner's authorization in the February 24, 2009 petition.

BACKGROUND

1. On September 25, 2001, the Office issued U.S. Patent No. 6,295,075 to Janay *et al* (the '075 patent).

2. On April 11, 2008, a third party requester deposited a request for *ex parte* reexamination of the '075 patent. The request was assigned reexamination control number 90/009,109 (the '9109 proceeding).[1]

3. On April 18, 2008, the Office issued a Notice of Failure to comply with *ex parte* Reexamination Request Filing Requirements.

4. On May 19, 2008, the third party requester filed a replacement request for *ex parte* reexamination of the '075 patent, which was granted a filing date.

5. On August 6, 2008, the Office issued an order granting reexamination for the '9109 reexamination replacement request.

6. Prosecution progressed to the point where, on February 17, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '9109 proceeding.

7. On February 20, 2009, the '9109 proceeding was designated 452 status as entering the print cycle.

8. On February 24, 2009, patent owner filed the instant petition accompanied by a new IDS, which patent owner requests the Office to consider.

9. The '9109 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**

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[1] The '075 patent was recently successfully enforced against the third party requester in Federal District Court litigation. *Resqnet.com, Inc. v. Lansa, Inc.*, 533 F.Supp.2d 397 (S.D.N.Y. 2008)

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 merged proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2656 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the 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 far less relevant" than the prior art relied upon by the third party requester and that several of the items of information were used during litigation between the parties against a different patent that is not at issue in the '9109 reexamination. 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. In fact patent owner has admitted on the record in the petition that they were aware of the existence of the items of information now being submitted over a year ago as part of the exhibits used by the third party requester

during their Federal District Court patent infringement litigation that concluded in April 2008. There is no factual accounting whatsoever as to why patent owner waited over at least a year, and during the entire life of the reexamination proceeding, to file the instant IDS containing the items of information listed. Therefore, the present petition does not satisfy even the requirements for a petition submitted for consideration of an IDS after a NIRC has been mailed, even if the IDS had been submitted before the proceeding 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 February 17, 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 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 February 24, 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.
90/009,110	04/11/2008	7039767	383681-105046	9171

2101 7590 06/22/2009

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David B. Cochran
JONES DAY
NORTH POINT - 901 LAKESIDE AVE.
CLEVELAND, OH 44114

Date:

MAILED

JUN 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009110
PATENT NO. : 7039767
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,110	04/11/2008	7039767	383681-105046	9171

2101 7590 06/22/2009

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David B. Cochran
JONES DAY
NORTH POINT - 901 LAKESIDE AVE.
CLEVELAND, OH 44114

Date:

MAILED

JUN 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009110
PATENT NO. : 7039767
ART UNIT : 3992

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BROOMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

(For Patent Owner)

DAVID B. COCHRAN
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND, OHIO 44114-1190

(For Third Party Requester)

In re Percival *et alia*
Reexamination Proceeding
Control No. 90/009,110
Request Deposited: April 11, 2008
For: U.S. Patent No.7, 039,767

In re Percival *et alia*
Reexamination Proceeding
Control No. 90/009,385
Request Deposited: January 16, 2009
For: U.S. Patent No. 7,039,767

: 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. 7,039,767 (hereinafter, the '767 patent), issued to Percival *et alia*, on May 2, 2006.

2. On April 11, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '767 patent. The reexamination proceeding was assigned Control No. 90/009,110 (hereinafter, the '9110 proceeding).

3. On January 16, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '767 patent. The reexamination proceeding was assigned Control No. 90/009,385 (hereinafter, the '9385 proceeding).

4. The Reexamination Order was granted for claims 1-4, 14, 19, 20, and 25-27 in the '9110 proceeding on June 4, 2008.

5. The Reexamination Order was granted for claim 15 in the '9385 proceeding on April 13, 2009.

6. 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 '9110 and the '9385 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. 90/009,110 and 90/009,385 are MERGED.

2. The reexamination files are being forwarded to the examiner for action.

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.

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.
90/009,110	04/11/2008	7039767	383681-105046	9171

2101 7590 09/18/2009

Sunstein Kann Murphy & Timbers LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/18/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David B. Cochran
JONES DAY
NORTH POINT - 901 LAKESIDE AVE.
CLEVELAND, OH 44114

Date:

MAILED

SEP 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009110
PATENT NO. : 7039767
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,385	01/16/2009	7039767	383681-105046	6544

2101 7590 09/18/2009

Sunstein Kann Murphy & Timbers LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/18/2009

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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

David B. Cochran
JONES DAY
North Point-901 Lakeside Ave.
Cleveland, OH 44114

Date:
MAILED
SEP 1 82009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009385
PATENT NO. : 7039767
ART UNIT : 3992

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

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

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

Sunstein Kann Murphy & Timbers LLP
125 SUMMER STREET
BOSTON MA 02110-1618

(For Patent Owner)

DAVID B. COCHRAN, ESQ
JONES DAY/,NORTH POINT
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

(For Requester)

MAILED

SEP 1 82009

CENTRAL REEXAMINATION UNIT

In re Percival (US Patent Number 7,039,767)
Reexamination Cont. Nos.: 90/009,110 (merged with 90/009,385)
Filed: April 11, 2008 and January 16, 2009
For: **METHOD AND SYSTEM FOR COHERENTLY CACHING I/O DEVICES ACROSS A NETWORK**

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petitions under 37 CFR 1.59(b), filed October 2, 2008 and June 22, 2009 (note: the petitions were filed in the 900/009,110 control number only), to expunge information from the above identified proceeding.

The petitions are granted.

Petitioner requests that documents identified as AE-AJ, AL-AP, AR, AS, AW, and AX, filed October 2, 2008, and documents identified as FF and FG, filed June 22, 2009, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

Patent Owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file and is being returned to Patent Owner along with this paper. A copy of this paper (without attachments) is being mailed to Requester and will be made of record in the proceeding.

It is also noted the PTOL-469 mailed incorrectly listed claims 1-4, 14, 19, 20, and 25-27 as both confirmed and amended (including dependent on amended claims). All of those claims were amended (including dependent on amended claims), so none of those claims are confirmed.

Eric Keasel
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,111	04/11/2008	7,111,129	383681-105046	8361

2101 7590 09/01/2009

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/01/2009

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

David B. Cochran, Esq.
Jones Day/North Point
901 Lakeside Avenue
Cleveland, OH 44114

Date:

MAILED

SEP 01 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009111
PATENT NO. : 7111129
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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Sunstein Kann Murphy & Timbers LLP
125 SUMMER STREET
BOSTON MA 02110-1618

(For Patent Owner)

MAILED

SEP 01 2009

CENTRAL REEXAMINATION UNIT

DAVID B. COCHRAN, ESQ
JONES DAY/,NORTH POINT
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

(For Requester)

In re Percival (US Patent Number 7,111,129)
Reexamination Cont. No.: 90/009,111
Filed: April 11, 2008
For: **METHOD AND SYSTEM FOR COHERENTLY CACHING I/O DEVICES ACROSS A NETWORK**

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petitions under 37 CFR 1.59(b), filed October 2, 2008 and June 22, 2009, to expunge information from the above identified proceeding.

The petitions are granted.

Petitioner requests that documents identified as AE-AJ, AL-AP, AR, AS, AW, and AX, filed October 2, 2008, and documents identified as FF and FG, filed June 22, 2009, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

Patent Owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file and is being returned to Patent Owner along with this paper. A copy of this paper (without attachments) is being mailed to Requester and will be made of record in the proceeding.

Eric Keasel
SPE, AU 3992

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Alexandria, VA 22313-1450
www.uspto.gov

Andrew I Kimmel
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

(For Patent Owner)

MAILED

MAR 11 2009

CENTRAL REEXAMINATION UNIT

Frank Michael Weyer
THE HECKER LAW GROUP
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES, CA 90067

(For Third Party Requester)

PETITION DECISION
DENYING
REQUEST TO VACATE
AS NON-COMPLIANT
[37 CFR 1.181(a) & (c)]

In re Peter Warren
Ex parte Reexamination Proceeding
Control No. 90/009,112
Deposited: 16 April 2008
For: U.S. Patent No. 7,013,009

This is a decision on the 13 August 2008 patent owner "Petition Under 37 CFR § 1.182 To Strike Detailed Request For Reexamination Due To Noncompliance With At Least MPEP § 2205"

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 RELVANT FACTS

1. On 14 March 2006, US Patent No. 7,013,009 was granted to Peter Warren.

2. On 16 April 2008 a request was deposited requesting reexamination of US Patent No. 7,013,009 by a Third Party Requester.

3. On 16 June 2008 the Order granting reexamination was mailed.

4. The instant petition was filed on 13 August 2008.

DISCUSSION AND CITATION OF RELEVENT AUTHORITY

On 13 August 2008 the Patent Owner petitioned the USPTO to strike the request for the reexamination proceeding identified by control number 90/009,112. This type of petition is handled under 37 CFR § 1.181(a) and (c), as such, the petition is before the director of the Central Reexamination. The petition was filed within two months of the action taken by the examiner and as such is timely filed. The petition fee was electronically filed. No certificate of service was provided by the patent owner for the instant petition.

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.

...

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

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

(d) Where a fee is required for a petition to the Director the appropriate section of

this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

...

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

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

37 CFR § 1.510 Request for ex parte reexamination. (in-part)

(a) Any person may, at any time during the period of enforceability of a patent, file a request for an ex parte reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).

37 CFR § 1.530 Statement by patent owner in ex parte reexamination; (in-part)

(c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the ex parte reexamination requester in accordance with § 1.248.

37 CFR § 1.248 Service of papers; manner of service; proof of service in cases other than interferences. (in-part)

(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:
(1) By delivering a copy of the paper to the person served;
(2) By leaving a copy at the usual place of business of the person served with someone in his employment;
(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;
(4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;
(5) Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the Official Gazette.
(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made

by:
(1) An acknowledgement of service by or on behalf of the person served or
(2) A statement signed by the attorney or agent containing the information required by this section.
(c) See § 41.106(e) of this title for service of papers in contested cases before the Board of Patent Appeals and Interferences.

37 CFR § 1.550. Conduct of *ex parte* reexamination proceedings (in-part)

(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.

DECISION

The patent owner petitions to strike the request for reexamination due to noncompliance identified as control number 90/009,112. The patent owner cites portions of MPEP § 2206 which state that *ex parte* reexamination proceedings are based solely on patents and printed publications. Further, the patent owner asserts that "the request includes an abundance of irrelevant factual allegations and improper innuendo, including statements which are not directed to patents or printed publications." The patent owner seeks to have the proceeding terminated by finding the request improper.

Review of the Order written by the examiner in charge of the proceeding indicates that the Order granting reexamination was based solely on patents or printed publications. The examiner further reviews the prosecution history to clarify whether the examiner believes that a substantial new question of patentability exists for the purpose of ordering the reexamination proceeding. The Order contains no reference to the language which the patent owner finds objectionable. The examiner in the Order granting *ex parte* reexamination mailed on 16 June 2008 has determined that a substantial new question of patentability exists based upon the patents and printed publications provided by the third party requester.

The patent owner is reminded that there was no indication that there was service on the third party requester of this petition. Pursuant to 37 CFR § 1.550(f) the document must reflect service or the document may be refused consideration by the Office. While this document was considered, the patent owner is reminded that future submissions require such service.

Considering all the facts it is clear there was language provided in the request for *ex parte* reexamination by the third party that is outside the scope of reexamination. It is further clear that the language bore no bearing on the examiner's determination that a substantial new question of patentability existed with respect to the patent no. 7,013,009 for which *ex parte* reexamination was sought. The determination that the Order should be granted was proper.

The petition dated 13 August 2008 to strike the detailed request is denied.

CONCLUSION

1. The patent owner's petition dated 13 August 2008 to strike detailed request for reexamination due to noncompliance is hereby **denied.**

2. The ex parte reexamination proceeding is forwarded to the examiner in charge of the proceeding for further action.

3. Future correspondence may be submitted as follows:

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,113	04/17/2008	6979117	24122-	4417

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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(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. *90/009,113*.

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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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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Alexandria, VA 22313-1450
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Larry K. Roberts
Roberts & Quiogue
P.O. BOX 8569
Newport Beach, CA 92658-8569

(For Patent Owner)

MAILED

JUL 29 2008

CENTRAL REEXAMINATION UNIT

Advance Security, Inc.
c/o Belasco Jacobs & Townsley, LLP
6100 Center Drive, Suite 630
Los Angeles, California 90045

(For Third Party Requester)

In re Drori
Ex Parte Reexamination Proceeding
Control No.: 90/009,115
Filed April 21, 2008
For: U.S. Patent No.: 5,146,215

DECISION DISMISSING AND EXPUNGING PETITION

This is a decision on the June 18, 2008 third party requester petition entitled "REQUEST FOR WITHDRAWAL OR SUSPENSION."

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

The petition is dismissed and is being expunged as an improper paper for the reasons pointed out below.

REVIEW OF FACTS

1. U.S. Patent No. 5,146,215 (the '215 patent) was issued on September 9, 1992.

2. A third party requester filed a request for *ex parte* reexamination of the '215 patent on April 21, 2008. The request for reexamination was assigned control number 90/009,115 (the '9115 proceeding) and is the present proceeding

3. Reexamination was ordered for the '9115 reexamination proceeding on June 10, 2008.

4. The third party requester filed the present petition to withdraw or suspend the '9115 reexamination proceeding on June 18, 2008.

DECISION RETURNING IMPROPER SUBMISSION

The present June 18, 2008 petition for withdrawal of the reexamination request is being expunged, since the petition requesting withdrawal is an improper submission:

1. Pursuant to the second sentence of 37 CFR 1.540:

> No submissions other than the statement pursuant to § 1.530 and the reply by the requester pursuant to § 1.535 will be considered prior to examination.

Under 37 CFR 1.540, the present petition paper does not have an entry right, since it is not a statement under 37 CFR 1.530, nor is it a reply under 37 CFR 1.535, and it has been filed prior to the start of *ex parte* examination on the merits. It is also to be noted that, except for the right to file a reply under 37 CFR 1.535 where appropriate, a third party requester has no right to comment or participate in a reexamination proceeding. The requester in this instance does not have the right to participate in the proceeding by requesting its withdrawal or suspension.

2. As to third parties in general, 37 CFR 1.550 provides:

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

The present petition paper is not entitled to entry under 37 CFR 1.550, as a submission by a third party in general, since it is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, it is not a reply to a patent owner's statement pursuant to 37 CFR 1.535, and it does not qualify as a prior art citation under 37 CFR 1.501.

3. In view of the above, the petition is an improper paper pursuant to 37 CFR 1.540 and 37 CFR 1.550, and the petition paper is not entitled to entry into the record of the reexamination file. A copy of the petition paper was, however, scanned into the electronic Image File Wrapper (IFW) of the '9115 proceeding, before the discovery of the impropriety. That copy cannot be physically removed from the electronic Image File Wrapper ("IFW") for this proceeding. Rather, the IFW copy of the paper is being expunged by closing it in the IFW file of the '9115 reexamination proceeding and marking the petition paper "closed" and "non-public" in the IFW. The petition will not form part of the official IFW record of the '9115 reexamination proceeding. However, the present decision will be made of part of the official record (the IFW) for the '9115 proceeding.

ADDITIONAL DISCUSSION

The third party requester has not requested the waiver of any regulation precluding entry of the present petition; however, no such waiver would be appropriate even if requested. Neither the statute, nor the rules, provide for the withdrawal of a request for reexamination that is presently sought. In fact, no withdrawal of a request for reexamination is possible. As stated in MPEP 2210:

> "After the request for reexamination, including the entire fee for requesting reexamination is received in the Office, no abandonment, withdrawal or striking of the request is possible, regardless of who requests the same."

See also *Joy Manufacturing Co. v National Mine Service Co,* 810 F.2d 1127 (Fed. Cir. 1987), where the court stated:

> "In this connection, we also note that the principal relief which Joy seeks -- namely, stopping the re-examination of its patent -- is not available in these proceedings. Accord Manual of Patent Examining Procedure § 2210 (5th ed. 1983)..."

The statement in MPEP 2210 is grounded upon the following analysis:

35 U.S.C. § 302 states, in pertinent part:

> "Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

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

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

printed publications. ... **On his own initiative, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.**" (Emphasis supplied.)

35 U.S.C. § 304 states, in pertinent part:

> "**If**, in a determination made under the provisions of subsection 303(a) of this title, **the Director finds that a substantial new question of patentability** affecting any claim of a patent **is raised**, the determination **will include an order for reexamination of the patent for resolution of the question.**" (Emphasis supplied.)

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

> "After the times for filing the statement and reply provided for by section 304 of this title have expired, **reexamination will be conducted** according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. ... In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, ..." (Emphasis supplied.)

35 U.S.C. §§ 302–305 provide, *inter alia*, that when a request for reexamination is filed, the Director will determine whether a substantial new question of patentability exists. [1] Thereafter, if the Director has determined that a substantial new question of patentability exists, that determination will include an order for reexamination of the patent. [2] Thereafter, reexamination will be conducted, and patent owner will be permitted to propose an amendment of his patent to address the new question. [3]

A request to withdraw an *ex parte* reexamination request is not permitted in view of that enacted legislation and the implementing rules which require that (1) once an *ex parte* reexamination request is filed, it will be decided, and (2) once the request is determined to raise a substantial new question of patentability of a claim of the patent, the request *will* result in an order for reexamination to resolve the substantial new question, which in turn *will* be followed by reexamination in accordance with 35 U.S.C. §§ 303-305.

The statutory language is based on the public interest in resolving any reexamination proceeding that is filed. Withdrawal of a reexamination proceeding would leave both the public and the patent owner with an unresolved request for reexamination. Both the public and the patent owner have a right to such a resolution. Further, in the event a substantial new question of patentability is raised by the request, the public and the patent owner have a statutory right to have that question resolved, including the patent owner's right to amend the patent as patent owner deems necessary. All of this would be abrogated by "withdrawing" or otherwise "abandoning" or "terminating" a reexamination.

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[1] 35 U.S.C. § 303
[2] 35 U.S.C. § 304
[3] 35 U.S.C. § 305

It is finally to be noted that, even **if** a reexamination request could be withdrawn, the Director is authorized under 35 U.S.C. § 303(a) to order reexamination on his own initiative, to address any substantial new question of patentability which might be raised by such a request. [4] As a matter of administrative convenience, the Office would not (and does not need to) expend the additional resources needed to withdraw one reexamination proceeding only to institute (on its own initiative) another one based on the same substantial new question of patentability that exists in a reexamination sought to be withdrawn.

CONCLUSION

1. The third party requester petition paper filed June 18, 2008, is hereby expunged as not having an entry right. The paper is being expunged by closing it in the IFW file of the present reexamination proceeding, and marking the petition paper "closed" and "non-public" in the IFW.

2. The present decision is being made of part of the official record (the IFW) for the present proceeding.

3. Jurisdiction over the present *ex parte* reexamination proceeding is being returned to the Central Reexamination Unit (CRU), for appropriate action in due course.

4. 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\kenWD\9115 Withdraw Request-dismiss+expunge.doc
C:\kiva\kimpropr\3PR-partic\9115 Withdraw Request-dismiss+expunge.doc

[4] And such would serve the public interest on which the Director-initiated-reexamination enactment is grounded.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,115	04/21/2008	5146215	08-063-BZ	5347

7590 07/29/2008

EXAMINER	
ART UNIT	PAPER NUMBER

Larry K. Roberts
ROBERTS & QUIOGUE
P.O. BOX 8569
Newport Beach, CA 92658-8569

DATE MAILED: 07/29/2008

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,118	04/21/2008	6890193	AKIRA KIMURA ET AL. -2	6824

25889 7590 08/25/2009

EXAMINER

LAW OFFICES OF CLEMENT CHENG
17220 NEWHOPE STREET #127
FOUNTAIN VALLEY, CA 92708

ART UNIT	PAPER NUMBER

DATE MAILED: 08/25/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,118	04/21/2008	6890193	AKIRA KIMURA ET AL. -2	6824

25889 7590 08/25/2009

COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/25/2009

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AUG 25 2009

CENTRAL REEXAMINATION UNIT

COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

(For Patent Owner)

LAW OFFICES OF CLEMENT CHENG
17220 NEWHOPE STREET #127
FOUNTAIN VALLEY, CA 92708

(For Third Party Requester)

In re Kimura et al.
Ex Parte Reexamination Proceeding
Control No.: 90/009,118
Filed: April 21, 2008
For: U.S. Patent No.: 6,890,193

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

This is a decision on the July 20, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. 1.182" to request entry of a supplemental amendment filed after the termination of the prosecution in this reexamination proceeding. The petition also requests issuance of a Supplemental Notice of Intent to Issue *Ex Parte* Reexamination Certificate.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to deposit account No. 03-2468 on July 21, 2009.

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

The petition is dismissed for the reasons set forth below.

The supplemental amendment filed on July 20, 2009, has not been entered for consideration by the examiner.

REVIEW OF RELEVANT FACTS

1. Patent number 6,890,193 issued May 10, 2005 with 15 claims.
2. A request for reexamination, assigned control No. 90/009,118 (the '9118 reexamination proceeding), was filed on April 21, 2008.
3. The proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on July 13, 2009.
4. The present petition was filed on July 20, 2009, accompanied by a supplemental amendment that the patent owner requests the Office to consider.

5. The reexamination proceeding is in the Office of Data Management (formerly the Office of Patent Publication) for printing of a reexamination certificate, and jurisdiction is being exercised by OPLA for the limited purpose of deciding the pending petition.

DECISION

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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

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

35 U.S.C. § 307(a) states:

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 1.530(f) states:

Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:
(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and
(2) The matter to be added by the reexamination proceeding must be underlined.

37 CFR 1.530(i) states:

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.

37 CFR 1.570(a) states:

(a) To conclude an *ex parte* reexamination proceeding, the Director will issue and publish an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.

MPEP § 2287 states in pertinent part:

Upon conclusion of the *ex parte* reexamination proceeding, the examiner must prepare a "Notice of Intent to Issue *Ex Parte* Reexamination Certificate" (NIRC) by completing form PTOL-469. If appropriate, an examiner's amendment will also be prepared. Where claims are found patentable, reasons must be given for each claim found patentable. See the discussion as to preparation of an examiner's amendment and reasons for allowance at the end of this section. In addition, the examiner must prepare the reexamination file so that the Office of Data Management can prepare and issue a certificate in accordance with 35 U.S.C. 307 and 37 CFR 1.570 setting forth the results of the reexamination proceeding and the content of the patent following the proceeding. See MPEP § 2288.

The examiner will so inform his/her Central Reexamination Unit (CRU) Supervisory Patent Examiner (SPE) or Technology Center (TC) Quality Assurance Specialist (QAS) of the conclusion of the reexamination proceeding. The CRU SPE/TC QAS will convene a panel review conference (see MPEP §

> 2271.01), and the conference members will review the patentability of the claim(s). If the conference confirms the examiner's decision, a NIRC shall be issued and signed by the examiner, with the two other conferees initialing the NIRC (as "conferee") to indicate their participation in the conference. Both conferees will initial, even though one of them may have dissented from the 3-party conference decision on the patentability of the claim(s). If the conference does not confirm the patentability of the claim(s), the examiner will reevaluate and issue an appropriate Office action rejecting the claim(s), not confirmed as patentable.
>
> *****
>
> Thus, a panel review conference **must** be held in each instance where a NIRC is about to be issued, unless the NIRC is being issued: (A) following and consistent with a decision by the Board of Patent Appeals and Interferences (or court) on the merits of the proceeding; or (B) as a consequence of the patent owner's failure to respond or take other action where such a response or action is necessary to maintain pendency of the proceeding and, as a result of which failure to respond, all of the claims will be canceled.
>
> A NIRC informs the patent owner and any third party requester that the reexamination prosecution has been terminated. The rules do not provide for an amendment to be filed in a reexamination proceeding after prosecution has been terminated. The provisions of 37 CFR 1.312 do not apply in reexamination. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after prosecution has been terminated must be accompanied by a petition under 37 CFR 1.182 to have the amendment considered.

A review of the record shows that patent owner filed an amendment on March 13, 2009 during the reexamination proceeding that was entered. In that amendment, **patent owner added limitations to claim 12** in order to distinguish the claim from the cited references.[1] The record further shows that the examiner conducted a patentability review conference as required. Thereafter, an examiner's amendment was made to claim 12 to make grammatical corrections in two instances by amending "portion" to "portions.[2] The examiner then terminated prosecution on the merits and issued an NIRC on July 13, 2009. Jurisdiction over the file was forwarded, pursuant to MPEP 2289, to the Office of Patent Legal Administration for screening in preparation to forwarding the file to the Office of Data Management (formerly the Office of Patent Publication) for issuance of the reexamination certificate. Jurisdiction over the file was then forwarded to the Office of Data Management on July 17, 2009.

The petition is accompanied by an amendment that proposes to amend claim 12 and to add claim 16 that depends from claim 12. Petitioner merely states that based upon further review of the previous amendment, the patentee believes that the subject matter claimed therein is less than he intended to claim and therefore the claims present in the previous amendment claim less than the patentee had a right to claim.[3] The petitioner further states that the subject matter of the amended claims is not taught or suggested by any of the cited prior art references, and the features presented in the previous amendment to claim 12, which now have been cancelled in the enclosed amendment, were not necessary to overcome the Examiner's rejections.[4] Since the examiner's amendment only made two minor grammatical corrections as discussed above, it is apparent that the **previous amendment referred to in the present petition is clearly patent owner's amendment filed on March 13, 2009**.

---

[1] See pages 8-9 of patent owner response filed on March 13, 2009 and page 5 of the claim amendments filed concurrently with the response.

[2] See pages 2-4 of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate mailed on July 13, 2009.

[3] See page 1 of the petition.

[4] Id. at pages 1-2.

The proposed supplemental amendment does not comply with 37 CFR 1.530(f) and (i). The proposed amendment does not show changes made in all the claims relative to the patent being reexamined in the manner required by 37 CFR 1.530(f) and (i). Rather, the changes shown in proposed claim 12 are relative to the previous amendment. Thus, the amendment cannot be entered, and the petition must be dismissed. It is also pointed out that a cursory review of the proposed supplemental amendment shows claim 12 to have been amended substantially and the distinguishing features of claim 12 cited in the examiner's reasons for allowance are no longer in claim 12; re-prosecution of claim 12, as it would be amended if the amendment were in proper form and entered, after issuance of the NIRC would involve delay that runs contrary to the statutory mandate for special dispatch in reexamination.

The proceeding has now entered the final stages of the publication process, with the proceeding being late in the reexamination certificate printing cycle. 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.

The following considerations all point to the fact that, if the requested amendment were to be entered, (a) issuance of the reexamination certificate will be unduly delayed and (b) the expenditure of further Office resources would be needed to redo work already undertaken before the reexamination proceeding could be forwarded for publication of a reexamination certificate:

1) The claim amendments were submitted after prosecution had been terminated by issuance of a NIRC on July 13, 2009. The features that would be deleted from claim 12 in the proposed amendment were added by patent owner in the amendment filed on March 13, 2009.

2) The proposed amendment to the claims appears to introduce changes that must be reviewed to determine whether they raise issues regarding the patentability of some of the claims.

3) The proposed amendment does not comply with 37 CFR 1.530(f) and (i).

4) If the claim amendment were entered, another patentability review conference and re-work will have to be conducted to address the claims as amended.

5) Screening in the Office of Patent Legal Administration will have to be conducted again.

Therefore, it is considered that patent owner has not demonstrated a sound reason for reopening the reexamination proceeding.

CONCLUSION

1. The present petition under 37 CFR 1.182 requesting entry of an amendment filed after the NIRC is dismissed.

2. The proposed amendment filed after the NIRC and concurrently with the present petition

under 37 CFR 1.182 has not been entered for consideration by the examiner.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,122	04/24/2008	5,518,918	L111 7002	5088

70960 7590 12/19/2008

SHERIDAN ROSS P.C.
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/19/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
PATENT DOCKETING 32nd FLOOR
P.O. BOX 7037
ATLANTA, GA 30357-0037

Date:
MAILED
DEC 19 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009122
PATENT NO. : 5518918
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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Gary Connell
Sheridan Ross P.C.
1560 Broadway
Suite 1200
Denver, CO 80202

For Patent Owner

MAILED

DEC 19 2008

CENTRAL REEXAMINATION UNIT

Susan E. Shaw McBee
Womble Carlyle Sandridge and Rice PLLC
Patent Docketing 32nd Floor
P.O. Box 7037
Atlanta, GA 30357-0037

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,122
Filed: April 24, 2008
For: US Patent No. 5,518,918

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

This is a decision on the petition filed December 18, 2008 to request a two-month extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated November 6, 2008.

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

The petition is **GRANTED** for **ONE MONTH** for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated November 6, 2008 which set a two month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

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

The petition for extension of time states that many of the critical individuals have been available on a very limited basis during November and December. Despite this, the outstanding Office action has been analyzed and it has been determined that additional experiments to repeat examples from the cited art are necessary. An extension of time for two months is requested to prepare a complete and substantive response.

Analysis and Findings

Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period; however, when balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Patent Owner's showing is insufficient to justify the grant of a two-month extension of time in which to file a response to the outstanding Office action. In the interest of providing the Patent Owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for one (1) month is granted.

Conclusion

1. The Patent Owner's petition for a two-month extension of time in which to file a response to the Office action is **GRANTED for ONE MONTH.**

2. The Patent Owner's response is due February 6, 2009.

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/
Gregory Morse,
Director,
Central Reexamination Unit

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

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SEP 23 2008

CENTRAL REEXAMINATION UNIT

SRI INTERNATIONAL
333 RAVENSWOOD AVENUE
MENLO PARK CA 94025

(For Patent Owner)

Renée DuBord Brown, Esq
DAY CASEBEER MADRID
& BATCHELDER LLP
20300 Stevens Creek Boulevard
Suite 400
Cupertino, CA 95014

(for Third Party Requester)

DECISION,
MERGING
REEXAMINATION
PROCEEDINGS
37 C.F.R. § 1.565(c)

In re: Porras *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,125
Deposited: 7 July 2006
For: US Patent No. 6,484,203

In re: Porras *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,126
Deposited: 25 April 2008
For: US Patent No. 6,484,203

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

BACKGROUND

1. Patent No. 6,484,203 issued on 19 November 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,125 was requested by a third party requester on 7 July 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,125 on 31 August 2006.

4. There are currently no amendments proceeding control number 90/008,125.

5. *Ex Parte* Reexamination Proceeding, control no. 90/009,126 was requested by a third party requester filed on 25 April 2008.

6. The Reexamination Order was granted in proceeding, control no. 90/009,126 on 19 July 2008.

7. There are currently no amendments proceeding control number 90/009,126.

8. Proceedings control numbers 90/008,113 and 90/009,126 await action from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

2283 Multiple Copending Ex Parte Reexamination Proceedings (in part)

In order for a second or subsequent request for ex parte reexamination to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. MPEP § 2240 provides a discussion as to whether a substantial new question of patentability is raised by the prior art cited in a second or subsequent request for reexamination filed while a reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to combine the proceedings will be made by the Central Reexamination Unit (CRU)

Director where the reexamination is pending. The CRU Director may delegate this to the Special Program Examiner (SPRE). No decision on combining the reexaminations should be made until reexamination is actually ordered in the later filed request for reexamination.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. While merger is at the discretion of the Director of the CRU, given the facts noted above, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,125 and 90/009,126 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,125 and 90/009,126 are hereby **MERGED**.

2. The reexamination files are being forwarded to the examiner for further action.

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

DEC 03 2008

CENTRAL REEXAMINATION UNIT

Thomas A. Rozylowicz : (For Patent Owner)
FISH & RICHARDSON, P.C. :
PO Box 1022 :
MINNEAPOLIS, MN 55440-1022 :

Renee DuBord, Esq. : (For Third-Party Requester)
DAY, CASEBEER MADRID :
& BATCHELDER LLP :
20300 STEVENS CREEK BLVD :
SUITE 400 :
CUPERTINO, CA 95014 :

In re PORRAS *et alia* : DECISION DISMISSING
Reexamination Proceeding : PETITION FOR
Control No. 90 / 008,125 : ADMISSION OF EVIDENCE
For: U.S. Patent No. 6,484,203 : UNDER 37 CFR 1.116

In re PORRAS *et alia* :
Reexamination Proceeding :
Control No. 90 / 009,126 :
For: U.S. Patent No. 6,484,203 :

This is a decision on patent owner's petition for admission of evidence under 37 CFR 1.116 filed on November 21, 2008. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 6,484,203 was ordered in the Determination mailed August 31, 2006.

2. The proceeding was merged with Reexamination proceeding 90/009,126 on September 23, 2008.

4. A petition for an extension of time was filed on November 21, 2008.

4. The petition for extension of time was granted on November 25, 2008. The period for response has been extended to the date requested by Owner. Patent owner's response to the Office action dated September 24, 2008 is due December 5, 2008.

37 CFR 1.116 states in pertinent part:

> ***§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.***
> *(a) An amendment after final action must comply with § 1.114 or this section.*
> *(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):*
>
> *(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.*
>
> *[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]*

DECISION

37 CFR 1.116 provides for the admission of amendments affidavits or other evidence after final action and prior to appeal. Here, it appears petitioner is asking for an indication that the showing of good and sufficient reasons why the evidence is necessary and was not earlier presented passes approval prior to the formulation of a complete response to the outstanding final rejection. Petitioner states "this evidence is necessary to formulate a complete response to the outstanding final office action" indicating the petition is not to be construed as a complete response. It is apparent that petitioner hopes to be persuasive in some manner via the presentation of the evidence and it is not be submitted merely to be made "of record". However the paper has not been presented as an "amendment after final rejection" or "submission of evidence after final rejection": the paper is stylized as a "petition" for admission of evidence under 37 CFR 1.116.

37 CFR 1.116 provides no basis for granting the relief sought. Judgment on the propriety of any response submitted after final rejection is passed upon by the primary examiner and is reviewed in the total context of the complete response including the showing of good and sufficient

reasons why the affidavit or other evidence is necessary and was not earlier presented. Simply, this judgment can not be made separate from and absent the proposed actions or arguments provided by a complete response. Further, 37 CFR 1.116 nowhere authorizes any "petition".

The petition can not be construed as a petition filed under 37 CFR 1.181 as no adverse action related to the admission of evidence has been made by the examiner. Should applicant submit a complete response and believe it to be improperly denied entry by the examiner; relief may be sought under this regulation.

The following observations are noted. As it is stated the evidence resulted from cross-examined trial testimony, it would be helpful if any showing after Final included an indication as to the source of the testimony. It would be reasonable to explain which side of the litigation the witnesses represented. If the witnesses were testifying on behalf of Owner, an explanation of why the positions of the witness(s) were not earlier presented via affidavit would be in order.

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running from the September 5, 2008 Office action as extended in the November 11, 2008 decision on petition for extension of time. Patent Owner's response is due December 5, 2008.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html.**

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

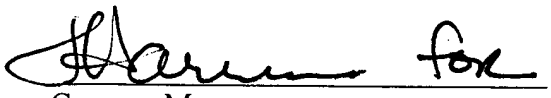
By FAX to: (571) 273-9900
Central Reexamination Unit

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for

reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.



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.
90/008,113	09/07/2006	6711615	1904-001	2543

45274 7590 09/23/2008

SRI INTERNATIONAL
333 RAVENSWOOD AVENUE
MENLO PARK, CA 94025

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/009,127	04/25/2008	6711615	1904-001	7612

45274 7590 09/23/2008

SRI INTERNATIONAL
333 RAVENSWOOD AVENUE
MENLO PARK, CA 94025

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RENEE D. BROWN
DAY, CASEBEER,MADRID&BATCHELDER LLP
20300 STEVENS CREEK BLVD. SUITE 400
CUPERTINO, CA 95014

Date:
MAILED

SEP 23 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008113
PATENT NO. : 6711615
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAY CASEBEER MADRID & BATCHELDER LLP
ATTN: RENEE DUBORD BROWN
20300 STEVENS CREEK BOULEVARD SUITE 400
CUPERTINO, CA 95014

Date:
MAILED
SEP 23 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009127
PATENT NO. : 6711615
ART UNIT : 3992

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

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

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 23 2008

CENTRAL REEXAMINATION UNIT

SRI INTERNATIONAL
333 RAVENSWOOD AVENUE
MENLO PARK CA 94025

(For Patent Owner)

Renee DuBord Brown
DAY CASEBEER MADRID
& BATCHELDER LLP
20300 Stevens Creek Boulevard
Suite 400
Cupertino, CA 95014

(for Third Party Requester)

DECISION,
MERGING
REEXAMINATION
PROCEEDINGS
37 C.F.R. § 1.565(c)

In re: Porras *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,113
Deposited: 7 September 2006
For: US Patent No. 6,711,615

In re: Porras *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,127
Deposited: 25 April 2008
For: US Patent No. 6,711,615

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

BACKGROUND

1. Patent No. 6,711,615 issued on 23 March 2004.

2. *Ex Parte* Reexamination Proceeding, control no. 90/008,113 was requested by a third party requester on 7 September 2006.

3. The Reexamination Order was granted in proceeding, control no. 90/008,113 on 22 November 2006.

4. There are currently no amendments proceeding control number 90/008,113.

5. *Ex Parte* Reexamination Proceeding, control no. 90/009,127 was requested by a third party requester filed on 25 April 2008.

6. The Reexamination Order was granted in proceeding, control no. 90/009,127 on 19 July 2008.

7. There are currently no amendments proceeding control number 90/009,127.

8. Proceedings control numbers 90/008,113 and 90/009,127await action from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

2283 Multiple Copending Ex Parte Reexamination Proceedings (in part)

In order for a second or subsequent request for ex parte reexamination to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. MPEP § 2240 provides a discussion as to whether a substantial new question of patentability is raised by the prior art cited in a second or subsequent request for reexamination filed while a reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to combine the proceedings will be made by the Central Reexamination Unit (CRU)

Director where the reexamination is pending. The CRU Director may delegate this to the Special Program Examiner (SPRE). No decision on combining the reexaminations should be made until reexamination is actually ordered in the later filed request for reexamination.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. While merger is at the discretion of the Director of the CRU, given the facts noted above, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/008,113 and 90/009,127 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/008,113 and 90/009,127 are hereby **MERGED**.

2. The reexamination files are being forwarded to the examiner for further action.

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

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

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

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

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

/Mark Reinhart/
for

_____

Gregory Morse,
Director,
Central Reexamination Unit

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.
90/009,129	04/29/2008	7174352	112056-0500P1	9442

24267 7590 03/10/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Ronald L. Yin
DLA Piper US LLP
2000 University Avenue
East Palo Alto, CA 94303

MAILED

MAR 10 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,129*.

PATENT NO. *7174352*.

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

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

(For Patent Owner)

MAILED

MAR 10 2010

CENTRAL REEXAMINATION UNIT

RONALD Y. YIN
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303

(For Requester)

In re Kleiman et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,129
Filed: April 29, 2008
For: U.S. Patent No. 7,174,352 B2

DECISION
DISMISSING PETITION
UNDER § 1.182

This is a decision on the December 21, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

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

The petition is **dismissed**.

BACKGROUND

- On April 29, 2008, 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 90/009,129 ("the '9129 proceeding").

- Prosecution in the '9129 proceeding progressed until, on August 27, 2009, a final Office action was mailed. The final Office action addressed claims 1-8, 18, 22, 25, 33-36, 38, and 63-68, which are subject to reexamination. The action listed claims 9-17, 19-21, 23, 24, 26-32, 37, and 39-62 as not subject to reexamination.

- On October 27, 2009, patent owner filed a response, including amendments to claims 8, 18, 33, 35, 36, 38, 64, 65, 67, and 68, and cancelling claims 63 and 66, to the final Office action of August 27, 2009.

- On November 19, 2009, an advisory Office action was mailed by the Office, refusing entry of the amendments submitted on October 27, 2009 as raising new issues and not materially reducing or simplifying the issues for appeal, and setting a time period for response to run 4 months from the date of the final Office action.

- On December 21, 2009, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the amendments filed on October 27, 2009, and refused entry on November 19, 2009.

- On December 28, 2009, a Notice of Appeal was filed by patent owner.

- On February 18, 2010, patent owner filed a petition under 37 C.F.R. § 1.550(c) seeking an extension of time to file an 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)

DECISION

The December 21, 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 October 27, 2009, and refused entry by the examiner in an advisory Office action mailed November 19, 2009.

1. The Basis of Relief For the Instant Petition is Under 37 C.F.R. § 1.182

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, in part, that the examiner erred in his refusal to enter the October 27, 2009 amendment in the advisory action mailed November 19, 2009, because the amendment did not raise new issues and was proper for entry under § 1.116, and/or that the final Office action of August 27, 2009 presented new analysis while failing to address all of patent owner's arguments. See pages 5 and 7-9 of the December 21, 2009 patent owner petition. These allegations made in the instant 37 C.F.R. § 1.182 petition address alleged impropriety as to the final Office action and the advisory action, and do not form the basis for a petition requesting continued examination under 37 C.F.R. § 1.182. Allegations as to an impropriety of an action by an examiner are properly addressed under 37 C.F.R. § 1.181 instead. Therefore, the propriety of the final Office action and the advisory action will not be discussed in this decision.

2. Merits of the Request for Relief Under 37 C.F.R. § 1.182

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.

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

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. Patent owners were advised by the Office to use the petition procedure set forth in 37 C.F.R. § 1.182 for situations not otherwise addressed, 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.

In light of this, patent owner, in his petition, alleged that entry of the October 27, 2009 amendment is a *bona fide* attempt to advance prosecution as entry would "likely further reduce or better define issues for appeal and will better serve the PTO's requirement of special dispatch than commencement of appeal at this time." Petition at 10.

However, the substance of the proposed amendment does not support this allegation. It is first noted that patent owner's petition does not present reasons why the proposed amendments could not have been submitted prior to the final Office action. The amendments proposed by patent owner would amend each other independent claim under reexamination "to include a limitation present in claim 1 as issued," a limitation that has been the subject of active discussion throughout the reexamination proceeding. Petition at 8. Therefore, patent owner had the opportunity to amend the other claims to include such a limitation at any time during the reexamination proceeding There is no reason presented by the patent owner, or apparent from the history of the reexamination proceeding, why the proposed amendment could not reasonably have been submitted, if patent owner so chose, prior to final Office action. Entry of such an

amendment at this point in the proceedings would not be consistent with conducting reexamination proceedings with special dispatch within the Office.

Furthermore, from a review of the advisory Office action, the entry of this amendment would not advance the prosecution of the instant reexamination proceeding, or better define issues for appeal. Instead, the entry of the proposed amendment would import an issue that has already been discussed in detail by the examiner and patent owner into the other independent claims. The issues for appeal would be thereby increased rather than reduced, while the proceeding would contemporaneously be delayed by the reopening of prosecution. Entry of this amendment would thus not result in a savings of time or otherwise satisfy the requirements for conducting reexamination proceedings with 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 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 November 19, 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.

CONCLUSION

- The December 21, 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.

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

March 9, 2010
Kenpet7/RCR

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Commissioner for Patents
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Alexandria, VA 22313-1450
www.uspto.gov

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AUG 22 2008

CENTRAL REEXAMINATION UNIT

MICHAEL BEST & FRIEDRICH LLP (For Patent Owner)
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
CHICAGO, IL 60601

LAW OFFICES OF CLEMENT CHENG (for Third Party
17220 NEWHOPE STREET #127 Requester)
FOUNTAIN VALLEY, CA 92708

DECISION,
MERGING
REEXAMINATION
PROCEEDINGS
37 C.F.R. § 1.565(c)

In re: Hayashi
Ex Parte Reexamination Proceeding
Control No. 90/009,131
Deposited: 5 May 2008
For: US Patent No. 6,315,616

In re: Hayashi
Ex Parte Reexamination Proceeding
Control No. 90/009,160
Deposited: 11 June 2008
For: US Patent No. 6,315,616

This is a decision on the 8 August 2008, petition for "Waiver of Patent Owner's Statement and Petition to Merge Proceedings." The above-identified reexamination files are before the Director of the Central Reexamination Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,315,616 issued on 13 November 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/009,131 was requested by a third party requester on 5 May 2008.

3. The Reexamination Order was granted in proceeding, control no. 90/009,131 on 5 June 2008.

4. There are currently no amendments proceeding control number 90/008,131.

5. *Ex Parte* Reexamination Proceeding, control no. 90/009,160 was requested by a third party requester filed on 11 June 2008.

6. The Reexamination Order was granted in proceeding, control no. 90/009,160 on 15 July 1008.

7. There are currently no amendments proceeding control number 90/009,160.

8. Proceedings control numbers 90/009,131 and 90/009,160 await action from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

2283 Multiple Copending Ex Parte Reexamination Proceedings (in part)

In order for a second or subsequent request for ex parte reexamination to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. MPEP § 2240 provides a discussion as to whether a substantial new question of patentability is raised by the prior art cited in a second or subsequent request for reexamination filed while a reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to combine the proceedings will be made by the Central Reexamination Unit (CRU)

Director where the reexamination is pending. The CRU Director may delegate this to the Special Program Examiner (SPRE). No decision on combining the reexaminations should be made until reexamination is actually ordered in the later filed request for reexamination.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. While merger is at the discretion of the Director of the CRU, given the facts noted above, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/009,131 and 90/009,160 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/009,131 and 90/009,160 are hereby **MERGED**.

2. The reexamination files are being forwarded to the examiner for further action.

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

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,132	05/02/2008	6,572,952	114510.010100/US/3	1020

70155 7590 04/14/2010

GREENBERG TRAURIG (HOU)
INTELLECTUAL PROPERTY DEPARTMENT
1000 Louisiana Street
Suite 1700
Houston, TX 77002

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2010

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

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APR 14 2010

CENTRAL REEXAMINATION UNIT

GREENBERG TRAURIG (HOU)
INTELLECTUAL PROPERTY DEPARTMENT
1000 LOUISIANA STREET
SUITE 1800
HOUSTON, TX 77002

In re Kanter	:	
Ex Parte Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 90/009,132	:	UNDER 37 CFR § 1.181
Deposited: May 2, 2008	:	
For: U.S. Patent No.: 6,572,952	:	

This is a decision on a petition filed by the patent owner on February 22, 2010. The petition is entitled "PETITION UNDER 37 CFR § 1.181" (hereinafter "the petition"), and is a request to the Director to exercise his discretion, pursuant to 37 CFR 1.181. Specifically, the petition requests that the Director finds the Final rejection, dated November 20, 2009, premature, and/or determine that the response of January 20, 2010 should be entered into the record.

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 February 22, 2010 is denied with respect to finding the November 20, 2009 Final rejection premature, and entering the response of January 20, 2010.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,572,952 issued on June 3, 2003.

2. A request for *ex parte* reexamination proceeding, assigned control No. 90/009,132 was filed by the patent owner on May 2, 2008.

3. *Ex parte* reexamination was ordered for the proceeding on May 22, 2008.

4. On September 24, 2008, the patent owner filed a preliminary amendment, which amended patent claim 1 and added proposed new dependent claims 3 and 4.

5. On January 8, 2009, a non-final Office action was mailed. The action rejected claim 1 as being anticipated by Horowitz, and claims 2-4 as being rendered obvious by Horowitz.

6. On March 6, 2009, the patent owner submitted a response, which was not compliant with Office's rules and procedures for claim amendments in reexamination proceedings. Patent Owner also filed informal amendments on March 9, 2009, and March 11, 2009.

7. On October 9, 2009, the Office mailed a notice informing patent owner of the noncompliant amendment of March 11, 2009.

8. On November 9, 2009, patent filed a compliant amendment, which further amended claim 1 and added proposed new dependent claim 5.

9. On November 20, 2009, the Office issued a Final rejection Office action. The Office action newly rejected claims 1-5 under 35 U.S.C. 112, first and second paragraphs, claims 1 & 5 as being anticipated by Horowitz, and claims 2-4 as being rendered obvious by Horowitz

10. On January 20, 2010, Patent Owner filed an after Final response, which included further amendments to claim 1, amendments to dependent claims 2-5, and new proposed dependent claim 6.

11. On January 29, 2010, the Office issued an advisory action denying entry of the amendment because the amendment to claim 1 raises new issues under 35 U.S.C. 112, 305, and proposed new claim 6 raises new issues that would require further consideration.

12. On February 22, 2010, the patent owner filed a Notice of Appeal, and the instant petition.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding to make the November 20, 2009 Office action final and to not enter amendment of January 20, 2010 because the Final rejection included new grounds of rejection, and that the January 20, 2010 amendment was in response to the new grounds of rejection under 35 U.S.C. 112. See pages 5-6 of the petition.

In response to patent owner's arguments that the examiner erred in deciding to make the November 20, 2009 Office action final and to not enter amendment of January 20, 2010, the director finds there are not good and sufficient reasons to enter the declaration. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection and for consideration of after final responses. See MPEP 2272.

Turning to the facts in this proceeding, the Final rejection of November 20, 2009 sets forth the same grounds of rejection for claims 1-4 based on prior art as set forth in the first Office action. As discussed above in the relevant facts section, the amendment of November 9, 2009 further amended claim 1 to change the limitation that the "... mat has an edge of closed cell foam at least one perimeter edge of the carper assembly (mat)," and added new proposed claim 5. The Final rejection of November 20, 2009 did make new rejections under 35 U.S.C. 112 on proposed amended claim 1 and dependent claims 1-5, as a direct result of the November 9, 2009 amendment. The Final rejection also included a new rejection under 35 U.S.C. 102 for new proposed claim 5 based upon the same reference, Horowitz, which was applied against claims 1-4 in the first Office action. The record is clear that these new rejections were caused by the amendment to claim 1 and the addition of proposed new claim 5 in the response of November 9, 2009.

In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed amendment of January 20, 2010 because the proposed amendment addresses the issues under 35 U.S.C. 112 raised in the Final rejection, and does not raise further issues under 35 U.S.C. 112 and 305. See pages 5-6 of the petition. In support of this allegation, the patent owner explains how the amendment of January 20, 2010 clarifies that claim 1 should be interpreted to include four limitations, places the claims in better form for appeal, and that the amendment could not have been previously made because the patent owner was unaware that the examiner was not

interpreting claim 1 to include four element until the Final rejection. See page 6 of the petition. The petitioner also states that the amendment to claim 1 is fully supported by the specification and is not enlarging the scope of the claims. See page 6 of the petition.

Upon review of the record, it is found that the examiner correctly determined that the January 20, 2010 amendment raised new issues pertaining to 35 USC 112 and 305, and also introduced new limitations via proposed new claim 6 that would require more than just a cursory review. For example, it is clear that the new limitations of claim 1 require an edge molding that is affixed to the mat, which is a feature that was not claimed before and would require more than just a cursory review of the record to determine the patentability of the claims, as proposed to be amended in the January 20, 2010 response. The examiner clearly explained the issues raised by the proposed amendment in the January 20, 2010 that would require further consideration. Patent owner's arguments that the proposed amendment of claim 1 does not violate 35 U.S.C. 112 and 305 are not persuasive because the examiner only stated that the January 20, 2010 amendment raised issues pertaining to 35 U.S.C. 112 and 305, which would require further consideration. In other words, the examiner did not make an explicit determination of a new rejection under 35 U.S.C. 112 and 305, but was only showing how the January 20, 2010 raises new issues that would require more consideration. In summary, the record supports the examiner's determination that these issues would require further consideration by the examiner.

In regard to patent owner's argument that the Final rejection of November 20, 2009 raises new issues of claim interpretation regarding claim 1, first, it is noted that the rejection of claim 1 under 35 U.S.C. 102 based on the Horowitz reference has not changed since the first Office action. See pages 6-7 in the November 20, 2009 Final rejection and pages 4-5 in the first Office action, dated January 8, 2009. Second, the examiner's response in the paragraph spanning pages 10-11 in the final rejection of November 20, 2009 is consistent with the prior interpretation of the claim. The examiner must rebut any arguments and evidence presented in the patent owner's response and the examiner appropriately did so in the Final rejection. Finally, the issue of what is the proper claim interpretation touches on matters that are appealable, and therefore, the substance of the issue will not be addressed in this petition. See MPEP 1002 and 1201.

In summary, the examiner appropriately applied Office policies and procedures in determining that the amendment of January 20, 2010 should not be entered because the proposed amendments to independent claim 1 introduced new issues pertaining to 35 U.S.C. 112 and 305, and the proposed new claim 6 raised new issues that would require further consideration. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures, and did not abuse his discretion in deciding to make the November 20, 2009 Office action final and to not enter the amendment of January 20, 2010.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the examiner's decision to make the November 20, 2009 Office action final and to not enter amendment of January 20, 2010 is denied.

2. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535 or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,133	06/16/2008	6206695		3428

23377 7590 11/04/2009

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2009

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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Woodcock Washburn LLP
Cira Centre
12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

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NOV 04 2009

CENTRAL REEXAMINATION UNIT

In re Edward Balassanian
Ex Parte Reexamination Proceeding
Control No. 90/009,133
Filed: June 16, 2008
For: U.S. Patent No. 6,206,695

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

This is a decision on the June 8, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination[1] ("the June 8, 2009 patent owner petition to revive").

The appropriate petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the June 8, 2009 patent owner petition to revive has been paid.

The June 8, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The June 8, 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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a response under 37 CFR 1.550(b) to the March 6, 2009 Office action.

shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.550 provides, in pertinent part:

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

*

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the June 8, 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 proper response to the March 6, 2009 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least

thirty days to file a proper response to any Office action. The March 6, 2009 Office action set a two-month period for response. A proper response to the March 6, 2009 Office action was not filed until June 8, 2009, which was untimely. However, for the purpose of evaluating whether the June 8, 2009 patent owner petition to revive is a grantable petition, the submission of the June 8, 2009 response to the March 6, 2009 Office action satisfies item (1).[2]

Accordingly, the June 8, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The June 8, 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 3751, for processing of the June 8, 2009 Response Pursuant To 37 CFR § 1.550(b).

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Robert Fetsuga, of CRU Art Unit 3751, at (571) 272-4886.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

L. Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

[2] This decision is not directed to the persuasiveness and propriety of the arguments presented in the June 8, 2009 response as to each of the rejections set forth in the March 6, 2009 Office action; such is the examiner's province.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,134	05/02/2008	5340742	L111 7003	3242

22442 7590 06/30/2009

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER DONELSON BEARMAN, CALDWELL & BERKOWITZ, PC
555 ELEVENTH STREET, NW
SIXTH FLOOR
WASHINGTON, DC 20004

Date:

MAILED

JUN 30 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009134
PATENT NO. : 5340742
ART UNIT : 3991

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

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

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JUN 30 2009

CENTRAL REEXAMINATION UNIT

Gary J. Connell
Sheridan Ross P.C.
1560 Broadway
Suite 1200
Denver, CO 80202

For Patent Owner

Susan E. Shaw McBee
Baker, Donelson, Bearman, Caldwell &
Berkowitz, PC
555 Eleventh Street, NW, Sixth Floor
Washington, DC 20004

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,134
Filed: May 02, 2008
For: US Patent No. 5,340,742

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

This is a decision on the petition filed June 26, 2009 to request an additional one-month extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated April 2, 2009.

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

The petition is **GRANTED** for the reasons set forth below.

Decision

The Patent Owner requests an additional extension of time in which to file a response to the Office action dated April 2, 2009 which set a two month date for filing a response thereto. The Office action is a Final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

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

The petition for extension of time states that Patent Owner and counsel prepared a draft response to the Office action mailed April 2, 2009. An interview was conducted on May 22, 2009 at which the subject matter of claim 2 was discussed. As a result of this interview, Patent Owner conducted additional experiments to demonstrate the effect of sodium sulfate on fermentations and the resultant biomass. Additional time is necessary to analyze the data and prepare a revised response. Patent Owner requests an additional one-month extension of time to complete the experiments and prepare the response.

Analysis and Findings

Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Patent Owner's showing is sufficient to justify the grant of a one-month extension of time in which to file a response to the outstanding Office action. To provide Patent Owner with a fair opportunity to present an argument against the rejections of record within the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for one (1) month is granted.

Conclusion

1. The Patent Owner's petition for an additional one-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 2, 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.

/Deborah Jones/

Deborah Jones,
SPE, Art Unit 3991
Central Reexamination Unit

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,137	05/05/2008	6297721	22168-0007RX1	4217

26191 7590 07/01/2009

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/01/2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

ADAM TREIBER BAKER & HOSTETLER, LLP

WASHINGTON SQUARE

1050 CONNECTICUT AVENUE, NW SUITE 1100

WASHINGTON, DC 21702

MAILED

JUL 01 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,137*.

PATENT NO. *6,297,721*.

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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PO BOX 1022
MINNEAPOLIS MN 55440-1022

(For Patent Owner)

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JUL 01 2009

CENTRAL REEXAMINATION UNIT

Adam Treiber
Baker & Hostetler LLP
Washington Square
1050 Connecticut Avenue, NW Suite 1100
Washington, DC 21702

(For Requester)

In re Reissue Application Lu *et al.*
Application No. 12/437,439
Filed: May 7, 2009
For: U.S. Patent No. 6,297,721

In re Lu *et al.*
Reexamination Proceeding
Control No. 90/009,137
Filed: May 5, 2008
For: U.S. Patent No. 6,297,721

DECISION ON PETITION UNDER 37 CFR 1.182 TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

This is a decision on the May 8, 2009 patent owner petition under 1.182 to merge above-captioned reissue application and reexamination proceeding.

The petition, reissue application 12/437,439, and reexamination control number 90/009,137 are all before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition is dismissed.

REVIEW OF FACTS

1. On October 2, 2001, the Office issued U.S. Patent No. 6,297,721 (the '721 patent) to Lu *et al.*

2. On May 5, 2008 a request for reexamination of the '721 patent was filed by a third party requester and assigned control No. 90/009,137 (the '9137 proceeding).

3. On June 26, 2008, the Office ordered reexamination in the '9137 proceeding.

4. On May 7, 2009, patent owner filed an application for reissue of the '721 patent, assigned application No. 12/437,439 (the '439 application).

5. On May 8, 2009, the present petition under 37 CFR 1.182 was filed by the patent owner in the '9137 proceeding requesting merger of the reissue application and reexamination proceeding.

6. On June 9, 2009, the Office published a notice of reissue of the '439 reissue application in the *Official Gazette*.

FEES

No fees were charged for this decision.

DISCUSSION

MPEP 1441 ("Two-Month Delay Period") provides as follows:

> "Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a)."

Under MPEP 1441, the present petition for a merger decision is premature and not yet ripe for decision because the '439 reissue application cannot be acted until 2 months after publication of its notice of reissue publication in the *Official Gazette*. The '439 reissue application was announced in the *Official Gazette* on June 9, 2009, therefore the earliest any action can be taken by the Office in the '439 reissue application is August 9, 2009. Accordingly, the petition for merger is dismissed, since it is premature to consider such a petition.

While petitioner may file a petition for a waiver of the 2-month delay provision of MPEP 1441 under 37 CFR 1.182, a sufficient showing must be provided, before the Office will act on the '439 reissue application without delaying for 2 months. MPEP 1441 provides as follows:

> "Additionally, the Office will entertain a petition under 37 CFR 1.182 which is accompanied by the required petition fee (37 CFR 1.17(f)) to act on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see MPEP § 1441.01) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting that the 2-month delay period not be employed include that litigation involving a patent has been stayed to permit the filing of an application for the reissue of the patent. Where the basis for the petition is ongoing litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application prior to the expiration of

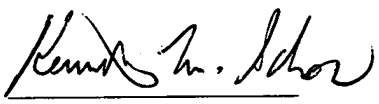
the 2-month delay period. Such petitions are decided by the Office of Patent Legal Administration."

CONCLUSION

1. The petition requesting merger of the '439 reissue application and '9138 reexamination proceeding is dismissed.

2. Jurisdiction over the '483 reissue application is being transferred to Technology Center 2800, in which the reissue proceeding is assigned. Jurisdiction over the '9138 reexamination proceeding is being returned to the Central Reexamination Unit.

3. 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.
90/009,138	05/05/2008	6344785	22168-0010RX1	4218

26191 7590 07/01/2009

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

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ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,138	05/05/2008	6344785	22168-0010RX1	4218

26191 7590 07/01/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Adam Treiber
Baker & Hostetler, LLP
Washington Square
1050 Connecticut Avenue, NW Suite 1100
Washington, DC 21702

DATE MAILED: 07/01/2009

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PO BOX 1022
MINNEAPOLIS MN 55440-1022

(For Patent Owner)

Adam Treiber
Baker & Hostetler LLP
Washington Square
1050 Connecticut Avenue, NW Suite 1100
Washington, DC 21702

(For Requester)

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JUL 01 2009

CENTRAL REEXAMINATION UNIT

In re Reissue Application Lu *et al.*
Application No. 12/437,483
Filed: May 7, 2009
For: U.S. Patent No. 6,344,785

In re Lu *et al.*
Reexamination Proceeding
Control No. 90/009,138
Filed: May 5, 2008
For: U.S. Patent No. 6,344,785

DECISION ON PETITION UNDER 37 CFR 1.182 TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

This is a decision on the May 8, 2009 patent owner petition under 1.182 to merge above-captioned reissue application and reexamination proceeding.

The petition, reissue application 12/437,483, and reexamination control number 90/009,138 are all before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition is dismissed.

REVIEW OF FACTS

1. On February 2, 2002, the Office issued U.S. Patent No. 6,344,785 (the '785 patent) to Lu *et al.*

2. On May 5, 2008 a request for reexamination of the '785 patent was filed by a third party requester and assigned control No. 90/009,138 (the '9138 proceeding).

3. On June 23, 2008, the Office ordered reexamination in the '9138 proceeding.

4. On May 7, 2009, patent owner filed an application for reissue of the '785 patent, assigned application No. 12/437,483 (the '483 application).

5. On May 8, 2009, the present petition under 37 CFR 1.182 was filed by the patent owner in the '9138 proceeding requesting merger of the reissue application and reexamination proceeding.

6. On June 9, 2009, the Office published a notice of reissue of the '483 reissue application in the *Official Gazette*.

FEES

No fees were charged for this decision.

DISCUSSION

MPEP 1441 ("Two-Month Delay Period") provides as follows:

> "Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a)."

Under MPEP 1441, the present petition for a merger decision is premature and not yet ripe for decision because the '483 reissue application cannot be acted until 2 months after publication of its notice of reissue publication in the *Official Gazette*. The '483 reissue application was announced in the *Official Gazette* on June 9, 2009, therefore the earliest any action can be taken by the Office in the '483 reissue application is August 9, 2009. Accordingly, the petition for merger is dismissed, since it is premature to consider such a petition.

While petitioner may file a petition for a waiver of the 2-month delay provision of MPEP 1441 under 37 CFR 1.182, a sufficient showing must be provided, before the Office will act on the '483 reissue application without delaying for 2 months. MPEP 1441 provides as follows:

> "Additionally, the Office will entertain a petition under 37 CFR 1.182 which is accompanied by the required petition fee (37 CFR 1.17(f)) to act on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see MPEP § 1441.01) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting that the 2-month delay period not be employed include that litigation involving a patent has been stayed to permit the filing of an application for the reissue of the patent. Where the basis for the petition is ongoing litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application prior to the expiration of

the 2-month delay period. Such petitions are decided by the Office of Patent Legal Administration."

CONCLUSION

1. The petition requesting merger of the '483 reissue application and '9138 reexamination proceeding is dismissed.

2. Jurisdiction over the '483 reissue application is being transferred to Technology Center 2800, in which the reissue proceeding is assigned. Jurisdiction over the '9138 reexamination proceeding is being returned to the Central Reexamination Unit.

3. 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.
90/009,139	05/05/2008	6297720	22168-0006RX1	1719

26191 7590 07/02/2009

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2009

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MINNEAPOLIS MN 55440-1022

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Adam Treiber
Baker & Hostetler LLP
Washington Square
1050 Connecticut Avenue, NW Suite 1100
Washington, DC 21702

(For Requester)

In re Reissue Application Lu *et al.*
Application No. 12/437,456
Filed: May 7, 2009
For: U.S. Patent No. 6,267,720

In re Lu *et al.*
Reexamination Proceeding
Control No: 90/009,139
Filed: May 5, 2008
For: U.S. Patent No. 6,267,720

DECISION ON PETITION UNDER 37 CFR 1.182 TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

This is a decision on the May 8, 2009 patent owner petition under 1.182 to merge above-captioned reissue application and reexamination proceeding.

The petition, reissue application 12/437,456, and reexamination control number 90/009,139 are all before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition is dismissed.

REVIEW OF FACTS

1. On October 2, 2001, the Office issued U.S. Patent No. 6,297,720 (the '720 patent) to Lu *et al.*

2. On May 5, 2008 a request for reexamination of the '720 patent was filed by a third party requester and assigned control No. 90/009,139 (the '9139 proceeding).

3. On June 18, 2008, the Office ordered reexamination in the '9139 proceeding.

4. On May 7, 2009, patent owner filed an application for reissue of the '560 patent, assigned application No. 12/437,456 (the '456 application).

5. On May 8, 2009, the present petition under 37 CFR 1.182 was filed by the patent owner in the '9139 proceeding requesting merger of the reissue application and reexamination proceeding.

6. On June 9, 2009, the Office published a notice of reissue of the '456 reissue application in the *Official Gazette*.

FEES

No fees were charged for this decision.

DISCUSSION

MPEP 1441 ("Two-Month Delay Period") provides as follows:

> "Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a)."

Under MPEP 1441, the present petition for a merger decision is premature and not yet ripe for decision because the '456 reissue application cannot be acted until 2 months after publication of its notice of reissue publication in the *Official Gazette*. The '456 reissue application was announced in the *Official Gazette* on June 9, 2009, therefore the earliest any action can be taken by the Office in the '456 reissue application is August 9, 2009. Accordingly, the petition for merger is dismissed, since it is premature to consider such a petition.

While petitioner may file a petition for a waiver of the 2-month delay provision of MPEP 1441 under 37 CFR 1.182, a sufficient showing must be provided, before the Office will act on the '456 reissue application without delaying for 2 months. MPEP 1441 provides as follows:

> "Additionally, the Office will entertain a petition under 37 CFR 1.182 which is accompanied by the required petition fee (37 CFR 1.17(f)) to act on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see MPEP § 1441.01) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting that the 2-month delay period not be employed include that litigation involving a patent has been stayed to permit the filing of an application for the reissue of the patent. Where the basis for the petition is ongoing

litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application prior to the expiration of the 2-month delay period. Such petitions are decided by the Office of Patent Legal Administration."

CONCLUSION

1. The petition requesting merger of the '456 reissue application and '9139 reexamination proceeding is dismissed.

2. Jurisdiction over the '456 reissue application is being transferred to Technology Center 3700, in which the reissue proceeding is assigned. Jurisdiction over the '9139 reexamination proceeding is being returned to the Central Reexamination Unit.

3. 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.
90/009,140	05/05/2008	5656985	22168-0005RX1	1720

26191 7590 06/02/2009

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2009

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CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ADAM M. TREIBER
WASHINGTON SQUARE
1050 CONNECTICUT AVE, N.W. SUITE 1100
WASHINGTON, D.C. 21702

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009140
PATENT NO. : 5656985
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, Minnesota 55440-1022

(For Patent Owner)

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JUN 0 2 2009

CENTRAL REEXAMINATION UNIT

Adam Treiber
Baker & Hostetler, LLP
Washington Square
1050 Connecticut Avenue, N.W.
Suite 1100
Washington, DC 21702

(For Requester)

In re Reissue Application of: Peter Lu et al.
Application No. 12/437,460
Filed: May 7, 2009
For: U.S. Patent No. 5,656,985

In re Peter Lu et al.
Reexamination Proceeding
Control No. 90/009,140
Filed: May 5, 2008
For: U.S. Patent No. 5,656,985

DECISION ON PETITION UNDER 37 CFR 1.182 TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

This is a decision on the May 8, 2009 patent owner petition under 1.182 to merge the above-captioned reissue application and reexamination proceeding.

The petition, reissue application 12/437,460, and reexamination control number 90/009,140 are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 5,656,985 (the '985 patent) issued to Peter Lu et al. on August 12, 1997, with 8 claims.

2. A request for reexamination of the '985 patent was filed by a third party requester on May 5, 2008, and was assigned control No. 90/009,140 (the '9140 proceeding).

3. Reexamination was ordered for the '9140 proceeding on July 8, 2008.

4. An application for reissue of the '985 patent, assigned application No. 12/437,460 (the '460 application), was filed by the patent owner on May 7, 2009.

5. On May 8, 2009, the present petition under 37 CFR 1.182 was filed by the patent owner in the '9140 proceeding requesting merger of the reissue application and reexamination proceeding.

6. The notice of reissue of the '460 reissue application is not yet scheduled to be published in the *Official Gazette.*

DISCUSSION

Under MPEP 1441, the present petition for a merger decision is premature and not yet ripe for decision because the '460 reissue application is not to be acted on sooner than 2 months after the date when the notice of reissue will be published in the *Official Gazette.*

MPEP 1441 ("Two-Month Delay Period") provides as follows:

> Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette.* The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a).

Thus, even after the '460 reissue application is announced in the *Official Gazette*, action is still not to be taken by the Office for the '460 reissue application until two months from the announcement date. Accordingly, the petition for merger is dismissed, since it is premature to consider such a petition.

While petitioner may file a petition for a waiver of the 2-month delay provision of MPEP 1441 under 37 CFR 1.182, a sufficient showing must be provided, before the Office will act on the '460 reissue application without delaying for 2 months. MPEP 1441 provides as follows:

> Additionally, the Office will entertain a petition under 37 CFR 1.182 which is accompanied by the required petition fee (37 CFR 1.17(f)) to act on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see MPEP § 1441.01) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting that the 2-month delay period not be employed include that litigation involving a patent has been stayed to permit the filing of an application for the reissue of the

patent. Where the basis for the petition is ongoing litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application prior to the expiration of the 2-month delay period. Such petitions are decided by the Office of Patent Legal Administration.

CONCLUSION

1. The petition requesting merger of the '460 reissue application and '9140 reexamination proceeding is dismissed.

2. Jurisdiction over the '9140 reexamination proceeding is being returned to the Central Reexamination Unit. Jurisdiction over the '460 reissue application is transferred to Technology Center 2800, in which the reissue proceeding is assigned.

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

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

5/19/09
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UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, Minnesota 55440-1022

(For Patent Owner)

Adam Treiber
Baker & Hostetler, LLP
Washington Square
1050 Connecticut Avenue, N.W.
Suite 1100
Washington, DC 21702

(For Requester)

MAILED

JUN 02 2009

CENTRAL REEXAMINATION UNIT

In re Reissue Application of: Peter Lu et al.
Application No. 12/437,488
Filed: May 7, 2009
For: U.S. Patent No. 6,662,431

In re Peter Lu et al.
Reexamination Proceeding
Control No. 90/009,142
Filed: May 5, 2008
For: U.S. Patent No. 6,662,431

DECISION ON PETITION UNDER 37 CFR 1.182 TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

This is a decision on the May 8, 2009 patent owner petition under 1.182 to merge the above-captioned reissue application and reexamination proceeding.

The petition, reissue application 12/437,488, and reexamination control number 90/009,142 are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,662,431 (the '431 patent) issued to Peter Lu et al. on December 16, 2003, with 5 claims.

2. A request for reexamination of the '431 patent was filed by a third party requester on May 5, 2008, and was assigned control No. 90/009,142 (the '9142 proceeding).

3. Reexamination was ordered for the '9142 proceeding on June 23, 2008.

4. An application for reissue of the '431 patent, assigned application No. 12/437,488 (the '488 application), was filed by the patent owner on May 7, 2009.

5. On May 8, 2009, the present petition under 37 CFR 1.182 was filed by the patent owner in the '9142 proceeding requesting merger of the reissue application and reexamination proceeding.

6. The '488 reissue application is still undergoing pre-examination processing and the notice of reissue of the '488 reissue application is not yet scheduled to be published in the *Official Gazette.*

DISCUSSION

Under MPEP 1441, the present petition for a merger decision is premature and not yet ripe for decision because the '488 reissue application is not to be acted on sooner than 2 months after the date when the notice of reissue will be published in the *Official Gazette.*

MPEP 1441 ("Two-Month Delay Period") provides as follows:

> Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette.* The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a).

Thus, even after the '488 reissue application completes reexamination processing, is forwarded to the technology center, and is announced in the *Official Gazette*, action is still not to be taken by the Office for the '488 reissue application until two months from the announcement date. Accordingly, the petition for merger is dismissed, since it is premature to consider such a petition.

While petitioner may file a petition for a waiver of the 2-month delay provision of MPEP 1441 under 37 CFR 1.182, a sufficient showing must be provided, before the Office will act on the '488 reissue application without delaying for 2 months. MPEP 1441 provides as follows:

> Additionally, the Office will entertain a petition under 37 CFR 1.182 which is accompanied by the required petition fee (37 CFR 1.17(f)) to act on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see MPEP § 1441.01) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting

that the 2-month delay period not be employed include that litigation involving a patent has been stayed to permit the filing of an application for the reissue of the patent. Where the basis for the petition is ongoing litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application prior to the expiration of the 2-month delay period. Such petitions are decided by the Office of Patent Legal Administration.

Furthermore, it should be noted that the Office will not merge the reissue application with the reexamination proceeding before the reissue application is in condition for examination. Accordingly, until pre-examination processing is completed and the reissue application is forwarded to the technology center, a petition to merge the proceedings is premature.

CONCLUSION

1. The petition requesting merger of the '488 reissue application and '9142 reexamination proceeding is dismissed.

2. Jurisdiction over the '9142 reexamination proceeding is being returned to the Central Reexamination Unit. After completion of pre-examination processing, jurisdiction over the '488 reissue application will be transferred to Technology Center 2800, in which the reissue proceeding is assigned.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,151	05/16/2008	6,706,370	S011-6217	6936

27623 7590 11/23/2009

OHLANDT, GREELEY, RUGGIERO & PERLE, LLP
ONE LANDMARK SQUARE, 10TH FLOOR
STAMFORD, CT 06901

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BRUCE L. ADAMS, EQS.
ADAMS & WILKS
17 BATTERY PLACE- SUITE 1231
NEW YORK, NY 10004

Date:

MAILED

NOV 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009151
PATENT NO. : 6706370
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
www.uspto.gov

Paul D. Greeley, Esq.
Ohlandt, Greeley, Ruggiero & Perle, LLP
One Landmark Square, 10th Floor
Stamford, CT 06901-2682

for Patent Owner

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NOV 23 2009

CENTRAL REEXAMINATION UNIT

Bruce L. Adams, Esq.
Adams & Wilks
17 Battery Place, Suite 1231
New York, NY 10004

for Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,151
Filed: May 16, 2008
For: US Patent No. 6,706,370

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

This is a decision on the petition filed November 20, 2009 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office actions dated August 21, 2009 and the Advisory action mailed November 10, 2009.

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

The petition is granted for one month for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated August 21, 2009, which set a two-month date for filing a response thereto and the subsequent Advisory action mailed November 10, 2009. The Office action is a Final Office action. The request is timely filed and includes

authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

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

The petition for extension of time states that the patent owner has prepared a response that includes amendments and requests additional time so that the examiner can consider and enter the amendment to at least place the claims in better condition for appeal.

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. 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 one-month extension of time in which to file a response to the outstanding Office action. Accordingly, the period of

time for filing a reply to the Office action dated August 21, 2009 is extended to run four (4) months from the date of the Office action and is due on December 21, 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 extension of time in which to file a response to the Office action dated August 21, 2009 is **granted** for one (1) month.
2. The Patent Owner's response is due on December 21, 2009.

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/
Deborah Jones, SPE
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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CHRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

(For Patent Owner)

MAILED

NOV 06 2008

CENTRAL REEXAMINATION UNIT

ROBERT L. MASH
54 DANADA DRIVE
P.O. BOX 4468
WHEATON, IL 60187-4468

(For Requester)

In re Oblack
Reexamination Proceeding
Control No. 90/009,157
Filed: May 21, 2008
For: U.S. Patent No. 6,076,829

: DECISION
: UNDER
: 37 CFR 1.181

This is a decision on the October 10, 2008 patent owner petition entitled "Petition to Director of the Central Reexamination Unit under 37 CFR § 1.181." The petition is before the Director of the Central Reexamination Unit for consideration of the above petition.

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

REVIEW OF FACTS

1. U.S. Patent No. 6,076,829 (the '829 patent) issued on June 20, 2000.

2. On May 16, 2005, the patent owner filed a revocation of power of attorney and a new power of attorney to Customer No. 26389 (Christensen, O'Connor, Johnson, Kindness, PLLC) in the file for the '829 patent.

3. A request for reexamination was filed by a third party requester on May 21, 2008 and assigned control No. 90/009,157 (the '157 reexamination proceeding).

4. On June 16, 2008, the Office mailed a "Notice of Acceptance of the Power of Attorney" and a "Notice Regarding Change of Power of Attorney" in response to the May 16, 2005 power of attorney correspondence.

5. An Order Granting Request for *Ex Parte* Reexamination in the '157 reexamination proceeding was mailed on August 4, 2008 to Craine Associates, Inc., which had a power of attorney in the '829 patent until June 16, 2008.

6. On October 10, 2008, the patent owner filed the "Petition to Director of the Central

Reexamination Unit under 37 CFR § 1.181" to request that the Order of August 4, 2008 be remailed.

7. On October 16, 2008, the Office remailed the Order of August 4, 2008 to Christensen, O'Connor, Johnson, Kindness, PLLC, 1420 Fifth Avenue, Suite 2800, Seattle, WA 98101.

DECISION

The patent owner's "Petition to Director of the Central Reexamination Unit under 37 CFR § 1.181," which was filed on October 10, 2008, is dismissed as moot because the requested relief was already performed. As pointed out, the Office mistakenly mailed the August 4, 2008 Order to the former correspondence address, and on October 16, 2008, mailed the Order Granting Request for *Ex Parte* Reexamination to the current power of attorney for the patent owner. The Order of October 16, 2008 gives the patent owner two months to file patent owner comments under 37 CFR 1.530(b) from October 16, 2008. Accordingly, the relief requested in the above-mentioned petition (e.g., remailing of the Order and restarting of the two month time period) has already been done.

Accordingly, the petition is dismissed as moot.

CONCLUSION

1. Patent owner's "Petition to Director of the Central Reexamination Unit under 37 CFR § 1.181,"is dismissed as moot.

2. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714 or Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in their absence, to the undersigned at (571) 272-3838.

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Christensen, O'Connor, Johnson, Kindness, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

For Patent Owner

MAILED

AUG 07 2009

CENTRAL REEXAMINATION UNIT

Robert L. Marsh
54 Danada Drive
P.O. Box 4468
Wheaton, IL 60189-4468

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,157
Filed: May 21, 2008
For: U.S. Patent No. 6,076,829

DECISION ON PETITION
UNDER 37 CFR 1.181
REQUESTING WITHDRAWAL
OF FINALITY OF ACTION

This is a decision on the August 6, 2009, "Petition to the Director Under 37 CFR § 1.181 Requesting Reconsideration and Withdrawal of Final Rejection as Premature" requesting that the finality of the Office action mailed June 11, 2009, be withdrawn. This decision takes into consideration the "Request for Reconsideration and Withdrawal of Final Rejection as Premature" filed July 29, 2009 as well.

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 June 20, 2000, U.S. Patent No. 6,076,829 issued to Mark Oblack.

2. On May 21, 2008, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,157. The request asked for the reexamination of claims 1-3, all of the patent claims.

3. On August 4, 2008, an Order was mailed granting reexamination in control No. 90/009,157. As the Order was mailed to an incorrect address, it was remailed on October 16, 2008.

4. On January 16, 2009 a non-final Office action was mailed.

5. On March 11, 2009, a response was received from the Patent Owner.

6. On June 11, 2009, a final Office action was mailed.

7. On July 29, 2009, the request and on August 6, 2009, the instant petition was filed.

Decision

The request for reexamination was based on a number of US Patents. The order granting reexamination agreed, substantially in all aspects, with the request that a substantial new question of patentability had been presented by the third party requester. The first Office action mailed January 16, 2009, did not set forth any of the rejections proposed by third party requester. Instead, the Office action relied on a number of new references in rejecting all of the patent claims. Patent Owner filed a response of March 11, 2009. No amendments were made to original claims 1-3, however 15 new claims were added. The final Office action maintained all but one of the rejections presented in the first Office action and those rejections included newly added claims. New grounds of rejections were added against the newly submitted claims, which rejections were necessitated by amendment. All arguments presented by Patent Owner were responded to in the final Office action.

The criteria for making a rejection final in an *ex parte* reexamination proceeding is analogous to that set forth in MPEP § 706.07 and 706.07(a) for making a rejection final in an application. The policy is based on 37 CFR 1.113 that states in part:

> "(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under §1.510, patent owner's reply is limited to appeal in the case of rejection of any claim... or to amendment as specified in § 1.114 or § 1.116....
>
> (b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof."

Further, in MPEP § 706.07(a) the current policy regarding making second action finals is explained and it states, in part:

> "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Absent from the guidelines set forth in the aforementioned rule and sections of the MPEP is a requirement that the claims be twice rejected on the same grounds before an action

can be made final, which appears to be the basis on which Patent Owner is relying on to have the finality of the Office action mailed June 11, 2009 withdrawn.

The final rejection in question did not introduce any new grounds of rejection for original un-amended claims 1-3. The original claims remain rejected for the reasons set forth in the first Office action. Of the new rejections, those based on 35 U.S.C. 305, and 35 U.S.C. 112 pertain only to the new claims, and the rejections using art cited for the first time in the final Office action are directed only to the newly added claims. Accordingly, there are no bases for granting Patent Owner's petition requesting withdrawal of the last Office action. The final rejection is proper and the petition is dismissed.

Conclusion

1. The Patent Owner's petition requesting withdrawal of the finality of the Office action mailed June 11, 2009 is **dismissed.**

2. 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

3. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Christensen, O'Connor, Johnson,
Kindness, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

For Patent Owner

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CENTRAL REEXAMINATION UNIT

Robert L. Marsh
54 Danada Drive
P.O. Box 4468
Wheaton, IL 60189-4468

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,157
Filed: May 21, 2008
For: U.S. Patent No. 6,076,829

: DECISION DENYING
: PETITION UNDER 37 CFR 1.181
: REQUESTING WITHDRAWAL
: OF FINALITY OF ACTION

This is a decision on the August 19, 2009 petition (hereinafter "instant petition"), entitled "Request for Reconsideration of Decision On Petition to the Director Under 37 CFR § 1.181 Requesting Withdrawal of Finality of Action," requesting reconsideration of the decision, mailed August 7, 2009, dismissing the petition filed on July 29, 2009 (hereinafter "initial petition"). The initial petition requested that the finality of the Office action, mailed June 11, 2009, be withdrawn.

The petition is before the Director of Technology Center1600, who oversees the Central Reexamination Unit, for consideration.

The petition is denied for the reasons set forth below.

Summary of Relevant Facts

1. On June 20, 2000, U.S. Patent No. 6,076,829 issued to Mark Oblack.

2. On May 21, 2008, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,157. The request asked for the reexamination of claims 1-3, all of the patent claims.

3. On August 4, 2008, an Order was mailed granting reexamination in control No. 90/009,157. As the Order was mailed to an incorrect address, it was remailed on October 16, 2008.

4. On November 10, 2008, patent owner filed a waiver of their right to file a patent owner's statement under 37 CFR 1.530.

5. On January 16, 2009 a non-final Office action was mailed.

6. On March 11, 2009, a response was received from the Patent Owner.

7. On June 11, 2009, a final Office action was mailed.

8. On July 29, 2009, the initial petition requesting withdrawal of the finality of the June 11, 2009 Office action was filed.

9. On July 30, 2009, a petition for a one-month extension of time was filed.

10. On August 7, 2009, a decision dismissing the initial petition was mailed and a decision granting the one-month extension of time was mailed.

11. On August 19, 2009, the instant petition, requesting reconsideration of the decision of August 7, 2009, was filed.

Decision

In response to patent owner's arguments that the examiner erred in making the Office action of June 11, 2009 final, the director finds there are not good and sufficient reasons to withdraw the finality of that Office action. 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. See MPEP 2271.

The criteria for making a rejection final in an *ex parte* reexamination proceeding is analogous to that set forth in MPEP § 706.07 and 706.07(a) for making a rejection final in an application. The policy is based on 37 CFR 1.113 that states in part:

"(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under §1.510, patent owner's reply is limited to appeal in the case of rejection of any claim... or to amendment as specified in § 1.114 or § 1.116....

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof."

Further, in MPEP § 706.07(a) the current policy regarding making second action final is explained and it states, in part:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

In addition, MPEP 2271 states, 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 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."

Turning to the facts in this proceeding, the request for reexamination was based on a number of U.S. Patents. The order granting reexamination agreed, substantially in all aspects, with the request that a substantial new question of patentability had been presented by the third party requester. The Patent Owner chose not to file comments under 37 CFR 1.530. The first Office action mailed January 16, 2009, did not set forth any of the rejections proposed by third party requester. Instead, the Office action relied on a number of new references in rejecting all of the patent claims. Patent Owner filed a response of March 11, 2009. No amendments were made to original claims 1-3, however, fifteen new claims were added. The final Office action maintained all but one of the rejections presented in the first Office action. New grounds of rejections were only added against the newly submitted claims, which rejections were necessitated by amendment. All arguments presented by Patent Owner were responded to in the final Office action.

Patent Owner is relying on the statements in MPEP 2271 that the examiner will twice provide the patent owner with information that may be useful to define the position of the Office, and that the examiner should not "prematurely" cut off prosecution to support their request that the finality of the June 11, 2009 Office action should be withdrawn. Specifically, the Patent Owner stated that they were not aware that the examiner was not interpreting certain claim limitations under 35 U.S.C. 112, sixth paragraph, until the final rejection. See pages 1-2 of the instant petition. The Patent Owner did not specifically identify which claim limitations they believe are invoking 35 U.S.C. 112, sixth paragraph, in the instant petition, but the initial petition identified the claim limitation "an opening capable of snap-fitting and engaging a ball" as invoking 35 U.S.C. 112, sixth paragraph.

In reviewing the record, the examiner twice provided the patent owner information and references that may be useful in defining the position of the Office. Both the order granting reexamination and the first Office action provided information and references that are useful in defining the position of the Office. Specifically, the order, dated October 16, 2008, explained how the prior art cited by the third party requester teaches the claim limitation "an opening capable of snap-fitting and engaging a ball" in the analysis of whether there is a substantial new question of patentability. See, e.g., page 8 of the order, which clearly states that limitation "capable of snap-fitting and engaging a ball" is a functional limitation. It is clear from this analysis the examiner was not interpreting the claim limitation "an opening capable of snap-fitting and engaging a ball" under 35 U.S.C. 112, sixth paragraph. Furthermore, the examiner's interpretation of this claim limitation was in accordance with the Office guidelines for 35 U.S.C. 112, sixth

paragraph, because the limitation does not meet the 3-prong test in MPEP 2181.[1] Likewise, the first Office action, dated January 16, 2009, also made it clear that the examiner was not interpreting the limitation "an opening capable of snap-fitting and engaging a ball" under 35 U.S.C. 112, sixth paragraph. See, e.g., page 5 of the January 16, 2009 Office action, which discusses how the reference meets the functional limitation of being capable of snapping-fitting and engaging a ball. Therefore, the record shows that the Patent Owner was twice notified that the examiner was not interpreting the claims under 35 U.S.C. 112, sixth paragraph.

As stated in the relevant facts, the Patent Owner decided to not file any comments in response to the order granting reexamination and filed a waiver of their right to file comments under 37 CFR 1.530. Therefore, the Patent Owner could have filed comments to explain that certain limitations in claims 1-3 are invoking 35 U.S.C. 112, sixth paragraph prior to the first Office action, but chose not to do so. It was not until after the Patent Owner filed remarks in response to the first Office action on March 11, 2009 that the examiner was first notified of the Patent Owner's view that the limitation "an opening capable of snap-fitting and engaging a ball" should be interpreted under 35 U.S.C. 112, sixth paragraph. See, e.g., pages 6-8 of the March 11, 2009 response. The examiner, however, was not persuaded by the Patent Owner and maintained his prior interpretation of the claims in the final Office action. See page 21 of the June 11, 2009 Office action.

As explained above, reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. The fact that the Patent Owner chose to wait to present arguments based upon interpretation under 35 U.S.C. 112, sixth paragraph until after the first Office action is not a good and sufficient reason to continue prosecution in light of the special dispatch requirement. The record shows that the examiner appropriately followed Office policies and procedures, e.g., as set forth in MPEP 2271, and 706.07 *et seq.*, in making the determination that the June 11, 2009 should be designated as final in the interest of special dispatch. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to making the June 11, 2009 Office action final.

In summary, the final rejection in question did not introduce any new grounds of rejection for original claims 1-3. The original claims remain rejected for the reasons set forth in the first Office action. Of the new rejections, those based on 35 U.S.C. 305, and

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[1] "A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase "means for" or "step for;"

(B) the "means for" or "step for" must be modified by functional language; and

(C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function."

35 U.S.C. 112 pertain only to the new claims, and the rejections using art cited for the first time in the final Office action are directed only to the newly added claims.

Accordingly, the examiner properly designated the June 11, 2009 Office action as final in accordance with the statutory mandate of special dispatch. Therefore, the final rejection was proper and the petition is denied.

Conclusion

1. The Patent Owner's petition, filed August 19, 2009, requesting withdrawal of the finality of the Office action mailed June 11, 2009 is **denied.**

2. 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

3. 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.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Fulwider Patton LLP
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045

(For Patent Owner)

Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, VA 22102

(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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Fulwider Patton LLP
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045

(For Patent Owner)

Jack S. Barufka
Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, VA 22102

(For 3rd Party Requester)

Reexam Control No.: 90/007,889
Filed : January 23, 2006
For U.S. Patent No. : 6,066,167

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,620
Filed : May 7, 2007
For U.S. Patent No. : 6,066,167

MAILED

SEP 10 2008

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/009,159
Filed : May 23, 2008
For U.S. Patent No. : 6,066,167

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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AUG 22 2008

CENTRAL REEXAMINATION UNIT

MICHAEL BEST & FRIEDRICH LLP (For Patent Owner)
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
CHICAGO, IL 60601

LAW OFFICES OF CLEMENT CHENG (for Third Party
17220 NEWHOPE STREET #127 Requester)
FOUNTAIN VALLEY, CA 92708

DECISION,
MERGING
REEXAMINATION
PROCEEDINGS
37 C.F.R. § 1.565(c)

In re: Hayashi
Ex Parte Reexamination Proceeding
Control No. 90/009,131
Deposited: 5 May 2008
For: US Patent No. 6,315,616

In re: Hayashi
Ex Parte Reexamination Proceeding
Control No. 90/009,160
Deposited: 11 June 2008
For: US Patent No. 6,315,616

This is a decision on the 8 August 2008, petition for "Waiver of Patent Owner's Statement and Petition to Merge Proceedings." The above-identified reexamination files are before the Director of the Central Reexamination Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,315,616 issued on 13 November 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/009,131 was requested by a third party requester on 5 May 2008.

3. The Reexamination Order was granted in proceeding, control no. 90/009,131 on 5 June 2008.

4. There are currently no amendments proceeding control number 90/008,131.

5. *Ex Parte* Reexamination Proceeding, control no. 90/009,160 was requested by a third party requester filed on 11 June 2008.

6. The Reexamination Order was granted in proceeding, control no. 90/009,160 on 15 July 1008.

7. There are currently no amendments proceeding control number 90/009,160.

8. Proceedings control numbers 90/009,131 and 90/009,160 await action from the assigned examiner.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

2283 Multiple Copending Ex Parte Reexamination Proceedings (in part)

In order for a second or subsequent request for ex parte reexamination to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. MPEP § 2240 provides a discussion as to whether a substantial new question of patentability is raised by the prior art cited in a second or subsequent request for reexamination filed while a reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to combine the proceedings will be made by the Central Reexamination Unit (CRU)

Director where the reexamination is pending. The CRU Director may delegate this to the Special Program Examiner (SPRE). No decision on combining the reexaminations should be made until reexamination is actually ordered in the later filed request for reexamination.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. While merger is at the discretion of the Director of the CRU, given the facts noted above, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/009,131 and 90/009,160 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009,131 and 90/009,160 are hereby **MERGED**.

2. The reexamination files are being forwarded to the examiner for further action.

3. All correspondence regarding these proceedings should be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, or Eric Keasel, at (571) 272-4929, Supervisory Patent Examiners, Art Unit 3992.

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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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. 90/009,167
Filed: June 3, 2008
For: U.S. Patent No. 6,730,042

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 May 4, 2008, U.S. Patent No. 6,730,042 issued to Richard E. Fulton et al.
2. On June 3, 2008, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,167.
3. An Order granting reexamination in control No. 90/009,167 was mailed August 6, 2008.
4. On November 6, 2008, a non-final Office action was mailed.
5. A response was received from the patent owner on January 6, 2009. The response failed to comply with the requirements of 37 CFR 1.530 (d) and (f) in that new

claims were presented but were not underlined as is specifically required by 37 CFR 1.530(d)(2).

6. 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.)
7. On April 23, 2009, patent owner requested a one-month extension of time.
8. On April 27, 2009, a decision granting the extension of time request was mailed.
9. A second request for a one-month extension of time was filed June 3, 2009.
10. On June 5, 2009, the second one-month extension of time request was granted.
11. 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.

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**

[1] A separate decision treating this post-NIRC submission is being mailed on the same date as this decision.

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 new claims 36 and 37 as renumbered claims 38 and 39 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 all reexamination proceedings under this section be conducted with special dispatch within the Office. The amendment filed January 9, 2009 failed to comply with the requirements of 37 CFR 1.530. 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

[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.

[3] See penultimate paragraph on the page marked as page of the final Office action mailed March 10, 2009.

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 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.
90/009,167	06/03/2008	6730042	END5431USREX4	4968

27805 7590 10/09/2009

THOMPSON HINE L.L.P.
Intellectual Property Group
P.O. BOX 8801
DAYTON, OH 45401-8801

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2009

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90/009,167	06/03/2008	6730042	END5431USREX4	4968

27805 7590 10/09/2009

WELSH & FLAXMAN LLC
2000 DUKE STREET, SUITE 100
ALEXANDRIA, VA 22314

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27805 7590 10/09/2009

EXAMINER	
ART UNIT	PAPER NUMBER

DOUGLAS R. HANSCOM
JONES, TULLAR & COOPER P.C.
P.O. BOX 2266 EADS STATION
ARLINGTON, VA 22202

DATE MAILED: 10/09/2009

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Welsh & Flaxman LLC
2000 Duke Street
Suite 100
Alexandria, VA 22314

(For Patent Owner)

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OCT 09 2009

CENTRAL REEXAMINATION UNIT

Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

(For Third Party Requester)

Thompson Hine L.L.P.
Intellectual Property Group
P.O. Box 8801
Dayton, OH 45401-8801

(Courtesy Copy)

In re Richard E. Fulton et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,167
Filed: June 3, 2008
For: U.S. Patent No. 6,730,042

: **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 6,730,042 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 6, 2009 Notice of Acceptance of Power of Attorney present in the file of the '9167 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 '042 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 '042 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.
90/009,167	06/03/2008	6730042	END5431USREX4	4968

27805 7590 12/04/2009

THOMPSON HINE L.L.P.
Intellectual Property Group
P.O. BOX 8801
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ART UNIT	PAPER NUMBER

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27805 7590 12/04/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

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Intellectual Property Group
P.O. Box 8801
Dayton, OH 45401-8801

(For Patent Owner)

Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

In re Richard E. Fulton et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,167
Filed: June 3, 2008
For: U.S. Patent No. 6,730,042

: **DECISION**
: **ON**
: **PETITIONS**

This is a decision addressing the October 21, 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 21, 2009 petition.

The above noted petitions are before the Office of Patent Legal Administration.

For the reasons set forth below, the October 21, 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 21, 2009 petition under 37 CFR 1.182 was transmitted by EFS-Web on October 21, 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 May 4, 2004, U.S. Patent No. 6,730,042 issued to Richard E. Fulton 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 June 3, 2008, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,167.

3. On August 6, 2008, an order granting reexamination was mailed.

4. On November 6, 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 21, 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 25, 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 21, 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 21, 2009, the petition under 37 CFR 1.182 referred to in the November 10, 2009 petition is taken to be the October 21, 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 25, 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 25, 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 21, 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 21, 2009 request for continued prosecution of the present reexamination proceeding, the October 21, 2009 petition is hereby dismissed as withdrawn. The November 10, 2009 petition for withdrawal of the October 21, 2009 petition accordingly is granted.

CONCLUSION

1. The October 21, 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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Intellectual Property Group
P.O. BOX 8801
DAYTON, OH 45401-8801

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ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DOUGLAS R. HANSCOM
JONES, TULLAR & COOPER P.C.
P.O. BOX 2266 EADS STATION
ARLINGTON, VA 22202

Date:
MAILED

DEC 07 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009167
PATENT NO. : 6730042
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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THOMPSON HINE L.L.P
INTELLECTUAL PROPERTY GROUP
P.O. BOX 8801
DAYTON, OH 45401-8801

(For Patent Owner)

Douglas R. Hanscom
Jones, Tullar & Cooper P.C.
P.O. Box 2266 Eads Station
Arlington, VA 22202

(For Requester)

In re Fulton et al.
Reexamination Proceeding
Control No.: 90/009,167
Filed: June 3, 2008
For: U.S. Patent No.: 6,730,042

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on November 25, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181 FOR 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 amendments and affidavits of William A. Bernie (hereinafter "the Bernie affidavit"), Terry E. Lawler (hereinafter "the Lawler affidavit") and John F. Cummings (hereinafter "the Cummings 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 25, 2009 is denied with respect to entry of the amendment and the affidavits of Bernie, Lawler and Cummings filed on July 24, 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,730,042 (hereinafter, the '042 patent) issued on May 4, 2004.

2. A request for *ex parte* reexamination, assigned control No. 90/009,167 (hereinafter, the '167 proceeding), was filed by a third party requester on June 3, 2008. Reexamination was requested for claims 24-27 and 30-35. These were the only claims remaining after the issuance of a prior reexamination certificate on May 27, 2008.

3. *Ex parte* reexamination was ordered for the '167 proceeding on August 6, 2008 for claims 24-27 and 30-35.

4. On November 6, 2008, a non-final Office action, which rejected claims 24-27 based upon anticipation and, in the alternative, obviousness over U.S. Patent No. 4,832,686 to Anderson and rejected claims 24-27 and 30-35 based upon obviousness over U.S. Patent No. 6,228,055 to Foerster in view of Anderson, was mailed in the '167 reexamination proceeding.

5. On January 6, 2009, the patent owner filed a response and submitted newly filed claims 38 and 39.

6. 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 24-27 based upon obviousness over Anderson. The Office action also rejected claims 24-27 and 30-35 based upon obviousness over Foerster in view of Anderson. The Office action also rejected claims 38 and 39 based upon obviousness over Foerster in view of Anderson and further in view of U.S. Patent No. 5,388,588 to Nabai.

7. On April 23, 2009, patent owner filed a request for an extension of time, which was granted in a petition decision mailed April 27, 2009. Extension of time was granted until June 10, 2009.

8. On June 3, 2009, patent owner filed a second request for an extension of time, which was granted in a petition decision mailed June 5, 2009. Extension of time was granted for an additional month, until July 10, 2009.

9. On July 8, 2009, patent owner filed a response that included an amendment to claim 24 and newly filed claims 40-42 and the Bernie, Lawler and Cummings affidavits.

10. 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.

11. On July 24, 2009, patent owner filed another response correcting the claim amendments submitted in the January 6, 2009 response and the Bernie, Lawler and Cummings affidavits.

12. 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)".

13. 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.

14. On September 8, 2009, patent owner filed a Petition to Revive under 37 CFR 1.137(b).

15. 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.

16. On November 10, 2009, patent owner filed a response after final rejection.

17. On November 13, 2009, the Office mailed an advisory action refusing entry of the amendments and affidavits by Bernie, Lawler and Cummings filed July 24, 2009.

18. On November 25, 2009, patent owner filed the instant petition requesting entry of the amendment and affidavits of Bernie, Lawler and Cummings. On even date, patent owner also filed a third request for extension of time

DECISION

The patent owner (petitioner) states that the examiner erred in deciding not to enter the amendments and affidavits of Bernie, Lawler and Cummings filed July 24, 2009, because the amendment was submitted solely to comply with a requirement of form (e.g., underlining and renumbering the new claims 38 and 39) and to place claims in better form for appeal (claim 24) and the affidavits and new claims 40-42 were submitted in response to a new argument regarding the Anderson reference presented by the Office in the Final Office action dated March 10, 2009. As such, petitioner contends that the amendments and affidavits are 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 asserting 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 3 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the amendments and the Bernie, Lawler and Cummings affidavit filed July 24, 2009, the director finds there are no good and sufficient reasons to enter the proposed amendment and affidavits. 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 24-27 were again rejected based on obviousness over Anderson and claims 24-27 and 30-35 were again rejected based on obviousness over Foerster in view of Anderson. Newly filed claims 38 and 39 were rejected based on obviousness over Foerster in view of Anderson and further in view of Nabai. 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 page 11 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 amendments and the Bernie, Lawler and Cummings affidavits filed July 24, 2009 should not be entered. The patent owner had an opportunity to enter the amendments and the affidavits 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 affidavits were 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, with the exception of the rejection of newly filed claims. 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 amendment and the Bernie, Lawler and Cummings affidavits 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 the amendments and the Bernie, Lawler and Cummings affidavits 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,167	06/03/2008	6730042	END5431USREX4	4968

27805 7590 02/02/2010

THOMPSON HINE L.L.P.
Intellectual Property Group
P.O. BOX 8801
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Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

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Jones, Tullar & Cooper P.C.

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,167*.

PATENT NO. *6730042*.

ART UNIT *3993*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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Thompson Hine L.L.P.
Intellectual Property Group
P.O. Box 8801
Dayton, OH 45401-8801

(For Patent Owner)

Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

In re Richard E. Fulton et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,167
Filed: June 3, 2008
For: U.S. Patent No. 6,730,042

: **DECISION ON**
: **PETITION TO**
: **CONTINUE *EX PARTE***
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the December 18, 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 18, 2009.

REVIEW OF RELEVANT FACTS

1. On May 4, 2004, U.S. Patent No. 6,730,042 issued to Richard E. Fulton et al.

2. On June 3, 2008, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,167.

3. On August 6, 2008, an order granting reexamination was mailed.

4. On November 6, 2008, a non-final Office action was mailed.

5. The 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 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 21, 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 25, 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 25, 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 21, 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 25, 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 18, 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 declarations 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 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 8, 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.

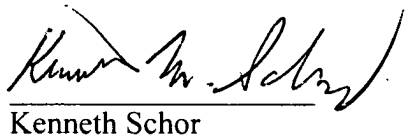
In view of the above, the petition under 37 CFR 1.182 is **dismissed** as premature.

CONCLUSION

1. The patent owner petition under 37 CFR 1.182 for continued reexamination filed on December 18, 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

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

[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.
90/009,167	06/03/2008	6730042	END5431USREX4	4968

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THOMPSON HINE L.L.P.
Intellectual Property Group
P.O. BOX 8801
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Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

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INTELLECTUAL PROPERTY GROUP
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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Douglas R. Hanscom
Jones, Tullar & Cooper P.C.
P.O. Box 2266 Eads Station
Arlington, VA 22202

(For Requester)

In re Fulton et al. :
Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/009,167 : UNDER 37 CFR 1.181
Filed: June 3, 2008 :
For: U.S. Patent No.: 6,730,042 :

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 DIRECTOROF 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 amendments and affidavits of William A. Bernie (hereinafter "the Bernie affidavit"), Terry E. Lawler (hereinafter "the Lawler affidavit") and John F. Cummings (hereinafter "the Cummings 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. 6,730,042 (hereinafter, the '042 patent) issued on May 4, 2004.

2. A request for *ex parte* reexamination, assigned control No. 90/009,167 (hereinafter, the '167 proceeding), was filed by a third party requester on June 3, 2008. Reexamination was requested for claims 24-27 and 30-35. These were the only claims remaining after the issuance of a prior reexamination certificate on May 27, 2008.

3. *Ex parte* reexamination was ordered for the '167 proceeding on August 6, 2008 for claims 24-27 and 30-35.

4. On November 6, 2008, a non-final Office action, which rejected claims 24-27 based upon anticipation and, in the alternative, obviousness over U.S. Patent No. 4,832,686 to Anderson and rejected claims 24-27 and 30-35 based upon obviousness over U.S. Patent No. 6,228,055 to Foerster in view of Anderson, was mailed in the '167 reexamination proceeding.

5. On January 6, 2009, the patent owner filed a response and submitted newly filed claims 38 and 39.

6. 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 24-27 based upon obviousness over Anderson. The Office action also rejected claims 24-27 and 30-35 based upon obviousness over Foerster in view of Anderson. The Office action also rejected claims 38 and 39 based upon obviousness over Foerster in view of Anderson and further in view of U.S. Patent No. 5,388,588 to Nabai.

7. On April 23, 2009, patent owner filed a request for an extension of time, which was granted in a petition decision mailed April 27, 2009. Extension of time was granted until June 10, 2009.

8. On June 3, 2009, patent owner filed a second request for an extension of time, which was granted in a petition decision mailed June 5, 2009. Extension of time was granted for an additional month, until July 10, 2009.

9. On July 8, 2009, patent owner filed a response, an amendment to claim 24 and newly filed claims 40-42 and the Bernie, Lawler and Cummings affidavits.

10. 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.

11. On July 24, 2009, patent owner filed another response correcting the claim amendments submitted in the January 6, 2009 response and the Bernie, Lawler and Cummings affidavits.

12. 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)".

13. 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.

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17. On November 13, 2009, the Office mailed an advisory action refusing entry of the amendments and affidavits by Bernie, Lawler and Cummings filed July 24, 2009.

18. On November 25, 2009, patent owner filed a petition requesting entry of the amendment and affidavits of Bernie, Lawler and Cummings. On even date, patent owner also filed a third request for extension of time.

19. On December 7, 2009, the petition filed November 24, 2009 was denied.

20. 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 amendments and affidavits of Bernie, Lawler and Cummings filed July 24, 2009, because the amendment was submitted solely to comply with a requirement of firm (e.g., underlining and renumbering the new claims 38 and 39), to place claims in better form for appeal (claim 24), and the affidavits and new claims 40-42 were submitted in response to a new argument regarding the Anderson reference presented by the Office in the Final Office action dated March 10, 2009. As such, petitioner contends that the amendments and affidavits are 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 asserting 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 3 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the amendments and the Bernie, Lawler and Cummings affidavits filed July 24, 2009, the director finds there are not good and sufficient reasons to enter the proposed amendment and affidavits. 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 24-27 were again rejected based on obviousness over Anderson and claims 24-27 and 30-35 were again rejected based on obviousness over Foerster in view of Anderson. Newly filed claims 38 and 39 were rejected based on obviousness over Foerster in view of Anderson and further in view of Nabai. 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 page 11 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 amendments and the Bernie, Lawler and Cummings affidavits filed July 24, 2009 should not be entered. The patent owner had an opportunity to enter the amendments and the affidavits 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 affidavits were 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, with the exception of the rejection of newly filed claims. 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 amendment and the Bernie, Lawler and Cummings affidavits 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

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THOMPSON HINE L.L.P.
Intellectual Property Group
P.O. BOX 8801
DAYTON, OH 45401-8801

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Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

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Intellectual Property Group
P.O. Box 8801
Dayton, OH 45401-8801

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Douglas R. Hanscom
Jones, Tullar & Cooper
2001 Jefferson Davis Highway
Suite 1002
Arlington, VA 22202

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In re Richard E. Fulton et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,167
Filed: June 3, 2008
For: U.S. Patent No. 6,730,042

: **DECISION ON**
: **PETITION TO**
: **CONTINUE *EX PARTE***
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the February 23, 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 18, 2009 for the original petition under 37 CFR 1.182. A fee is not required for the present renewed petition.

BACKGROUND

1. On May 4, 2004, the Office issued U.S. Patent No. 6,730,042 (the '042 patent) to Fulton et al.

2. On June 3, 2008, a request for *ex parte* reexamination of the '042 patent was filed by a third party requester. The resulting reexamination proceeding was assigned reexamination control No. 90/009,167 (hereinafter '9167).

3. On August 6, 2008, the Office issued an order granting the '9167 *ex parte* reexamination request.

4. On November 6, 2008, a first Office action on the merits issued, rejecting claims 24-27 and 30-35. Claims 1-23, 28, 29, 36, and 37 were canceled by Reexamination Certificate No. 6,730,042 published on May 27, 2008, for reexamination proceeding 90/007,165.

5. On January 6, 2009, patent owner filed a response retaining original claims 24-27, and 30-35 as not amended and adding new claims 36 and 37.

6. On March 10, 2009, a final Office action was mailed, rejecting claims 24-27, 30-35 and newly added claims "38 and 39."

7. 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.

8. 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.

9. 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.

10. 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.

11. On July 8, 2009, patent owner filed an amendment after the final Office action, the amendment being accompanied by declarations.

12. 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 July 8, 2009 amendment did not comply with 37 CFR 1.530.

13. 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.

14. On August 10, 2009, patent owner filed a Notice of Appeal.

15. On September 8, 2009, patent owner filed a petition entitled "PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b)."

16. On October 9, 2009, the Office mailed a decision granting the September 8, 2009 petition under 37 CFR 1.137(b).

17. On October 21, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

18. On November 10, 2009, patent owner filed a petition entitled "REQUEST TO WITHDRAW PETITION UNDER 37 C.F.R. §1.182 FOR CONTINUED REEXAMINATION."

19. On November 13, 2009, the Office mailed an advisory Office 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. The advisory action also stated that the after-final amendment would not be entered because it raised new issues that would require further search and/or consideration and did not place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal.

20. On November 25, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.181 FOR ENTRY OF AFFIDAVIT SUBMITTED AFTER FINAL ACTION."

21. On November 25, 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.

22. On December 4, 2009, the Office mailed a decision dismissing the October 21, 2009 petition under 37 CFR 1.182 as withdrawn and granting the November 10, 2009 petition under 37 CFR 1.182 to withdraw petition.

23. On December 7, 2009, the Office mailed a decision denying the November 25, 2009 petition under 37 CFR 1.181.

24. On December 7, 2009, the Office mailed a decision granting a one-month extension of time to file an appeal brief.

25. On December 18, 2009, patent owner filed a petition entitled "SECOND PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION."

26. 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."

27. On January 11, 2010, patent owner timely filed an appeal brief.

28. On January 22, 2010, the Office mailed a Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in *Ex Parte* Reexamination.

29. On February 2, 2010, the Office mailed a decision dismissing the December 18, 2009 petition under 37 CFR 1.182 as being premature.

30. On February 5, 2010, the Office mailed a decision denying the January 8, 2010 petition under 37 CFR 1.181.

31. On February 9, 2010, the patent owner filed a corrected appeal brief.

32. On February 23, 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 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*

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

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 the amendment after final and accompanying declarations 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 amendment after final and accompanying declarations were not and could not have been presented earlier because the arguments that the Office made in support of the rejections changed materially in the final Office action.[2] The petition further alleges that "review and consideration of the . . . Declarations 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 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 declarations and amendment would act to define the issues for appeal, or the issuance of a reexamination certificate. Petitioner does not address the effect of entry of the amendment in the instant petition. With respect to entry of the declarations, petitioner only states that entry would "enable the Office to be more fully informed." Looking to the remarks accompanying the July 24, 2009 proposed amendment and declarations, patent owner argued that the declarations would support the contention that the claims, as amended in the July 24, 2009 proposed amendment, would not be met by the applied rejections, as the art previously applied to the finally rejected claims would

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[2] Renewed petition at page 3. Specifically, patent owner argues that 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 and that while patent owner disagrees with the Office's newly presented construction of the Anderson reference (in the final Office action), the reference takes on increased relevance if IL-2 can in fact be considered optional.

[3] Renewed petition at page 4.

[4] On December 7, 2009, the Office mailed a decision denying the November 25, 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.

not read on the amended claims.[5] However, the examiner, in the November 13, 2009 advisory Office action, stated that the amended claims would raise new issues that would require further consideration and search; and further, were not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal. Patent owner, in the instant petition, does not address these statements by the examiner in the advisory Office action. Independent of the merits of the amendment, the instant petition fails to clearly show how the amendment is a *bona fide* effort to address the rejections of the claims so as to define the issues for appeal, or the issuance of a reexamination certificate. Reopening of the prosecution to consider this amendment absent a showing of such a *bona fide* effort would validate the patent owner's unnecessary delay in presenting the instant amendment in this proceeding contrary to the requirement of "special dispatch within the Office."

With respect to why the patent owner's proposed response could not have been anticipated earlier, the patent owner has not provided persuasive reasons why the amendment after final rejection and the Bernie, Lawler, and Cummings affidavits filed on July 24, 2009 could not have been submitted earlier. The affidavits were stated to be submitted to address the rejections made in the final rejection; in particular, the Anderson reference. 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 same exact rejection as in the non-final Office action, which included rejections based upon the Anderson reference, with the exception of the rejection of the newly filed claims. 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 basis of the rejection.[6] Therefore, it can be seen that the July 24, 2009 affidavit and amendment submissions address issues first raised in the first, non-final action that was mailed on November 6, 2008. Petitioner presents no persuasive reasoning why the need for the affidavits and amendments addressing issues raised in the first, 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

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[5] Renewed petition at 4. Specifically, Patent owner states that in response to the newly asserted relevance of the Anderson reference, it engaged two experts to construe the Anderson reference and a third to reproduce the copolymer disclosed in the Anderson that is most similar to that claimed by the patent owner to determine if Anderson's copolymer would be suitable in a biopsy marker. 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 argues that Dr. Lawler's declaration is important to review and consider in that it attests that the "bioresorbable body comprising polylactic acid and polyglycolic acid" disclosed in the Anderson patent was tested and determined to be unsuitable for use in a biopsy marker. The patent owner asserts that the Cummings Declaration is important for the Office to review because Dr. Cummings observed that Anderson injected the IL2-formulations in the form of a dispersion in saline and that such an approach was not suitable for a biopsy marker because it did not pinpoint the location of the biopsy and did not meet the requirement of the claims that the marker be in the form of a "bioresorbable body." Renewed petition at 3-4.

[6] It is noted that in the March 10, 2009 final Office action at page 6, the examiner relied on the secondary reference to Anderson for the teaching of a bioresorbable body comprising polylactic acid and polyglycolic acid .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.

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 renewed patent owner petition under 37 CFR 1.182 for continued reexamination filed on February 23, 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 9, 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

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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CENTRAL REEXAMINATION UNIT

David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For 3rd Party Requester)
90/009,185

Scott Witonsky
Proskauer Rose LLP
One International Place
Boston, MA 02110

(For 3rd Party Requester)
90/010,177

Douglas J. Gilbert, Esq.
Pearl Cohen Zedek Latzer LLP
1500 Broadway, 12th Floor
New York, NY 10036

(For 3rd Party Requester)
90/010,198

Reexam Control No.: 90/009,185
Filed : June 13, 2008
For U.S. Patent No. : 6,547,780

Reexam Control No.: 90/010,177
Filed : May 22, 2008
For U.S. Patent No. : 6,547,780

Reexam Control No.: 90/010,198
Filed : June 16, 2008
For U.S. Patent No. : 6,547,780

: DECISION MERGING
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the September 25, 2008 patent owner petition filed in reexamination control number 90/010,177. The petition is entitled "Request for Consolidation of Multiple Co-Pending *Ex Parte* Reexamination Proceedings Under 37 C.F.R § 1.565."

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).

Relevant Authority

37 CFR 1.565(c) provides:

> 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.

MPEP § 2283, Subsection VII, provides:

> No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the determination (37 CFR 1.515) and order to reexamine (37 CFR 1.525) on the second request, it will not be considered but will be returned to the party submitting the same by the CRU Director. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2267.
>
> While the patent owner can file a petition to merge the proceedings at any time after the order to reexamine (37 CFR 1.525) on the second request, the better practice is to include any such petition with the patent owner's statement under 37 CFR 1.530, in the event the CRU Director has not acted prior to that date to merge the multiple reexamination proceedings. If the requester of any of the multiple reexamination proceedings is not the patent owner, that party may petition to merge the proceedings as a part of a reply pursuant to 37 CFR 1.535 in the event the CRU Director has not acted prior to that date to merge the multiple proceedings. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the requesters of the reexamination will not be considered but will be returned to that party by the CRU Director as being improper under 37 CFR 1.550(g).
>
> All decisions on the merits of petitions to merge multiple reexamination proceedings will be made by the CRU Director (or to the CRU SPE if the CRU Director delegates it to him or her).

Consideration of Merger

The petition to merge *ex parte* reexamination proceeding 90/009,185 (the '185 proceeding), *ex parte* reexamination proceeding 90/010,177 (the '177 proceeding), and *ex parte* reexamination proceeding 90/010,198 (the '198 proceeding) was filed on September 25, 2008 in the file of '177 proceeding. No fee was submitted, and none is required inasmuch MPEP § as the Office will generally treat the issue of merger *sua sponte*, if no petition to merge is filed. Thus, in this instance, the present petition is taken as being equivalent to notice to the Office that merger should be considered.

Reexamination of the '185 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1, 2, and 7-12 of U.S. Patent No. 6,547,780 (the '780 patent). Concurrently with the filing of the present petition, patent owner filed a notice waiving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '185 reexamination proceeding. Accordingly, the '185 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination in the '177 proceeding was ordered in a decision mailed July 19, 2008. Reexamination was ordered for claims 1-14, i.e., all of the claims, of the '780 patent. The time for filing a patent owner's statement under 37 CFR 1.530 expired on September 19, 2008, without a patent owner's statement having been filed. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '711 reexamination proceeding. Accordingly, the '177 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination in the '198 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1, 2, and 7-12 of the '780 patent. Concurrently with the filing of the present petition, patent owner filed a notice waiving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '198 reexamination proceeding. Accordingly, the '198 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

As evidenced by the above facts, the '185, '177 and '198 reexamination proceedings are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, and a patent owner's statement has not been and now cannot be filed in any of those 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 1-14, which are all of the claims of the '780 patent and for which reexamination has been ordered, 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 proceeding, and each action will be entered into each of the files (which will be maintained as separate electronic Image File Wrapper 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 fee, appeal 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. 90/009,185, 90/010,177 and 90/010,198 are hereby merged into a single proceeding. It being noted that the claims of record are identical in each of the merged *ex parte* reexamination proceedings, 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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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

David Leason
Leason Ellis LLP
81 Main Street, Suite 100
White Plains, NY 10601

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Matthew A. Newboles
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For 3rd Party Requester)
90/009,186

Scott Witonsky
Proskauer Rose LLP
One International Place
Boston, MA 02110

(For 3rd Party Requester)
90/010,176

Douglas J. Gilbert
Pearl Cohen Zedek Latzer LLP
1500 Broadway, 12th Floor
New York, NY 10036

(For 3rd Party Requester)
90/010,197

Reexam Control No.: 90/009,186
Filed : June 13, 2008
For U.S. Patent No. : 6,159,203

Reexam Control No.: 90/010,176
Filed : May 22, 2008
For U.S. Patent No. : 6,159,203

Reexam Control No.: 90/010,197
Filed : June 16, 2008
For U.S. Patent No. : 6,159,203

: DECISION MERGING
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the September 25, 2008 patent owner petition filed in each of the above-identified reexamination proceedings. The petition is entitled "Request for Consolidation of Multiple Co-Pending *Ex Parte* Reexamination Proceedings Under 37 C.F.R. § 1.565."

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).

Relevant Authority

37 CFR 1.565(c) provides:

> "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."

MPEP § 2283, Subsection VII, provides:

> No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte,* make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the determination (37 CFR 1.515) and order to reexamine (37 CFR 1.525) on the second request, it will not be considered but will be returned to the party submitting the same by the CRU Director. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2267.
>
> While the patent owner can file a petition to merge the proceedings at any time after the order to reexamine (37 CFR 1.525) on the second request, the better practice is to include any such petition with the patent owner's statement under 37 CFR 1.530, in the event the CRU Director has not acted prior to that date to merge the multiple reexamination proceedings. If the requester of any of the multiple reexamination proceedings is not the patent owner, that party may petition to merge the proceedings as a part of a reply pursuant to 37 CFR 1.535 in the event the CRU Director has not acted prior to that date to merge the multiple proceedings. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the requesters of the reexamination will not be considered but will be returned to that party by the CRU Director as being improper under 37 CFR 1.550(g).
>
> All decisions on the merits of petitions to merge multiple reexamination proceedings will be made by the CRU Director (or the CRU Special Program Examiner, if the CRU Director delegates it to him or her).

Consideration of Merger

A petition to merge *ex parte* reexamination proceeding 90/009,186 (the '186 proceeding), *ex parte* reexamination proceeding 90/010,176 (the '176 proceeding), and *ex parte* reexamination proceeding 90/010,197 (the '197 proceeding) was filed September 25, 2008 in each of the above-identified files. No fee was submitted, and none is required inasmuch as the Office will generally treat the issue of merger *sua sponte*, if no petition to merge is filed. Thus in this instance, the present petition is taken as being equivalent to a notice to the Office that merger should be considered.

Reexamination of the '186 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1-3, 9-15, and 20-25 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '186 proceeding. Accordingly, the '186 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '176 proceeding was ordered in a decision mailed August 21, 2008. Reexamination was ordered for claims 1-26 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent

owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '176 proceeding. Accordingly, the '176 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '197 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1-3, 8-15, and 20-25 of U.S. patent No. 6,159,203 (the '203 patent). Concurrently with the filing of the present petition, patent owner filed a notice waving patent owner's right to file a patent owner's statement under 37 CFR 1.530. Thus, no third party requester reply under 37 CFR 1.535 to the patent owner's statement can be filed in the '197 proceeding. Accordingly, the '197 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

As evidenced by the above facts, the '186, '176, and '197 reexamination proceedings are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, and a patent owner's statement has not and now cannot be filed in any of those 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 1-26, which are all of the claims of the '203 patent and for which reexamination has been ordered, 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 proceeding, and each action will be entered into each of the files (which will be maintained as separate electronic Image File Wrapper 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 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. 90/009,186, 90/010,176 and 90/010,197 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow

for Gregory Morse, Director
Central Reexamination Unit