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David Leason
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(For Patent Owner)

MAILED

NOV 19 2008

CENTRAL REEXAMINATION UNIT

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Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For 3rd Party Requester)
90/009,188

Scott Witonsky
Proskauer Rose LLP
One International Place
Boston, MA 02110

(For 3rd Party Requester)
90/010,175

Douglas J. Gilbert
Pearl Cohen Zedek Latzer LLP
1500 Broadway, 12th Floor
New York, NY 10036

(For 3rd Party Requester)
90/010,196

Marc M. Wefers
Fish & Richardson PC
P.O. Box 1022
Minneapolis, MN 55440-1022

(For 3rd Party Requester)
90/010,194

Reexam Control No.: 90/009,188
Filed : June 13, 2008
For U.S. Patent No. : 5,843,073

Reexam Control No.: 90/010,175
Filed : May 22, 2008
For U.S. Patent No. : 5,843,073

Reexam Control No.: 90/010,196
Filed : June 16, 2008
For U.S. Patent No. : 5,843,073

Reexam Control No.: 90/010,194
Filed : June 16, 2008
For U.S. Patent No. : 5,843,073

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 90/009,188 (the '188 proceeding), *ex parte* reexamination proceeding 90/010,175 (the '175 proceeding), *ex parte* reexamination proceeding 90/010,196 (the '196 proceeding), and *ex parte* reexamination proceeding 90/010,194 (the '194 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 '188 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1, 2, 7, and 10-13 of U.S. patent No. 5,843,073 (the '073 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 '188 proceeding. Accordingly, the '188 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '175 proceeding was ordered in a decision mailed July 18, 2008. Reexamination was ordered for claims 1-13 of U.S. patent No. 5,843,073 (the '073 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 '175 proceeding. Accordingly, the '175 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '196 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1, 2, 6, 7 and 10-13 of U.S. patent No. 5,843,073 (the '073 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 '196 proceeding. Accordingly, the '196 reexamination proceeding is now ripe for examination as to the patentability of the claims for which reexamination has been ordered.

Reexamination of the '194 proceeding was ordered in a decision mailed August 22, 2008. Reexamination was ordered for claims 1-13 of U.S. patent No. 5,843,073 (the '073 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 '194 proceeding. Accordingly, the '194 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 '188, '175, '196, and '194 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 1-13, which are all of the claims of the '073 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. 90/009,188, 90/010,175, 90/010,196, and 90/010,194 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

Gregory Morse, Director
Central Reexamination Unit

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90/010,175; 90/010,194; 90/010,196; 90/010,578;

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,188	06/13/2008	5843073	CRDIO-046X	9268

76808 7590 11/17/2009

EXAMINER

Leason Ellis LLP
81 Main Street
Suite 503
White Plains, NY 10601

ART UNIT	PAPER NUMBER

DATE MAILED: 11/17/2009

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

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90/009,188; 90/010,194; 90/010,196; 90/010,578;

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,175	05/22/2008	5843073	CRD-001RX	5404

EM1

76808 7590 11/17/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/17/2009

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90/009,188; 90/010,175; 90/010,196; 90/010,578;

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,194	06/16/2008	5843073	16577-004RX1	2672

76808 7590 11/17/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/17/2009

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90/009,188; 90/010,175; 90/010,194; 90/010,578;

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,196	06/16/2008	5843073	70422-25-01	2938

76808 7590 11/17/2009

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 11/17/2009

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90/009,188; 90/010,175; 90/010,194; 90/010,196;

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,578	06/18/2009	5843073	16577-0004RX2	6093

76808 7590 11/17/2009

EXAMINER

Leason Ellis LLP
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ART UNIT	PAPER NUMBER

DATE MAILED: 11/17/2009

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NOV 17 2009

CENTRAL REEXAMINATION UNIT

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For 3rd Party Requester
90/010,194 &
90/010,578

Ex Parte Reexamination Proceeding
Control No. 90/009,188
Filed: June 13, 2008
For: U.S. Patent No. 5,843,073

Ex Parte Reexamination Proceeding
Control No. 90/010,175
Filed: May 22, 2008
For: U.S. Patent No. 5,843,073

Ex Parte Reexamination Proceeding
Control No. 90/010,194
Filed: June 16, 2008
For: U.S. Patent No. 5,843,073

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Ex Parte Reexamination Proceeding
Control No. 90/010,196
Filed: June 16, 2008
For: U.S. Patent No. 5,843,073

Ex Parte Reexamination Proceeding
Control No. 90/010,578
Filed: June 18, 2009
For: U.S. Patent No. 5,843,073

Reexamination proceedings control Nos. 90/009,188; 90/010,175; 90/010,194; and 90/010,196 (hereinafter: "the first set") were previously merged in a decision mailed November 19, 2008, and these proceedings are still pending and prosecution has not been terminated. Reexamination proceeding control No. 90/010,578 was filed June 18, 2009 and reexamination ordered in a decision mailed July 30, 2009. Accordingly, the above two sets of reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided 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."

As indicated above, the first set of proceedings was merged in a decision mailed November 19, 2008. The decision indicated that claims 1-13, all of the claims in US Patent No. 5,843,073, would be reexamined. On November 20, 2008, a non-final Office action was mailed rejecting all of the pending claims. On February 13, 2009, a response was filed by patent owner. The response includes no changes to the claims and drawings, but does include changes to the specification. No Office action has been rendered since the receipt of patent owner's amendment.

As also indicated above, reexamination in application control No. 90/010,578 was ordered in a decision mailed July 30, 2009. The decision indicating that claims 1-13, all of the claims in US Patent No. 5,843,073, would be reexamined. No patent owner's statement under 37 CFR 1.530 was filed and no Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, the first set of reexamination proceedings and reexamination control No. 90/010,578 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely and the 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, no amendments have been made to the claims or drawings. However, the specification has been amended by virtue of the amendment filed March 13, 2009 in the first set of proceedings. The patent owner is required to maintain identical claims, drawings, and specification in both files. **Accordingly, patent owner is hereby required to provide a "housekeeping" amendment within one month of the mailing date of this decision placing identical specifications in each of the 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.

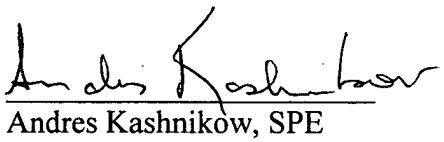
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently all of the pending claims, namely claims 1-13, are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexaminations. All papers issued by the Office will contain the identifying data each of the proceedings, and each paper 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 with four copies, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and 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 fee, brief fee, etc.) only a single feed 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 art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination control Nos. 90/009,188; 90/010,175; 90/010,194; 90/010,196; and 90/010,578 are hereby merged into a single proceeding. **As stated above, patent owner has one-month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same specification in each of the files**. Upon receipt of the response or expiration of the time period indicated above, whichever comes first, the 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, Supervisory Primary Examiner, at telephone No. (571) 272-4361.



Andres Kashnikow, SPE
Central Reexamination Unit 3993

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,195	06/19/2008	5606361	Davidsohn-1 Reexam	5240

48924 7590 09/11/2009

KOHN & ASSOCIATES, PLLC
30500 NORTHWESTERN HWY, SUITE 410
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/11/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Elizabeth C. Richter
COLLARD & ROE, PC
1077 Northern Blvd.
Roslyn, NY 11576-1696

Date: MAILED

SEP 11 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009195
PATENT NO. : 5606361
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
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(For Patent Owner)

Collard & Roe, P.C.
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Roslyn, NY 11576

(For Requester)

In re John Davidsohn et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,195
Filed: June 19, 2008
For: U.S. Patent No. 5,606,361

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

This is a decision on the August 28, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination ("the August 28, 2009 patent owner petition to revive").

The appropriate petition fee of $810.00 set forth in 37 CFR 1.17(m) for the August 28, 2009 patent owner petition to revive has been paid.

The August 28, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 28, 2009 patent owner petition to revive is **granted**.

The August 31, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 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 August 28, 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 June 5, 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 June 5, 2009 Office action set a two-month period for response. A proper response to the June 5, 2009 Office action was not filed until August 28, 2009, which was untimely. However, for the purpose of evaluating whether the August 28, 2009 patent owner petition to revive is a grantable petition, the submission of the August 28, 2009 response to the June 5, 2009 Office action satisfies item (1).[1]

Accordingly, the August 28, 2009 patent owner petition to revive is **granted**.

The August 31, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

CONCLUSION

1. The August 28, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. The August 31, 2009 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992, for treatment of the August 28, 2009 Amendment.

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Matthew Heneghan, of CRU Art Unit 3992, at (571) 272-3834.

[1] This decision is not directed to the persuasiveness and propriety of the arguments presented in the August 28, 2009 response as to each of the rejections set forth in the June 5, 2009 Office action; such is the examiner's province.

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

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.
90/009,196	06/23/2008	5148366	140.0001-00000	5652

22882 7590 07/07/2009

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Thomas M. Sullivan
LANDO & ANASTASI, LLP
One Main Street, Suite 1100
Cambridge, MA 02142

Date:

MAILED

JUL 07 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009196
PATENT NO. : 5148366
ART UNIT : 3992

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

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

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(For Patent Owner)

MAILED

JUL 07 2009

CENTRAL REEXAMINATION UNIT

Thomas M. Sullivan, Esq.
LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

(For Third Party Requester)

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

In re: Buchanan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,196
Deposited: 23 June 2006
For: US Patent No. 5,148,366

This is a decision on the 02 July 2009, "Supplemental Petition Under 37 CFR 1.550(c) For A One-Month Extension of Time" requesting that the time for responding to the non-final Office action mailed 05 June 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 granted for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 15 September 1992 US Patent No. 5,148,366 was granted to Ken Buchanan *et alia.*

2. On 23 June 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,196.

3. On 05 July 2008 the Order was granted for *ex parte* reexamination in control number 90/009,196.

4. On 05 June 2009 a non-final Office action was mailed setting a period for response of one-month.

5. On 02 July 2009 the instant petition was submitted

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 05 June 2009, which set a one (1) 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 2 July 2009.

The extension of time is 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. ...

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'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 non-final rejection was mailed 05 June 2008. The petition was timely filed.

The petition dated 02 July 2009 notes that the length of the action and time spent to date preparing the response as well as the needed time to fully respond.

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

CONCLUSION

1. The patent owner's petition for extension of one month time in which to file a response to the Office action dated 05 May 2009 is hereby **granted.**

2. The Patent Owner's response is due **05 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

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MAR 25 2010

CENTRAL REEXAMINATION UNIT

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Thomas M Sullivan
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2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

In re: Buchanan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,196
Deposited : 23 June 2008
For: US Patent No. 5,148,366

DECISION
SUA SPONTE
MERGING
PROCEEDINGS
[37 CFR § 1.565(c)]

In re: Buchanan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,670
Deposited : 10 September 2009
For: US Patent No. 5,148,366

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

BACKGROUND

1. On 15 September 1992 US Patent No. 5,148,366 was granted to Buchanan *et alia.*

2. On 23 June 2008 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,196.

3. On 25 July 2008 the Order was granted for *ex parte* reexamination in control number 90/009,196.

4. On 05 June 2009 a non-final Office action was mailed in 90/009,196.

5. On 06 July 2009 an amendment and remarks were received in 90/009,196.

6. On 10 September 2009 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,670.

7. On 20 November 2009 the Order was granted for ex parte reexamination in control number 90/010,670.

8. There are no amendments to the claims in control number 90/010,670.

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. 90/009,196 & 90/010,670 *ex parte* 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 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.

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. 90/009,196 & 90/010,670 *ex parte* reexamination proceedings 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

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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/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,197	06/19/2008	7240569	20080619	7906

7590 10/16/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/16/2008

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

ROBERT N. MONTGOMERY

109 BROWNLEE AVE.

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MAILED

OCT 16 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,197*.

PATENT NO. *7240569*.

ART UNIT *3992*.

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

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

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(For Patent Owner)

MAILED

OCT 16 2008

CENTRAL REEXAMINATION UNIT

Robert N. Montgomery
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(For Third Party Requester)

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

In re: Foley *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,197
Deposited on: 19 June 2008
For: US Patent No. 7,240,569

This is a decision on the 8 October 2008 , petition for "Petition Under 37 CFR § 1.550 (c) for Two Months Extension of time," requesting that the time for responding to the Order granting reexamination mailed 19 August 2008 be extended by two-months.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Order granting reexamination mailed 19 August 2008, which set a two month date for filing a response thereto. The petition for extension of time was timely filed on 8 October 2008, together with the authorization to charge $200.00 petition fee as required by 37 CFR § 1.515(c) and § 1.17(g).

37 CFR § 1.550 (c) states:

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

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

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

Analysis and Findings

The petitioner representing the patent owner states that the patent owner will be out of the country from 3 October 2208 to 12 October 2008. On balance the justification for "sufficient cause" for granting any extension of time must be balanced between the need for the patent owner to have sufficient time for which to respond against the need for special dispatch. In this case since the patent owner will be out of the country for a period of 10 days, the time for response will be extended for a period which the patent owner may provide a response to the Order granting reexamination by 10 days.

The time for which the patent owner may provide a patent owner's statement following the granting of the Order for reexamination is extended by ten-days.

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

Conclusion

1. The patent owner's petition for extension of two-months time in which to file a response to the Order granting reexamination is hereby **granted-in-part**.

2. A ten-day extension of time is hereby granted.

3. The Patent Owner's response is due **29 October 2008**.

4. Response may be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
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By Fax to: (571) 273-9900
Central Reexamination Unit

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

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

/Mark Reinhart/

Gregory Morse,
Director,
Central Reexamination Unit

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

Steinberg Raskin & Davidson
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(For Patent Owner)

MAILED

JUL 15 2009

CENTRAL REEXAMINATION UNIT

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P.O. Box 1022
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(For Requester)

Cozen O'Connor
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New York, NY 10177

(Courtesy Copy)

In re Townsend et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,202
Filed: June 26, 2008
For: U.S. Patent No. 5,736,910

DECISION
DISMISSING
PETITION

This is a decision on the patent owner petition, filed May 18, 2009, denominated "Petition Under 37 CFR § 1.183 Requesting Waiver of an Inventor's Signature" and directed to a filed declaration under 37 CFR 1.131 and acceptance of that declaration under 37 CFR 1.131 without execution by all of the named inventors.

The proceeding and the petition are before the Office of Patent Legal Administration for decision.

The petition fee required under 37 CFR 1.17(f) has been received.

The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is **dismissed** for the reasons detailed below.

REVIEW OF FACTS

1. On April 7, 1998, U.S. Patent No. 5,736,910 (the '910 patent) issued from application no. 08/561,931 (the '931 application) to Townsend et al. with 22 claims.

2. The original declaration in the '931 application grants power of attorney for the inventors to Martin Raskin, Clifford Davidson, Michael Mercanti, Brian Roffe, and Laurence Manber, with a correspondence address of Steinberg Raskin & Davidson, 1140 Avenue of the Americas, New York, NY 10036. A request for a change of address was filed in the patent file on Sept. 9, 2008; however, contrary to the statement on the request, the change of address *was not signed by an attorney of record.* Therefore, the address remains as the original correspondence address.

3. The patent lists the assignee as Steward Connector Systems, Inc., which corresponds to the first recorded assignment documents for the '931 application. There is no statement of record in accordance with 37 CFR 3.73(b) that the attorneys of record for the inventors were given authority to act on behalf of the assignee. Subsequent assignments were recorded as follows:
   a. Steward Connector Systems, Inc. executed a "Notice of Amendment to Subsidiary Patent" to Citicorp USA, Inc. on July 3, 1997;
   b. Steward Connector Systems, Inc. executed a security interest to Bank One NA on Aug. 21, 2000;
   c. Steward Connector Systems, Inc. executed an assignment to Bel Fuse Ltd., Bel Fuse Macau LDA and others on March 24, 2003;
   d. Bel Fuse Macau LDA executed an assignment to Bel Fuse (Macau Commercial Offshore) Ltd. on Dec. 19, 2008.

4. On June 26, 2008, a third party requester filed a request for *ex parte* reexamination of claims 1-22 of the '910 patent, and the request was assigned control no. 90/009,202 (the '9202 proceeding).

5. A concurrent litigation in the U.S. District Court, New Jersey, styled *Bel Fuse, Inc. v. Halo Electronics, Inc.*, No. 2:07cv2168, is stayed pending reexamination of the '910 patent.

6. On August 21, 2008, an order granting the reexamination request was mailed.

7. A non-final Office action was mailed February 17, 2009, in which claims 1-22 were rejected.

8. An interview was held on May 1, 2009, with Joshua Raskin, who stated that he was patent owner's representative.

9. A response was submitted on May 18, 2009, along with numerous exhibits and declarations under 37 CFR §§ 1.132 and 1.131, after an extension of time was granted. The subject petition was submitted concurrently with the May 18 response. The May 18 response and petition are not personally signed by a registered patent attorney, as the name "Joshua L. Raskin" is printed and initialed by an unidentified person.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of § 1.4(d), § 1.4(e), or § 2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that -

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

37 CFR 1.34 Acting in a representative capacity.

When a patent practitioner acting in a representative capacity appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party on whose behalf he or she acts. In filing such a paper, the patent practitioner must set forth his or her registration number, his or her name and signature. Further proof of authority to act in a representative capacity may be required.

37 CFR § 3.73 Establishing right of assignee to take action:

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b) (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § **3.11** in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § **3.11**; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

MPEP 402 in part states:

In accordance with 37 CFR **1.34**, a paper filed by a registered patent attorney or agent in an application in which he or she is not of record must include his or her name and registration number with his or her signature. Acceptance of papers filed in patent applications and reexamination proceedings by registered attorneys and agents upon a representation that the attorney or agent is authorized to act in a representative capacity is for the purpose of facilitating replies on behalf of applicants in patent applications and, further, to obviate the need for filing powers of attorney in individual applications or patents when there has been a change in composition of law firms or corporate patent staffs. Interviews with a registered attorney or agent not of record will, in view of **35 U.S.C. 122**, be conducted only on the basis of information and files supplied by the attorney or agent. A person acting in a representative capacity may not sign (A) a power of attorney (**37 CFR 1.32(b)(4)**), (B) a document granting access to an application (except where an executed oath or declaration has not been filed, and the patent practitioner was named in the papers accompanying the application papers - 37 CFR **1.14**(c)), (C) a change of correspondence address (except where an executed oath or declaration has not been filed, and the patent practitioner filed the application - 37 CFR **1.33**(a)), (D) a terminal disclaimer (**37 CFR 1.321(b)(1)**(iv)), or (E) a request for an express abandonment without filing a continuing application (37 CFR **1.138**(b)).

37 CFR 1.183 provides, in pertinent part:

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

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

37 CFR 1.131(a) provides, in pertinent part (emphasis added):

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, **the owner of the patent under reexamination**, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. [Emphasis added.]

MPEP 715.04 I. provides, in pertinent part (emphasis added):

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s)**. Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. [Emphasis added.]

ANALYSIS AND FINDINGS

1. The Petition and Response have not been signed by a registered patent attorney and are improper filings.

As required by 37 CFR 10.18(a), each piece of correspondence submitted by a registered practitioner must bear his or her signature. The subject petition and accompanying response have not been signed by the registered practitioner listed on the papers. Therefore, they are improper submissions and will not be entered into the record.

Despite the assertion that the petition is signed by counsel for the assignees of the patent, the submitter, Joshua Raskin, has not complied with the provisions for acting in a representative capacity as explained in MPEP 402. Thus, Joshua Raskin can only file a paper in this proceeding under the provisions of 37 CFR **1.34**. In accordance with 37 CFR **1.34**, a paper filed by a registered patent attorney or agent in an application in which he or she is not of record must include his or her name and registration number with his or her signature. Joshua Raskin is not of record in this proceeding or the original patent application, and has not included his name and registration number with his signature.

2. A proper response has not been filed in the proceeding, and the time period for response has expired.

The period for response to the outstanding Office action has expired. In accordance with the procedure explained in MPEP 2268 and pursuant to 37 CFR **1.550(d)**, the prosecution of an *ex parte* reexamination proceeding is terminated 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 37 CFR **1.560(b)**. An *ex parte* reexamination prosecution terminated under 37 CFR **1.550(d)** can be revived if the delay in response by the patent owner (or the failure to timely file the interview statement) was unavoidable in accordance with 37 CFR **1.137(a)**, or unintentional in accordance with 37 CFR **1.137(b)**.

3. The Petition asserts that the petitioner is signed by counsel for the assignees of the patent, but no authority to act on behalf of the assignee has been established as required by rule.

No power of attorney has been filed in this proceeding and the requisite power of attorney has not been filed in the patent being reexamined. The original power of attorney filed in the patent's application file granted power to five registered practitioners (see fact no. 2 above) from the inventors. The inventors apparently subsequently assigned their rights to an assignee; however, no authority to act on behalf of the assignee has been established in this proceeding.

As required by 37 CFR 3.73(b)(1), in order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. Ownership is established in patent matters by submitting to the Office a signed statement identifying the assignee, accompanied by either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment) accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § **3.11**; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number). No 37 CFR 3.73(b)(1) statement establishing ownership has been submitted in the present patent and reexamination proceeding. Also, in accordance with 37 CFR 3.73(b)(2), a submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by: (i) including a statement that the person signing the submission is authorized to act on behalf of the assignee; or (ii) being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee. No such showing has been made.

It is also observed that the chain of title in the recorded assignment records in unclear. There are at least two outstanding security obligations with no evidence of resolution. It is not clear that the original assignee had the authority to transfer complete ownership interest to the current recorded owner.

4. The Change of Correspondence Address was improper.

A registered practitioner who is not of record and is merely acting in a representative capacity may not sign a change of correspondence address (except where an executed oath or declaration has not been filed, and the patent practitioner filed the application - 37 CFR **1.33**(a)). Thus, the

change of correspondence address filed in the patent on September 9, 2008 was improper. Accordingly, the correspondence address has not been changed.

5. The merits of the request for waiver have not been reached, as it is unclear that the person making the request has authority to participate in the proceeding, nor is the proceeding pending.

The petitioner has not submitted a signed request, has not established that he is acting in representative capacity, is not of record in the proceeding, and has no apparent authority to act on behalf of the true owner or owners of the patent. As such, the Office does not have the authority to consider the merits of the request. Further, the proceeding is not pending, as pointed out above in part (2) of the Analysis and Findings. Thus, the merits of the petition cannot not be decided.

While the merits of the petition will not be reached in this decision and the paper is improper, it is noted that 37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination*. . . may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). As pointed out in MPEP 715.04 I.(D), an assignee, or other party in interest is permitted to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is asserted in the case here. In accordance with the language of 37 CFR 1.131, the assignee may make the declaration for a patent under reexamination, even if the inventors are available to sign a declaration. As this would be an appropriate remedy in this case, an extraordinary situation would not exist that would support a waiver of the rule.

PATENT OWNER'S ADDRESS

The patent owner is reminded to update the correspondence address in the patent file and this proceeding based on any change in power of attorney and submitted change of correspondence address. The Office will not engage in double correspondence with more than one attorney or agent. See 37 CFR 1.33(c).

CONCLUSION

1. For the reasons set forth above, the petition under 37 CFR 1.183 to waive 37 CFR 1.131 as to its requirement for signature of an oath or declaration is **dismissed**.

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).

3. Any inquiry concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

Kenffid/ 7-13-09

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

Cozen O'Connor
250 Park Avenue
New York, NY 10177

(For Patent Owner)

Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Requester)

MAILED

AUG 25 2009

CENTRAL REEXAMINATION UNIT

In re Peter K. Townsend et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,202
Filed: June 26, 2008
For: U.S. Patent No. 5,736,910

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

This is a decision on the August 14, 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 August 14, 2009 patent owner petition to revive").

The appropriate petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the August 14, 2009 patent owner petition to revive has been paid.

The August 14, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 14, 2009 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a response under 37 CFR 1.550(b) to the February 17, 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 August 14, 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 February 17, 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 February 17, 2009 Office action set a two-month period for response. A proper response to the February 17, 2009 Office action was not filed until August 14, 2009, which was untimely. However, for the purpose of evaluating whether the August 14, 2009 patent owner petition to revive is a grantable petition, the submission of the August 14, 2009 response to the February 17, 2009 Office action satisfies item (1).[2]

Accordingly, the August 14, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The August 14, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for processing of the August 14, 2009 Response To Non-Final Action in *Ex Parte* Reexamination.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Alexander Kosowski, of CRU Art Unit 3992, at (571) 272-3744.

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 August 14, 2009 response as to each of the rejections set forth in the February 17, 2009 Office action; such is the examiner's province.

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.
90/009,202	06/26/2008	5,736,910	22168-011RX1	6466

54042 7590 10/01/2009

Cozen O"Connor
250 PARK AVENUE
NEW YORK, NY 10177

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/01/2009

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 Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

Cozen O'Connor
250 PARK AVENUE
NEW YORK NY 10177

(For Patent Owner)

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Requester)

In re Townsend *et alia* (US Patent Number 5,736,910)
Reexamination Cont. No.: 90/009,202
Filed: June 26, 2008
For: **MODULAR JACK CONNECTOR WITH A FLEXIBLE LAMINATE CAPACITOR MOUNTED ON A CIRCUIT BOARD**

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed June 4, 2009, to expunge information from the above identified proceeding.

The petition is granted.

Petitioner requests that a document identified as

"Plaintiff Bel Fuse, Inc.'s Supplemental Responses to Defendant's First Set of Interrogatories (Nos. 1-9)"

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

Enclosure (to Patent Owner only): "Plaintiff Bel Fuse, Inc.'s Supplemental Responses to Defendant's First Set of Interrogatories (Nos. 1-9)"

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.
90/009,204	10/14/2008	6081786	SMA001	5799

20792 7590 06/22/2009

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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
GOODMAN, ALLEN & FILETTI PPLC
4501 HIGHTWOODS PARKWAY
SUITE 210
GLEN ALLEN, VA 23060

Date:
MAILED
JUN 22 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009204
PATENT NO. : 6081786
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
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MAILED

JUN 22 2009

CENTRAL REEXAMINATION UNIT

MYERS BIGEL SIBLEY & SAJOVEC (For Patent Owner)
PO BOX 37428
RALEIGH NC 27627

GOODMAN, ALLEN & FILETTI PLLC (For Third Party Requester)
4501 HIGHWOODS PARKWAY
SUITE 210
GLEN ALLEN, VA 23060

DAY CASEBEER MADRID & BATCHELDER (For Third Party Requester)
20300 STEVENS CREEK BLVD.
SUITE 400
CUPERTINO, CA 95014

In re Barry *et alia* : DECISION *SUA SPONTE*
Reexamination Proceeding : MERGING
Control No. 90/009,204 : REEXAMINATION
For: U.S. Patent No. 6,081,786 : PROCEEDINGS

In re Barry *et alia* :
Reexamination Proceeding :
Control No. 90/010,313 :
For: U.S. Patent No. 6,081,786 :

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,081,786 (hereinafter, the '786 patent), issued to Barry *et alia*, on June 27, 2000.

2. On October 10, 2008, a request for *ex parte* reexamination of the '786 patent was filed. The reexamination proceeding was assigned Control Nos. 90/010,313 (hereinafter, the '10313 proceeding).

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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.
90/010,313	10/10/2008	6081786	1911-001	2580

20792 7590 06/22/2009

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JONATHAN LOEB
DAY CASEBEER MADRID & BATCHELDER
20300 STEVENS CREEK BLVD., SUITE 400
CUPERTINO, CA 95014

Date:
MAILED
JUN 22 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010313
PATENT NO. : 6081786
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)).

3. On October 14, 2008, a third party deposited a corrected request for *ex parte* reexamination of the '786 patent. The reexamination proceeding had been assigned Control No. 90/010,313 (hereinafter, the '10313 proceeding).

4. On November 29, 2008, the reexamination order granting the request in the '9204 proceeding was mailed.

5. On January 7, 2009, the reexamination order granting the request in the '10313 proceeding was mailed.

6. The time period for patent owner statements have expired in both proceedings. There are no amendments in the 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 the above-identified reexamination proceedings. Consideration of 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 '9204 and '10313 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 both proceedings, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009,204 and 90/010,313 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 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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Winstead PC (FCC-FKI)
Henry L. Ehrlich
P.O. Box 50784
Dallas, TX 75201

(For Patent Owner)

MAILED

FEB 27 2009

CENTRAL REEXAMINATION UNIT

Gary L. Busch
Andrews & Kurth, LLP
600 Travis, Suite 4200
Houston, TX 77002

(For 3rd Party Requester)

In re	: Vernon J. Bouligny
Reexamination Proceeding	
Control No.	: 90/009,207
Filed	: July 1, 2008
For U.S. Patent No.	: 6,309,002

DECISION ON PETITION

This is a decision on petitioner's request filed February 17, 2009 that seeks to reset the reply period to the Office action mailed January 16, 2009, due to late receipt by patent owner of the Office action in question. Patent owner asserts that the Office action mailed January 16, 2009 was not received at patent owner's correspondence address until February 12, 2009. There is no fee for this petition.

In order to grant a petition to restart/reset the previously set period for reply to an Office action from the date of receipt of the Office action at the correspondence address of record, the following criteria must be met: (1) the petition must be filed within two weeks of the date of receipt of the Office action at the correspondence address; (2) a substantial portion of the set reply period had elapsed on the date of receipt; and (3) the petition includes evidence showing the date of receipt of the Office action at the correspondence address, and a statement setting forth the date of receipt of the Office action at the correspondence address and explaining how the evidence being presented establishes the date of receipt of the Office action at the correspondence address.

The request filed February 17, 2009 includes all the above elements. The request is therefore GRANTED. The period of TWO (2) months to file a reply to the Office action mailed January 16, 2009 is hereby reset to begin February 12, 2009. Thus a response is due on or before April 12, 2009.

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

Andres Kashnikow

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.
90/009,207	07/01/2008	6309002	TES028RE	8837

75548 7590 04/15/2009

EXAMINER	

Winstead PC (FCC-FKI)
Henry L. Ehrlich
P.O. Box 50784
Dallas, TX 75201

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Gary L. Bush
ANDREWS & KURTH, LLP
600 Travis, Suite 4200
Houston, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,207*.

PATENT NO. *6309002*.

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
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In re Application of 6309002
Appl. No.: 90/009,207
Filed: July 01, 2008
For: Tubular Running Tool

RESPONSE TO PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed March 31, 2009, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), at which time the petition will be decided.

Petitioner requests that documents identified as:

Exhibit CA: Attorney Lester L. Hewitt, Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non- Infringement, March 2, 2009, Case No. 2:07cv15;
Exhibit CB: James R. Hall, Ex. 1 Pt. 1 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, Dec. 15, 2008, Case No. 2:07cv15;
Exhibit CC: Ex. 1 Pt. 8 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation, and, Alternatively, Non-infringement, Materials Considered by James R. Hall, Dec. 15, 2008, Case No. 2:07cv15;
Exhibit CD: James R. Hall, Ex. 10 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, Anticipation Chart for U.S. Patent No. 6,309,002, Feb. 6, 2009, Case No. 2:07cv15;
Exhibit CE: James R. Hall, Ex. 26 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, James R. Hall's Rebuttal Report to Fleckstein Supplemental Report on Validity of U.S. Patent No. 6,309,202, Jan. 30, 2009, Case No. 2:07cv15;
Exhibit CF: Ex. 30 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and,

Alternatively, Non-Infringement, Frank's Response to Tesco's "Statement of Undisputed Material Facts" , Case No. 2:07cv15;
Exhibit CG: James R. Hall, James R. Hall's Rebuttal Report to Fleckstein Report on Validity of U.S. Patent No. 6,309,002, Dec. 15, 2008, Case No. 2:07cv15;
Exhibit CH: Exhibit 5 to James R. Hall's Rebuttal Report to Fleckstein Report on Validity of U.S. Patent No. 6,309,002, Materials Considered by James R. Hall, Dec. 15, 2008, Case No. 2:07cv15;
Exhibit CI: James R. Hall, Ex. 31 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, Declaration of James R. Hall, Feb. 27, 2009, Case No. 2:07cv15;
Exhibit CJ: Attorney David P. Griffith, Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, Jan 20, 2009, Case No. 2:07cv15;
Exhibit CK: Attorney David P. Griffith, Tesco's Sealed Reply Regarding Anticipation/Obviousness Summary Judgment Motion, March 9, 2009, Case No. 2:07cv15;
Exhibit CL: Attorney L. Hewitt, Plaintiffs and Consolidated Defendants Frank's Sealed Sur-Reply to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, March 16, 2009, case No 2:07cv15;
Exhibit CM: Attorney David P. Griffith, Tesco's Sealed Summary Judgment Motion Based on Invalidity Under 35 U.S.C. § 112, Jan. 20, 2009, Case No. 2:07cv15;
Exhibit CN: Attorney Lester L. Hewitt, Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Motion for Summary Judgment Based on Invalidity Under 35 U.S.C. § 112, March 2, 2009, Case No. 2:07cv15;
Exhibit CO: Attorney David P. Griffith, Tesco's Sealed Reply Regarding Its Summary Judgment Motion Based on Invalidity Under 35 U.S.C. § 112, March 9, 2009, Case No. 2:07cv15;
Exhibit CP: Attorney Lester L. Hewitt, Plaintiffs and Consolidated Defendants Frank's Sealed Sur-Reply to Tesco's Sealed Motion for Summary Judgment Based on Invalidity Under 35 U.S.C. § 112, March 16, 2009, Case No. 2:07cv15; and
Information Disclosure Statement (IDS) Letter, filed March 31, 2009,

be expunged from the record.

Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information

which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,207	07/01/2008	6309002	TES028RE	8837

75548 7590 05/08/2009

Winstead PC (FCC-FKI)
Henry L. Ehrlich
P.O. Box 50784
Dallas, TX 75201

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/08/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ANDREWS & KURTH LLP
600 TRAVIS
SUITE 4200
HOUSTON, TX 77002

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009207
PATENT NO. : 6309002
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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MAY 08 2009

CENTRAL REEXAMINATION UNIT

In re Application of 6309002
Appl. No.: 90/009,207
Filed: July 01, 2008
For: Tubular Running Tool

RESPONSE TO PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed April 24, 2009, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), at which time the petition will be decided.

Petitioner requests that documents identified as:

Exhibit CA: Attorney David P. Griffith, Tesco's Sealed Motion for Summary Judgment Based on Inequitable Conduct (with Exhibits A-D, F-L, O-Q, T-U, and AA-KK), December 10, 2008, 421 pages, Case No. 2:07-CV-15; and

Information Disclosure Statement (IDS) Letter, filed April 24, 2009,

be expunged from the record.

Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,207	07/01/2008	6309002	TES028RE	8837

75548 7590 08/06/2009

Winstead PC (FCC-FKI)
Henry L. Ehrlich
P.O. Box 50784
Dallas, TX 75201

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/06/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ANDREWS & KURTH LLP
600 TRAVIS
SUITE 4200
HOUSTON, TX 77002

Date:
MAILED
AUG 06 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009207
PATENT NO. : 6309002
ART UNIT : 3993

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In re Application of 6309002
Appl. No.: 90/009,207
Filed: July 01, 2008
For: Tubular Running Tool

DECISION ON PETITION UNDER 37 CFR 1.59

MAILED

AUG 06 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the petition under 37 CFR 1.59(b), filed April 24, 2009, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents entitled:

Exhibit CA: Attorney David P. Griffith, Tesco's Sealed Motion for Summary Judgment Based on Inequitable Conduct (with Exhibits A-D, F-L, O-Q, T-U, and AA-KK), December 10, 2008, 421 pages, Case No. 2:07cv15; and

Information Disclosure Statement (IDS) Letter, filed April 24, 2009,

filed April 24, 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 application.

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

The expunged material has been removed from the official file.

Andres Kashnikow,
SPE, CRU 3993
(571) 272-4361

Enclosure: Exhibit CA and IDS Letter

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,207	07/01/2008	6309002	TES028RE	8837

75548 7590 08/06/2009

Winstead PC (FCC-FKI)
Henry L. Ehrlich
P.O. Box 50784
Dallas, TX 75201

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/06/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ANDREWS & KURTH LLP
600 TRAVIS
SUITE 4200
HOUSTON, TX 77002

Date:
MAILED
AUG 06 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009207
PATENT NO. : 6309002
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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In re Application of 6309002
Appl. No.: 90/009,207
Filed: July 01, 2008
For: Tubular Running Tool

DECISION ON PETITION UNDER 37 CFR 1.59

MAILED

AUG 06 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the petition under 37 CFR 1.59(b), filed March 31, 2009, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents entitled:

Exhibit CA: Attorney Lester L. Hewitt, Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, March 2, 2009, Case No. 2:07cv15;
Exhibit CB: James R. Hall, Ex.1 Pt. 1 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, Dec. 15, 2008, Case No. 2:07cv15;
Exhibit CC: Ex.1 Pt. 8 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation and, Alternatively, Non-Infringement, Materials Considered by James R. Hall, Dec. 15, 2008, Case No. 2:07cv15;
Exhibit CD: James R. Hall, Ex. 10 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, Anticipation Chart for U.S. Patent No. 6,309,002, Feb. 6, 2009, Case No. 2:07cv15;
Exhibit CE: James R. Hall, Ex. 26 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, James R. Hall's Rebuttal Report to Fleckstein Supplemental Report on Validity of U.S. Patent No. 6,309,002, Jan. 30, 2009, Case No. 2:07cv15;
Exhibit CF: Ex. 30 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and,

Alternatively, Non-Infringement, Frank's Response to Tesco's "Statement of Undisputed Material Facts", Case 2:07cv15;
Exhibit CG: James R. Hall, James R. Hall's Rebuttal to Report to Fleckstein Report's on Validity of U.S. Patent No. 6,309,002, Dec. 15, 2008, Case No. 2:07cv15;
Exhibit CH: Exhibit 5 to James R. Hall's Rebuttal Report to Fleckstein Report on Validity of U.S. Patent No. 6,309,002, Materials Considered by James R. Hall, Dec. 15, 2008, Case No. 2:07cv15;
Exhibit CI: James R. Hall, Ex. 31 to Plaintiffs and Consolidated Defendants Frank's Sealed Response to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, Declaration of James R. Hall, Feb. 27, 2009, Case No. 2:07cv15;
Exhibit CJ: Attorney David P. Griffith, Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, Jan. 20, 2009, Case No. 2:07cv15;
Exhibit CK: Attorney David P. Griffith, Tesco's Sealed Reply Regarding Anticipation/Obviousness Summary Judgment Motion, March 9, 2009, Case No. 2:07cv15;
Exhibit CL: Attorney Lester L. Hewitt, Plaintiffs and Consolidated Defendants Frank's Sealed Sur-Reply to Tesco's Sealed Summary Judgment Motion Based on Anticipation/Obviousness and, Alternatively, Non-Infringement, March 16, 2009, Case No. 2:07cv15;
Exhibit CM: Attorney David P. Griffith, Tesco's Sealed Summary Judgment Motion Based on Invalidity Under 35 U.S.C. § 112, Jan. 20, 2009, Case No. 2:07cv15;
Exhibit CN: Attorney Lester L. Hewitt, Plaintiffs and Consolidated Defendants Frank's Sealed Response To Tesco's Sealed Motion for Summary Judgment Based on Invalidity Under 35 U.S.C. § 112, March 2, 2009, Case 2:07cv15;
Exhibit CO: Attorney David P. Griffith, Tesco's Sealed Reply Regarding Its Summary Judgment Motion Based on Invalidity Under 35 U.S.C. § 112, March 9, 2009, Case No. 2:07cv15;
Exhibit CP: Attorney Lester L. Hewitt, Plaintiffs and Consolidated Defendants Frank's Sealed Sur-Reply to Tesco's Sealed Motion for Summary Judgment Based on Invalidity Under 35 U.S.C. § 112, March 16, 2009, Case No. 2:07cv15; and
Information Disclosure Statement (IDS) Letter,

filed March 31, 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 application.

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

The expunged material has been removed from the official file.

Andres Kashnikow,
SPE, CRU 3993
(571) 272-4361

Enclosure: Exhibits CA to CP identified above and IDS

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.
90/009,209	07/22/2008	6012771	97-1211	7680

24938 7590 01/15/2010

DAIMLERCHRYSLER INTELLECTUAL CAPITAL CORPORATION
CIMS 483-02-19
800 CHRYSLER DR EAST
AUBURN HILLS, MI 48326-2757

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/15/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JAY M. SCHLOFF
INTELLIPEX PLLC
30200 TELEGRAPH ROAD, SUITE 245
BINGHAM FARMS, MI 48025

Date: MAILED

JAN 15 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009209
PATENT NO. : 6012771
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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JAN 15 2010

CENTRAL REEXAMINATION UNIT

DAIMLERCHRYSLER INTELLECTUAL
CAPITAL CORPORATION
CIMS 483-02-19
800 CHRYSLER DR EAST
AUBURN HILLS MI 48326-2757

(For Patent Owner)

JAY M. SCHLOFF
INTELLIPEX PLLC
30200 TELEGRAPH ROAD SUITE 245
BINGHAM FARMS, MI 48025

(For Third Party Requester)

In re Shea
Ex Parte Reexamination Proceeding
Control No. 90/009,209
Filed: July 22, 2008
For: U.S. Patent No. 6,012,771

: **DECISION**
: **DISMISSING PETITION**
: **UNDER § 1.182**

This is a decision on the September 21, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION."

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

The petition is **dismissed as premature**.

BACKGROUND

- On June 30, 2008, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/009,209 ("the '9209 proceeding"), and given a filing date of July 22, 2008, the date of compliance with the filing date requirements.

- Prosecution progressed until, on March 23, 2009, a final Office action was issued by the Office.

- On May 26, 2009, and on June 23, 2009, patent owner filed requests for extension of time.

- On December 2, 2009, the Office mailed a decision granting the May 26, 2009 and June 23, 2009 requests for extension of time, setting a response date of July 23, 2009.

- On July 23, 2009, and on August 7, 2009, patent owner filed requests for extension of time.

- On August 21, 2009, patent owner filed a "Response after Final Rejection."

- On September 21, 2009, patent owner filed the instant petition entitled "PETITION UNDER 37 CFR 1.182," requesting continued prosecution of the reexamination, including entry and consideration of an attached declaration.

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. § 1.550(a) provides, in pertinent part:

> 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.

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 a final rejection in an *ex parte* reexamination proceeding.

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

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 not, according to the terms of the regulation, the appropriate mechanism for relief. 37 C.F.R. § 1.550(a) provides a vehicle for the entry of comments and amendment after a final rejection (in accordance with 37 C.F.R. § 1.116) submitted during the time period set for response.

In this instance, there is no indication in the record that the evidence submission filed September 21, 2009 has been denied entry after a final rejection. Accordingly, the present § 1.182 petition to request continued reexamination filed to seek entry of the September 21, 2009 submission filed after final rejection is premature, and is dismissed as such.

In addition, the relief requested in the petition under 37 C.F.R. § 1.182 would be moot, should relief be granted through the examiner's entry and consideration of the remarks filed under 37 C.F.R. § 1.550(a) and the supplemental declaration filed on September 21, 2009. Since the entry of the August 21, 2009, and September 21, 2009 submissions are currently in the process of being addressed through 37 C.F.R. § 1.550, 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. § 1.550 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, such a petition must be timely filed and should focus on how entry of the September 21, 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 September 21, 2009 submission would be needed do so.

It is also noted that the requests for extension of time filed on July 23, 2009 and August 7, 2009 have not been decided as of the date of this decision, thus it is not clear whether the proceeding is still pending or not. Note further that, according to 37 C.F.R. § 1.181(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."

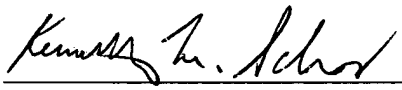
In view of the above, the petition is **dismissed** as premature.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.

- The Central Reexamination Unit will address the July 23, 2009 and August 7, 2009 requests for extension of time, the August 21, 2009 remarks, and the September 21, 2009 evidence submission 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

January 14, 2010
C:\Kiva\Kenpet7\RCR\

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,210	06/30/2008	7076806	45941-260856	6713

26158 7590 08/20/2009

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
ATTN: PATENT DOCKETING
P.O. BOX 7037
ATLANTA, GA 30357-0037

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/20/2009

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WOMBLE CARLYLE SANDRIDGE
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ATTN: PATENT DOCKETING
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(For Patent Owner)

MAILED
AUG 20 2009
CENTRAL REEXAMINATION UNIT

JAMES R. BURDETT
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P.O. BOX 34385
WASHINGTON, DC 20043-9998

(For Requester)

In re Van Winkle et al.
Reexamination Proceeding
Control No.: 90/009,210
Filed: June 30, 2008
For: U.S. Patent No.: 7,076,806

DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on July 15, 2009. The petition is entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" [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 May 6, 2009 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 July 15, 2009 is granted with respect to withdrawal the finality of the May 6, 2009 Office action.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,076,806 (hereinafter, the '806 patent) issued on July 18, 2006.

2. A request for *ex parte* reexamination, assigned control No. 90/009,210 (hereinafter, the '210 proceeding), was filed by a third party requester on June 30, 2008.

3. *Ex parte* reexamination was ordered for the '210 proceeding on July 19, 2008.

4. The patent owner did not file any comments in response to the order.

5. On February 11, 2009, a non-final Office action, which rejected claims 1-13 was mailed in the '210 reexamination proceeding.

6. On March 31, 2009, a personal interview was held.

7. On April 10, 2009, the patent owner filed a response, including amendments to both independent claims 1 and 9 and dependent claim 2, added proposed new claims 14-30 and filed a declaration challenging the enablement of the Widder reference.

8. On May 6, 2009, the Office issued a Final rejection Office action, which addressed the patent owner's response of April 10, 2009. The Office action rejected claims 1-30. The Office action maintained the rejections under 35 U.S.C. 102 based on the Widder reference and under 35 U.S.C. 103 over the Widder reference in view of Graves. The Office action also included a new rejection under 35 U.S.C. 103 over the Widder reference for some of the proposed new claims. Finally, the Office action included a new rejection under 35 U.S.C. 103(a) based on admitted prior art in view of Widder for claims 1-4, 9, 10, and 14-30.

9. On June 19, 2009, patent owner filed a response to the final rejection, which included remarks and a request to withdraw the finality of the May 6, 2009 Office action.

10. On June 25, 2009, an advisory action was mailed. The advisory action stated the June 19, 2009 was considered but the response does not place the proceeding in condition for allowance. The advisory action denied the request to withdraw the finality of the May 6, 2009 Office action and explained why the examiner issued the new grounds of rejection.

11. On July 15, 2009, the patent owner filed the petition requesting withdrawal of the finality of the May 6, 2009 Office action.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding to make the May 6, 2009 final for the following reasons:

(1) The final rejection of claims 3, 4, and 10 as unpatentable under 35 U.S.C. 103(a) over a description of prior art body armor contained within the specification of the '806 patent (APA) in view of U.S. Patent No. 5,072,453 to *Widder* is improper under MPEP §706.07(a).

(2) The final rejection of claims 1-2, 9, and 14-30 as unpatentable under 35 U.S.C. § 103 (a) over *APA* in view of *Widder* as a new ground of rejection that was not necessitated by claim amendments as required is improper under MPEP § 706.07(a).

(3) The Examiner has not made a thorough and complete examination of the claims.

See page 1 of the petition.

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 withdraw the finality of the May 6, 2009 Office action was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the withdrawal request.

In response to patent owner's arguments that the examiner erred in deciding in deciding to make the May 6, 2009 final, the director finds there is a good and sufficient reason to withdraw the finality of the May 6, 2009 Office action. The director finds that the amendment to claims 1, 2, and 9 did not necessitate the new ground of rejection based on Admitted Prior Art (APA) in view of Widder for the reasons discussed below.

Turning to the facts in this proceeding, the patent owner amended claims 1, 2, and 9 to include limitations that essentially require that the axillary panel is "removably" attached to the vest. See the amendment dated April 10, 2009 and page 4 of the petition. Claims 1 and 9 are the only independent claims. Therefore, amending claims 1 and 9 has the effect of amending all the claims because dependent claims incorporate all the limitations of the independent claims. The Final rejection of May 6, 2009 withdrew two rejections based on Tamura and the rejection based on Lewis in view of Widder; maintained the rejection under anticipation based on Widder and the rejection under obviousness based on Widder in view of Graves; extended the maintained anticipation rejection based on Widder to some of the new proposed claims; and set forth a new ground of rejection of claims 1-2, 9, and 14-30 as unpatentable under 35 U.S.C. 103(a) over *APA* in view of Widder and a new ground of rejection of proposed new claims 17, 21, 26, and 30 under 35 U.S.C. 103(a) over Widder alone.

It is clear that the amendment did necessitate the withdrawal of the rejections based on the Tamura reference because patent owner argued that Tamura does not teach that the axillary panel is "removably" attached to the vest. See, e.g., pages 8 and 13-14 of the April 10, 2009 response. However, the director agrees with the patent owner that the amendment to claims 1, 2, and 9 did

not necessitate the new ground of rejection of claims 1-2, 9, and 14-30 as unpatentable under 35 U.S.C. 103(a) over *APA* in view of Widder. See pages 3-5 of the petition. As pointed out by the patent owner, the APA was not applied for teaching the new limitations added by the amendment of April 10, 2009. Instead, Widder was applied as a secondary reference for teaching the amended claim limitations. Furthermore, the anticipation based on Widder was maintained even in light of the amendment to claims 1, 2, and 9. In addition, the advisory action of June 25, 2009 states that the examiner was not clear how the amendments were intended to distinguish the claimed invention from Widder, and also suggests that the new ground of rejection was made in response to the patent owner's challenge of the enablement of the Widder reference via the Cox declaration, filed under 37 CFR 1.132. Therefore, the record does not clearly shows that the amendment necessitated the new ground of rejection of claims 1-2, 9, and 14-30 as unpatentable under 35 U.S.C. 103(a) over *APA* in view of Widder.

Accordingly, a good and sufficient reason to reopen prosecution in the reexamination proceeding have been provided and the patent owner's petition is granted. Because it is agreed that there is one reason for withdrawal of the finality of the May 6, 2009 Office action, none of the other issues presented in the petition are addressed in this decision. It is not necessary to do so after it is determined that at least one good and sufficient reason has been raised by the petition to withdraw the finality of the May 6, 2009 Office action.

CONCLUSION

1. The petition under 37 CFR 1.181 for withdrawal of the finality of the May 6, 2009 action is **granted**.

2. The **finality** of the Office action mailed May 6, 2009 is **withdrawn**. Accordingly, the Office action mailed May 6, 2009 is designated as a **nonfinal** Office action. The patent owner's response of June 19, 2009, as indicated by the advisory action, is entered into the record.

3. Patent owner is given ONE month or thirty days, whichever is longer, from the mailing date of this decision to file any supplement response to the May 6, 2009 Office action. Any supplemental response filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,213	10/14/2008	6188988	SMA002	1603

20792 7590 03/19/2009

MYERS BIGEL SIBLEY & SAJOVEC
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RALEIGH, NC 27627

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/19/2009

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Goodman, Allen, & Filetti PLLC
4501 Highwoods Parkway, Suite 210
Glen Allen VA 23060

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MAR 19 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,213*.

PATENT NO. *6188988*.

ART UNIT *3992*.

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

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

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(For Patent Owner)

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(For *Ex Parte* Requester)

MAILED

MAR 19 2009

CENTRAL REEXAMINATION UNIT

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CUPERTINO, CA 95014

(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,213
Filed: October 14, 2008
For: U.S. Patent No. 6,188,988

Inter Partes Reexamination Proceeding
Control No. 95/001,088
Filed: October 10, 2008
For: U.S. Patent No. 6,188,988

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,188,988 (the '988 patent) issued to Barry *et al.* on February 13, 2001.

2. An incomplete request for *ex parte* reexamination of claims 1-66 of the '988 patent was deposited on June 26, 2008, by third party requester Smartgene, Inc., and the request was assigned control number 90/009,213 (the '9213 *ex parte* proceeding).

3. A request for *inter partes* reexamination of claims 1-66 of the '988 patent was filed on October 10, 2008, by third party requester Robert W. Shafer, the real party in interest, and the request was assigned control number 95/001,088 (the '1088 *inter partes* proceeding).

4. A corrected *ex parte* reexamination request of claims 1-66 of the '988 patent was subsequently filed, and the *ex parte* reexamination request was assigned a filing date of October 14, 2008.

5. On November 29, 2008, *ex parte* reexamination was ordered for claims 1-66 of the '988 patent based on the examiner's determination that the October 14, 2007 request raised a substantial new question of patentability affecting these claims.

6. On January 7, 2009, *inter partes* reexamination was ordered for claims 1-66 of the '988 patent based on the examiner's determination that the October 10, 2008 request raised a substantial new question of patentability affecting these claims.

7. There has been no further Office action in either the '1088 *inter partes* proceeding or the '9213 *ex parte* proceeding. The time period for filing a patent owner's statement in the '9213 *ex parte* proceeding has expired.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '1088 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. The order to reexamine has been mailed for both reexamination proceedings, and the time for filing a patent owner's statement has expired in the *ex parte* proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is

ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

In accordance with 37 CFR 1.989(a), the 90/009,213 and 95/001,088 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

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. The examiner will conduct reexamination in the merged proceeding for claims 1-66 of the '988 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. 95/001,088 and *ex parte* Reexamination Control No. 90/009,213 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.

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.
90/009,213	10/14/2008	6188988	SMA002	1603

20792 7590 06/22/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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MOUNTAIN VIEW, CA 94039-0460

Date: MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009213
PATENT NO. : 6188988
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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MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

In re Barry *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,088
Filed: October 10, 2008
For: U.S. Patent No.: 6,188,988

In re Barry *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,213
Filed: October 14, 2008
For: U.S. Patent No.: 6,188,988

: DECISION
: DISMISSING
: PETITION

This is a decision on the April 12, 2010 patent owner petition, denominated "PETITION UNDER 37 C.F.R. § 1.183 – REQUEST FOR A WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING A RESPONDENT BRIEF UNDER 37 C.F.R. § 41.66(b) AND A REQUEST FOR AN EXTENSION OF TIME FOR FILING A RESPONDENT BRIEF.

The petition is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is dismissed as moot.

DECISION

37 CFR 1.183 states:

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

37 CFR 41.66(b) states:

> (b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

On April 12, 2010 patent owner filed the present petition, patent owner requests that the Office suspend the one month time period of 37 CFR 41.66(b) for filing a respondent brief until two other concurrently filed patent owner petitions are decided. However, on May 3, 2010, patent owner timely filed a respondent brief, thus rendering the April 12, 2010 petition for an extension of time to file a respondent brief moot. Accordingly, the present petition is DISMISSED AS MOOT.

CONCLUSION

1. The petition under 37 CFR 1.183 is **dismissed as moot**.

2. The reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination consistent with this decision.

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

6-21-10
Kenreexam/EOT

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(For Patent Owner)

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FEB 27 2009

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(90/009,216)

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(For 3rd Party Requester)
(90/009,356)

Reexam Control No.: 90/009,216
Filed : July 10, 2008
For U.S. Patent No. : 5,735,844

Reexam Control No.: 90/009,356
Filed : December 8, 2008
For U.S. Patent No. : 5,735,844

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. 90/009,216 was ordered in a decision mailed August 29, 2008 indicating that claims 11, 12, 14, 17, 18, 27, and 32 would be reexamined be reexamined. On January 22, 2009, a preliminary amendment was filed adding claims 33-59 to the proceedings. In addition on January 22, 2009, an Information Disclosure Statements was filed. No Office action has been issued in this proceeding.

Reexamination in application control No. 90/009,356 was ordered in a decision mailed January 7, 2009, indicating that claims 1-3, 6-8, 12-14, 17, 19, 20, 27, 28, 30, and 32 would be reexamined. On January 26, 2009 patent owner filed a waiver, waiving the rights to file a patent owner statement under 37 CFR 1.530. On February 20, 2009, a preliminary amendment was filed adding claims 33-59 (identical to those in reexamination proceeding 90/009,217) to the instant proceeding. In addition, an Information Disclosure Statement was filed February 20, 2009. No Office action has been issued in this proceeding.

As evidenced by the above facts, reexamination control No. 90/009,216 and reexamination control No. 90/009,356 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 1-3, 6-8, 10-14, 17-20, 27, 28, 30, 32, and 33-59 will be reexamined in this merged proceeding. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and each requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,216 and 90/009,356 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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FEB 27 2009

CENTRAL REEXAMINATION UNIT

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(90/009,217)

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(90/009,355)

Reexam Control No.: 90/009,217
Filed : July 10, 2008
For U.S. Patent No. : 5,595,568

Reexam Control No.: 90/009,355
Filed : December 8, 2008
For U.S. Patent No. : 5,595,568

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. 90/009,217 was ordered in a decision mailed August 29, 2008 indicating that claims 1-10, 13, 14, 18, and 19 would be reexamined. On January 21, 2009, a preliminary amendment was filed adding claims 23 and 24 to the proceedings. In addition on January 21, 2009 and February 17, 2009, Information Disclosure Statements were filed. On February 17, 2009 a document titled "Submission of Court Documents in Related Litigation" was filed. No Office action has been issued in this proceeding.

Reexamination in application control No. 90/009,355 was ordered in a decision mailed January 7, 2009, indicating that claims 1, 3-10, 13, 14, and 18-21 would be reexamined. On January 26, 2009 patent owner filed a waiver, waiving the rights to file a patent owner statement under 37 CFR 1.530. On February 20, 2009, a preliminary amendment was filed adding claims 23 and 24 (identical to those in reexamination proceeding 90/009,217) to the instant proceeding. In addition, an Information Disclosure Statement was filed February 20, 2009. No Office action has been issued in this proceeding.

As evidenced by the above facts, reexamination control No. 90/009,217 and reexamination control No. 90/009,355 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 1-10, 13, 14, 18-21, 23, and 24 will be reexamined in this merged proceeding. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and each requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,217 and 90/009,355 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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MAY 12 2009

CENTRAL REEXAMINATION UNIT

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(For 3rd Party Requester)

Reexam Control No.: 90/009,221
Filed : August 1, 2008
For U.S. Patent No. : 7,210,573

Reexam Control No.: 90/011,997
Filed : September 2, 2008
For U.S. Patent No. : 7,210,573

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. 90/009,221 was ordered in a decision mailed September 4, 2008 indicating that claims 1-5, all of the claims would be reexamined. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued. Thus, there have been no changes made to the specification, claims, or drawings.

Reexamination in application control No. 90/011,997 was ordered in a decision mailed October 24, 2008 indicating that claims 1-3, and 5 would be reexamined. This proceeding was a patent owner filed proceeding that included a preliminary amendment amending claim 1. No patent owner's statement has been filed in this proceeding, nor has an Office action been issued.

As evidenced by the above facts, reexamination control No. 90/009,221 and reexamination control No. 90/011,997 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claim 1 has been amended in the '997 reexamination proceeding by virtue of the preliminary amendment filed April 1, 2008. No amendments have been filed in the '221 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-5, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,221 and 90/011,997 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,231	07/31/2008	7,191,915	CRAN01-00299	8969

42624 7590 01/02/2009

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/02/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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DALLAS,TX 75380

Date: MAILED

JAN 02 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009231
PATENT NO. : 7191915
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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JAN 02 2009

CENTRAL REEXAMINATION UNIT

Docket Clerk
PO Drawer 800889
Dallas, Texas 75380

(For Third Party Requester)

In re Hair III et al.
Ex Parte Reexamination Proceeding
Control No.: 90/009,231
Filed: July 31, 2008
For: U.S. Patent No. 7,191,915 C1

: DECISION
: DENYING
: PETITION

This is a decision on the third party requester petition entitled "PETITION UNDER 37 C.F.R. §§ 1.181 and 1.515(c)," filed on October 20, 2008, in which requester seeks reconsideration of the Order Denying Ex Parte Reexamination mailed September 19, 2008. The petition is 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. 7,191,915 (hereinafter, the '915 patent) issued on March 20, 2007.

2. A request for *ex parte* reexamination was filed by a third party requestor, on July 31, 2008. The resulting reexamination proceeding was assigned Control No. 90/009,231 (hereinafter, the '9231 proceeding).

3. Reexamination was requested for claims 1-46 of the '915 patent.

4. A Notice of Reexamination Request Filing Date was issued on August 5, 2008.

5. An order denying the request for reexamination for claims 1-46 was mailed on September 19, 2008.

6. On October 20, 2008, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.515(c).

7. On October 31, 2008, the third party requester filed a request for refund for the $400 petition fee charged to Deposit Account No. 50-0208.

DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '9231 reexamination proceeding has petitioned seeking relief from the examiner's September 19, 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."

35 USC § 303(c) and 37 CFR 1.515(c) provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. 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 July 31, 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 '915 patent filed in the '9231 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 U.S. Pat. No. 6,330,958 to Rushkin (hereinafter "the Rushkin '958 patent") – the reference relied upon as providing the new teaching to establish the SNQ – does not qualify as prior art to the '915 patent for which reexamination was requested.

Specifically, the examiner determined that the '915 patent had an effective filing date of, at least, March 3, 1999, and Rushkin was only entitled to a prior art date of October 8, 1999, its actual U.S. filing date and was not 102(e) prior art based on any internationally filed application. Since Rushkin's prior art date as determined by the examiner is not prior to the effective filing date of the '915 patent, the examiner found that Rushkin was not prior art to the '915 patent, and therefore, does not raise an SNQ. The examiner also stated that the references cited in the request were considered both alone and in combination, and that the references fail to raise an SNQ to any one of the claims of the '915 patent. See paragraph 7 of the Order dated September 19, 2008.

III. Petitioner's Argument that the Request for Reexamination Did Raise an SNQ

Petitioner takes the position that the request in the '9231 reexamination request must be deemed to raise a substantial "new" question of patentability, because, under the current form of 35 USC 102(e), the proper prior art date for the Rushkin '958 patent is earlier than the April 29, 1998 priority date of the '915 patent.

In support of this position, petitioner states that the Rushkin '958 patent (filed October 8, 1999) is a continuation-in-part of international application PCT/US98/08064 [hereinafter "PCT '064"], filed on April 15, 1998, and PCT '064 is a continuation-in-part of U.S. Patent Application No. 08/844,767 [hereinafter "the '767 application"], which was filed on April 22, 1997.[1]

Petitioner presents two arguments in support of his position:

(1) Relying on the text of the amendments to 35 USC 102(e) enacted with an effective date of November 29, 2000, the petition argues that the subject matter of Rushkin supported by PCT '064 receives the benefit of the earlier filing date of April 15, 1998, and the subject matter of

[1] Petitioner does not raise the question of whether Rushkin is entitled to the October 13, 1998 priority date of provisional application 60/104,006 from which it claims priority. Presumably, such priority would not avail requester, since the '915 patent is given benefit back to April 29, 1998.

Rushkin support by both PCT '064 and the '767 application receives the benefit of the earlier filing date of April 22, 1997; and
(2) Articles 11(3) and 64(4)(a) of the Patent Cooperation treaty require the granting of such benefit under 35 USC 102(e). (See petition pages 3-6).

Thus, in light of the assertion that the Ruskin '958 patent qualifies as prior art under 35 USC 102(e), the petitioner requests reconsideration of the order denying reexamination.

IV. Analysis of Petitioner's Arguments

(1) Petitioner's first argument is fatally flawed in that it ignores the effective date provision of the AIPA for the amendments to 35 USC 102(e). This fact alone is dispositive. Therefore, petitioner's detailed parsing of the statutory language as amended by the AIPA will not be addressed.

The effective date provision, reproduced below, clearly states that for a patent resulting from an international application filed before November 29, 2000 the prior art date is based on the version of 35 USC 102(e) in effect on November 28, 2000. As the Rushkin '958 patent was filed on October 8, 1999, the prior art effect of the Rushkin '958 patent is governed by the version of 35 U.S.C. 102(e) in effect on November 28, 2000, and as a result, its prior art date cannot be any international filing date but is instead the U.S. filing date of the later filed 35 U.S.C. 111(a) application or, possibly, the provisional filing date under 35 U.S.C. 111(b).[2, 3] Accordingly, the prior art date of the Rushkin '958 patent is no earlier than October 13, 1998, the filing date of Rushkin's provisional application.[4]

The '915 patent has an effective priority date of April 29, 1998 based on the filing date of a provisional application under 35 U.S.C. 111(b). Requester has not raised (per MPEP 2617) any question as to the patent's entitlement to that priority.

Because the '915 priority date is before Rushkin's 102(e) prior art date, the Rushkin '958 patent is not available as prior art relative to the '915 patent for which reexamination is requested. Therefore, the teachings of the Rushkin '958 patent would not be important to a reasonable examiner in deciding whether or not the claims of the '915 patent are patentable.

35 U.S.C. § 102(e) currently provides:

---

[2] Particularly instructive and relevant to the instant situation is example 9 in MPEP 706.02(f)(1) See the text below the timeline in Example 9 in MPEP 706.02(f)(1) that states: "If the IA properly claimed the benefit of any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e)(1) date for the IA publication by WIPO, and the U.S. application publication and patent would still have a 35 U.S.C. 102(e) date of the actual filing date of later-filed 35 U.S.C. 111(a) application in the example above (01 Dec 2000)."

[3] It is further noted that the '767 application was abandoned on October 14, 1998, which was prior to the filing date of Rushkin's 35 U.S.C. 111(a) application, which issued as the '958 patent. Therefore, there was no co-pendency between the Rushkin '958 patent and the '767 application

[4] This decision takes no position as to whether the '958 patent is actually entitled to the earlier provisional filing date, and is thus prior art as of that date.

A person shall be entitled to a patent unless —

...

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

...

(Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505); Subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903.)

"Sec. 4508. Effective Date" of the AIPA provides in relevant part:

Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.

35 U.S.C. § 102(e) in effect on November 28, 2000 provided:

A person shall be entitled to a patent unless —

...

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, or on an international application by another who has fulfilled the requirements f paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent,

(2) Petitioner's second argument that Articles 11(3) and 64(4)(a) of the Patent Cooperation Treaty (PCT) require the granting of such benefit under 35 USC 102(e) will not be explicitly addressed in this decision. Petitioner's argument is solely based on the language of the PCT, and does not adequately address U.S. law, *e.g.*, as set by the applicable U.S. statutes (see subsection IV(1) above). The PCT is not a self-executing treaty and is only put in effect by the enactment of U.S. law (*e.g.*, statutes and regulations). Therefore, petitioner's second argument is not convincing.

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

A *de novo* review of the request for reexamination in the '9231 *ex parte* reexamination, as it was filed on July 31, 2008, shows that the request for reexamination was based upon an assertion by third party requester that the Rushkin '958 patent qualifies as a prior art reference based upon 35 USC 102(e). Review of the record resulted in a determination that the examiner properly found

the Rushkin '958 patent not to qualify as prior art to the '915 patent by applying the version of 35 USC 102(e) that was in effect prior to the enactment of the AIPA.

The *de novo* review on the record of the request for reexamination in the '9231 reexamination proceeding, undertaken in light of the arguments presented in the present petition compels the conclusion that the request for reexamination in the '9231 reexamination proceeding does not raise a new SNQ with respect to the claims of the '915 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.

CONCLUSION

1. The third party requester petition seeking review of the examiner's decision is **denied**, as to the underlying relief requested. Based on a *de novo* review on the record of the request for re-examination, the Rushkin '958 patent is not available as prior art relative to the '915 patent for which reexamination is requested, and therefore, the teachings of the Rushkin '958 patent would not be important to a reasonable examiner in deciding whether or not the claims of the '915 patent are patentable. Accordingly, a SNQ is not found to have been raised by the request for reexamination.

2. The request for refund of the petition fees, filed on October 31, 2008, will be acted upon in due course.

3. A partial refund of the filing fee for the request for reexamination will be made to the third party requester in due course. See 35 U.S.C. 312(c) and 37 CFR 1.26(c).

4. 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.

5. Telephone inquiries related to the present decision may be directed to Jeanne Clark at (571) 272-7714, Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

Pet7/Deny reexam
12-30-08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,234	07/31/2008	7343220	CRAN01-00300	2325

42624 7590 01/06/2009

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4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2009

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

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DALLAS, TX 75380

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009234
PATENT NO. : 7343220
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Davidson Berquist Jackson & Gowdey, LLP (For Patent Owner)
4300 Wilson Boulevard
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Arlington, Virginia 22203

Docket Clerk (For Third Party Requester)
PO Drawer 800889
Dallas, Texas 75380

In re Hair III et al.
Ex Parte Reexamination Proceeding : DECISION
Control No.: 90/009,234 : DENYING
Filed: July 31, 2008 : PETITION
For: U.S. Patent No. 7,343,220 B2 :

This is a decision on the third party requester petition entitled "PETITION UNDER 37 C.F.R. §§ 1.181 and 1.515(c)," filed on October 20, 2008, in which requester seeks reconsideration of the Order Denying Ex Parte Reexamination mailed September 19, 2008. The petition is 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. 7,343,220 (hereinafter, the '220 patent) issued on March 11, 2008.

2. A request for *ex parte* reexamination was filed by a third party requestor, on July 31, 2008. The resulting reexamination proceeding was assigned Control No. 90/009,234 (hereinafter, the '9234 proceeding).

3. Reexamination was requested for claims 1-37 of the '220 patent.

4. A Notice of Reexamination Request Filing Date was issued on August 5, 2008.

5. An order denying the request for reexamination for claims 1-37 was mailed on September 19, 2008.

6. On October 20, 2008, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.515(c).

7. On October 31, 2008, the third party requester filed a request for refund for the $400 petition fee charged to Deposit Account No. 50-0208.

8. On November 20, 2008, the request for the refund was denied by the Office.

9. On December 19, 2008, the third party requested filed a second request for refund for the $400 petition fee charged to Deposit Account No. 50-0208.

DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '9234 reexamination proceeding has petitioned seeking relief from the examiner's September 19, 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."

35 USC § 303(c) and 37 CFR 1.515(c) provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo.* 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 July 31, 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 '220 patent filed in the '9234 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 U.S. Pat. No. 6,330,958 to Rushkin (hereinafter "the Rushkin '958 patent") – the reference relied upon as providing the new teaching to establish the SNQ – does not qualify as prior art to the '220 patent for which reexamination was requested.

Specifically, the examiner determined that the '220 patent had an effective filing date of, at least, March 3, 1999, and Rushkin was only entitled to a prior art date of October 8, 1999, its actual U.S. filing date and was not 102(e) prior art based on any internationally filed application. Since Rushkin's prior art date as determined by the examiner is not prior to the effective filing date of the '220 patent, the examiner found that Rushkin was not prior art to the '220 patent, and therefore, does not raise an SNQ. The examiner also stated that the references cited in the request were considered both alone and in combination, and that the references fail to raise an SNQ to any one of the claims of the '220 patent. See paragraph 7 of the Order dated September 19, 2008.

III. Petitioner's Argument that the Request for Reexamination Did Raise an SNQ

Petitioner takes the position that the request in the '9234 reexamination request must be deemed to raise a substantial "new" question of patentability, because, under the current form of 35 USC 102(e), the proper prior art date for the Rushkin '958 patent is earlier than the April 29, 1998 priority date of the '220 patent.

In support of this position, petitioner states that the Rushkin '958 patent (filed October 8, 1999) is a continuation-in-part of international application PCT/US98/08064 [hereinafter "PCT '064"], filed on April 15, 1998, and PCT '064 is a continuation-in-part of U.S. Patent Application No. 08/844,767 [hereinafter "the '767 application"], which was filed on April 22, 1997.[1]

[1] Petitioner does not raise the question of whether Rushkin is entitled to the October 13, 1998 priority date of provisional application 60/104,006 from which it claims priority. Presumably, such priority would not avail requester, since the '220 patent is given benefit back to April 29, 1998.

Petitioner presents two arguments in support of his position:

(1) Relying on the text of the amendments to 35 USC 102(e) enacted with an effective date of November 29, 2000, the petition argues that the subject matter of Rushkin supported by PCT '064 receives the benefit of the earlier filing date of April 15, 1998, and the subject matter of Rushkin support by both PCT '064 and the '767 application receives the benefit of the earlier filing date of April 22, 1997; and
(2) Articles 11(3) and 64(4)(a) of the Patent Cooperation treaty require the granting of such benefit under 35 USC 102(e). (See petition pages 3-6).

Thus, in light of the assertion that the Ruskin '958 patent qualifies as prior art under 35 USC 102(e), the petitioner requests reconsideration of the order denying reexamination.

IV. Analysis of Petitioner's Arguments

(1) Petitioner's first argument is fatally flawed in that it ignores the effective date provision of the AIPA for the amendments to 35 USC 102(e). This fact alone is dispositive. Therefore, petitioner's detailed parsing of the statutory language as amended by the AIPA will not be addressed.

The effective date provision, reproduced below, clearly states that for a patent resulting from an international application filed before November 29, 2000 the prior art date is based on the version of 35 USC 102(e) in effect on November 28, 2000. As the Rushkin '958 patent was filed on October 8, 1999, the prior art effect of the Rushkin '958 patent is governed by the version of 35 U.S.C. 102(e) in effect on November 28, 2000, and as a result, its prior art date cannot be any international filing date but is instead the U.S. filing date of the later filed 35 U.S.C. 111(a) application or, possibly, the provisional filing date under 35 U.S.C. 111(b).[2, 3] Accordingly, the prior art date of the Rushkin '958 patent is no earlier than October 13, 1998, the filing date of Rushkin's provisional application.[4]

The '220 patent has an effective priority date of April 29, 1998 based on the filing date of a provisional application under 35 U.S.C. 111(b). Requester has not raised (per MPEP 2617) any question as to the patent's entitlement to that priority.

Because the '220 priority date is before Rushkin's 102(e) prior art date, the Rushkin '958 patent is not available as prior art relative to the '220 patent for which reexamination is requested.

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[2] Particularly instructive and relevant to the instant situation is example 9 in MPEP 706.02(f)(1) See the text below the timeline in Example 9 in MPEP 706.02(f)(1) that states: "If the IA properly claimed the benefit of any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e)(1) date for the IA publication by WIPO, and the U.S. application publication and patent would still have a 35 U.S.C. 102(e) date of the actual filing date of later-filed 35 U.S.C. 111(a) application in the example above (01 Dec 2000)."

[3] It is further noted that the '767 application was abandoned on October 14, 1998, which was prior to the filing date of Rushkin's 35 U.S.C. 111(a) application, which issued as the '958 patent. Therefore, there was no co-pendency between the Rushkin '958 patent and the '767 application

[4] This decision takes no position as to whether the '958 patent is actually entitled to the earlier provisional filing date, and is thus prior art as of that date.

Therefore, the teachings of the Rushkin '958 patent would not be important to a reasonable examiner in deciding whether or not the claims of the '220 patent are patentable.

35 U.S.C. § 102(e) currently provides:

> A person shall be entitled to a patent unless —
> ...
> (e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;
> ...
> (Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505); Subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903.)

"Sec. 4508. Effective Date" of the AIPA provides in relevant part:

> Patents resulting from an international application filed before November 29, 2000 and applications published pursuant to section 122(b) or Article 21(2) of the treaty defined in section 351(a) resulting from an international application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application; however, such patents shall be effective as prior art in accordance with section 102(e) in effect on November 28, 2000.

35 U.S.C. § 102(e) in effect on November 28, 2000 provided:

> A person shall be entitled to a patent unless —
> ...
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, or on an international application by another who has fulfilled the requirements f paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent,

(2) Petitioner's second argument that Articles 11(3) and 64(4)(a) of the Patent Cooperation Treaty (PCT) require the granting of such benefit under 35 USC 102(e) will not be explicitly addressed in this decision. Petitioner's argument is solely based on the language of the PCT, and does not adequately address U.S. law, *e.g.*, as set by the applicable U.S. statutes (see subsection IV(1) above). The PCT is not a self-executing treaty and is only put in effect by the enactment of U.S. law (*e.g.*, statutes and regulations). Therefore, petitioner's second argument is not convincing.

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

A *de novo* review of the request for reexamination in the '9234 *ex parte* reexamination, as it was filed on July 31, 2008, shows that the request for reexamination was based upon an assertion by third party requester that the Rushkin '958 patent qualifies as a prior art reference based upon 35 USC 102(e). Review of the record resulted in a determination that the examiner properly found the Rushkin '958 patent not to qualify as prior art to the '220 patent by applying the version of 35 USC 102(e) that was in effect prior to the enactment of the AIPA.

The *de novo* review on the record of the request for reexamination in the '9234 reexamination proceeding, undertaken in light of the arguments presented in the present petition compels the conclusion that the request for reexamination in the '9234 reexamination proceeding does not raise a new SNQ with respect to the claims of the '220 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.

CONCLUSION

1. The third party requester petition seeking review of the examiner's decision is **denied**, as to the underlying relief requested. Based on a *de novo* review on the record of the request for re-examination, the Rushkin '958 patent is not available as prior art relative to the '220 patent for which reexamination is requested, and therefore, the teachings of the Rushkin '958 patent would not be important to a reasonable examiner in deciding whether or not the claims of the '220 patent are patentable. Accordingly, a SNQ is not found to have been raised by the request for reexamination.

2. The second request for refund of the petition fees, filed on December 19, 2008, will be acted upon in due course.

3. A partial refund of the filing fee for the request for reexamination will be made to the third party requester in due course. See 35 U.S.C. 312(c) and 37 CFR 1.26(c).

4. 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.

5. Telephone inquiries related to the present decision may be directed to Jeanne Clark at (571) 272-7714, Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04/05/10

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction for Appl. No.: 90009248 Patent No.: 6775577

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**.

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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:

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Randolph Square 9D40-D
Palm Location 7580

You can fax the Directors/SPE response to 571-270-9990

Lamonte Newsome
Certificates of Correction Branch
703-756-1574

Thank You For Your Assistance

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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: _____

_____

_____

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_____

MARK J. REINHART
CRU SPE-AU 3992
SPE

3992
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

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King & Spalding LLP
P.O. Box 889
Belmont, CA 94002-0889

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MAR 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,249*.

PATENT NO. *6881571*.

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.
90/009,249	09/09/2008	6881571	50146/004002	3457

21559 7590 03/18/2009

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2009

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

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Clark & Elbing LLP
101 Federal Street
Boston, MA 02110

(for Patent Owner)

King & Spalding LLP
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Belmont, CA 94002-0889

(for Third Party Requester)

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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.
90/009,253	08/15/2008	6248390	SJS-0011	4729

23377 7590 04/21/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE / NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

Date:
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APR 2 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009253
PATENT NO. : 6248390
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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David N. Farsiou
Woodcock Washburn LLP
CIRA CENTRE, 12the Floor
2929 Arch Street
Philadelphia, PA 19104-2891

For Patent Owner

MAILED

APR 2 1 2010

CENTRAL REEXAMINATION UNIT

WilmerHale/New York
399 Park Avenue
New York, NY 10022

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,253
Filed: August 15, 2008
For: U.S. Patent No. 6,248,390

: DECISION DISMISSING
: PETITION UNDER 37 CFR 1.181
: REQUESTING WITHDRAWAL
: OF FINALITY OF ACTION

This is a decision on the January 25, 2010, "Petition Under 37 C.F.R. § 1.181 To Withdraw Finality" requesting that the finality of the Office action mailed December 1, 2009, be withdrawn.

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 19, 2001, U.S. Patent No. 6,248,390 (the '390 patent) issued to Suzanne Stillman.

2. On August 15, 2008, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,253. The request asked for the reexamination of claims 1-45, all of the patent claims.

3. On October 24, 2008, an Order was mailed granting reexamination for claims 1-45 of the '390 patent in control No. 90/009,253.

4. The patent owner did not file a patent owner's statement under 37 CFR 1.530.

5. On July 17, 2009 a non-final Office action was mailed.

6. On September 18, 2009, a response was received from the patent owner.

7. On December 1, 2009, a final Office action was mailed.

8. On January 8, 2010, a petition for a one-month extension of time was filed.

9. On January 15, 2010, a decision granting the one-month extension of time was mailed.

10. On January 25, 2010, a petition requesting withdrawal of the finality of the December 1, 2009 Office action was filed.

11. On February 17, 2010, a personal interview was held.

12. On February 18, 2010, a petition for an additional two week extension of time was filed.

13. On February 26, 2010, a decision granting the two-week extension of time was mailed.

14. On March 15, 2010, the patent owner submitted an after-final response.

15. On April 14, 2010, an advisory was mailed, which indicated that patent claims 1-45 as amended in the March 15, 2010 response would be allowable if submitted in a separate, timely filed amendment without new proposed claims 46-87 and fixing the minor noted grammatical errors in claims 1 and 3.

Decision

In response to patent owner's arguments that the examiner erred in making the Office action of December 1, 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."

Turning to the facts in this proceeding, the request for reexamination was based on a number of references. 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 July 17, 2009, set forth rejections substantially as proposed by third party requester. Patent owner filed a response of September 18, 2009. No amendments were made to original claims 1-45. Proposed new claims 46-50 were added. The final Office action maintained all 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 contending that the obviousness rejection based on the Ohkuma is a new ground of rejection because the basis for the rejection is allegedly different than in the first Office action. Specifically, the patent owner stated that they were not aware that the examiner was relying on the teachings in Table 7 combined with the teachings of Sample B in the Ohkuma reference. See pages 2-4 of the instant petition. The patent owner states that they never had the opportunity to respond to the line of argument that Sample B and the composition of Table 7 were prepared using essentially the same method and would be expected to have essentially the same properties. For these reasons, patent owner requests that the finality of the December 1, 2009 Office action should be withdrawn.

In reviewing the record, the examiner provided the patent owner information and references that are 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 24, 2008, incorporated by reference from the request as to how the prior art cited by the third party requester teaches the limitations of claims 1, 4-6, 9, 12-21, 23-33, and 35-45 in the analysis of whether there is a substantial new question of patentability. See, e.g., page 4 of the order. Likewise, the first Office action, dated July 17, 2009, also made it clear that the examiner was relying on both the disclosure regarding Sample B and Table 7 under 35 U.S.C. 103. See, e.g., page 10 of the July 17, 2009 Office action. The record also shows that the final rejection maintained the obviousness rejection based upon the Ohkuma reference, and repeated the **identical grounds**. See, pages 13-15 in the December 1, 2009 Office action. Therefore, the record shows that the patent owner was notified that the

examiner was relying on both the disclosures of Sample B and Table 7 in the Ohkuma reference as the basis for the obviousness rejection.

As explained above, reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. In the petition, patent owner alleges that the examiner presented a new basis for the obviousness rejection based on the Ohkuma reference. To the contrary, the examiner set forth the *exact* same obviousness rejection based on the Ohkuma reference as in the non-final Office action of July 17, 2009, with the exception of the rejection of newly filed claims. The "new basis" to which petitioner refers is merely the examiner's response to arguments set forth in patent owner's response filed September 18, 2009. To reiterate, in the final Office action, the examiner was addressing arguments made by the patent owner, not modifying or altering the grounds of rejection.

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 December 1, 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 her discretion in deciding to making the December 1, 2009 Office action final.

In summary, the final rejection in question did not introduce any new grounds of rejection for original claims 1-45. The original claims remain rejected for the reasons set forth in the first Office action. Accordingly, the examiner properly designated the December 1, 2009 Office action as final in accordance with the statutory mandate of special dispatch. Therefore, the final rejection was proper, and the petition is dismissed.

Conclusion

1. The Patent Owner's petition, filed January 25, 2010, requesting withdrawal of the finality of the Office action mailed December 1, 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 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.
90/009,254	08/19/2008	7238380	SJS-0012	9148

23377 7590 04/21/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2010

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
WILMERHALE / NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

Date: MAILED

APR 2 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009254
PATENT NO. : 7238380
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

MAILED

APR 21 2010

CENTRAL REEXAMINATION UNIT

David N. Farsiou
Woodcock Washburn LLP
CIRA CENTRE, 12the Floor
2929 Arch Street
Philadelphia, PA 19104-2891

For Patent Owner

WilmerHale/New York
399 Park Avenue
New York, NY 10022

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,254
Filed: August 15, 2008
For: U.S. Patent No. 7,238,380

: DECISION DISMISSING
: PETITION UNDER 37 CFR 1.181
: REQUESTING WITHDRAWAL
: OF FINALITY OF ACTION

This is a decision on the January 25, 2010, "Petition Under 37 C.F.R. § 1.181 To Withdraw Finality" requesting that the finality of the Office action mailed December 1, 2009, be withdrawn.

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 July 3, 2007, U.S. Patent No. 7,238,380 (the '380 patent) issued to Suzanne Stillman.

2. On August 15, 2008, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,254. The request asked for the reexamination of claims 1-13, all of the patent claims.

3. On October 24, 2008, an Order was mailed granting reexamination for claims 1-13 of the '380 patent in control No. 90/009,254.

4. The patent owner did not file a patent owner's statement under 37 CFR 1.530.

5. On July 17, 2009 a non-final Office action was mailed.

6. On September 18, 2009, a response was received from the patent owner.

7. On December 1, 2009, a final Office action was mailed.

8. On January 8, 2010, a petition for a one-month extension of time was filed.

9. On January 15, 2010, a decision granting the one-month extension of time was mailed.

10. On January 25, 2010, a petition requesting withdrawal of the finality of the December 1, 2009 Office action was filed.

11. On February 17, 2010, a personal interview was held.

12. On February 18, 2010, a petition for an additional two week extension of time was filed.

13. On February 26, 2010, a decision granting the two-week extension of time was mailed.

14. On March 15, 2010, the patent owner submitted an after-final response.

15. On April 14, 2010, an advisory was mailed, which indicated that patent claims 1-13 as amended in the March 15, 2010 response would be allowable if submitted in a separate, timely filed amendment without new proposed claims 14-23 and fixing the minor noted grammatical error in claim 1.

Decision

In response to patent owner's arguments that the examiner erred in making the Office action of December 1, 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."

Turning to the facts in this proceeding, the request for reexamination was based on a number of references. 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 July 17, 2009, set forth rejections substantially as proposed by third party requester. Patent owner filed a response of September 18, 2009. Claim 1 was amended and claim 12 was cancelled. No amendments were made to original claims 2-11 and 13. Proposed new claims 14-16 were added. The final Office action maintained all 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 contending that the anticipation rejection based on the Ohkuma is a new ground of rejection because the basis for the rejection is allegedly different than in the first Office action. Specifically, the patent owner stated that the examiner was relying different information regarding the teachings in Table 7 and the teachings of Sample B in the Ohkuma reference. See pages 2-4 of the instant petition. The patent owner states that they never had the opportunity to respond to the line of argument that Sample B is 100% percent fiber. For these reasons, patent owner requests that the finality of the December 1, 2009 Office action should be withdrawn.

In reviewing the record, the examiner provided the patent owner information and references that are 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 24, 2008, incorporated by reference from the request as to how the prior art cited by the third party requester teaches the limitations of claims 1 and 4-13 in the analysis of whether there is a substantial new question of patentability. See, e.g., page 4 of the order. Likewise, the first Office action, dated July 17, 2009, also made it clear that the examiner was relying on both the disclosure regarding Sample B and Table 7 under 35 U.S.C. 103. See, e.g., pages 4-6 of the July 17, 2009 Office action. The record also shows that the final rejection maintained the anticipation rejection based upon the Ohkuma reference, and repeated the **identical grounds**. See, pages 4-5 in the December 1, 2009 Office action. Therefore, the record shows that the patent owner was notified that the examiner was relying on both the disclosures of Sample B and Table 7 in the Ohkuma reference as the basis for the anticipation rejection.

As explained above, reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. In the petition, patent owner alleges that the examiner presented a new basis for the anticipation rejection based on the Ohkuma reference. To the contrary, the examiner set forth the *exact* same anticipation rejection based on the Ohkuma reference as in the non-final Office action of July 17, 2009, with the exception of the rejection of newly filed claims. The "new basis" to which petitioner refers is merely the examiner's response to arguments set forth in patent owner's response filed September 18, 2009. To reiterate, in the final Office action, the examiner was addressing arguments made by the patent owner, not modifying or altering the grounds of rejection.

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 December 1, 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 her discretion in deciding to making the December 1, 2009 Office action final.

In summary, the final rejection in question did not introduce any new grounds of rejection for amended claim 1 or original claims 2-11 and 13. The original claims remain rejected for the reasons set forth in the first Office action. Accordingly, the examiner properly designated the December 1, 2009 Office action as final in accordance with the statutory mandate of special dispatch. Therefore, the final rejection was proper, and the petition is dismissed.

Conclusion

1. The Patent Owner's petition, filed January 25, 2010, requesting withdrawal of the finality of the Office action mailed December 1, 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 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

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

David N. Farsiou
Woodcock Washburn LLP
CIRA CENTRE, 12the Floor
2929 Arch Street
Philadelphia, PA 19104-2891

For Patent Owner

WilmerHale/New York
399 Park Avenue
New York, NY 10022

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,255
Filed: August 15, 2008
For: U.S. Patent No. 7,115,297

: DECISION DISMISSING
: PETITION UNDER 37 CFR 1.181
: REQUESTING WITHDRAWAL
: OF FINALITY OF ACTION

This is a decision on the January 25, 2010, "Petition Under 37 C.F.R. § 1.181 To Withdraw Finality" requesting that the finality of the Office action mailed December 2, 2009, be withdrawn.

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 October 3, 2006, U.S. Patent No. 7,115,297 (the '297 patent) issued to Suzanne Stillman.

2. On August 15, 2008, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,255. The request asked for the reexamination of claims 2 and 10 of the '297 patent.

3. On October 10, 2008, an Order was mailed granting reexamination for claims 2 and 10 of the '297 patent in control No. 90/009,255.

4. The patent owner did not file a patent owner's statement under 37 CFR 1.530.

5. On July 17, 2009 a non-final Office action was mailed.

6. On September 18, 2009, a response was received from the patent owner.

7. On December 2, 2009, a final Office action was mailed.

8. On January 8, 2010, a petition for a one-month extension of time was filed.

9. On January 16, 2010, a decision granting the one-month extension of time was mailed.

10. On January 25, 2010, a petition requesting withdrawal of the finality of the December 2, 2009 Office action was filed.

11. On February 17, 2010, a personal interview was held.

12. On February 18, 2010, a petition for an additional two week extension of time was filed.

13. On February 26, 2010, a decision granting the two-week extension of time was mailed.

14. On March 15, 2010, the patent owner submitted an after-final response.

15. On April 15, 2010, an advisory was mailed, which indicated that the March 15, 2010 response raised new issues that would request further consideration.

Decision

In response to patent owner's arguments that the examiner erred in making the Office action of December 2, 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."

Turning to the facts in this proceeding, the request for reexamination was based on a number of references. 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 July 17, 2009, set forth rejections substantially as proposed by third party requester. Patent owner filed a response of September 18, 2009. No amendments were made to original claims 2 and 10. Proposed new claims 112-118 were added. The final Office action maintained all 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 contending that the obviousness rejection based on the Ohkuma is a new ground of rejection because the basis for the rejection is allegedly different than in the first Office action. Specifically, the patent owner stated that they were not aware that the examiner was relying on the teachings in Table 7 combined with the teachings of Sample B in the Ohkuma reference. See pages 2-4 of the instant petition. The patent owner states that they never had the opportunity to respond to the line of argument that Sample B and the composition of Table 7 were prepared using essentially the same method and would be expected to have essentially the same properties. For these reasons, patent owner requests that the finality of the December 2, 2009 Office action should be withdrawn.

In reviewing the record, the examiner provided the patent owner information and references that are 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 10, 2008, incorporated by reference from the request as to how the prior art cited by the third party requester teaches the limitations of claims 2 and 10 in the analysis of whether there is a substantial new question of patentability. See, e.g., page 5 of the order. Likewise, the first Office action, dated July 17, 2009, also made it clear that the examiner was relying on both the disclosure regarding Sample B and Table 7 under 35 U.S.C. 103. See, e.g., pages 6-8 of the July 17, 2009 Office action. The record also shows that the final rejection maintained the obviousness rejection based upon the Ohkuma reference, and repeated the **identical grounds**. See, pages 6-7 in the December 2, 2009 Office action. Therefore, the record shows that the patent owner was notified that the examiner was relying on both the disclosures of Sample B and Table 7 in the Ohkuma reference as the basis for the obviousness rejection.

As explained above, reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. In the petition, patent owner alleges that the examiner presented a new basis for the obviousness rejection based on the Ohkuma reference. To the contrary, the examiner set forth the *exact* same obviousness rejection based on the Ohkuma reference as in the non-final Office action of July 17, 2009, with the exception of the rejection of newly filed claims. The "new basis" to which petitioner refers is merely the examiner's response to arguments set forth in patent owner's response filed September 18, 2009. To reiterate, in the final Office action, the examiner was addressing arguments made by the patent owner, not modifying or altering the grounds of rejection.

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 December 2, 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 her discretion in deciding to making the December 2, 2009 Office action final.

In summary, the final rejection in question did not introduce any new grounds of rejection for original claims 2 and 10. These claims remain rejected for the reasons set forth in the first Office action. Accordingly, the examiner properly designated the December 2, 2009 Office action as final in accordance with the statutory mandate of special dispatch. Therefore, the final rejection was proper, and the petition is dismissed.

Conclusion

1. The Patent Owner's petition, filed January 25, 2010, requesting withdrawal of the finality of the Office action mailed December 2, 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 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.
90/009,260	08/21/2008	5507485	UPLAY-101RX	8315

38137 7590 02/09/2009

ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE, 10TH FLOOR
NEW YORK, NY 10017

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/09/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

ABELMAN, FRAYNE & SCHWAB
150 EAST 42ND STREET
NEW YORK, NY 10017-5612

MAILED

FEB 0 9 2009

CENTRAL REEXAMINATION UNIT

(For Requester)

Neal M. Cohen
VISTA IP LAW GROUP LLP
2040 Main Street, 9th Floor
Irvine, CA 92614

In re *Fisher*
Reexamination Proceeding
Control No. 90/009,260
Filed: August 21, 2008
For: U.S. Patent No. 5,507,485

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on November 11, 2008, styled as "PETITION TO THE DIRECTOR FOR REVIEW OF EXAMINER'S DENAIL OF REQUEST FOR *EX PARTE* REEXAMINATION UNDER 37 C.F.R. § 1.515(c)," is before the Director of the Central Reexamination Unit (CRU). The November 11, 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 October 20, 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 granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,507,485 (hereinafter, the '485 patent) issued on April 16, 1996.

2. On August 21, 2008, the third party requester deposited a corrected request for *ex parte* reexamination for claims 1-54 of the '485 patent, and the resulting reexamination proceeding was assigned Control No. 90/009,260 (hereinafter, the '260 proceeding).

3. On October 20, 2008, an order denying the request for reexamination for claims 1-54 was issued.

4. On November 11, 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 two errors. The petitioner advances the following points:

1. The examiner incorrectly determined that U.S. Patent No. 5,438,518 to Bianco et al. (hereinafter "Bianco") and U.S. Patent No. 5,558,333 to Kelson et al (hereinafter "Kelson") were not prior art. See pages 3-5 and 6-9 of the petition.
2. The examiner incorrectly determined that the request did not establish a substantial new question of patentability because the examiner improperly applied a prima facie obviousness standard in denying the request for reexamination. See pages 5-6 and 9-13 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 1-54 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 1-54 of the '485 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC § 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of

patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[1] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial 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.[2] 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."[3,4] This new light must be in

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[1] Public Law 96-517, enacted on December 12, 1980.

[2] This requirement is not aplicable to Director ordered reexaminations.

[3] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

[4] For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J.*

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.

III. Analysis of the Request for Reexamination

As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated August 21, 2008.

In response to petitioner's argument that the examiner incorrectly determined that U.S. Patent No. 5,438,518 to Bianco et al. (hereinafter "Bianco") and U.S. Patent No. 5,558,333 to Kelson et al (hereinafter "Kelson") were not prior art, the Director finds that the examiner improperly concluded that the date of the invention is June 24, 1993 based upon the declaration under 37 CFR 1.131 filed in the prior prosecution. See paragraphs 2 and 3 of the Order dated October 20, 2008. The petitioner correctly points out that the sufficiency of the prior-filed declaration filed under 37 CFR 1.131 may be raised in a request for reexamination. Specifically, MPEP 2258.01 states that:

> "Another example involves the situation where an examiner discussed a reference in a prior Office proceeding, but did not either reject a claim based upon the reference or maintain the rejection based on the mistaken belief that the reference did not qualify as prior art. For example, the examiner may not have believed that the reference qualified as prior art because: (i) the reference was undated or was believed to have a bad date; (ii) ***the applicant submitted a declaration believed to be sufficient to antedate the reference under 37 CFR 1.131***; or (iii) the examiner attributed an incorrect filing date to the claimed invention. If the reexamination request were to explain how and why the reference actually does qualify as prior art, it may be appropriate to rely on the reference to order and/or conduct reexamination. For example, the request could: (i) verify the date of the reference; (ii) ***undermine the sufficiency of the declaration filed under 37 CFR 1.131 >(by a showing of an inaccuracy/mistake of fact in the declaration)***<... ." (emphasis added in bolded italics).

The request for reexamination, dated August 21, 2008, raises issues that undermine the sufficiency of the declaration filed under 37 CFR 1.131, on April 26, 1995, in the prosecution of the application that issued as the '485 patent. See pages 11-13 of the request. Specifically, the request raises the issue of whether the declaration under 37 CFR 1.131, which was filed in the prior examination, showed conception of the claimed invention of the independent claims and whether the declaration shows the claim limitations taught by newly cited references to Bianco and Kelson. In the prosecution of the application that issued as the '485 patent, the examiner

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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

only stated that the "[t]he declaration filed on April 26, 1995 under 37 C.F.R. § 1.131 is sufficient to overcome a potential rejection of the claims based upon the Gunthorpe et al reference (PCT WO93/12439) which was cited by applicant on April 26, 1995." See paragraph 1 on page 2 of the Office action of June 7, 1995. The Bianco and Kelson references are newly cited art in this reexamination proceeding. Accordingly, no determination was made in the prior examination as to whether the declaration, filed in the prior examination, effectively swears behind these references. Furthermore, the examiner did not make any specific factual findings and did not state what claims were shown to have the earlier conception date. Upon review of the declaration under 37 CFR 1.131 filed in the prior examination, it is agreed with the requester that the declaration under 37 CFR 1.131 is not sufficient to swear behind newly cited references to Bianco and Kelson for the reasons stated on pages 11-13 of the request for reexamination. See MPEP 715.02 and 715.07.

Bianco was filed on January 19, 1994 and Kelson was filed on November 30, 1993. These filing dates are prior to filing date of April 28, 1994 for the application that issued as the '485 patent. Therefore, as the record currently stands, Bianco and Kelson are deemed to be prior art under 35 U.S.C. 102(e). This decision does not preclude the patent owner from filing a declaration under 37 CFR 1.131 to swear behind the Bianco and Kelson references in this reexamination proceeding, or arguing the sufficiency of the prior declaration under 37 CFR 1.131.

The request for reexamination, dated August 21, 2008, stated that claims 1-54 of the '485 patent are either anticipated under 35 U.S.C. § 102 or rendered obvious under 35 U.S.C. § 103 by Bianco. See pages 1-4 of the request that list numerous proposed rejections based on Bianco. The request also states that Bianco was not cited in the prior examination and raises an SNQ based upon its teachings of subject matter indicated allowable in the prosecution of the application that issued as the '485 patent. See pages 6-8 of the request for reexamination. For example, Bianco has teachings pertaining to displays of a plurality of graphical representations of the golf course depending on the current location of the device, which is relevant to independent claims 1, 18, 19, 38, and 54 of the '485 patent. See page 6 of the request for reexamination. Bianco also teaches subject matter regarding the storing and displaying of stroke and scoring data, which is relevant to claims 16 and 25; the inputting and updating of performance data, which is relevant to claim 49; and the replay means, which is relevant to claim 36. See pages 7-8 of the request for reexamination.

As explained above, Bianco provides teachings pertaining to the claim limitations for which the claims were allowed, and as such, presents new technical teachings not clearly present the prior art applied against the claims in the previous examination. Accordingly, a reasonable examiner would find the new teachings of Bianco to be important in deciding whether or not a claim is patentable. Accordingly, Bianco, cited in the request for the '260 reexamination proceeding, raises an SNQ as to claims 1-54 of the '485 patent.

Because it is agreed that Bianco raises a SNQ with respect to claims 1-54 of the '485 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested. The

examiner to whom this proceeding will be assigned may wish to reevaluate whether (1) the other references cited in the request raise a substantial new question of patentability, and (2) if so, whether rejections based upon these references should be made.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claims 1-54 of the '485 patent is GRANTED, and reexamination is hereby ordered.

3. The petitioner mistakenly submitted a petition fee of $400 with the petition, but no petition fee was required. A refund of the $400 fee charged, on November 12, 2008, to a credit card will be acted upon in due course.

4. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.

5. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

6. 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.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/05/2008

EXAMINER	
ART UNIT	PAPER NUMBER

R. ROSS VIGUET
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DATE MAILED: 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,396	01/27/2005	5770231	00166.0051-US09	9488

26853 7590 12/05/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/05/2008

EXAMINER	
ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/05/2008

EXAMINER	
ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/05/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

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DEC 05 2008

CENTRAL REEXAMINATION UNIT

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Dallas, TX 75201

In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	:
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	:
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	:
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '7839, '7936, '7942, '7957, and '9261 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

As noted above, the original claims remain unamended and new claims 30-112 have been added in the '7839, '7936, '7942, and '7957 reexamination proceedings. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. This may be accomplished by canceling new claims 30-112 in the '7839, '7936, '7942, and '7957 reexamination proceedings. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

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

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

CONCLUSION

1. Reexamination Control Nos. 90/007,839, 90/007,936, 90/007,942, 90/007,957, and 90/009,261 are **merged**.

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

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

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

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

By hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/30/2008

EXAMINER	

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FRANCE

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/30/2008

EXAMINER	
ART UNIT	PAPER NUMBER

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DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 12/30/2008

EXAMINER	
ART UNIT	PAPER NUMBER

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DALLAS, TX 75201-2784

DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/30/2008

EXAMINER	
ART UNIT	PAPER NUMBER

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DATE MAILED: 12/30/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/30/2008

EXAMINER	
ART UNIT	PAPER NUMBER

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DALLAS, TX 75201

DATE MAILED: 12/30/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HILDA C. GALVAN
JONES DAY
2727 NORTH HARWOOD STREET
DALLAS, TX 75201-1515

Date:
MAILED
DEC 30 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007839
PATENT NO. : 5734961
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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DEC 30 2008

CENTRAL REEXAMINATION UNIT

ANTOR CORPORATION
C/O JEAN-PAUL CASTILLE
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DIJON 21000 FR FRANCE

(For Patent Owner)

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Washington, DC 20001-2113

(For Third Party Requester)

Thomas A. Rozylowics
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Suite 1100
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(For Third Party Requester)

HOWREY LLP-HN
C/O IP DOCKETING DEPARTMENT
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FALLS CHURCH, VA 22042-7195

(For Third Party Requester)

Robert C. Laurenson
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Irvine, CA 92614

(For Third Party Requester)

EVAN LAW GROUP LLC
600 WEST JACKSON BLVD., SUITE 625
CHICAGO, IL 60661

(For Third Party Requester)

R. Ross Viguet
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Ave.
Suite 2800
Dallas, TX 75201

(Courtesy Copy)

In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	: DECISION DISMISSING : PETITION UNDER 37 CFR 1.181 : TO VACATE FINALITY :
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	: : : :
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	: : : :

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of the finality of the rejection mailed August 19, 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

6. The five requests were merged on December 5, 2008.

7. A non-final rejection was mailed December 22, 2005 in the merged proceedings.

DECISION

In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

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

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

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

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

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

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

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

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 12/30/2008

EXAMINER

R. ROSS VIGUET
FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVE.
SUITE 2800
DALLAS, TX 75201

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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

Copied from 90007839 on 01/07/2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

7590 12/30/2008

EXAMINER	
ART UNIT	PAPER NUMBER

R. ROSS VIGUET
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2200 ROSS AVE.
SUITE 2800
DALLAS, TX 75201-2784

DATE MAILED: 12/30/2008

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

7590 12/30/2008

EXAMINER

R. ROSS VIGUET
FULBRIGHT & JAWORSKI LLP
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

7590 12/30/2008

EXAMINER	
ART UNIT	PAPER NUMBER

R. ROSS VIGUET
FULBRIGHT & JAWORSKI LLP
2200 ROSS AVE., SUITE 2800
DALLAS, TX 75201

DATE MAILED: 12/30/2008

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

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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.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 12/30/2008

ANTOR CORPORATION
C/O JEAN-PAUL CASTILLE
28 RUE DES ARANDES
DIJON, 21000
FRANCE

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HILDA C. GALVAN
JONES DAY
2727 NORTH HARWOOD STREET
DALLAS, TX 75201-1515

Date:

DEC 30 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007839
PATENT NO. : 5734961
ART UNIT : 3900

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

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

Copied from 90007839 on 01/07/2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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DEC 30 2008
CENTRAL REEXAMINATION UNIT

ANTOR CORPORATION
C/O JEAN-PAUL CASTILLE
28 RUE DES ARANDES
DIJON 21000 FR FRANCE

(For Patent Owner)

Alan L. Whitehurst
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51 Louisiana Avenue, N.W.
Washington, DC 20001-2113

(For Third Party Requester)

Thomas A. Rozylowics
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1425 K Street, N.W.
Suite 1100
Washington, DC 20005

(For Third Party Requester)

HOWREY LLP-HN
C/O IP DOCKETING DEPARTMENT
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FALLS CHURCH, VA 22042-7195

(For Third Party Requester)

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2020 Main Street
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Irvine, CA 92614

(For Third Party Requester)

EVAN LAW GROUP LLC
600 WEST JACKSON BLVD., SUITE 625
CHICAGO, IL 60661

(For Third Party Requester)

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FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Ave.
Suite 2800
Dallas, TX 75201

(Courtesy Copy)

Copied from 90007839 on 01/07/2009

In re Castille Reexamination Proceeding Control No. 90/007,839 For: U.S. Patent No. 5,734,961	DECISION DISMISSING PETITION UNDER 37 CFR 1.181 TO VACATE FINALITY
In re Castille Reexamination Proceeding Control No. 90/007,936 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,942 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/007,957 For: U.S. Patent No. 5,734,961	
In re Castille Reexamination Proceeding Control No. 90/009,261 For: U.S. Patent No. 5,734,961	

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of the finality of the rejection mailed August 19, 2008.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,734,961 (hereinafter, the '961 patent), issued to Castille, on March 31, 1998.

2. Between December 7, 2005 and March 3, 2006, four Requests for *Ex Parte* Reexamination of the '961 patent. The reexamination proceedings were assigned Control Nos. 90/007,839 (hereinafter, the '7839 proceeding), 90/007,936 (hereinafter, the '7936 proceeding), 90/007,942 (hereinafter, the '7942 proceeding), and 90/007,957 (hereinafter, the '7957 proceeding).

3. The four requests for reexamination were granted. The four proceedings were merged. After a non-final office action, Patent Owner did not amend original claims 1-29 and

Copied from 90007839 on 01/07/2009

added new claims 30-112. Later in prosecution, on August 19, 2008 a final rejection was mailed.

4. On August 21, 2008, a third party deposited a Request for *Ex Parte* Reexamination of the '961 patent. The reexamination proceeding was assigned Control No. 90/009,261 (hereinafter, the '9261 proceeding).

5. The Reexamination Order was granted in the '9261 proceeding on November 12, 2008.

6. The five requests were merged on December 5, 2008.

7. A non-final rejection was mailed December 22, 2005 in the merged proceedings.

DECISION

In view of the non-final office action mailed December 22, 2005, the petition to vacate the finality of the office action mailed August 19, 2008 is **dismissed as moot**.

CONCLUSION

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

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By Mail to: Mail Stop *Ex Parte* Reexam
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Commissioner for Patents
United States Patent & Trademark Office
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Alexandria, VA 22314

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

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

Copied from 90007839 on 01/07/2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 01/08/2009

ANTOR CORPORATION
C/O JEAN-PAUL CASTILLE
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DIJON, 21000
FRANCE

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 01/08/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Evan Law Group LLC
600 West Jackson Blvd., Suite 625
Chicago, IL 60661

DATE MAILED: 01/08/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

R. Ross Viguet
FULBRIGHT & JAWORSKI L.L.P.
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Dallas, TX 75201

(For Patent Owner)

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Washington, DC 20001-2113

(For Third Party
Requester)

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

Thomas A. Rozylowics
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(For Third Party
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(For Third Party
Requester)

Paul Rauch
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600 West Jackson Blvd, Suite 625
Chicago, IL 60661

(For Third Party
Requester)

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

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,839
Deposited on: 7 December 2005
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,936
Deposited on: 17 February 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,942
Deposited on: 17 February 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/007,957
Deposited on: 3 March 2006
For U.S. Patent No. 5,734,961

In re : Castille
Ex Parte Reexamination Proceeding
Control No. 90/009,261
Deposited on: 21 August 2008
For U.S. Patent No. 5,734,961

MAILED

JAN 08 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the 30 December 2008, petition for "Petition for Extension of Time Under 37 CFR § 1.550 (c)," requesting that the time for responding to the Office action mailed 22 December 2008, be extended by one-month in the above noted *ex parte* proceedings.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action mailed 22 December 2008, which set a one month date for filing a response thereto. The Office action is a Non-Final Office action. The petition for extension of time was timely filed on 30 December 2008, together with the $200.00 petition fee as is required by 37 CFR §1.515(c) and as set forth in 37 CFR § 1.17 (g).

37 CFR § 1.550 (c) states:

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

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

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

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is met by reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner further notes the need for expert input whose availability during the response period is insufficient for a proper response. As such, the "sufficient cause" requirement is considered to be met by in this petition to the director of the Central Reexamination Unit. The sufficient cause justifies granting a one-month extension of time.

The petition request for a one month extension of time is hereby **granted**.

Conclusion

1. The patent owner's petition for extension of two-month time in which to file a response to the Office action dated 22 December 2008 is hereby **granted**.

2. The time to respond is extended by one-month.

3. The Patent Owner's response is due **22 February 2009**

4. Response may be submitted as follows:

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RICHARD H. WALKER
WALKER, McKENZIE & WALKER, P.C.
6363 POPLAR AVE., SUITE 434
MEMPHIS, TN 38119-4896

MAILED

OCT 01 2008

CENTRAL REEXAMINATION UNIT

In re Application of
Virginia S. McClendon
Control No. 90/009,264 (U.S. Patent 6,044,503)
Filed: August 29, 2008
Attorney Docket No. 98.058CIP

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 11, 2008.

The request is **APPROVED**.

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

The request was signed by Russell H. Walker on behalf of all attorneys of record who are associated with Customer No. 25574. All attorneys/agents associated with the Customer No. 25774 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is no outstanding Office action that requires a reply from the applicant.

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

Patricia Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: **Virginia S. McClendon**
1188 Saxon Avenue
Memphis, TN 38106-2320

cc: **KENYON & KENYON LLP** (Third Party Requester)
ATTN: Daniel G. Shanley
1500 K STREET, N.W., Suite 700
WASHINGTON, DC 20005

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on September 11, 2008. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,268	09/08/2008	5830237	OHI 1717-047C	4529

8698 7590 07/21/2009

STANDLEY LAW GROUP LLP
6300 Riverside Drive
Dublin, OH 43017

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2009

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

DR. ALDO A. LAGHI
c/o RONALD A. CHRISTALDI
P.O. BOX 172609
TAMPA, FL 33601

Date:

RECEIVED
JUL 21 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009268
PATENT NO. : 5830237
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Standley Law Group, LLP
6300 Riverside Drive
Dublin, OH 43017

(For Patent Owner)

Dr. Aldo A. Laghi
c/o Ronald A. Christaldi
P.O. Box 172609
Tampa, FL 33601

(For Requester)

RECEIVED
JUL 21 2009
CENTRAL REEXAMINATION UNIT

In re Kania
Ex Parte Reexamination Proceeding
Control No. 90/009,268
Filed: September 8, 2008
For: U.S. Patent No. 5,830,237

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the July 1, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the July 1, 2009 patent owner petition to revive").

The July 1, 2009 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been received.

SUMMARY

The July 1, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) . . . A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional . . .

*

*

(d) *Terminal Disclaimer.*

*

*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

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

Abandonment for Failure To Reply to a Non-Final Action

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:

(A) an argument or an amendment under 37 CFR 1.111 . . .

The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be bona fide. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period . . . for correction of the error or omission.

MPEP 2268 provides, in pertinent part:

> II. PETITION BASED ON UNINTENTIONAL DELAY
>
> The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).
>
> *
>
> *
>
> IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS
>
> See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response[1] to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. The patent owner has submitted a response to the April 27, 2009 nonfinal Office action, and a petition fee under 37 CFR 1.17(m), with the present July 1, 2009 patent owner petition, which satisfy items (1)[2] and (2), respectively. A proper statement under 37 CFR 1.137(b)(3) has also been submitted with the July 1, 2009 petition, which satisfies item (3). Accordingly, the July 1, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[3] is **granted**.

CONCLUSION

- The July 1, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

---

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

[2] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (a). Note that **the grant of a petition under 37 CFR 1.137 is not a determination that any response is complete. Where the proposed response is to a non-final Office action, the petition may be granted if the response appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.**

[3] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.111, to the nonfinal Office action.

- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for processing of the patent owner amendment/response to the April 27, 2009 nonfinal Office action.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jeffrey Jastrzab, of CRU Art Unit 3993, at (571) 272-4947.

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

Robert A. Clarke
Director
Office of Patent Legal Administration

cn

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.
90/009,282	09/23/2008	5,691,897	14983-129	9097

25315 7590 02/12/2009

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2009

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
PATRICK W. RASCHE
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE, SUITE 2600
ST. LOUIS, MO 63102-2740

Date: MAILED

FEB 12 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009282
PATENT NO. : 5691897
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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Wendy M. Gombert
BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE WA 98104

(For Patent Owner)

MAILED

FEB 12 2009

CENTRAL REEXAMINATION UNIT

William J. Zychlewicz
PATRICK W. RASCHE
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102-2740

(For Third Party Requester)

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

In re: Brown *et alia*
Inter Partes Reexamination Proceeding
Control No. 90/009,282
Deposited on: 23 September 2008
For: US Patent No. 5,691,897

This is a decision on the 6 February 2009, patent owner "Petition and Request for Extension of under 37 CFR § 1.550(c) and Payment of Fee Under 37 CFR § 1.17(g)," requesting that the time for responding to the Office action mailed 4 February 2009 to 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.

Statement of Relevant Facts

1. On 25 November 1997 US patent No. 5,691,897 was granted.

2. On 23 September 2008 a request for reexamination was filed by a third party requester for *Ex Parte* Reexamination with the Office.

3. On 10 November 2008 an Order Granting Request for *Ex Parte* Reexamination was mailed.

4. On 4 February 2009 a non-final Office action was mailed setting a time for response of two (2) months.

5. On 6 February 2009 a petition for a two (2) months extension of time was received.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 4 February 2009. The non-final Office action provides two (2) month period for response. The petition requesting a two (2) months extension of time was timely filed on 6 February 2009. On 10 February 2009 a letter was received authorizing payment by a deposit account for the $200 petition fee pursuant to 37 CFR §1.17 (g).

The request is granted-in-part.

37 CFR 1.550 (c) states:

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

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

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

37 CFR § 1.550 **(f)** states

> (f) The reexamination requester will be sent copies of Office actions issued during the ex parte reexamination proceeding. After filing of a request for ex parte reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

MPEP 2266.03 **Service of Papers** (in-part)

> Any paper filed with the Office, i.e., any submission made, in a third party requested reexamination by either the patent owner or the third party requester, must be served on every other party in the reexamination proceeding.
>
> As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper. It is required that the name and address of the party served, and the method of service be set forth in the certificate of service. Further, a copy of the certificate of service must be attached with the copy of the paper that is served on the other party.
>
> Any paper for which proof of service is required, which is filed without proof of service, **may be denied consideration**. (emphasis added) Where no proof of service is included, the reexamination clerk should immediately contact the party making the submission by telephone to see whether the indication of proof of service was inadvertently omitted from the submission but there was actual service.

Analysis and Findings

The petition requests an extension of two (2) months time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner notes that the Office action is lengthy and the applied references length is extensive. Further the patent owner is assessing the need for experts to determine the need for declarations under 37 CFR § 1.132.

In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is sufficient cause to grant-in-part the petition for extension of time. A one (1) month extension of time is hereby granted.

The patent owner is reminded of their requirement to serve **all** papers to the third party requester in this *ex parte* proceeding. Proof of service must be attached to all papers submitted to the Office. With this reminder the patent owner should expect that future paper lacking proof of service may be denied entry.

The petition request is hereby granted-in-part.

A **one-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 4 February 2009 is **granted-in-part**.

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

3. The office action mailed set a two-months response time for which to respond, with the granting of this extension of time, the period will end on **4 May 2009**.

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, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, Supervisory Patent Examiner, at 571-272-4929, or Jessica Harrison at (571) 272-4449, Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992may be contacted.

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,285	01/08/2009	7414220	22188/07530	4922

24024 7590 01/25/2010

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND, OH 44114

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Aaron P. McGushion
4565 Dogwood Ave
Seal Beach, CA 90740

Date:
MAILED

JAN 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009285
PATENT NO. : 7414220
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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CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND OH 44114

(Patent Owner)

Aaron P. McGushion
4565 DOGWOOD AVE
SEAL BEACH, CA 90740

(Third Party Requester)

MAILED

JAN 25 2010

CENTRAL REEXAMINATION UNIT

In re Oyster *et al.*
Reexamination Proceeding
Control No.: 90/009,285
Filed: January 8, 2009
For: U.S. Patent No.: 7,414,220

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the December 2, 2009 patent owner petition under 37 CFR 1.182, requesting the Office to entry of an amendment to the claims 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.

BACKGROUND

1. On August 19, 2008, the Office issued U. S. patent number 7,414,220 (the '220 patent).
2. On January 8, 2009, a request for reexamination of claims 1-35 and 38-41 of the '220 patent was filed by a third party requestor. The request was assigned reexamination control no. 90/009,285 (the '9285 proceeding).
3. On March 11, 2009, the Office issued an order granting the '9285 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1-35 and 38-41 of the '220 patent would be subject to reexamination.
4. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9285 *ex parte* reexamination proceeding expired after May 11, 2009.
5. On May 27, 2009, the Office issued a first Office action on the merits rejecting claims 1-9, 11-21, 23, 25-32, 34, 38-40 and confirming claims 10, 22, 24, 33, 35-37 and 41-47.[1]

[1] Although claims 35-37 and 42-47 were not subject to reexamination the examiner exercised discretion and commented on them in the form of conformation commentary as to their patentability.

6. On July 27, 2009, patent owner submitted a response to the May 27, 2009 Office action. The response included an amendment to claims 1, 8, 10, 22 and 36, cancellation of claims 2 and 5, and presented new claims 48-65.

7. On October 6, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the '9285 proceeding. The NIRC confirmed the patentability of original claims 17-21, 23-35, 38-40 and 41-47; and determined that amended claims 1, 3-4, 6-16, 22, 36 and 37 and newly added claims 48-65 were patentable.

8. On October 12, 2009, the '9285 proceeding entered the printing cycle, for printing of a reexamination certificate.

9. On December 2, 2009, patent owner filed the instant petition, accompanied with an amendment to the claims. Patent owner requests the Office enter the amendment.

10. On December 29, 2009, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (7281st), US 7,414,220 C1.

DECISION

MPEP 2287 states (in part):

> 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.

MPEP 2287.01 states (in part):

> The rules do not provide for an amendment to be filed in a reexamination proceeding after a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has been issued. Note that 37 CFR 1.312 does not apply in a reexamination proceeding. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after the NIRC must be accompanied by a petition under 37 CFR 1.182. The petition must be granted, in order to have the amendment, information disclosure statement, or other paper related to the merits considered. Where an amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding is filed after the NIRC, and the accompanying petition under 37 CFR 1.182 is granted, the examiner will reconsider the case in view of the new information, and if appropriate, will reopen prosecution.

The present reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (7281st), US 7,414,220 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '220 patent. Therefore, the submission of an amendment to the claims for entry is not authorized by statute. Accordingly, the petition is **dismissed.**

Although the amendment submitted is for the purpose of correcting an error made by patent owner and the correction would be supported by the record,[2] the amendment cannot be entered as the Office lost jurisdiction over the '220 patent with the issuance of the *Ex Parte* Reexamination Certificate on December 29, 2009. The petition was submitted very late in the proceeding and after the '9285 proceeding had already entered the print cycle. The petition was not matched and taken up for action in time to permit entry of the amendment. In order to correct this error, patent owner may wish to consider the filing of a reissue application, if the error meets the standards set forth in 35 U.S.C. § 251.

In view of the above, the petition is **dismissed.**

CONCLUSION

1. The petition is **dismissed** as to the request for of an amendment after NIRC.

2. The amendment has not been entered, but has been 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

Kenfinal+ACP – after it/amdt-decl enter 1-22-10

[2] See page 3 of patent owner's December 2, 2009 petition and the relevant portions of the record cited by patent owner therein.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,287	10/03/2008	7120634	DN-CON	3847

37420 7590 09/15/2009

VISTA PRINT USA, INC.
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON, MA 02421

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2009

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SEP 15 2009

CENTRAL REEXAMINATION UNIT

VISTA PRINT USA, INC.
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON MA 02421

(For Patent Owner)

SHUMAKER & SIEFFERT, P. A.
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

(For Third Party Requester)

In re Jecha *et alia*
Reexamination Proceeding
Control No. 90/009,287
Request Deposited: October 3, 2008
For: U.S. Patent No. 7,120,634

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Jecha *et alia*
Reexamination Proceeding
Control No. 90/009,314
Corrected Request Deposited: March 23, 2009
For: U.S. Patent No. 7,120,634

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. 7,120,634 (hereinafter, the '634 patent), issued to Jecha *et alia*, on October 10, 2006.

2. On October 3, 2008, patent owner deposited a Request for *Ex Parte* Reexamination of the '634 patent. The reexamination proceeding was assigned Control No. 90/009,287 (hereinafter, the '9287 proceeding).

3. The Reexamination Order was granted in the '9287 proceeding on December 18, 2008.

4. There are currently no amendments in the '9287 proceeding.

5. On March 23, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '634 patent. The reexamination proceeding was assigned Control No. 90/009,314 (hereinafter, the '9314 proceeding).

6. The Reexamination Order was granted in the '9314 proceeding on June 5, 2009.

7. There are currently no amendments in the '9314 proceeding.

8. The '9287 and '9314 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 '9287 and the '9314 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. 90/009,287 and 90/009,314 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first 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
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,288	09/29/2008	6074454	5238-082951	3848

28289 7590 11/19/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Stephen L. Peterson, Esq.
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Avenue, NW
Washington DC 20001

DATE MAILED: 11/19/2009

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,288	09/29/2008	6074454	5238-082951	3848

28289 7590 11/19/2009

THE WEBB LAW FIRM, P.C.
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH, PA 15219

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Kent E. Baldauf
The Webb Law Firm
700 Coppers Building
436 Seventh Avenue
Pittsburg, PA 15219

For Patent Owner

MAILED

NOV 19 2009

CENTRAL REEXAMINATION UNIT

Stephen L. Peterson
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001

For Requestor

Ex Parte Reexamination Proceeding
Control No. 90/009,288
Filed: September 29, 2008
For: US Patent No. 6,074,454

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

This is a decision on the petition filed November 17, 2009 under 37 CFR 1.550 to request a one-month extension of time in which to file a response to the Office action mailed September 18, 2009.

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

The petition is granted for two (2) weeks 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 September 18, 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 Patentee's counsel have been diligently working on framing a response to the Final Office action and conducted a personal interview on November 5, 2009. Patentee's counsel has also required time to prepare and file a brief in opposition to defendant's motion in connection with the lawsuit presently pending against the patent under reexamination. An extension of time for one month is requested.

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 adequate to justify only a two-week extension of time in which to file a response. Accordingly, the period of time for filing the response is extended to December 2, 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 is granted for two (2) weeks.

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

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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90/009,288	09/29/2008	6074454	5238-082951	3848

28289 7590 03/23/2010

EXAMINER	

ART UNIT	PAPER NUMBER

Stephen L. Peterson, Esq.
Finnegan, Henderson, Farabow,
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901 New York Avenue, NW
Washington DC 20001

DATE MAILED: 03/23/2010

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Kent E. Baldauf
The Webb Law Firm
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219

For Patent Owner

MAILED

MAR 29 2010

CENTRAL REEXAMINATION UNIT

Stephen L. Peterson
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001

For Requestor

Ex Parte Reexamination Proceeding
Control No. 90/009,288
Filed: September 29, 2008
For: US Patent No. 6,074,454

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the petition filed January 19, 2010 under 37 CFR 1.181 to request entry of amendments, arguments, and evidence submitted on December 2, 2009 in response to the Final Office Action dated September 18, 2009.

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

The petition is denied for the reasons set forth below.

Review of Salient Facts

June 13, 2000 - U.S. Patent No. 6,074,454 ('454 patent) issued to Abrams et al.

September 29, 2008 – a request for *ex parte* reexamination was filed by a third party requester and the resulting proceeding was assigned control number 90/009,288 ('288 proceeding).

December 2, 2008 – an Order granting reexamination was mailed.

May 14, 2009 – a first Office action on the merits was mailed.

July 13, 2009 – Patent Owner filed a response to the May 14, 2009 Office action.

September 18, 2009 – a final Office action was mailed.

November 5, 2009 - a personal interview was held with Kent Baldauf, Kent Baldauf, Jr., Dr. Randall German and examiners Johnson, Diamond, and Jones.

November 18, 2009 – Patent Owner filed a response to the final Office action that included amendments to the specification and the claims.

November 25, 2009 – an Advisory action was mailed denying entry of after-final amendments citing lack of support for the amendments.

December 2, 2009 – Patent Owner resubmitted the after-final amendment with declarations.

December 9, 2009 – an Advisory action was mailed denying entry of amendments and declarations.

January 19, 2010 – Patent Owner filed a Notice of Appeal, a Petition under 37 CFR 1.181 and Petition under 37 CFR 1.182 for entry of supplemental amendments and declarations.

Analysis and Findings

37 CFR 1.116 provides, in part:

> (b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, ..., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

...

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 CFR 1.550(a) provides:

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

MPEP 2271 provides, in part:

Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...

> It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

MPEP 706.07(a) states in part:

> Under present practice, second or any subsequent actions of the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).
>
> Any second or subsequent amendment after final will be considered only to the extent that it removes issues for appeal or puts a claim in obvious patentable condition.
> Since patents undergoing reexamination cannot become abandoned and cannot be re-filed, and since the holding of claims unpatentable and canceled in a certificate is absolutely final, it is appropriate that the examiner consider the feasibility of entering amendments touching the merits after final rejection or after appeal has been taken, where there is a showing why the amendments are necessary and a suitable reason is given why they were not earlier presented.

Petitioner patent owner argues that the entire response of December 2, 2009, including the proposed claim amendments and the Serven and German declarations, should be entered into the record because the response is required to distinguish the claimed invention from the art of record. See pages 7-9 of the petition. Specifically, petitioner states that the proposed amendments and the supporting evidence were not earlier submitted because (1) they believed that they could overcome the rejections by arguments alone (see pages 7-8); (2) "... the true significance of amendment the claims to define the claimed bullet as 'unjacketed' became evident only once the Examiner responded to Patent Owner's argument that Slater failed to disclose a bullet" as claimed; and (3) for litigation reasons, patent owner chose not to amend the claims after the first Office action.

In response to patent owner's arguments that the examiner erred in deciding not to enter the entire response of December 2, 2009, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 305 requires that all *exparte* 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 of the proceeding, in the first Office action the position of the Examiner was (and remains) based upon the fact that Slater teaches a bullet meeting the parameters of claims 1, 2, 5, 7, 39 and 40 and that Woodworth teaches the powder compositions of instant claims 49, 53, and 64. Woodworth is also taken to render claims 50 and 54 as obvious and, in combination with Slater, renders claims 6, 12-15, 23, 24, 38, 41, 42, and 66 obvious as well.

Patent Owner's response included no amendments and argued that the bullet of Slater required, *inter alia,* jacketing. Patent Owner argued that Slater uses a jacket to hold the bullet together while in the instantly claimed bullet, the necessary ductility is furnished through the partially impeded sintering process which ameliorates the need for jacketing. As stated above, patent owner made a decision to not amend the claims and provide evidence in response to the first Office action.

The Final action, which maintained the same rejections, asserted that Slater teaches a frangible bullet which "easily disintegrates on striking a hard target" and it may be formed by controlling the density of the pressed powder compact through control of sintering time or temperature or a combination of both (partially-impeded sintering). The jacketing of the Slater bullet prevented damage to the gun barrel. The examiner asserted that the instant claims were not exclusive of jacketing and, in any event, the composition and processing parameters were met by the reference.

A personal interview was held on November 5, 2009. A review of the Interview Summary shows that Patent Owner discussed the possibility of including "unjacketed" in the independent claims. The Examiner indicated that this lacked support, would be considered new matter, and would not be entered. Nevertheless, Patent Owner responded by amending the specification and claims to indicate the frangible bullet as "unjacketed." The Examiner denied entry of these amendments in an Advisory action, based on the fact that "unjacketed" is new matter. In response, Patent Owner re-submitted the amendment with a declaration. This was also denied entry. The Examiner posited that this amendment presented new matter and raised new issues and Patent Owner provided no reason why the declaration was not earlier presented.

It is incumbent upon Patent Owner to provide any evidence and rebuttal at the earliest time possible in the proceeding. An extension of time was granted to permit Patent Owner with an adequate opportunity to prepare a response after the personal interview. There is no showing as to why that response did not include the supporting declaratory evidence. Even if entered, the proposed amendment

does not put the claims in condition for issue and clearly does not reduce the issues for appeal.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the entire response of December 2, 2009 should not be entered. The patent owner had an opportunity to enter the claim amendments and supporting evidence following the non-final Office action of May 14, 2009. As stated above, patent owner did not presented any reasons why the declaration was not earlier presented in the response of December 2, 2009. In the petition, patent owner alleges the amendment was not truly needed until after the final rejection of September 18, 2009. This statement is not supported by the record because the examiner set forth the *exact* same rejection in the final rejection as in the non-final Office action of May 14, 2009. The "true significance" of the need for the claim amendments and supporting evidence to which petitioner refers is merely based upon the examiner's response to arguments set forth in patent owner's response filed July 13, 2009. To reiterate, the examiner addressed arguments made by the patent owner, and did not modify or alter the grounds of rejection. The fact that patent owner chose not to amend claims in response to the first Office action, due to reasons based upon pending litigation, does not provide good and sufficient reasons to delay the reexamination proceedings by requiring consideration of new issues after a final rejection. Such delay is clearly against the statutory mandate of special dispatch. The patent owner, by deciding to wait to introduce the claim amendments, made a calculated decision, which involved the risk that the Office would issue a final rejection and may deny entry of amendments after final rejection. See MPEP 2260. Thus, the petition does not present persuasive reasons why the claims amendments and supporting evidence of the December 2, 2009 response *could* not have been earlier filed.

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 entire response of December 2, 2009 and either reopen prosecution or enter for appeal purposes.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding or to enter the entire response of December 2, 2009 for appeal purposes have not been provided and the patent owner's petition is denied.

Conclusion

The proposed amendment remains not entered in the record. The amendment is not seen to remove issues for appeal nor does it put the claims in clear patentable condition, and therefore, does not meet the requirements of 37 CFR 1.116(b) or (e). For example, the entry of this amendment would necessitate further consideration of rejections based on new matter.

Accordingly, Patent Owner's request for entry and consideration of the December 2, 2009 filing is denied.

Patent Owner's Appeal Brief was due on March 19, 2010.

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

Telephone inquiries with regard to this decision should be directed to Gregory Morse, Director, Central Reexamination Unit, 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.
90/009,288	09/29/2008	6074454	5238-082951	3848

28289 7590 03/24/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2010

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90/009,288	09/29/2008	6074454	5238-082951	3848

28289 7590 03/24/2010

EXAMINER	
ART UNIT	PAPER NUMBER

Stephen L. Peterson, Esq.
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001

DATE MAILED: 03/24/2010

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Kent E. Baldauf
The Webb Law Firm
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219

(For Patent Owner)

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MAR 24 2010

CENTRAL REEXAMINATION UNIT

Stephen L. Peterson
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001

(For Requestor)

Ex Parte Reexamination Proceeding
Control No. 90/009,288
Filed: September 29, 2008
For: US Patent No. 6,074,454

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

This is a decision on the petition filed March 18, 2010 under 37 CFR 1.550 to request a one-month extension of time in which to file Patent Owner's Appeal Brief.

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

The petition is granted for **two (2) weeks** for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file an Appeal Brief. The Appeal Brief is currently due on March 18, 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 a decision on the petition filed January 19, 2010 under 37 CFR 1.181 has not been issued. An extension of the due date for filing the Appeal Brief is requested to allow for the decision and for Patent Owner to file the appropriate Appeal Brief.

Conclusion

The period of time for filing the Brief is extended for two (2) weeks, to April 1, 2010. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

1. The Patent Owner's petition for extension of time in which to file a Brief is **granted** for two (2) weeks.

2. The Patent Owner's Brief is due April 1, 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
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Telephone inquiries with regard to this decision should be directed to Deborah Jones, SPE, Art Unit 3991, Central Reexamination Unit, at (571) 272-1535.

/Deborah Jones/
SPE Art Unit 3991
Central Reexamination Unit

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28289 7590 05/13/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER LLP
901 NEW YORK AVENUE NW
WASHINGTON, DC 20001-4413

Da**MAILED**

MAY 13 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009288
PATENT NO. : 6074454
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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(For Patent Owner)

MAILED

MAY 13 2010

CENTRAL REEXAMINATION UNIT

STEPHEN L. PETERSON
FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER, LLP
901 NEW YORK AVE, NW
WASHINGTON, DC 20001

(For Requester)

In re Abrams et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,288
Filed: September 29, 2008
For: U.S. Patent No. 6,074,454

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 C.F.R. § 1.182**

This is a decision on the January 19, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182."

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

The petition fee under 37 C.F.R. § 1.17(f) of $400 has been submitted.

The petition is **dismissed**.

BACKGROUND

- On September 29, 2008, a request for *ex parte* reexamination was filed by a third party requester, and the resulting reexamination proceeding was assigned control number 90/009,288 ("the '9288 proceeding").

- On December 2, 2008, an Order granting *ex parte* reexamination of claims 1, 2, 5-7, 12-15, 23, 24, 38-42, 49, 50, 53, 54, 64, and 66 of the 6,074,454 patent was issued.

- Prosecution progressed until, on September 18, 2009, a final Office action was issued.

- On October 5, 2009, third party requester filed a notice of concurrent proceedings, consisting of Memorandum and Judgment Orders in *Delta Frangible Ammunition v. Sinterfire*, Civil Action No. 06-cf-1477 (W.D.P.A. September 30, 2009) granting summary judgment on anticipation and obviousness.

- On November 5, 2009, an interview between patent owner and Office personnel was held, in which the examiner stated that a proposed amendment to insert an "unjacketed" limitation was not supported and would not be entered.

- On November 18, 2009, patent owner submitted claim amendments, including amending the independent claims (1 and 39) to include an "unjacketed" limitation, and remarks in response to the final Office action.

- On November 25, 2009, an advisory Office action was entered refusing entry of the proposed amendment of November 18, 2009, stating that the "unjacketed" limitation was not supported in the original specification, and entry would additionally raise a new issue requiring further consideration and/or search.

- On December 2, 2009, patent owner submitted claim amendments, including amending the independent claims (1 and 39) to include an "unjacketed" limitation, cancelling claims 49-66, and remarks in response to the final Office action, and supporting declarations.

- On December 9, 2009, the Office mailed an advisory Office action denying entry of the December 2, 2009 claim amendments, stating that the "unjacketed" limitation was not supported in the original specification, and entry would additionally raise a new issue requiring further consideration and/or search, and that entry of the declarations was refused because patent owner failed to provide a showing of good and sufficient reasons why the affidavits are necessary and were not earlier presented.

- On January 19, 2010, patent owner filed the following:

    - A Notice of Appeal.
    - A petition entitled "PETITION UNDER 37 C.F.R. § 1.181," requesting entry of the amendment, evidence, and remarks filed on December 2, 2009.
    - The instant petition entitled "PETITION UNDER 37 C.F.R. § 1.182," requesting entry of the amendment, evidence, and remarks filed on December 2, 2009.

- On March 18, 2010, patent owner filed a petition for extension of time under 37 C.F.R. § 1.550(c).

- On March 23, 2010, the Office issued a decision denying patent owner's January 19, 2010 petition under 37 C.F.R. § 1.181.

- On March 24, 2010, the Office issued a decision granting patent owner's March 18, 2010 petition for extension of time, extending the date for filing an appeal brief until April 1, 2010.

- On March 26, 2010, patent owner filed a notice of concurrent proceedings, stating that the appeals to the Federal Circuit on the holding of invalidity of claims 1, 2, 5, 6, 7, 13, 15, 39, 40, 41, 42, 49, and 50 in *Delta Frangible Ammunition v. Sinterfire*, Civil Action No. 06-cf-1477 (W.D.P.A. September 30, 2009) have been dismissed by mutual agreement of the parties. The Federal Circuit issued its mandate dismissing the proceeding on March 19, 2010, in *Delta Frangible Ammunition v. Sinterfire*, 2010-1170, -1182.

- On April 1, 2010, patent owner filed an Appeal Brief.

APPLICABLE REGULATION

37 CFR § 1.182 provides:

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

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form

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

of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. 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, in keeping with the requirement of special dispatch, a petition for continuation of the reexamination prosecution should identify the issue which the submission is intended to address, and explain how the issue arose at a point of the prosecution such that patent owner had no earlier opportunity to address the issue.

In this instance, patent owner's response includes a submission directed towards the entry of proposed amendments to the claims and specification, evidence submissions comprising declarations of Randall German and Alan Serven, cancellation of claims 49-66, and accompanying remarks, as described in patent owner's instant petition. This submission was denied entry in the advisory Office action of December 9, 2009. The proposed amendments were alleged, in the first submission of the amendment on December 2, 2009, to address the rejections made in the final Office action by adding "unjacketed" to claims 1 and 39 and to the specification. The Serven declaration was submitted for the purpose of showing that an "unjacketed" limitation was supported in the '454 patent disclosure and thus supported the addition of "unjacketed" to independent claims 1 and 39 in the instant proposed amendment. The German declaration was submitted for the purpose of addressing the final rejection of claims 6, 12-15, 23, 24, 38, 41, 42, and 66.

As an initial matter, claims 1, 2, 5, 6, 7, 13, 15, 39, 40, 41, 42, 49, and 50 have been held invalid in a District Court decision in which appeals have been dismissed in a decision by the Federal Circuit.[2] These claims are thus no longer under consideration in the reexamination, which continues as to any remaining claims being examined; i.e., claims 12, 14, 23, 24, and 38.[3] As these claims are no longer under reexamination, they may not now be amended.

Patent owner has not identified how the amendment is a *bona fide* effort towards an efficient resolution of the substantial new question of patentability raised in the proceeding sufficient to outweigh the delay in the proceedings to consider the amendment. The proposed amendment would add an "unjacketed" limitation to claims 1 and 39. However, since these claims are under

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[2] *Delta Frangible Ammunition v. Sinterfire*, 2010-1170, -1182 (Fed. Cir. 2010), dismissing the outstanding appeals from *Delta Frangible Ammunition v. Sinterfire*, Civil Action No. 06-cf-1477 (W.D.P.A. September 30, 2009) (holding claims 1, 2, 5, 6, 7, 13, 15, 39, 40, 41, 42, 49, and 50 invalid).

[3] *See* MPEP 2286 (IV).

a final holding of invalidity,[4] these claims may now not be amended. Even were the petition granted, the amendment could not be entered, as it acts to amend claims 1 and 39, which are under a final holding of invalidity and are not subject to amendment. With respect to the proposed amendment to add "unjacketed" to the specification, even if such an addition does not constitute new matter, such an addition would not advance the prosecution because such a limitation does not appear in any of the claims currently pending. As the proposed amendment to the claims may not be entered as discussed above, the proposed amendment to the specification fails to address any of the outstanding rejections of the currently pending claims. Under the facts and circumstances of this reexamination proceeding, reopening of the prosecution to consider this amendment would not advance the prosecution towards issuance of a reexamination certificate or simplify matters for appeal.

Consideration of such amendments after the close of prosecution would here result in delay of the reexamination proceeding contrary to the mandate of special dispatch. It is also to be noted that, following the adverse decision of the Federal Circuit, before the decision became final, patent owner could have filed a reissue application in an effort to correct the patent narrowing the claims through the inclusion of the "unjacketed" limitation. The filing of a reissue application is the appropriate vehicle for correction of an error in a patent, and such a filing of a reissue application would still permit the reexamination to proceed with special dispatch in resolving the substantial new question of patentability in the reexamination.

The Serven declaration submitted with the petition is directed towards supporting the contention that amending claims 1 and 39 to include an "unjacketed" limitation would not constitute new matter.[5] However, since applicant cannot amend claims 1 and 39 to include the "unjacketed" limitation, because these claims are under a final holding of invalidity,[6] evidence supporting its support in the specification would not have any effect on the reexamination proceeding. Therefore, entry of this declaration would not act to resolve any outstanding issues in the proceeding, and thus would not advance the prosecution towards issuance or simplify matters for appeal.

The German declaration submitted with the petition is directed towards supporting patent owner's contention that the obviousness rejection of claims 6, 12-15, 23, 24, 38, 41, 42, and 66 was not proper.[7] With respect to this contention, claims 6, 13, 15, 41, and 42 are under a final holding of invalidity;[8] furthermore, applicant's amendment would cancel claim 66. Furthermore, it is also noted that the District Court for the Western District of Pennsylvania reviewed testimony from the declarant, Dr. Randall German, and nonetheless held that claims 13 and 15 were anticipated or obvious over the prior art.[9] The remaining claims, claims 12, 14, 23, 24, and 38 are directed towards specific composition ranges. These specific composition ranges are not

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[4] *Delta Frangible Ammunition v. Sinterfire*, 2010-1170, -1182 (Fed. Cir. 2010), dismissing the outstanding appeals from *Delta Frangible Ammunition v. Sinterfire*, Civil Action No. 06-cf-1477 (W.D.P.A. September 30, 2009).
[5] Petition at 7.
[6] *Id.*
[7] Petition at 8.
[8] *Id.*
[9] *Delta Frangible Ammunition v. Sinterfire*, Civil Action No. 06-cf-1477 (W.D.P.A. September 30, 2009), Memorandum Order at 2.

addressed by the declaration so as to support a finding that these claims would be patentable despite the invalidity of the claims from which they depend. Therefore, regardless of the merits of the arguments supported by the declaration, entry of this declaration would not act to resolve any outstanding issues in the proceeding, and thus would not advance the prosecution towards issuance of a reexamination certificate or simplify matters for appeal.

With respect to the proposed cancellation of claims 49-66, such cancellation may be effected by amendment pursuant to 37 C.F.R. § 41.63(a), so long as the cancellation does not affect the scope of any other pending claim in the proceeding. There is therefore no need to reopen prosecution to permit patent owner to cancel these claims, which could have been done through a separate amendment after final rejection, and which may be done through a separate amendment at the current time.

For these reasons, reopening of prosecution to consider the proposed amendment and evidence would not advance the prosecution towards issuance of a reexamination certificate or simplify matters for appeal. Therefore, the interests of special dispatch preclude reopening of prosecution at this stage of the proceeding.

Furthermore, patent owner's petition does not present reasons, nor do facts of this proceeding make plain, 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 amendment and evidence submissions are alleged to be responsive to anticipation and obviousness rejections over the applied Slater, Woodworth, and ASM Handbook references. However, these rejections were first made in the original Office action and later were repeated in the final Office action. Since patent owner was notified in the first Office action that the claims at issue were rejected as anticipated and/or made obvious over the applied Slater, Woodworth, and ASM Handbook references, the issue arose at a point of the prosecution such that patent owner had an opportunity to address the issue prior to the final Office action. The proposed amendments are not in response to newly raised issues; rather, the amendments address issues that have been present since the first Office action.[10] As stated by patent owner in the instant petition, patent owner chose to delay submission of the amendments until after a related court proceeding was decided adverse to patent owner.[11] Patent owner thus 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. Similarly, patent owner failed to submit evidence at the earliest possible point of the prosecution, 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.

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

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[10] With respect to petitioner's contention that the final rejection contained an examiner's discussion of patent owner's arguments such that this constituted a reason for submitting an amendment after the final rejection, the examiner's comments were limited to addressing patent owner's arguments and did not introduce any new grounds of rejection or interpretations relevant to the rejection of the patent claims by the art. *See* the Office decision of March 23, 2010, dismissing patent owner's petition under 37 C.F.R. § 1.181.

[11] *See* petition at 8, first paragraph.

with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances of the instant proceeding, the petition is dismissed.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

May 12, 2010
Kenpet8

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.
90/009,290	10/01/2008	6607695	100858.0137	3833

27557 7590 06/11/2010

BLANK ROME LLP
WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Peter S. Weissman
Blank Rome LLP
Watergate
600 New Hampshire Ave. N.W.
Washington, D.C. 20037-2485

For Patent Owner

MAILED

JUN 11 2010

CENTRAL REEXAMINATION UNIT

Ex Parte Vellutato
Reexamination Proceeding
Control No. 90/009,290
Filed: October 1, 2008
For: US Patent No. 6,607,695

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

This is a decision on the petition filed June 3, 2010 to request a one-month extension of time pursuant to 37 CFR 1.550(c) for submitting an Appeal Brief. The Appeal Brief is currently due on June 15, 2010.

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

The petition is granted for two (2) weeks for the reasons set forth below.

Decision

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

37 CFR 1.550 (c) states:

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

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

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

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

The petition for extension of time states that the advisory action dated May 26, 2010 did not address the rejection of claims 8 and 12 under 35 USC 112, 1st paragraph that was argued in the amendment after final. Patent Owner states that a telephone message was left for the examiner inquiring about the status of these claims and that the examiner in turn left a telephone message stating she would issue a statement to withdraw the rejection of claims 8 and 12 under 35 USC 112, 1st paragraph. This information is necessary in preparing the brief. An extension for one (1) month is requested.

Analysis and Findings

A review of the record fails to show any documentation of a telephone interview during which an agreement was made to withdraw the rejection of claims 8 and 12 under 35 USC 112, 1st paragraph. The advisory action mailed May 26, 2010 clearly indicates this rejection was not overcome. No additional time is needed by the Office to address this issue; however, in the interest of providing the Patent Owner with a fair opportunity to present an argument against the rejections of record and in consideration of the requirement of 35 USC 305 that this proceeding

be handled with special dispatch, Patent Owner's showing is adequate to justify the grant of a two-week extension of time in which to file a Brief. Accordingly, the period of time for filing the Brief is extended to June 29, 2010. 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 of one month in which to file an Appeal Brief is **granted for two (2) weeks**.

2. The Patent Owner's Appeal Brief is due on June 29, 2010.

3. Response may be submitted as follows:

By EFS: See 37 CFR 1.8(a)(C)(ii)

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

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

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

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

/Deborah Jones/,
SPE, Art Unit 3991
Central Reexamination Unit

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BERENATO, WHITE, & STAVISH
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6650 ROCK SPRING DRIVE
BETHESDA, MD 20817

(For Patent Owner)

MAILED

JUL 24 2009

CENTRAL REEXAMINATION UNIT

JAMES J. FOSTER
WOLF, GREENFIELD, & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211

(For Requesters)

Ex parte Reexamination Proceeding
Control No. 90/009,292
Filed: October 2, 2008
For: U.S. Patent No. 7,220,022

Inter Partes Reexamination Proceeding
Control No. 95/000,425
Filed: December 23, 2008
For: U.S. Patent No. 7,220,022

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,220,022 (the '022 patent) issued to Allen *et al.* on May 22, 2007.

2. A request for *ex parte* reexamination of claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent was filed on October 2, 2008, by third party requester James J. Foster. The resulting reexamination proceeding was assigned control number 90/009,292 (the '9292 *ex parte* proceeding).

3. A request for *inter partes* reexamination of claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent was filed on December 23, 2008, by third party requester New England Pottery, the real party in interest, and the request was assigned control number 95/000,425 (the '425 *inter partes* proceeding).

4. On October 30, 2008, *ex parte* reexamination was ordered for claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability affecting these claims.

5. On February 17, 2009, *inter partes* reexamination was ordered for claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent based on the examiner's determination that the December 23, 2008 request raised a substantial new question of patentability affecting these claims.

6. There has been no further Office action in either the '425 *inter partes* proceeding or the '9292 *ex parte* proceeding. The time period for filing a patent owner's statement in the '9292 *ex parte* proceeding has expired.

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 '9292 and the '425 reexamination proceedings are currently pending. An order granting reexamination of claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent owner's statement has expired in the '9292 *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 95/000,425 and 90/009,292 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,387 and 90/010,207 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, New England Pottery LLC has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 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. 95/000,425 and *ex parte* Reexamination Control No. 90/009,292 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,293	10/03/2008	6242830	10695.005.00	4935

38834 7590 12/11/2009

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

Date:

MAILED

DEC 1 : 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009293
PATENT NO. : 6242830
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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,401	02/06/2009	6,242,830	10695.005.00	1820

38834 7590 12/11/2009

EXAMINER	
ART UNIT	PAPER NUMBER

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

DATE MAILED: 12/11/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SONG K. JUNG
McKENNA LONG & ALDRIDGE
1900 K STREET, N.W.
WASHINGTON, DC 20006

Date:

MAILED

DEC 11 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009401
PATENT NO. : 6242830
ART UNIT : 3992

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

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MAILED

DEC 1 : 2009

CENTRAL REEXAMINATION UNIT

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2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037

MCKENNA LONG & ALDRIDGE LLP (For Third Party Requester)
1900 K STREET, NW
WASHINGTON, DC 20006

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP (Courtesy Copy)
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON DC 20036

In re Katagiri	: DECISION *SUA SPONTE*
Reexamination Proceeding	: MERGING
Control No. 90/009,293	: REEXAMINATION
For: U.S. Patent No. 6,242,830	: PROCEEDINGS
In re Katagiri	:
Reexamination Proceeding	:
Control No. 90/009,401	:
For: U.S. Patent No. 6,242,830	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,242,830 (hereinafter, the '830 patent), issued to Katagiri, on June 5, 2001.

2. On October 3, 2008, a request for *ex parte* reexamination of the '830 patent was filed. The reexamination proceeding was assigned Control No. 90/009,293 (hereinafter, the '9293 proceeding).

3. On December 30, 2008, the reexamination order granting the request in the '9293 proceeding was mailed. In response to a non-final rejection, claims 20-79 were added.

4. On February 6, 2009, a third party deposited a request for *ex parte* reexamination of the '830 patent. The reexamination proceeding was assigned Control No. 90/009,401 (hereinafter, the '9401 proceeding).

5. On April 14, 2009, the reexamination order granting the request in the '9401 proceeding was mailed. In response to a non-final rejection, claims 20-61 were added.

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 '9293 and '9401 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, new claims have been added. 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 each proceeding, 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.

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 '830 patent file is that of

SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037

As a courtesy, this decision is being mailed to the address of

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON DC 20036

in view of the February 11, 2009 Power of Attorney and the February 18, 2009 Notice of Acceptance of Power of Attorney present in the file of the '9293 reexamination proceeding.

The address of
SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037

, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '830 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. Reexamination Control Nos. 90/009,293 and 90/009,401 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, Central Reexamination Unit, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SEP 16 2009

CENTRAL REEXAMINATION UNIT

VISTA PRINT USA, INC. (For Patent Owner)
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON MA 02421

SHUMAKER & SIEFFERT, P. A. (For Third Party Requester)
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

In re Jecha *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/009,295	: MERGING
Corrected Request Deposited: November 14, 2008	: REEXAMINATION
For: U.S. Patent No. 6,247,011	: PROCEEDINGS
In re Jecha *et alia*	:
Reexamination Proceeding	:
Control No. 90/009,315	:
Corrected Request Deposited: February 11, 2009	:
For: U.S. Patent No. 6,247,011	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,247,011 (hereinafter, the '011 patent), issued to Jecha *et alia*, on June 12, 2001.

2. On November 14, 2008, patent owner deposited a corrected Request for *Ex Parte* Reexamination of the '011 patent. The reexamination proceeding was assigned Control No. 90/009,295 (hereinafter, the '9295 proceeding).

3. The Reexamination Order was granted in the '9295 proceeding on February 12, 2009.

4. There are currently no amendments in the '9295 proceeding.

5. On February 11, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '634 patent. The reexamination proceeding was assigned Control No. 90/009,315 (hereinafter, the '9315 proceeding).

6. The Reexamination Order was granted in the '9315 proceeding on May 5, 2009.

7. There are currently no amendments in the '9315 proceeding.

8. The '9295 and '9315 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 '9295 and the '9315 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. 90/009,295 and 90/009,315 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first 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
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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SEP 16 2009

CENTRAL REEXAMINATION UNIT

VISTA PRINT USA, INC. (For Patent Owner)
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON MA 02421

SHUMAKER & SIEFFERT, P. A. (For Third Party Requester)
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

In re Jecha *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/009,296	: MERGING
Corrected Request Deposited: November 14, 2008	: REEXAMINATION
For: U.S. Patent No. 6,631,375	: PROCEEDINGS
In re Jecha *et alia*	:
Reexamination Proceeding	:
Control No. 90/009,313	:
Corrected Request Deposited: March 23, 2009	:
For: U.S. Patent No. 6,631,375	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,631,375 (hereinafter, the '375 patent), issued to Jecha *et alia*, on October 7, 2003.

2. On November 14, 2008, patent owner deposited a corrected Request for *Ex Parte* Reexamination of the '375 patent. The reexamination proceeding was assigned Control No. 90/009,296 (hereinafter, the '9296 proceeding).

3. The Reexamination Order was granted in the '9296 proceeding on February 12, 2009.

4. There are currently no amendments in the '9296 proceeding.

5. On March 23, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '375 patent. The reexamination proceeding was assigned Control No. 90/009,313 (hereinafter, the '9313 proceeding).

6. The Reexamination Order was granted in the '9313 proceeding on June 11, 2009.

7. There are currently no amendments in the '9313 proceeding.

8. The '9296 and '9313 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 '9296 and the '9313 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. 90/009,296 and 90/009,313 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first 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
SPE, AU 3992

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.
90/009,303	10/14/2008	5164444		9182

7590 07/06/2009

CHRISTIE, PARKER & HALE
P.O. BOX 7068
PASADENA, CA 91109-7068

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/06/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WATARU SHIMOKAWA
2858-2 KAWAGUCHI-MACHI, HACHIOJI-SHI
TOKYO, 193-0801
JAPAN

Date:
MAILED
JUL 06 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009303
PATENT NO. : 5164444
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
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Alexandria, VA 22313-1450
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JUL 06 2009

CENTRAL REEXAMINATION UNIT

John D. Carpenter
Christie Parker & Hale LLP
P.O. Box 7068
Pasadena, CA 91109-7068

for Patent Owner

Wataru Shimokawa
2858-2 Kawaguchi-Machi, Hachioji-Shi
Tokyo, 193-0801
Japan

for Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,303
Filed: October 14, 2008
For: US Patent No. 5,164,444

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

This is a decision on the petitions filed June 28, 2009 to request a two-week extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated May 7, 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 extension of time in which to file a response to the Office action dated May 7, 2009, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

37 CFR 1.550 (c) states:

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

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

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

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

These petitions for extensions of time state that Patent Owner had determined that substantial assistance from counsel is necessary to prepare a complete response to the outstanding Office action. Additional time is needed for counsel to review and prepare an adequate 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 adequate to justify the grant of a two-week 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 May 7, 2009 is extended to run two months and two weeks from the date of the Office action and is due on July 21, 2009. Patent Owner should expect that future requests for extensions will not be granted.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated May 7, 2009 is **granted** for two weeks.

2. The Patent Owner's response is due July 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

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 AU 3991
Central Reexamination Unit

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.
90/009,306	10/20/2008	6415831	0275A-400028	9326

7590 10/02/2009

EXAMINER	

Adan Ayala, Esq.
THE BLACK & DECKER CORP.
701 East Joppa Road
Towson, MD 21286

ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Adan Ayala, Esq.
The Black & Decker Corporation
701 East Joppa Road
Towson, MD 21286

(For Patent Owner)

MAILED

OCT 02 2009

CENTRAL REEXAMINATION UNIT

In re Ayala et al
Ex Parte Reexamination Proceeding
Control No. 90/009,306
Filed: October 20, 2008
For: U.S. Patent No. 6,415,831

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the September 18, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the September 18, 2009 patent owner petition to revive").

The September 18, 2009 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been received.

SUMMARY

The September 18, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) . . . A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional . . .

*

*

(d) *Terminal Disclaimer.*

*

*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

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

Abandonment for Failure To Reply to a Non-Final Action

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:

(A) an argument or an amendment under 37 CFR 1.111 . . .

The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be bona fide. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period . . . for correction of the error or omission.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on

November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response[1] to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. The patent owner has submitted a response to the June 19, 2009 nonfinal Office action, and a petition fee under 37 CFR 1.17(m), with the present September 18, 2009 patent owner petition, which satisfy items (1)[2] and (2), respectively. A proper statement under 37 CFR 1.137(b)(3) has also been submitted with the September 18, 2009 petition, which satisfies item (3).

Accordingly, the September 18, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[3] is **granted**.

CONCLUSION

- The September 18, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for processing of the patent owner amendment/response to the June 19, 2009 nonfinal Office action.

---

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

[2] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (a). Note that **the grant of a petition under 37 CFR 1.137 is not a determination that any response is complete. Where the proposed response is to a non-final Office action, the petition may be granted if the response appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.**

[3] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.111, to the nonfinal Office action.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, of CRU Art Unit 3993, at (571) 272-7116.

- Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7724.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

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.
90/009,306	10/20/2008	6415831	0275A-400028	9326

7590 06/14/2010

EXAMINER	

Adan Ayala, Esq.
THE BLACK & DECKER CORP.
701 East Joppa Road
Towson, MD 21286

ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2010

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

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Adan Ayala, Esq.
The Black & Decker Corp.
701 East Joppa Road
Towson, MD 21286

MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

In re Adan Ayala et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/009,306 : **DISMISSING**
Filed: October 20, 2008 : **PETITION UNDER**
For: U.S. Patent No. 6,415,831 : **37 CFR 1.137(b)**

This is a decision on the April 21, 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 April 21, 2010 patent owner petition to revive").

The appropriate petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the April 21, 2010 patent owner petition to revive has been paid.

The April 21, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The April 21, 2010 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

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[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of January 29, 2010.

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:

(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 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 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 present proceeding is a reexamination proceeding; thus, the April 21, 2010 petition does not require a terminal disclaimer.[2]

The April 21, 2010 petition satisfies only two of the three criteria required under 37 CFR 1.137(b).

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the April 21, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), however, the criterion of submitting the requisite response required by the outstanding final Office action has not been satisfied.

Specifically, the instant reexamination proceeding was terminated due to the failure to timely submit a response to the January 29, 2010 final Office action pursuant to 37 CFR 1.550(b). In a reexamination proceeding terminated for failure to reply to a final Office action, the reply required for consideration of a petition to revive must be (i) 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

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[2] *See*: 37 CFR 1.137(d)(3).

certificate by making all pending claims patentable or (ii) a Notice of Appeal and appeal fee.[3]

Patent owner submitted a paper titled "Amendment" on April 21, 2010. The primary examiner for the instant reexamination proceeding has confirmed that the April 21, 2010 response neither cancels all the rejected claims nor otherwise *prima facie* places the proceeding in condition for issuance of a reexamination certificate by making all pending claims patentable (in the event that the present proceeding would be restored to pendency). In addition, the Image File Wrapper record for the instant reexamination proceeding reveals that a Notice of Appeal has not been filed. Therefore, the April 21, 2010 petition is incomplete.

For the foregoing reasons, the April 21, 2010 patent owner petition to revive is **dismissed**.

CONCLUSION

1. The April 21, 2010 patent owner petition under 37 CFR 1.137(b) is **dismissed**.

2. For a grantable petition under 37 CFR 1.137(b), it is required that patent owner provide a proper reply to the January 29, 2010 final Office action and/or a Notice of Appeal and appeal fee. Any such submission(s) should include a cover letter titled "Renewed Petition Under 37 CFR 1.137(b)."

3. Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. An extension of time to file a request for reconsideration may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings. The reconsideration request should include a cover letter titled "Renewed Petition under 37 CFR 1.137(b)."

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, of CRU Art Unit 3993, at (571) 272-7116.

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

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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Fulwider Patton LLP
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(For Patent Owner)

MAILED

MAY 20 2009

Pillsbury Winthrop Shaw Pittman LLP
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McLean, VA 22102

(For 3rd Party Requester) CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/007,878
Filed : January 17, 2006
For U.S. Patent No. : 5,514,154

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/008,865
Filed : October 4, 2007
For U.S. Patent No. : 5,514,154

Reexam control No.: 90/009,309
Filed : October 24, 2008
For U.S. Patent No. : 5,514,154

The above noted reexamination proceedings, all filed by the same third party requester, are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

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

Reexamination in application control No. 90/007,878 was ordered in a decision mailed February 14, 2006, indicating that claims 1-23, all of the claims in the patent, would be reexamined. A non-final Office action was mailed December 21, 2006. A timely response to the Office action was received March 23, 2007. A number of Information Disclosure Statements and Submissions under 37 CFR 1.565 were filed subsequent to the March 23, 2007 response. The response made no changes to the specification, drawings, and/or claims.

Reexamination in application control No. 90/008,865 was ordered in a decision mailed November 26, 2007, indicating that claims 1, 3, 4, and 8-11 would be reexamined. No patent owner's statement was filed in this proceeding.

In a decision mailed January 31, 2008, reexamination proceedings 90/007,878 and 90/008,865 were merged. The decision indicated that claims 1-23, all of the claims in the patent, would be reexamined. A non-final Office action was mailed June 30, 2008. A request for extension of time was received July 11, 2008 and granted in a decision mailed July 22, 2008, extending the period for response up to and including September 30, 2008. On October 2, 2008 an amendment was filed with a certificate of mailing dated September 30, 2008. On March 18, 2009 an Information Disclosure Statement was filed. The amendment of October 2, 2008 made no changes to the specification, drawings and/or claims. No Office action has been prepared that is responsive to the October 2, 2008 amendment.

Reexamination in application control 90/009,309 was ordered in a decision mailed December 12, 2008, indicating that claims 4 and 12 would be reexamined. No patent owner's statement was filed in this proceeding. An Information Disclosure Statement was filed March 18, 2009. No changes to the specification, drawings and/or claim have been made in this proceeding. No Office action has been issued in this proceeding since the mailing of the decision granting reexamination.

As evidenced by the above facts, reexamination control No. 90/007,878, reexamination control No. 90/008,865, and reexamination control No. 90/009,309 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

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

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-23, all of the patent claims, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to each of the three reexaminations. All papers issued by the Office will contain the identifying data for each of the cases, and each action will be entered into each of the files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example,

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

Conclusion

Reexamination Control Nos. 90/007,878, 90/008,865, and 90/009,309 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination unit for issuance of an Office action.

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

Gregory Morse,
Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

VISTA PRINT USA, INC. (For Patent Owner)
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON MA 02421

SHUMAKER & SIEFFERT, P. A. (For Third Party Requester)
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

In re Jecha *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/009,296	: MERGING
Corrected Request Deposited: November 14, 2008	: REEXAMINATION
For: U.S. Patent No. 6,631,375	: PROCEEDINGS
	:
In re Jecha *et alia*	:
Reexamination Proceeding	:
Control No. 90/009,313	:
Corrected Request Deposited: March 23, 2009	:
For: U.S. Patent No. 6,631,375	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,631,375 (hereinafter, the '375 patent), issued to Jecha *et alia*, on October 7, 2003.

2. On November 14, 2008, patent owner deposited a corrected Request for *Ex Parte* Reexamination of the '375 patent. The reexamination proceeding was assigned Control No. 90/009,296 (hereinafter, the '9296 proceeding).

3. The Reexamination Order was granted in the '9296 proceeding on February 12, 2009.

4. There are currently no amendments in the '9296 proceeding.

5. On March 23, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '375 patent. The reexamination proceeding was assigned Control No. 90/009,313 (hereinafter, the '9313 proceeding).

6. The Reexamination Order was granted in the '9313 proceeding on June 11, 2009.

7. There are currently no amendments in the '9313 proceeding.

8. The '9296 and '9313 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 '9296 and the '9313 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. 90/009,296 and 90/009,313 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first 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
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,314	03/23/2009	7120634	1117-0010001	6635

37420 7590 09/15/2009

VISTA PRINT USA, INC.
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EXAMINER	
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DATE MAILED: 09/15/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,314	03/23/2009	7120634	1117-0010001	6635

37420 7590 09/15/2009

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2009

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CENTRAL REEXAMINATION UNIT

VISTA PRINT USA, INC.
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(For Patent Owner)

SHUMAKER & SIEFFERT, P. A.
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WOODBURY, MN 55125

(For Third Party Requester)

In re Jecha *et alia*
Reexamination Proceeding
Control No. 90/009,287
Request Deposited: October 3, 2008
For: U.S. Patent No. 7,120,634

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Jecha *et alia*
Reexamination Proceeding
Control No. 90/009,314
Corrected Request Deposited: March 23, 2009
For: U.S. Patent No. 7,120,634

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. 7,120,634 (hereinafter, the '634 patent), issued to Jecha *et alia*, on October 10, 2006.

2. On October 3, 2008, patent owner deposited a Request for *Ex Parte* Reexamination of the '634 patent. The reexamination proceeding was assigned Control No. 90/009,287 (hereinafter, the '9287 proceeding).

3. The Reexamination Order was granted in the '9287 proceeding on December 18, 2008.

4. There are currently no amendments in the '9287 proceeding.

5. On March 23, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '634 patent. The reexamination proceeding was assigned Control No. 90/009,314 (hereinafter, the '9314 proceeding).

6. The Reexamination Order was granted in the '9314 proceeding on June 5, 2009.

7. There are currently no amendments in the '9314 proceeding.

8. The '9287 and '9314 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 '9287 and the '9314 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. 90/009,287 and 90/009,314 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first 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
SPE, AU 3992

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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WOODBURY, MN 55125

(For Third Party Requester)

In re Jecha *et alia*
Reexamination Proceeding
Control No. 90/009,295
Corrected Request Deposited: November 14, 2008
For: U.S. Patent No. 6,247,011

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Jecha *et alia*
Reexamination Proceeding
Control No. 90/009,315
Corrected Request Deposited: February 11, 2009
For: U.S. Patent No. 6,247,011

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,247,011 (hereinafter, the '011 patent), issued to Jecha *et alia*, on June 12, 2001.

2. On November 14, 2008, patent owner deposited a corrected Request for *Ex Parte* Reexamination of the '011 patent. The reexamination proceeding was assigned Control No. 90/009,295 (hereinafter, the '9295 proceeding).

3. The Reexamination Order was granted in the '9295 proceeding on February 12, 2009.

4. There are currently no amendments in the '9295 proceeding.

5. On February 11, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '634 patent. The reexamination proceeding was assigned Control No. 90/009,315 (hereinafter, the '9315 proceeding).

6. The Reexamination Order was granted in the '9315 proceeding on May 5, 2009.

7. There are currently no amendments in the '9315 proceeding.

8. The '9295 and '9315 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 '9295 and the '9315 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. 90/009,295 and 90/009,315 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first 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
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,318	11/05/2008	5404505	X35582	6023

22913 7590 10/20/2009

Workman Nydegger
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/20/2009

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MAILED

OCT 20 2009

CENTRAL REEXAMINATION UNIT

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In re Frank H. Levinson :
Ex Parte Reexamination Proceeding :
Control No. 90/008,282 :
Filed: October 5, 2006 :
For: U.S. Patent No. 5,404,505 :
:
In re Frank H. Levinson : **DECISION**
Ex Parte Reexamination Proceeding : **GRANTING**
Control No. 90/008,408 : **PETITION UNDER**
Filed: January 12, 2007 : **37 CFR 1.137(b)**
For: U.S. Patent No. 5,404,505 :
:
In re Frank H. Levinson :
Ex Parte Reexamination Proceeding :
Control No. 90/008,807 :
Filed: August 1, 2007 :
For: U.S. Patent No. 5,404,505 :

In re Frank H. Levinson :
Ex Parte Reexamination Proceeding :
Control No. 90/009,318 :
Filed: November 5, 2008 :
For: U.S. Patent No. 5,404,505 :

This is a decision on the July 15, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Patent Owner's Statement of Interview and revive the present terminated merged reexamination ("the July 15, 2009 patent owner petition to revive").[1]

The July 15, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

The July 15, 2009 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

---

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the merged prosecution in this instance, the merged prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file the written statement of interview required under 37 CFR 1.560(b) for the interview of May 20, 2009.

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

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

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *
>
> (d) *Terminal disclaimer.*
>
> > *
> > *
> >
> > (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

> (d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.
>
> (e) If a response by the patent owner is not timely filed in the Office,
>
> > *
> > *
> >
> > (2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 1.560(b) provides:

> In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as

warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the July 15, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this merged reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the May 20, 2009 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the

statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until July 15, 2009, which was untimely. For the purpose of evaluating whether the July 15, 2009 patent owner petition to revive is a grantable petition, the submission of the statement under 37 CFR 1.560(b) on July 15, 2009, satisfies item (1).

Accordingly, the July 15, 2009 patent owner petition to revive is **granted**.

Because the present merged reexamination proceeding is revived, all proceeding papers that would have been proper but for the unintentional termination, including the October 9, 2009 final Office action, are hereby ratified. The mailing date of the October 9, 2009 final Office action is, accordingly, the mailing date of this decision.

PATENT OWNER'S CORRESPONDENCE ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 5,404,505 patent file is that of Workman Nydegger, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, UT 84111.

As a courtesy, this decision is being mailed to the address of Morgan, Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Suite 700, Palo Alto, CA 94306, in view of the Powers of Attorney present in the files of the merged reexamination proceeding.

The address of Workman Nydegger, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, UT 84111, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '505 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The July 15, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this merged reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for processing of the July 15, 2009 Patent Owner's Statement of Interview.

3. All proceeding papers that would have been proper but for the unintentional termination, including the October 9, 2009 final Office action, are ratified. The mailing date of the October 9, 2009 final Office action is accordingly, the mailing

date of this decision. Accordingly, a response to the October 9, 2009 final Office action is due two (2) months from the mailing date of this decision.

4. The address of Workman Nydegger, 1000 Eagle Gate Tower, 60 East South Temple, Salt Lake City, UT 84111, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '505 patent file is made in accordance with 37 CFR 1.33(c).

5. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Majid A. Banankhah, of CRU Art Unit 3992, at (571) 272-3770.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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MAY 12 2009

CENTRAL REEXAMINATION UNIT

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(90/010,354)

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(90/009,319)

Reexam Control No.: 90/010,354
Filed : December 1, 2008
For U.S. Patent No. : 5,485,827

Reexam Control No.: 90/009,319
Filed : January 15, 2009
For U.S. Patent No. : 5,485,827

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. 90/010,354 was ordered in a decision mailed February 24, 2009, indicating that claims 1-14 and 25-29 would be reexamined. No patent owner statement was filed in response to the decision granting reexamination that was mailed February 24, 2009. A number of Information Disclosure Statements were filed May 1, 2009. No Office action has been issued in this proceeding. No changes to the specification, claims and/or drawings have been made in made in this proceeding.

Reexamination in application control No. 90/009,319 was ordered in a decision mailed February 20, 2009, indicating that claims 1-18, and 25-29 would be reexamined. No patent owner statement was filed in response to the decision granting reexamination that was mailed February 20, 2009. An Information Disclosure Statement was filed May 1, 2009. No Office action has been issued in this proceeding. No changes to the specification, claims and/or drawings have been made in made in this proceeding.

As evidenced by the above facts, reexamination control No. 90/010,354 and reexamination control No. 90/009,319 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 1-18, and 25-29 will be reexamined in this merged proceeding. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and each requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/010,354 and 90/009,319 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.
90/009,319	01/15/2009	5485827	99461.0001	1846

26161 7590 09/04/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/04/2009

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

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SEP 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009319
PATENT NO. : 5485827
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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Ex Parte Reexamination Proceeding
Control No. 90/010,354
Filed: December 1, 2008
For: U.S. Patent No. 5,485,827

Ex parte Reexamination Proceeding
Control No. 90/009,319
Filed: January 15, 2009
For: U.S. Patent No. 5,485,827

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

This is a decision on the petition filed August 21, 2009 requesting withdrawal of the non-final Office action mailed July 30, 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 August 21, 2009 is denied with respect to withdrawal of the July 30, 2009 Office action.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,485,827 (hereinafter, the '827 patent), issued to *Zapol et al.*, on January 23, 1996.

2. On November 4, 2008, a third party deposited a request for *ex parte* reexamination of claims 1-18 and 24-29 of the '827 patent. The reexamination proceeding was assigned Control No. 90/009,319 (hereinafter, the '319 proceeding).

3. On December 11, 2008, another third party deposited a request for *ex parte* reexamination of claims 1-14 and 25-29 of the '827 patent. The reexamination proceeding was assigned Control No. 90/010,354 (hereinafter, the '354 proceeding).

4. On December 18, 2008, a decision *sua sponte* vacating the filing date was mailed in the '319 proceeding

5. On January 15, 2009, the third party requested filed a corrected request for reexamination in the '319 proceeding.

6. On February 20, 2009, an order granting reexamination of claims 1-18 and 24-29 was mailed in the '319 proceeding.

7. On February 24, 2009, an order granting reexamination of claims 1-14 and 25-29 was mailed in the '354 proceeding.

8. On May 12, 2009, a decision merging the '319 and '354 proceedings was mailed.

9. On July 30, 2009, a first Office action on the merits was mailed in the merged proceedings.

10. On August 21, 2009, the instant petition was filed.

DECISION

Patent owner is requesting withdrawal of the July 30, 2009 Office action because the examiner incorporated by reference pages 28-33 in the '354 request for reexamination, which included a discussion of the state of the art and the level of knowledge and skill of one of ordinary skill in the art. Specifically, the patent owner alleges that the Office action is not clear (a) if the following five documents are applied against the claim limitations in the rejections and (b) if the Office action is incorporating these documents and not just the discussion found on pages 28-33 in the '354 request for reexamination:

1. The Girard Report
2. The Dinh Xuan Report
3. The Beltramo Report
4. A delivery Note
5. An invoice of sales of NO gas

The patent owner advances that the Office action does not comply with Office policies and procedures because it incorporates a discussion which mentions the above-mentioned five documents, which are not published and/ are not prior art. See pages 2-3 of the petition. The patent owner also argues that the order granting reexamination was improper because of this discussion of the five documents in the request for reexamination in the '354 proceeding. See pages 3-5 of the petition.

37 CFR 1.181 provides for the filing of a petition to invoke supervisory authority of the Director in appropriate circumstances. The Director's review of the request in petition is *de novo*. The review will determine whether the examiner issued an Office action in accordance with Office policies and procedures and that was not arbitrary and capricious. Sufficient reasons must exist to withdraw an Office action because of the statutory mandate of special dispatch for reexamination proceedings. See 35 U.S.C. 305. The review will not address the allegation that the order is improper because such issue was not timely raised. See the discussion below.

Upon review of the record, the statement of the rejections and the explanations for how the references apply to the claim limitations do not include any of the five above-mentioned documents. See, pages 6-15 of the July 30, 2009 Office action and pages 35-79 in the '354 request for reexamination. Therefore, the Office action is clear that none of the above-mentioned five documents are being applied to reject the claims under 35 U.S.C. 103(a).

Because the rejections are made under 35 U.S.C. 103(a), the level of ordinary skill in the art is an important factor in establishing a prima facie showing of obviousness of the claimed invention. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) and also MPEP 2141. The examiner must resolve what the level of ordinary skill is in the pertinent art in making his or her obviousness analysis. Specifically, MPEP 2141 states:

> "The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. Factors that may be considered in determining the level of ordinary skill in the art may include: (1) "type of problems encountered in the art;" (2) "prior art solutions to those problems;" (3) "rapidity with which innovations are made;" (4) "sophistication of the technology; and" (5) "educational level of active workers in the field. In a given case, every factor may not be present, and one or more factors may predominate." *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986); *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983)."

The findings of fact pertaining to the obviousness analysis must be articulated, according to MPEP 2141. The July 30, 2009 Office action articulated such findings of fact, in part, via incorporation by reference of pages 28-33 in the '354 request for reexamination. In reviewing pages 28-33 in the '354 request, this discussion is relevant to the factors identified above, such as the types of problems encountered in the art, prior art solutions to those problems, etc.... For example, pages 28-29 further elaborates on the research

performed by Drs. Higenbottam and Pepke-Zaba, who are authors of references applied against the claim; pages 29-31 discuss the development of the knowledge and understanding of the role that nitric oxide plays in the human body and the dangers of its fast conversion to nitric dioxide; and pages 31-32 discusses prior art devices known to one of ordinary skill in the art to deliver gases, such as Olsson, another reference applied against the claims in rejections. While it is agreed that pages 32-33 do refer to expert reports by Drs. Girard, Dinh Xuan, and Beltramo, a delivery note, and sales receipt, this brief discussion, which mentions the five documents, also provides facts that are relevant to the level of ordinary skill in the relevant art (e.g., Dr. Higenbottam's team's work was known and used by others skilled in the art). These citations to alleged unpublished documents, which are not prior art as defined by 35 U.S.C. 102(a), (b), or (e), are not, by themselves, in violation of Office policies and procedures. "References which do not qualify as prior art because they postdate the claimed invention may be relied upon to show the level of ordinary skill in the art at or around the time the invention was made. *Ex parte Erlich*, 22 USPQ 1463 (Bd. Pat. App. & Inter. 1992)." See MPEP 2124. In summary, pages 28-33 of the '354 request provide facts relevant to the skill and knowledge of one of ordinary skill in the art and what would be considered predictable results by one of ordinary skill in the art.

Therefore, the patent owner has not demonstrated that the July 30, 2009 Office action is not in accordance with Office policies and procedures or that the action was arbitrary and capricious.

In regard to patent owner's question as to whether the above-mentioned five documents are incorporated by reference, the text of the questioned incorporation by reference statement in the July 30, 2009 Office action only incorporates the text present on pages 28-33 of the '354 request for reexamination. The text on pages 32-33 of the '354 request for reexamination only cites to the above-mentioned five documents and does not incorporate by reference those five documents. Mere reference to another document is not an incorporation of anything therein. See *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973) and MPEP 608.01(p). Therefore, the Office action is only incorporating the text on pages 28-33 of the '354 request and not the material in the five above-mentioned documents.

In regard to patent owner's allegation that the order granting reexamination was improper, this ground will not be addressed in this decision because this allegation is untimely raised. 37 CFR 1.181(f) requires that a petition must be filed within two months from the mailing date of the action or notice from which relief is requested. For this ground, the order, mailed February 24, 2009, is the action from which relief is requested. August 21, 2009 is more than two months from February 24, 2009. See MPEP 2246 for more information regarding a petition to vacate the order granting reexamination.

Accordingly, the July 30, 2009 Office action will not be withdrawn because patent owner has not shown that the Office action was not in accordance with Office policies and procedures or that the action was arbitrary and capricious. The time period for response

continues to run from the mailing date of the July 30, 2009 Office action. In summary, the Office action has incorporated the entire text of pages 28-33 in the '354 request for reexamination as evidence of the level of ordinary skill and knowledge in the pertinent art. Any documents cited to therein are not incorporated by reference via the statement made in the July 30, 2009 Office action. Patent owner is reminded, however, that the evaluation of any evidence of nonobviousness submitted will be based upon consideration of the entire record, including evidence of obviousness in the record. See MPEP 716.01(a).

Therefore, in the interest of special dispatch, the petition is denied.

Conclusion

1. The Patent Owner's petition for withdrawal of the July 30, 2009 Office action is **denied**.

2. 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 Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

Gregory Morse
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,324	11/07/2008	6063563	T126 7002	5431

44444 7590 07/30/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/30/2009

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JUL 30 2009

CENTRAL REEXAMINATION UNIT

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC

ATTN: PATENT DOCKETING

P.O. BOX 7037

ATLANTA, GA 30357-0037

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,324*.

PATENT NO. *6063563*.

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./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90009324	11/7/08	6063563	T126 7002

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EXAMINER
BRENDA BRUMBACK

ART UNIT	PAPER
3991	20090729

DATE MAILED:

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BAXTER HEALTHCARE CORPORATION
ONE BAXTER PARKWAY
DF2-2E
DEERFIELD, IL 6001

(for patent owner)

MAILED

JUL 30 2009

CENTRAL REEXAMINATION UNIT

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
ATTN: PATENT DOCKETING
P.O. BOX 7037
ATLANTA, GA 30357-0037

(for requester)

In re Reexamination of USP 6063563
Control No. : 90/009,324
Filed : November 07, 2008
For: **METHOD OF PCR TESTING OF POOLED BLOOD SAMPLES**

: **DECISION ON PETITION**
: **UNDER 37 CFR1.59**

This is a decision on the petition under 37 CFR 1.59(b), filed June 12, 2009 to expunge information from the above identified merged reexamination proceedings.

The petition is granted.

Petitioner requests that documents be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

Patent owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file and is being returned to petitioner (patent owner). A copy of this decision (without the expunged material) is

being sent to both requesters and will be entered in the file.

Telephone inquiries related to this decision should be directed to Deborah Jones, at (571) 272-1535.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,324	11/07/2008	6063563	T126 7002	5431

44444 7590 10/06/2009

BAXTER HEALTHCARE CORPORATION
ONE BAXTER PARKWAY
DF2-2E
DEERFIELD, IL 60015

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOMBLE CARLYLES SANDRIDGE & RICE, PLLC
ATTN: PATENT DOCKETING 32ND FLOOR
P.O. BOX 7037
ATLANTA, GA 30357-0037

Date: MAILED

OCT 06 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009324
PATENT NO. : 6063563
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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DEERFIELD IL 60015

(For Patent Owner)

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OCT 06 2009

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ATTN: PATENT DOCKETING
P.O. BOX 7037
ATLANTA, GA 30357-0037

(For 3rd Party Requester)

CENTRAL REEXAMINATION UNIT

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,324
Filed: November 7, 2008
For: U.S. Patent No.: 5,780,222

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

This is a decision on the July 13, 2009 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed July 13, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,780,222 (the '222 patent) issued on July 14, 1998.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-24 by a third party requester, which was accorded control number 90/009,324 (the '324 proceeding).

3. Prosecution proceeded until, on July 7, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '324 proceeding.

4. The instant petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

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

DECISION

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

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256. This policy states that the submission 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.

In the present instance, the submission satisfies the above-quoted (A) criterion. The instant petition was filed on July 13, 2009, less than one week after the NIRC was mailed, on July 9, 2009. Patent owner has submitted six documents in the information disclosure statement accompanying the instant petition. Five of these documents were submitted in IDS submissions prior to the mailing of the NIRC, in submissions dated June 26, 2009, and June 30, 2009. The sixth document was obtained only on July 2, 2009, as a result of a search based upon a Japanese Patent Office action of June 24, 2009. The patent owner has made the following factual assertions relating to the timeliness of the submission of the documents on the instant IDS submission:

With regard to the first document, the Sankary paper, the paper was first brought to the attention of the patent owner through a June 24, 2009, Japanese Patent Office action, and then submitted to the USPTO on June 26, 2009.

With regard to the second and third documents, the Schottstedt paper and its English language translation, the paper was first brought to the attention of the patent owner through a June 24, 2009, Japanese Patent Office action, and then the English language translation was submitted to the USPTO on June 26, 2009, followed by submission of the original document and its translation on June 30, 2009.

With regard to the fourth and fifth documents, the Imai paper and its English language translation, the paper and its translation were first submitted to the Office in a May 14, 2009 IDS; however, the translation was mis-cited on the IDS. Following discovery of this error by patent owner, the two documents were submitted to the Office, correctly cited, in an IDS dated June 30, 2009.

With regard to the sixth document, the Tuma paper was obtained only on July 2, 2009, as a result of a search based upon a Japanese Patent Office action of June 24, 2009.

Based upon the above facts, the documents were submitted to the Office in a timely manner, based upon the late date of discovery of the documents by the patent owner through foreign patent office documents. Therefore, the petition presents a sufficient explanation of why the information submitted could not have been submitted earlier.

With respect to the second requirement (the (B) criterion), the citation of these documents in a foreign patent office during prosecution of a related Japanese patent application is urged to meet the relevance standard. The references have been mentioned as part of a basis for the rejection for claims in the related Japanese patent application (Sankary), or discovered in the search in the related Japanese patent application but not relied on (Schottstedt and, upon the statement of patent owner, Imai), or resulting from a search based upon the references cited in the search in the related Japanese patent application (Tuma). However, patent owner has not provided an explanation of the relevance of the information submitted with respect to the claimed invention, i.e., the claim limitations, in the reexamination proceeding. It has not been explained what claim limitations are met, and what claim limitations are not. There is no indication as to how any of these references would raise a substantial new question of patentability for at least one claim. An explanation by patent owner is needed before the Office will consider an IDS submission after a NIRC has been mailed - to provide the Office with guidance as to evaluation of the submitted citations, in order to counter-balance the statutory requirement for special dispatch. If the patent owner wants the Office to pull/withdraw the reexamination proceeding from the publication process, the patent owner needs to give the Office sufficient information to enable the Office to address the newly submitted IDS with the special dispatch required by law. The patent owner has not provided such information here. Accordingly, the petition is not granted as to the request for consideration of the IDS papers. [1]

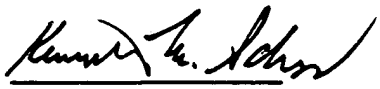
If, however, the patent owner in fact believes that any reference submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s).

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on June 13, 2009.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic file for the proceeding..

3. 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

October 5, 2009

[1]It is also observed that 37 CFR 1.555(c) sets forth "a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding." There is no explanation of how the references are material under the definition set forth by 37 CFR 1.555(b), such that there might be a duty to present the references to the Office at this time.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,324	11/07/2008	6063563	T126 7002	5431

44444 7590 12/01/2009

BAXTER HEALTHCARE CORPORATION
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/01/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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ATTN: PATENT DOCKETING 32ND FLOOR
P.O. BOX 7037
ATLANTA, GA 30357-0037

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009324
PATENT NO. : 6063563
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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CENTRAL REEXAMINATION UNIT

BAXTER HEALTHCARE CORPORATION
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(For Patent Owner)

WOMBLE, CARLYLE, SANDRIDGE, & RICE PLLC
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ATLANTA, GA 30357-0037

(For 3rd Party Requester)

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,324
Filed: November 7, 2008
For: U.S. Patent No.: 5,780,222

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

This is a decision on the October 26, 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 October 26, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,780,222 (the '222 patent) issued on July 14, 1998.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-24 by a third party requester, which was accorded control number 90/009,324 (the '324 proceeding).

3. Prosecution proceeded until, on July 7, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '324 proceeding.

4. A petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

5. The July 13, 2009 petition was dismissed on October 6, 2009.

6. On August 7, 2009, the present proceeding entered the publication cycle.

7. The instant petition was filed on October 26, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except**:
(1) Unpatentability of one of more claims, **which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable**;"

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

have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and, 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. The instant petition was filed on October 26, 2009. Patent owner states that the references were first made known to patent owner on September 30, 2009, and time was needed for translation. Therefore, the petition presents 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, after the present proceeding entered the publication cycle, and it fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, patent owner merely provides a translation of an opposition paper to a European patent having a common parent document to the U.S. '222 patent under reexamination. There are no statements by the patent owner that unequivocally state why the document submitted makes at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim or claims to be patentable.

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 July 7, 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 as to at least one claim under reexamination, the present 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 October 26, 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

November 30, 2009

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.
90/009,324	11/07/2008	6063563	T126 7002	5431

44444 7590 03/04/2010

BAXTER HEALTHCARE CORPORATION
ONE BAXTER PARKWAY
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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ATLANTA, GA 30357-0037

Date:

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009324
PATENT NO. : 6063563
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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CENTRAL REEXAMINATION UNIT

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WOMBLE, CARLYLE, SANDRIDGE, & RICE PLLC
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ATLANTA, GA 30357-0037

(For 3rd Party Requester)

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,324
Filed: November 7, 2008
For: U.S. Patent No.: 5,780,222

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

This is a decision on the December 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 reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

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

BACKGROUND

1. Patent number 5,780,222 (the '222 patent) issued on July 14, 1998.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-24 by a third party requester, which was accorded control number 90/009,324 (the '324 proceeding).

3. Prosecution proceeded until, on July 7, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '324 proceeding.

4. A petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

5. The July 13, 2009 petition was dismissed on October 6, 2009.

6. On August 7, 2009, the present proceeding entered the publication cycle.

7. A petition was filed on October 26, 2009, accompanied by an IDS that the patent owner requested the Office to consider.

8. The October 26, 2009 petition was dismissed by the Office in a decision mailed on December 1, 2009.

9. The instant petition was filed on December 7, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except**:
(1) Unpatentability of one of more claims, **which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable**;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and

printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, **the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A)** a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and, 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.

Patent owner's attention was drawn to this requirement, which is explicitly set forth at MPEP 2256, in the December 1, 2009 Office decision, mailed prior to patent owner's instant petition filed on December 7, 2009.

In the present instance, the submission fails to satisfy the above-noted criteria. The instant petition was filed on December 7, 2009. Patent owner states that the references were first made known to patent owner around October 2009, and time was needed for translation. Therefore, the petition presents 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, after the present proceeding entered the publication cycle, and it fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, patent owner merely provides a translation of an opposition paper to a European patent having a common parent document to the U.S. '222 patent under reexamination. There are no statements by the patent owner that unequivocally state why the document submitted makes at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim or claims to be patentable.

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 July 7, 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 as to at least one claim under reexamination, the present 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 December 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.

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

March 4, 2010

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ATTN: PATENT DOCKETING
P.O. BOX 7037
ATLANTA, GA 30357-0037

In re Reexamination of USP 6566052 :
Control No. : 90/009,325 : **DECISION ON PETITION**
Filed : November 07, 2008 : **UNDER 37 CFR1.59**
For: **EFFICIENT ALGORITHM FOR PCR TESTING OF BLOOD SAMPLES** :

This is a decision on the petition under 37 CFR 1.59(b), filed June 12, 2009 to expunge information from the above identified merged reexamination proceedings.

The petition is granted.

Petitioner requests that documents be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

Patent owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file and is being returned to petitioner (patent owner). A copy of this decision (without the expunged material) is

being sent to both requesters and will be entered in the file.

Telephone inquiries related to this decision should be directed to Deborah Jones, at (571) 272-1535.

Gregory Morse
Director, Central Reexamination Unit

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ATLANTA, GA 30357-0037

(For 3rd Party Requester)

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,325
Filed: November 7, 2008
For: U.S. Patent No.: 6,566,052

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

This is a decision on the July 13, 2009 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed July 13, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,566,052 (the '052 patent) issued on May 20, 2003.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-25 by a third party requester, which was accorded control number 90/009,325 (the '325 proceeding).

3. Prosecution proceeded until, on July 7, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '325 proceeding.

4. The instant petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

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

DECISION

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

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256. This policy states that the submission 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.

In the present instance, the submission satisfies the above-quoted (A) criterion. The instant petition was filed on July 13, 2009, less than one week after the NIRC was mailed, on July 7, 2009. Patent owner has submitted six documents in the information disclosure statement accompanying the instant petition. Five of these documents were submitted in IDS submissions prior to the mailing of the NIRC, in submissions dated June 26, 2009, and June 30, 2009. The sixth document was obtained only on July 2, 2009, as a result of a search based upon a Japanese Patent Office action of June 24, 2009. The patent owner has made the following factual assertions relating to the timeliness of the submission of the documents on the instant IDS submission:

With regard to the first document, the Sankary paper, the paper was first brought to the attention of the patent owner through a June 24, 2009, Japanese Patent Office action, and then submitted to the USPTO on June 26, 2009.

With regard to the second and third documents, the Schottstedt paper and its English language translation, the paper was first brought to the attention of the patent owner through a June 24, 2009, Japanese Patent Office action, and then the English language translation was submitted to the USPTO on June 26, 2009, followed by submission of the original document and its translation on June 30, 2009.

With regard to the fourth and fifth documents, the Imai paper and its English language translation, the paper and its translation were first submitted to the Office in a May 14, 2009 IDS; however, the translation was mis-cited on the IDS. Following discovery of this error by patent owner, the two documents were submitted to the Office, correctly cited, in an IDS dated June 30, 2009.

With regard to the sixth document, the Tuma paper was obtained only on July 2, 2009, as a result of a search based upon a Japanese Patent Office action of June 24, 2009.

Based upon the above facts, the documents were submitted to the Office in a timely manner, based upon the late date of discovery of the documents by the patent owner through foreign patent office documents. Therefore, the petition presents a sufficient explanation of why the information submitted could not have been submitted earlier.

With respect to the second requirement (the (B) criterion), the citation of these documents in a foreign patent office during prosecution of a related Japanese patent application is urged to meet the relevance standard. The references have been mentioned as part of a basis for the rejection for claims in the related Japanese patent application (Sankary), or discovered in the search in the related Japanese patent application but not relied on (Schottstedt and, upon the statement of patent owner, Imai), or resulting from a search based upon the references cited in the search in the related Japanese patent application (Tuma). However, patent owner has not provided an explanation of the relevance of the information submitted with respect to the claimed invention, i.e., the claim limitations, in the reexamination proceeding. It has not been explained what claim limitations are met, and what claim limitations are not. There is no indication as to how any of these references would raise a substantial new question of patentability for at least one claim. An explanation by patent owner is needed before the Office will consider an IDS submission after a NIRC has been mailed - to provide the Office with guidance as to evaluation of the submitted citations, in order to counter-balance the statutory requirement for special dispatch. If the patent owner wants the Office to pull/withdraw the reexamination proceeding from the publication process, the patent owner needs to give the Office sufficient information to enable the Office to address the newly submitted IDS with the special dispatch required by law. The patent owner has not provided such information here. Accordingly, the petition is not granted as to the request for consideration of the IDS papers. [1]

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).

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on June 13, 2009.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic file for the proceeding..

3. 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

August 4, 2009

[1] It is also observed that 37 CFR 1.555(c) sets forth "a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding." There is no explanation of how the references are material under the definition set forth by 37 CFR 1.555(b), such that there might be a duty to present the references to the Office at this time.

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(For 3rd Party Requester)

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,325
Filed: November 7, 2008
For: U.S. Patent No.: 6,566,052

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

This is a decision on the October 26, 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 October 26, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,566,052 (the '052 patent) issued on May 20, 2003.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-25 by a third party requester, which was accorded control number 90/009,325 (the '325 proceeding).

3. Prosecution proceeded until, on July 7, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '325 proceeding.

4. A petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

5. The July 13, 2009 petition was dismissed on August 20, 2009.

6. On August 7, 2009, the present proceeding entered the publication cycle.

7. The instant petition was filed on October 26, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except**:
(1) Unpatentability of one of more claims, **which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable**;"

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

have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and, 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. The instant petition was filed on October 26, 2009. Patent owner states that the references were first made known to patent owner on September 30, 2009, and time was needed for translation. Therefore, the petition presents 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, after the present proceeding entered the publication cycle, and it fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, patent owner merely provides a translation of an opposition paper to a European patent having a common parent document to the U.S. '052 patent under reexamination. There are no statements by the patent owner that unequivocally state why the document submitted makes at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim or claims to be patentable.

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 July 7, 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 to at least one 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 October 26, 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

November 30, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For 3rd Party Requester)

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,325
Filed: November 7, 2008
For: U.S. Patent No.: 6,566,052

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

This is a decision on the December 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 reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

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

BACKGROUND

1. Patent number 6,566,052 (the '052 patent) issued on May 20, 2003.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-25 by a third party requester, which was accorded control number 90/009,325 (the '325 proceeding).

3. Prosecution proceeded until, on July 7, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '325 proceeding.

4. A petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

5. The July 13, 2009 petition was dismissed on August 20, 2009.

6. On August 7, 2009, the present proceeding entered the publication cycle.

7. A petition was filed on October 26, 2009, accompanied by an IDS that the patent owner requested the Office to consider.

8. The October 26, 2009 petition was dismissed by the Office in a decision mailed on December 1, 2009.

9. The instant petition was filed on December 7, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except**:
(1) Unpatentability of one of more claims, **which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable**;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and

printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, **the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A)** a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and, 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.

Patent owner's attention was drawn to this requirement, which is explicitly set forth at MPEP 2256, in the December 1, 2009 Office decision, mailed prior to patent owner's instant petition filed on December 7, 2009.

In the present instance, the submission fails to satisfy the above-noted criteria. The instant petition was filed on December 7, 2009. Patent owner states that the references were first made known to patent owner around October 2009, and time was needed for translation. Therefore, the petition presents 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, after the present proceeding entered the publication cycle, and it fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, patent owner merely provides a translation of an opposition paper to a European patent having a common parent document to the U.S. '052 patent under reexamination. There are no statements by the patent owner that unequivocally state why the document submitted makes at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim or claims to be patentable.

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 July 7, 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 to at least one 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.

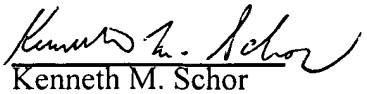
CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on December 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.



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

March 4, 2010

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DF2-2E
DEERFIELD, IL 6001

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC (for requester)
ATTN: PATENT DOCKETING
P.O. BOX 7037
ATLANTA, GA 30357-0037

In re Reexamination of USP 5780222 :
Control No. : 90/009,326 : **DECISION ON PETITION**
Filed : November 07, 2008 : **UNDER 37 CFR1.59**
For: **METHOD OF PCR TESTING OF POOLED BLOOD SAMPLES** :

This is a decision on the petition under 37 CFR 1.59(b), filed June 12, 2009 to expunge information from the above identified merged reexamination proceedings.

The petition is granted.

Petitioner requests that documents be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

Patent owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file and is being returned to petitioner (patent owner). A copy of this decision (without the expunged material) is

being sent to both requesters and will be entered in the file.

Telephone inquiries related to this decision should be directed to Deborah Jones, at (571) 272-1535.

Gregory Morse
Director, Central Reexamination Unit

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ATLANTA, GA 30357-0037

(For 3rd Party Requester)

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,326
Filed: November 7, 2008
For: U.S. Patent No.: 5,780,222

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

This is a decision on the July 13, 2009 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed July 13, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,780,222 (the '222 patent) issued on July 14, 1998.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-10 by a third party requester, which was accorded control number 90/009,326 (the '326 proceeding).

3. Prosecution proceeded until, on July 9, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '326 proceeding.

4. The instant petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

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

DECISION

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

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256. This policy states that the submission 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.

In the present instance, the submission satisfies the above-quoted (A) criterion. The instant petition was filed on July 13, 2009, less than one week after the NIRC was mailed, on July 9, 2009. Patent owner has submitted six documents in the information disclosure statement accompanying the instant petition. Five of these documents were submitted in IDS submissions prior to the mailing of the NIRC, in submissions dated June 26, 2009, and June 30, 2009. The sixth document was obtained only on July 2, 2009, as a result of a search based upon a Japanese Patent Office action of June 24, 2009. The patent owner has made the following factual assertions relating to the timeliness of the submission of the documents on the instant IDS submission:

With regard to the first document, the Sankary paper, the paper was first brought to the attention of the patent owner through a June 24, 2009, Japanese Patent Office action, and then submitted to the USPTO on June 26, 2009.

With regard to the second and third documents, the Schottstedt paper and its English language translation, the paper was first brought to the attention of the patent owner through a June 24, 2009, Japanese Patent Office action, and then the English language translation was submitted to the USPTO on June 26, 2009, followed by submission of the original document and its translation on June 30, 2009.

With regard to the fourth and fifth documents, the Imai paper and its English language translation, the paper and its translation were first submitted to the Office in a May 14, 2009 IDS; however, the translation was mis-cited on the IDS. Following discovery of this error by patent owner, the two documents were submitted to the Office, correctly cited, in an IDS dated June 30, 2009.

With regard to the sixth document, the Tuma paper was obtained only on July 2, 2009, as a result of a search based upon a Japanese Patent Office action of June 24, 2009.

Based upon the above facts, the documents were submitted to the Office in a timely manner, based upon the late date of discovery of the documents by the patent owner through foreign patent office documents. Therefore, the petition presents a sufficient explanation of why the information submitted could not have been submitted earlier.

With respect to the second requirement (the (B) criterion), the citation of these documents in a foreign patent office during prosecution of a related Japanese patent application is urged to meet the relevance standard. The references have been mentioned as part of a basis for the rejection for claims in the related Japanese patent application (Sankary), or discovered in the search in the related Japanese patent application but not relied on (Schottstedt and, upon the statement of patent owner, Imai), or resulting from a search based upon the references cited in the search in the related Japanese patent application (Tuma). However, patent owner has not provided an explanation of the relevance of the information submitted with respect to the claimed invention, i.e., the claim limitations, in the reexamination proceeding. It has not been explained what claim limitations are met, and what claim limitations are not. There is no indication as to how any of these references would raise a substantial new question of patentability for at least one claim. An explanation by patent owner is needed before the Office will consider an IDS submission after a NIRC has been mailed - to provide the Office with guidance as to evaluation of the submitted citations, in order to counter-balance the statutory requirement for special dispatch. If the patent owner wants the Office to pull/withdraw the reexamination proceeding from the publication process, the patent owner needs to give the Office sufficient information to enable the Office to address the newly submitted IDS with the special dispatch required by law. The patent owner has not provided such information here. Accordingly, the petition is not granted as to the request for consideration of the IDS papers. [1]

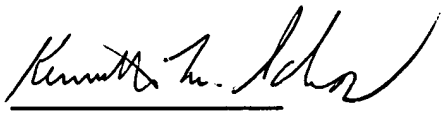
If, however, the patent owner in fact believes that any reference submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s).

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on June 13, 2009.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic file for the proceeding..

3. 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

August 4, 2009

[1] It is also observed that 37 CFR 1.555(c) sets forth "a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding." There is no explanation of how the references are material under the definition set forth by 37 CFR 1.555(b), such that there might be a duty to present the references to the Office at this time.

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(For 3rd Party Requester)

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,326
Filed: November 7, 2008
For: U.S. Patent No.: 5,780,222

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

This is a decision on the October 26, 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 October 26, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,780,222 (the '222 patent) issued on July 14, 1998.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-10 by a third party requester, which was accorded control number 90/009,326 (the '326 proceeding).

3. Prosecution proceeded until, on July 9, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '326 proceeding.

4. A petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

5. The July 13, 2009 petition was dismissed on August 20, 2009.

6. On August 7, 2009, the present proceeding entered the publication cycle.

7. The instant petition was filed on October 26, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except**:
(1) Unpatentability of one of more claims, **which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable**;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, **the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A)** a

factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and, 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. The instant petition was filed on October 26, 2009. Patent owner states that the references were first made known to patent owner on September 30, 2009, and time was needed for translation. Therefore, the petition presents 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, after the present proceeding entered the publication cycle, and it fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, patent owner merely provides a translation of an opposition paper to a European patent having a common parent document to the U.S. '222 patent under reexamination. There are no statements by the patent owner that unequivocally state why the document submitted makes at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim or claims to be patentable.

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 July 9, 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 as to at least one 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 October 26, 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

November 30, 2009

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(For 3rd Party Requester)

In re Peddada et al.
Reexamination Proceeding
Control No.: 90/009,326
Filed: November 7, 2008
For: U.S. Patent No.: 5,780,222

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

This is a decision on the December 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 reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

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

BACKGROUND

1. Patent number 5,780,222 (the '222 patent) issued on July 14, 1998.

2. On December 17, 2008, the Office issued an order granting a November 7, 2008 request for reexamination of claims 1-10 by a third party requester, which was accorded control number 90/009,326 (the '326 proceeding).

3. Prosecution proceeded until, on July 9, 2009, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '326 proceeding.

4. A petition was filed on July 13, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

5. The July 13, 2009 petition was dismissed on August 20, 2009.

6. On August 7, 2009, the present proceeding entered the publication cycle.

7. A petition was filed on October 26, 2009, accompanied by an IDS that the patent owner requested the Office to consider.

8. The October 26, 2009 petition was dismissed by the Office in a decision mailed on December 1, 2009.

9. The instant petition was filed on December 7, 2009, accompanied by an IDS that the patent owner requests the Office to consider.

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 NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except**:
(1) Unpatentability of one of more claims, **which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable**;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome

as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, **the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A)** a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and, 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.

Patent owner's attention was drawn to this requirement, which is explicitly set forth at MPEP 2256, in the December 1, 2009 Office decision, mailed prior to patent owner's instant petition filed on December 7, 2009.

In the present instance, the submission fails to satisfy the above-noted criteria. The instant petition was filed on December 7, 2009. Patent owner states that the references were first made known to patent owner around October 2009, and time was needed for translation. Therefore, the petition presents 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, after the present proceeding entered the publication cycle, and it fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, patent owner merely states that the document is "potentially relevant" to the U.S. '222 patent under reexamination. There are no statements by the patent owner that unequivocally state why the document submitted makes at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim or claims to be patentable.

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 July 9, 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 as to at least one 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.

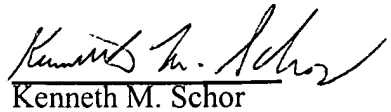
CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on December 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.



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

March 4, 2010

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FEB 27 2009

CENTRAL REEXAMINATION UNIT

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New York, NY 10112-4498

(For Patent Owner)
(90/009,104)

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(For Patent Owner)
(90/009,328)

Morrison & Foerster LLP
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(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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,329	11/10/2008	6233389	2513.002REX0	2859

26111 7590 08/21/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/21/2009

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Sterne Kessler Goldstein & Fox, LLP
110 New York Avenue, N.W.
Washington, D.C. 2005

(For Patent Owner)

MAILED

AUG 21 2009

CENTRAL REEXAMINATION UNIT

Morrison & Foerster, LLP
555 West Fifth Street, Suite 3500
Los Angeles, CA 90013

(For Requester)

In re Barton et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 90/009,329	:	UNDER 37 CFR 1.181
Filed: November 10, 2008	:	
For: U.S. Patent No. 6,233,389	:	

This is a decision on a petition filed by the patent owner on May 27, 2009 and third-party requester's opposition thereto. The petition is entitled "PETITION OF PATENT OWNER UNDER 35 USC §§ 1.181, 182 and/or 37 CFR 1.183..." [hereinafter "the petition"] and the opposition is titled "OPPOSITION TO PATENT OWNER'S PETITION TO VACATE..." [hereinafter "the opposition"] . The petition is treated as a petition under 37 CFR § 1.181 to invoke the supervisory authority of the director.

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

The petition is dismissed with respect to vacating the order under 37 CFR § 1.181.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,233,389 issued on May 15, 2001.

2. A request for *ex parte* reexamination of that patent, Control No. 90/007,750 ("the '750 proceeding"), was filed by a third party requester on October 17, 2005.

3. In the '750 proceeding, a substantial new question of patentability was found with respect to U.S. Patent 6,304,714 to Krause et al. (Order of December 15, 2005).

4. In the '750 proceeding, U.S. Patent 6,018,612 to Thomason et al. was cited along with many other references in an information disclosure statement on March 7, 2006. The citation was later initialed by the examiner.

5. The present request for reexamination ("the '329 proceeding") was filed November 10, 2008. Reexamination of Claims 31 and 61 was requested in light of the Krause and Thomason patents.

6. The electronic record of the '750 proceeding indicates that a certificate confirming the patentability of Claims 1-61 issued on November 11, 2008.

7. On January 7, 2009, reexamination was ordered in the '329 proceeding. A substantial new question of patentability was found with respect to a combination of the Krause and Thomason patents (page 2).

8. The petition was filed by patent owner on May 27, 2009.

9. The opposition was filed by third-party requester on June 10, 2009.

DECISION

The present petition asks the USPTO to vacate the order of January 7, 2009. An order granting reexamination is not a final agency action but is a determination that proceedings are to begin. See *Heinl v. Godici*, 143 F. Supp. 2d 593, 597 (observing that the decision to grant reexamination "is an intermediate, indeed initial, step in the agency process to resolve the question of the validity of a patent", and confirming that such a decision is not subject to judicial review.)

Because this is ultimately an appealable issue, rather than an issue that is appropriately resolved by petition. Patent owner's proper recourse now is through response to any action on the merits.

Nonetheless, taken as a request for supervisory review, patent owner has not demonstrated error by the examiner.

The Thomason reference, while cited in the '750 proceeding, was not discussed by the examiner in that proceeding. In 2002, 35 USC § 303 was amended to read "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office" (emphasis added). In the facts of the '329 proceeding, the Thomason reference was previously cited to the office along with

roughly 200 other documents, but not discussed by the examiner[1]. This is highlighted on page 2 of the opposition to this petition.

Patent owner asserts that "Statements such as those made by Primary Examiners Harvey and Escalante when allowing claims over cited references must be taken objectively, at their face value: that they considered all portions of the cited references they said were considered, and that they determined that those references do not invalidate the claims for the expressly stated reasons. In other words, examiners should not be forced to discuss in detail every single cited reference by name." While Patent Owner has demonstrated that the references were considered by the Office, that alone fails to prohibit reexamination given section 303's express language that such prior consideration does not preclude the existence of a substantial new question.

Previously, the rule set forth in *In re Portola Packaging* might have forbidden a reexamination under these circumstances.

> "Therefore, it must be presumed that the original examiner considered the Faulstich and Hunter patents, both alone and in combination with each other and with all of the other cited references, before allowing the original claims... Whether the earlier examination was correct or not, reexamination of the same claims in light of the same references does not raise a substantial new question of patentability, which is the statutory criterion for reexamination." (*In re Portola Packaging*, 110 F.3d 786)

However, the 2002 amendment to 35 USC § 303 reflected a deliberate decision by Congress to overrule this decision. As such, a second reexamination may be ordered on references previously cited and/or considered. This change was discussed in *In re Swanson.*

> Thus, under § 303(a) as amended, a reference may present a substantial new question even if the examiner considered or cited a reference for one purpose in earlier proceedings. Nothing in the statute creates an exception to this rule for references considered in the context of a rejection of prior claims. Indeed, such an exception would overwhelm the rule and thwart a central purpose of the amendment, to overrule In re Portola Packaging. In that case, as here, the issue was whether a piece of prior art relied on for a prior rejection could nevertheless create a new question of patentability sufficient to warrant a reexamination. (*In re Swanson*, 540 F. 3d 1368 (Fed. Cir. 2008)

As the order granting reexamination identifies what feature was not found in the '750 reexamination (page 4), where those elements are shown in the Thomason reference (page 6), and concludes that this feature would be important to a reasonable examiner (page 8), and as the 2002 amendment to 35 USC § 303 makes clear that references already of record may be used to find that a substantial new question of patentability is present, the decision of the examiner has not been shown to be in error.

---

[1] A review of the record of the '750 proceeding did not reveal any specific discussion of Thomason. If such a discussion exists it should be brought to the attention of the Office in a request for reconsideration of this petition.

Accordingly, the petition is dismissed.

CONCLUSION

1. The petition, taken as a petition under 37 CFR 1.181, is dismissed.

2. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4449 or in her absence to the undersigned at (571) 272-3838.

3. This decision is without prejudice to a request for reconsideration or higher-level review. See MPEP 1002.02.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,329	11/10/2008	6233389	2513.002REX0	2859

26111 7590 09/14/2009

EXAMINER

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

ART UNIT	PAPER NUMBER

DATE MAILED: 09/14/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER LLP
DAVID L. FEHRMAN
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LOS ANGELES, CA 90013

Date: MAILED

SEP 14 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009329
PATENT NO. : 6233389
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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Stenrne Kessler Goldstein & Fox, LLP
110 New York Avenue, N.W.
Washington, D.C. 2005

(For patent Owner)

MAILED

SEP 1 4 2009

CENTRAL REEXAMINATION UNIT

Morrison & Foerster, LLP
555 West Fifth Street, Suite 3500
Los Angeles, CA 90013

(For the Third-Party Requester)

In re Barton et al.
Ex Parte Reexamination Proceeding
Control No.: 90/009,329
Filed: November 10, 2008
For: U.S. Patent No. 6,233,389

: **DECISION DIMISSING**
: **PETITION FOR SUSPENSION**
: **OF *EX PARTE***
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the petition under 37 CFR § 1.182 filed by the patent owner on May 27, 2009, requesting a temporary suspension of the above-identified *ex parte* reexamination proceeding.

The petition is before the Office of Patent Legal Administration.

The petition is dismissed.

DECISION

In the petition under 37 CFR § 1.182, the patent owner requested the United States Patent and Trademark Office (USPTO) to temporarily suspend prosecution of the above-identified reexamination proceeding until the USPTO decides the concurrently filed "PETITION OF PATENT OWNER UNDER 37 C.F.R. § 1.181, 182 AND/OR 37 C.F.R. § 1.183 TO VACATE THE ORDER GRANTING SECOND REEXAMINATION REQUEST" (hereinafter "the concurrently filed petition"). The patent owner in the concurrently filed petition requested the USPTO to vacate the reexamination order mailed on January 7, 2009, which has been treated as a petition under 37 CFR § 1.181, to invoke the supervisory authority of the Director. On August 21, 2009, the USPTO mailed a decision on the concurrently filed petition, dismissing the petition with respect to vacating the reexamination order mailed on January 7, 2009.

Since the concurrently filed petition that is relied upon by the patent owner as the basis for its request for suspension has been decided, and there is no other justification offered by the patent owner to suspend the examination in the above-identified reexamination proceeding, the petition under 37 C.F.R. § 1.182, requesting a temporary suspension of the above-identified reexamination proceeding, must be dismissed. 35 U.S.C. § 305 mandates that *ex parte* reexamination proceedings must be conducted "with special dispatch within the Office."

In view of the above and the fact situation presented by the present record, the patent owner's petition under 37 C.F.R. § 1.182, requesting a temporary suspension of the above-identified reexamination proceeding, is dismissed.

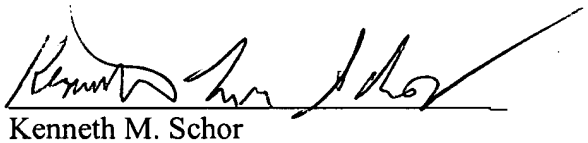
CONCLUSION

1) The patent owner's petition under 37 C.F.R. § 1.182 filed on May 27, 2009, requesting a temporary suspension of the above-identified reexamination proceeding, is dismissed.

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

3) The USPTO mailed an Office action on August 3, 2009, which sets forth a two-month shortened statutory period for response. This time period for response continues to run from the mailing date of the Office action. Failure to respond within this time period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with the Office action.

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



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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,343	11/26/2008	6371637	5377-014	2594

6980 7590 03/18/2010

TROUTMAN SANDERS LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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SUITE 300
CARY, NC 27518

Date:
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MAR 1 8 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009343
PATENT NO. : 6371637
ART UNIT : 3992

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

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

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MAR 18 2010

CENTRAL REEXAMINATION UNIT

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600 PEACHTREE STREET, N.E.
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ATLANTA GA 30308-2216

(For Patent Owner)

Daniel P Holmiller
1400 Crescent Green
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Cary, NC 27518

(For Third Party Requester)

In re: Atchinson *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,343
Deposited : 26 November 2008
For: US Patent No. 6,371,637

In re: Atchinson *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,611
Deposited : 02 November 2009
For: US Patent No. 6,371,637

DECISION
SUA SPONTE
MERGING
PROCEEDINGS
[37 CFR § 1.565(c)]

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

BACKGROUND

1. On 16 April 2002 US Patent No. 6,371,637 was granted to Atchinson *et alia*.

2. On 26 November 2008 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,343.

3. On 08 January 2009 the Order was granted for *ex parte* reexamination in control number 90/009,343.

4. On 11 September 2009 a non-final Office action was mailed in 90/009,343.

5. On 11 December 2009 an amendment and remarks were received in 90/009,343.

6. On 26 October 2009 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,611.

7. On 22 December 2009 the Order was granted for ex parte reexamination in control number 90/009,611.

8. There are no amendments to the claims in control number 90/009,611.

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. 90/009,343 & 90/009,611 *ex parte* 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 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.

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. 90/009,343 & 90/009,611 *ex parte* reexamination proceedings 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/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/009,611	11/02/2009	6,371,637	5377-014	5280

6980 7590 03/18/2010

TROUTMAN SANDERS LLP
5200 BANK OF AMERICA PLAZA
600 PEACHTREE STREET, N.E.
SUITE 5200
ATLANTA, GA 30308-2216

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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
COATS & BENNETT, P.L.L.C.
1400 CRESCENT GREEN
RALEIGH, NC 27602

Date:
MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009611
PATENT NO. : 6371637
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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,347	11/26/2008	7302164	081174-0000003	7525

20995 7590 07/02/2009

EXAMINER

Roger R. Wise
PILLSBURY WINTHROP SHAW PITTMAN
725 S. Figueroa Street Suite 2800
Los Angeles, CA 90017

ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2009

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.
90/009,347	11/26/2008	7302164	081174-0000003	7525

20995 7590 07/02/2009

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2040 MAIN STREET
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IRVINE, CA 92614

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2009

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

Rabinder N. Narula (For Patent Owner)
Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

Roger R. Wise (For Third Party Requester)
Pillsbury Winthrop Shaw Pittman LLP
725 S. Figueroa St.
Suite 2800
Los Angeles, CA 90017

MAILED

JUL 02 2009

CENTRAL REEXAMINATION UNIT

In re Wright *et al.*
Ex parte Reexamination Proceeding
Control No.: 90/009,347
Filed: Nov. 26, 2008
For: U.S. Patent No. 7,302,164

DECISION DISMISSING PETITION

This is a decision on the patent owner's "PETITION UNDER 37 CFR § 1.183 TO SUSPEND THE RULES" filed on June 5, 2009, requesting waiver of the rule to permit submission of non-patent literature documents in the form of files stored on compact disks.

The 90/009,347 proceeding, and the petition, are before the Office of Patent Legal Administration for consideration.

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

The petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 7,302,164 ("the '164 patent") issued on Nov. 27, 2007 with 27 claims.

2. On Nov. 26, 2008, a third party requester filed a request for *ex parte* reexamination, which proceeding was assigned Control No. 90/009,347 ("the '9347 proceeding") requesting reexamination of claims 9-27.

3. A concurrent proceeding is being conducted in the U.S. District Court, California Central, captioned *Datacard Systems, Inc. v. Codonics, Inc.*, Civil Action No. 8:08cv63.

4. On Jan. 30, 2009, the Office mailed an Order granting the request for *ex parte* re-examination of claims 9-22.

5. On June 5, 2009, patent owner filed an Information Disclosure Statement and a petition requesting that the requirements of 37 CFR 1.52(e) be suspended or waived to permit entry of twenty nine (29) CDs and two (2) floppy diskettes. This petition is the subject of the present decision.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

I. Pertinent Regulations

A. Relief Requested

37 CFR 1.183 provides:

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

B. Electronic Documents

A CD is an electronic document. Submission of electronic documents is governed by 37 CFR 1.52(e).

37 CFR 1.52(e) provides in pertinent part:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:
>
> (i) A computer program listing (see § 1.96);
>
> (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
>
> (iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).
>
> (2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.
>
> (3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.
>
> (ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with

paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret (e.g., tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

(i) The name of each inventor (if known);

(ii) Title of the invention;

(iii) The docket number, or application number if known, used by the person filing the application to identify the application; and

(iv) A creation date of the compact disc.

(v) If multiple compact discs are submitted, the label shall indicate their order (e.g. "1 of X").

(vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

C. Material Information

Information submitted for consideration during a reexamination proceeding is submitted in accordance with the provisions of 37 CFR 1.555 - Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.

37 CFR 1.555 provides (in selected parts):

(a)...The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled. Information material to the patentability of a cancelled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration in the reexamination proceeding. The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be

material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. ... Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

37 CFR 1.98 provides:

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each foreign patent;

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed.

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified

in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

D. Concurrent proceedings

37 CFR 1.565 Concurrent office proceedings which include an *ex parte* reexamination proceeding.

(a) In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. See § **1.985** for notification of prior or concurrent proceedings in an *inter partes* reexamination proceeding.

II. Findings and Analysis

Petitioner patent owner requests that the requirements of 37 CFR 1.52(e) be waived to allow submission of compact discs and floppy diskettes containing computer programs without accessible computer program listings, submitted for the purpose of patent owner's compliance with the duty to inform the Office of concurrent proceedings.

A patent owner has a duty to inform the Office of the existence of a concurrent proceedings in which a patent undergoing reexamination is involved and the results of such proceeding, if known. As explained in MPEP 2282, information regarding the existence of a concurrent proceeding includes status information as to the proceeding. In order to ensure a complete file with updated status information regarding a concurrent proceeding, 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. Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office. It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return, expunge or discard, at its sole discretion, all or part of the submission. In such an instance, a party may then 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 appears in this instance that patent owner is submitting materials from a concurrent civil litigation that provide more than bare notice and status information of the concurrent proceeding. Patent owner has listed these materials, which include compact discs and floppy diskettes, in the Information Disclosure Statement filed June 5, 2009, but states on page 1 of the subject petition that "[t]he Petitioner makes no representation that the information in the computer programs is considered to be material to patentability. Additionally, inclusion in this Petition is not an admission that any of the computer programs are prior art." As noted in MPEP 2280, an attorney, agent, or patent owner who receives information has no duty to submit such information if such information is not material to patentability in the reexamination proceeding. See 37 CFR 1.555(b) for the definition of "material to patentability" to which MPEP 2280 refers.

Since the programs are not being submitted in accordance with the requirements of disclosure under 37 CFR 1.555 or to provide notice of the concurrent proceeding under 37 C.F.R. 1.565, it is unclear why the CDs and diskettes are being submitted. There has been no indication by the patent owner as to the relevance of the submission to this reexamination proceeding, and certainly no clear statement of materiality to patentability on which to base the requested waiver of the rules.

In filing a petition under 37 CFR 1.183, the petitioner must show that the present situation should be deemed an "extraordinary" situation where "justice requires" that the rules be waived to permit entry of a CD-ROM containing copies of documents for an information disclosure statement into the record of the reexamination proceeding. There has been no showing as to why entry of the CDs and diskettes is necessary, or even desirable, and creates an extraordinary situation that would require waiver of the rules governing the proper format

of computer programs submitted as an electronic document. Therefore, the petition requesting such waiver is dismissed.

Additionally, it is noted that the submission does not comply with the other requirements of 37 CFR 1.52(e). The CDs and diskettes were not submitted in the appropriate case accompanied with a transmittal letter as required under 37 CFR 1.52(e)(3)(ii). The CDs and diskettes were not submitted in duplicate or labeled appropriately, as required in 1.52(e)(4), (5) and (6). Since the CDs and diskettes do not conform to these requirements for submission of electronic documents, the CDs and diskettes are not proper for entry into the record, even if the requirement that programs be submitted with accessible program listings were to be waived. Further, there is no reason why the provisions of 37 CFR 1.52 noted above would be waived. For these additional reasons, the petition is not grantable.

For the reasons stated above, patent owner has not demonstrated an entitlement to relief under 37 CFR 1.183. Accordingly, no waiver of the rule is appropriate. The petition is dismissed.

CONCLUSION

1. For the reasons set forth above, the instant petition is dismissed

2. The CDs and floppy diskettes submitted with the petition will not be entered into the record of the '9347 proceeding. The twenty nine (29) CDs and two (2) diskettes are being returned to patent owner, as an accompaniment to the present decision.

3. Jurisdiction of the '9347 proceeding is being returned to the Central Reexamination Unit for further handling consistent with this decision.

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

Kenneth M. Schor

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

7/2/09
C:\kivaKenids\decisions

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.
90/009,347	11/26/2008	7302164	081174-0000003	7525

20995 7590 01/05/2010

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
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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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROGER R. WISE
PILLSBURY WINTHROP SHAW PITTMAN LLP
725 S. FIGUEROA STREET, SUITE 2800
LOS ANGELES, CA 90017

Date:
MAILED

JAN 05 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009347
PATENT NO. : 7302164
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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RABINDER N. NARULA
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2040 MAIN STREET FOURTEENTH FLOOR
IRVINE CA 92614

MAILED

JAN 05 2010

CENTRAL REEXAMINATION UNIT

ROGER R WISE
PILLSBURY WINTHROP SHAW PITTMAN LLP :(for Requester)
725 SOUTH FIGUEROA STREET SUITE 2800
LOS ANGELES, CA 90017

In re Application of: WRIGHT et alia
Control No.: 90/009,347 : DECISION ON PETITION
Deposited: November 26, 2008 : Under 37 CFR 1.59
For: US Patent No. 7,302,164

This is a response to the petition under 37 CFR 1.59(b), filed on August 19, 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 recieved.

The petition is hereby dismissed.

REVIEW OF RELEVENT FACTS

1. On November 26, 2008 a third party requester requested *ex parte* reexamination of US Patent No. 7,302,164 which is identified under control no. 90/009,347.

2. Reexamination was granted and prosecution as progressed through mailing of an Office action on October 1, 2009.

3. On August 19, 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 seventy-seven (77) documents which were filed under seal and submitted as an artifact pursuant to a protective order entered on May 9, 2008 in related litigation be expunged from the record. These documents were filed August 19, 2009.

The petition is deficient because:

1) the petition does not contain 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.
2) the petition does not contain 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.
3) 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.

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
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RABINDER N. NARULA :
KNOBBE MARTENS OLSON & BEAR LLP :(for Owner)
2040 MAIN STREET FOURTEENTH FLOOR :
IRVINE CA 92614 :

ROGER R WISE :
PILLSBURY WINTHROP SHAW PITTMAN LLP :(for Requester)
725 SOUTH FIGUEROA STREET SUITE 2800 :
LOS ANGELES, CA 90017 :

In re Application of: WRIGHT et alia :
Control No.: 90/009,347 : DECISION ON PETITION
Deposited: November 26, 2008 : Under 37 CFR 1.59
For: US Patent No. 7,302,164 :

This is a response to the petition under 37 CFR 1.59(b), filed on August 19, 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 recieved.

The petition is hereby dismissed.

REVIEW OF RELEVENT FACTS

1. On November 26, 2008 a third party requester requested *ex parte* reexamination of US Patent No. 7,302,164 which is identified under control no. 90/009,347.

2. Reexamination was granted and prosecution as progressed through mailing of an Office action on October 1, 2009.

3. On August 19, 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
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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:
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(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 seventy-seven (77) documents which were filed under seal and submitted as an artifact pursuant to a protective order entered on May 9, 2008 in related litigation be expunged from the record. These documents were filed August 19, 2009.

The petition is deficient because:

1) the petition does not contain 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.
2) the petition does not contain 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.
3) 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.

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,350	02/09/2009	6510716	14206.0002.000000	4646

34610 7590 01/12/2010

KED & ASSOCIATES, LLP
P.O. Box 221200
Chantilly, VA 20153-1200

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/12/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOWREY LLP-DC
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH, VA 22042-2924

Date: MAILED
JAN 12 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009350
PATENT NO. : 6510716
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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KED & ASSOCIATES, LLP
P.O. Box 221200
Chantilly VA 20153-1200

(Patent Owner)

MAILED

JAN 12 2010

CENTRAL REEXAMINATION UNIT

Howery LLP-East
c/o IP Docketing Department
2941 Fairview Park Dr
Suite 200
Falls Church, VA 22042

(Third Party Requester)

In re Kim *et al.*
Reexamination Proceeding
Control No.: 90/009,350
Filed: February 9, 2009
For: U.S. Patent No.: 6,510,716

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

This is a decision on the October 5, 2009 patent owner petition under 37 CFR 1.182, requesting the Office to enter and consider information disclosure statements (IDS) 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 August 4, 2009, has not been entered for consideration by the examiner.

BACKGROUND

1. On January 28, 2003, the Office issued U. S. patent number 6,510,716 (the '716 patent).
2. On February 9, 2009, a request for reexamination of the '716 patent, assigned reexamination control no. 90/009,350 (the '9350 proceeding), was filed by a third party requestor.
3. On March 23, 2009, the Office ordered reexamination of the '716 patent in the '9350 reexamination proceeding.
4. On May 28, 2009, the patent owner filed an IDS submission intended for the '9350 proceeding, which was mislabeled by patent owner as being for the '9390 proceeding.
5. On July 21, 2009, the Office corrected patent owner's error and transferred the May 28, 2009 IDS submission to the '9350 proceeding.
6. On August 4, 2009, the patent owner filed a second IDS submission also intended for the '9350 proceeding, which was also mislabeled by patent owner as being for the '9390 proceeding.

7. On September 22, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the '9350 proceeding, which included an initialed copy of a four page PTO-1449 included in the May 28, 2009 IDS submission.
8. On October 2, 2009, the '9350 proceeding entered the printing cycle, for printing of a reexamination certificate.
9. On October 5, 2009, patent owner filed the instant petition, accompanied with a copy of the May 28, 2009 IDS. Patent owner requests the Office consider the May 28, 2009 IDS and the August 4, 2009 IDS.
10. On December 22, 2009, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (7258th), US 6,510,716 C1.
11. On December 29, 2009, the Office became aware of patent owner's error and transferred the August 4, 2009 IDS submission to the '9350 proceeding file.

DECISION

The present reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (7258th), US 6,510,716 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '716 patent. Therefore, the submission of information for consideration by the examiner is not authorized by statute. Accordingly, the petition is **dismissed.**

ADDITIONAL DISCUSSION

May 28, 2009 IDS. The Office considered the May 28, 2009 IDS, as evidenced by the examiner initialed PTO-1449 documents sent to patent owner concurrently with the September 22, 2009 NIRC. Patent owner asserts the Office did not adequately consider and/or consider the May 28, 2009 IDS, which patent owner asserts included a 12 page PTO-1449. Patent owner has included a new copy of the 12 page PTO-1449, which is actually a four page PTO-1449 submitted in triplicate. The Office considered the May 28, 2009 IDS, as evidenced by the examiner annotated copy of the four page PTO-1449 sent to patent owner concurrently with the September 22, 2009 NIRC.

August 4, 2009 IDS. A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on September 22, 2009, and the proceeding has now resulted in issuance of *Ex Parte* Reexamination Certificate (7258th), thereby divesting the Office of jurisdiction over the '716 patent. However, even had the petition been addressed prior to issuance of the certificate, the August 4, 2009 IDS would not have had an entry right. 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 2256 as follows:

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

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. Specifically, patent owner filed the petition requesting consideration of August 4, 2009 IDS, after issuance of a NIRC and after the '9350 proceeding had already entered the printing cycle for issuance of a reexamination certificate. The originally filed August 4, 2009 IDS was found in the image file wrapper (IFW) of reexamination proceeding '9390 and copied over to the '9350 proceeding on December 29, 2009. A review of the August 4, 2009 IDS indicates that patent owner mislabeled the submission with reexamination proceeding control number '9390, resulting in the August 4, 2009 IDS not being made of record in the '9350 proceeding. Accordingly, patent owner's error in mislabeling the August 4, 2009 IDS resulted in it being entered into the '9390 proceeding. Furthermore, patent owner has failed to provide a statement as to why the submitted information (an art citation) makes at least one claim unpatentable. Moreover, 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 '9350 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. Accordingly, patent owner's request with regard to the August 4, 2009 IDS is dismissed.

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, because the proceeding has concluded by issuance of the *Ex Parte* Reexamination Certificate, the IDS will not, and cannot, be considered.

CONCLUSION

1. The petition is **dismissed** as to the request for consideration of the IDS filed on August 4, 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,352	12/04/2008	5,899,855	7553.70001B / 08-0092	9347

60683 7590 04/02/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/02/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP
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SUITE 100
SAN DIEGO, CA 92130-2040

Date:

MAILED

APR 02 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009352
PATENT NO. : 5899855
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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Health Hero Network, Inc.
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FOR PATENT OWNER

MAILED

APR 02 2009

CENTRAL REEXAMINATION UNIT

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

FOR THIRD PARTY REQUESTER

In re Stephen James Brown
Reexamination Proceeding
Control No. 90/009,352
Filed: December 4, 2008
For: U.S. Patent No. 5,899,855

DECISION DISMISSING PETITION TO VACATE ORDER GRANTING REEXAMINATION

This is a decision on the March 5, 2009 patent owner petition requesting that the order granting reexamination be withdrawn, which petition is being taken as a request to vacate the order granting reexamination. In addition, on March 23, 2009, requester filed an opposition to the patent owner's petition to vacate the reexamination order, which opposition has been considered.

The patent owner petition to vacate, the requester opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The patent owner petition is dismissed.

BACKGROUND

1. Patent No. 5,899,855 (the '855 patent) issued to Stephen James Brown on May 4, 1999.

2. A request for reexamination of claims 47-50 of the '855 patent, assigned Control No. 90/008,234 (the '8234 proceeding), filed by third party requester DexCom Inc. (hereinafter "DexCom") was deposited on August 17, 2006. Defects in the original deposit were subsequently corrected, which resulted in the '8234 proceeding being granted a filing date of October 31, 2006.

3. Reexamination was ordered for claims 47-50 of the '855 patent in the '8234 reexamination proceeding on December 13, 2006.

4. A second request for reexamination of claims 47-50 of the '855 patent, assigned Control No. 90/008,909 (the '8909 proceeding), was filed by third party requester DexCom on December 11, 2007.

5. Reexamination was ordered for claims 47-50 of the '855 patent in the '8909 reexamination proceeding on January 24, 2008.

6. A decision by the Office merging the '8234 and '8909 proceedings into a single proceeding was mailed on July 7, 2008.

7. An amendment to the claims in the merged '8234 and '8909 proceedings was filed by patent owner on October 14, 2008.

8. A reexamination certificate, finding the amended claims to be patentable, was issued for the '855 patent on January 7, 2009.

9. On December 4, 2008, requester DexCom filed a request for reexamination of the '855 patent, as amended by the reexamination certificate. The request was assigned Control No. 90/009,352 (the '9352 proceeding). Reexamination of claims 47-50 of the '855 patent was requested.

10. Reexamination of claims 47-50 of the '855 patent was ordered for the '9352 reexamination proceeding on February 6, 2009.

11. On March 5, 2009, the patent owner filed the present petition to vacate the February 6, 2009 order for reexamination, which petition is the subject of this decision.

12. On March 23, 2009, the third party requester filed, pursuant to MPEP 2246(II), an opposition to the patent owner's petition to vacate the reexamination order.

RELEVANT STATUTES, REGULATIONS, AND PROCEDURE

Selected excerpts of the statutes, regulations and MPEP which are relevant to this decision are reproduced below with emphasis added (in bold) to highlight relevant portions.

35 U.S.C. § 303 Determination of issue by Director.

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

may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. **The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.** (Emphasis added.)

MPEP 2242 provides in relevant part:

II.A. Prior Favorable Decisions by the U.S. Patent and Trademark Office (Office) on the Same or Substantially Identical Prior Art in Relation to the Same Patent.

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

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

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

MPEP 2246 provides in relevant part:

When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, any such opposition by the third party requester must be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration.

DECISION

Patent owner contends that the request for reexamination of the '855 patent does not raise a substantial new question (SNQ) of patentability because certain references relied upon - "Allen, Smith, Beckers, Shults, Thompson, and Velho" - were the same as those in the prior filed '8234 and '8909 reexaminations. Petition at 9. Patent owner further contends that additional references used as the basis of the SNQ in the instant reexamination - U.S. Patent No. 5,137,028 to Nishimura and U.S. Patent No. 5,316,008 to Suga - do not provide a substantial new question of patentability which is different from that raised in the concluded reexaminations. *Id.*

Patent owner additionally contends that the instant reexamination request was filed for "the apparent purpose of obtaining an *inter partes* type of reexamination process in an *ex parte* reexamination proceeding." Petition at 10.

Third party requester filed papers opposing the instant patent owner petition on March 23rd, citing procedure for such opposition as set forth in MPEP 2246. It is first noted that MPEP 2246 sets forth a two week time limit for opposition papers, which begins on the date of service to the third party requester. The date of service in the instant petition is March 5, 2009, and the time limit for such opposition expired on March 19, 2009. As the third party submission was filed on March 23, 200, the submission was outside the authorized time frame, and the arguments therein are not ensured consideration. However, the arguments set forth in the third party submission have been considered in providing the below analysis.

With respect to patent owner's first contention, a review of the record of the prior filed '8234 and '8909 reexamination files reveals that some of the references upon which the SNQ of the instant reexamination proceeding is based also provided basis for the SNQs of the prior filed '8234 and '8909 reexaminations. However, since the reexamination request for the present proceeding was filed after November 22, 2002, reliance on previously cited art does not preclude the finding of a substantial new question of patentability. See 35 U.S.C. § 303, last sentence.

Furthermore, the SNQ in the instant reexamination proceeding is not based solely on previously cited prior art references, but also upon newly cited U.S. Patent No. 5,137,028 to Nishimura and U.S. Patent No. 5,316,008 to Suga. The order of February 6, 2009, specifically states (at pages 8-9):

> [T]he teaching of the video display for displaying pictorial, symbolic, graphic and alphanumeric information was not present in the prosecution of the application which became the '855 Patent or in the reexamination of the '855 Patent in the merged proceedings of control numbers 90/008,234-and 90/008,909. In fact, the amended claim language of "said video display configured to display pictorial symbolic, graphic and. alphanumeric information" was added immediately proceeding [sic] the notice of intent to issue a reexam certificate in the merged '8909 and '8234 reexam proceedings. No prior art was applied or cited as to this new limitation.
>
> Therefore, there is a substantial likelihood that a reasonable examiner would consider this teaching, i.e. the Nishimura reference video display, presented in the request important in deciding whether or not these claims are patentable.

> Accordingly, Nishimura taken alone or with Matsumura raises a substantial new question of patentability as to claims 47-49, which question has not been decided in a previous examination or reexamination of the '855 Patent.

For all claims under reexamination, a SNQ was based upon the new Nishimura reference. Thus, the Office clearly has jurisdiction to reexamine the claims under reexamination. Also, the use of a new reference to address a new claim limitation, in the manner set forth by the examiner in the order, is a clear indication that the examiner did, in fact, review the patent file history and acted in accordance with the guidance set out in the MPEP in determining whether an SNQ was raised by the requester.

With respect to patent owner's second contention, expressing concerns that a single third party is using *ex parte* reexamination to approximate *inter partes* reexamination, it is noted that the third party requester, DexCom, is in fact the same in each of the '8909, '8234, and '9352 requests for reexamination. Since the patent under reexamination issued from an application filed prior to November 29, 1999, *inter partes* reexamination is unavailable for the '855 patent. Because *inter partes* reexamination is not available for the '855 patent, the third party is not using *ex parte* reexamination *to avoid* the limitations of *inter partes* reexamination, such as the estoppel provisions of 35 U.S.C. 317 (b) and 37 CFR 1.907(c).

As to the propriety of the filing of this third reexamination request, reexamination of a patent, which has previously undergone a reexamination, proceeding is permitted where a different SNQ is raised in the subsequent reexamination request. See MPEP §§ 2240, 2283, and 2295. And, in this instance, the present SNQ has raised a different SNQ.

The requirement that a subsequent request for reexamination contain a substantial new question of patentability provides a safeguard against harassment of the patent owner. [1] Reexamination may be used to address a third party's concerns where such concerns could not have been addressed earlier. In a situation where a subsequent reexamination is filed to address an issue that was not present in an earlier reexamination proceeding, such a subsequent reexamination request does not, absent clear evidence of such, constitute harassment of the patent owner.

In the instant case, the prior merged reexamination of the '855 patent resulted in the issuance of a reexamination certificate in which all the claims subject to reexamination were amended to overcome rejections of record. The reexamination certificate was issued within three months of the instant request for reexamination. Pursuant to MPEP 2295, the proceedings were not merged, and the request for reexamination was considered based upon the claims in the patent resulting from the issued reexamination certificate, rather than the original claims of the patent. The SNQ arises from new art, including a new primary reference, applied to claims which were amended via the issued and published reexamination certificate. In this circumstance, the original request submission was effective to cause applicant to amend the claims, and requester was prevented from addressing the amendments entered to overcome the cited prior art until the

---

[1] With respect to patent owner's expressed assertion that "third party will continue the pattern by filing yet another request" after patent owner responds in the '9352 proceeding (Petition at 9), the Office can not deal with speculation. If and when such a situation occurs, and the matter is called to the Office's attention, the Office will assess the matter, based on the facts and circumstances of that situation.

filing of this request. The submission of the present new reexamination request to contest the patentability of the claim based upon art addressing the newly amended feature(s) does not constitute improper harassment of patent owner Additionally, the claims for which reexamination was requested are based upon art that was not submitted in a previous examination. The order granting reexamination of the '9352 request has thus not been shown to be improper.

In view of the above, the petition to vacate the reexamination proceeding is dismissed.

CONCLUSION

1. The petition to vacate the reexamination order is dismissed.

2. Jurisdiction over the present reexamination proceeding is being returned to the Central Reexamination Unit, for preparation of an Office action in due course.

3. Telephone inquiries related to the present decision should be directed to Michael Cygan, Legal Advisor, at 571-272-7700, or, in his absence, to Pinchus M. Laufer, Legal Advisor, at 571-272-7726.

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

04/1/09
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WilmerHale/Boston
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(For Patent Owner)

MAILED

FEB 27 2009

CENTRAL REEXAMINATION UNIT

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(For 3rd Party Requester)
(90/009,217)

John P. White
Cooper & Dunham LLP
30 Rockefeller Plaza, 20th Floor
New York, NY 10112

(For 3rd Party Requester)
(90/009,355)

Reexam Control No.: 90/009,217
Filed : July 10, 2008
For U.S. Patent No. : 5,595,568

Reexam Control No.: 90/009,355
Filed : December 8, 2008
For U.S. Patent No. : 5,595,568

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. 90/009,217 was ordered in a decision mailed August 29, 2008 indicating that claims 1-10, 13, 14, 18, and 19 would be reexamined. On January 21, 2009, a preliminary amendment was filed adding claims 23 and 24 to the proceedings. In addition on January 21, 2009 and February 17, 2009, Information Disclosure Statements were filed. On February 17, 2009 a document titled "Submission of Court Documents in Related Litigation" was filed. No Office action has been issued in this proceeding.

Reexamination in application control No. 90/009,355 was ordered in a decision mailed January 7, 2009, indicating that claims 1, 3-10, 13, 14, and 18-21 would be reexamined. On January 26, 2009 patent owner filed a waiver, waiving the rights to file a patent owner statement under 37 CFR 1.530. On February 20, 2009, a preliminary amendment was filed adding claims 23 and 24 (identical to those in reexamination proceeding 90/009,217) to the instant proceeding. In addition, an Information Disclosure Statement was filed February 20, 2009. No Office action has been issued in this proceeding.

As evidenced by the above facts, reexamination control No. 90/009,217 and reexamination control No. 90/009,355 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 1-10, 13, 14, 18-21, 23, and 24 will be reexamined in this merged proceeding. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and each requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,217 and 90/009,355 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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WilmerHale/Boston
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(For Patent Owner)

MAILED

FEB 27 2009

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(For 3rd Party Requester)
(90/009,216)

John P. White
Cooper & Dunham LLP
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(90/009,356)

Reexam Control No.: 90/009,216
Filed : July 10, 2008
For U.S. Patent No. : 5,735,844

Reexam Control No.: 90/009,356
Filed : December 8, 2008
For U.S. Patent No. : 5,735,844

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. 90/009,216 was ordered in a decision mailed August 29, 2008 indicating that claims 11, 12, 14, 17, 18, 27, and 32 would be reexamined be reexamined. On January 22, 2009, a preliminary amendment was filed adding claims 33-59 to the proceedings. In addition on January 22, 2009, an Information Disclosure Statements was filed. No Office action has been issued in this proceeding.

Reexamination in application control No. 90/009,356 was ordered in a decision mailed January 7, 2009, indicating that claims 1-3, 6-8, 12-14, 17, 19, 20, 27, 28, 30, and 32 would be reexamined. On January 26, 2009 patent owner filed a waiver, waiving the rights to file a patent owner statement under 37 CFR 1.530. On February 20, 2009, a preliminary amendment was filed adding claims 33-59 (identical to those in reexamination proceeding 90/009,217) to the instant proceeding. In addition, an Information Disclosure Statement was filed February 20, 2009. No Office action has been issued in this proceeding.

As evidenced by the above facts, reexamination control No. 90/009,216 and reexamination control No. 90/009,356 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 1-3, 6-8, 10-14, 17-20, 27, 28, 30, 32, and 33-59 will be reexamined in this merged proceeding. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and each requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/009,216 and 90/009,356 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.
90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 06/17/2009

EXAMINER	
ART UNIT	PAPER NUMBER

Fabio E. Marino
Orrick, Herrington & Sutcliffe, LLP
1000 Marsh Road
Menlo Park, CA 94025

DATE MAILED: 06/17/2009

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

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90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 06/17/2009

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4 PARK PLAZA STE 1600
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 06/17/2009

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WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2009

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Robert Greene Sterne.
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(For Patent Owner)

Fabio Marino
ORRICK, HERRINGTON
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IP PROSECUTION DEPARTMENT
4 PARK PLAZA
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IRVINE, CA 92614-2558

(For Third Party Requester)

MAILED

JUN 17 2009

CENTRAL REEXAMINATION UNIT

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
37 CFR § 1.550(c) and § 1.181

In re: Barth *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,357
Deposited: 08 December 2008
For: US Patent No. 7,210,016

This is a decision on the 12 June 2009, "Petition For Extension of Time to File Response to First Office Action Pursuant to 37 CFR § 1.550(c)" requesting that the time for responding to the non-final Office action mailed 08 May 2009, be extended by two (2) months. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g). The petition includes the required 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.

SUMMARY OF RELEVANT FACTS

1. On 24 April 2007 US Patent No. 7,210,016 was granted to Ware *et alia.*

2. On 08 December 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,357.

3. On 16 January 2008 the Order was granted for *ex parte* reexamination in control number 90/009,357.

4. On 08 May 2009 a non-final Office action was mailed

5. On 12 June 2009 the instant petition was submitted.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 08 May 2009. The Office action is a non-final Office action. The petition for extension of time was timely filed on 12 June 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.17 (g). The petition includes the required certificate of service.

The extension of time is granted-in-part

37 CFR § 1.550 (c) states:

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

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

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

ANALYSIS AND FINDINGS

The patent owner's representative petition to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final rejection mailed 08 May 2009. The petition was timely filed on 12 June 2009. The petition indicates that service was provided to the third party requester.

The petition dated 12 June 2009 articulates the extensive number of pages of deposition to be reviewed, examining the need for expert declarants and the possibility of swearing behind references. On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time.

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

CONCLUSION

1. The patent owner's petition for extension of one month time in which to file a response to the Office action dated 08 May 2009 is hereby **granted in-part**.

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

3. The patent owner's response is due on **08 August 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 12/16/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 12/16/2009

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DALLAS, TX 75219

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For Patent Owner)
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HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: Fabio E. Marino
1000 Marsh Road
Menlo Park, CA 94025

MAILED
DEC 16 2009
CENTRAL REEXAMINATION UNIT

In re Ware *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,160
Filed: March 24, 2009
For: U.S. Patent No. 7,210,016

In re Ware *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,357
Filed: December 8, 2008
For: U.S. Patent No. 7,210,016

: DECISION
: DISMISSING
: PETITION TO
: PREVENT MERGER
: AND
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 14, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 REGARDING MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS" filed in *ex parte* reexamination proceeding 90/009,357.

The Patent Owner petition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400 was charged to Patent Owner's credit card on October 15, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

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

Patent Owner's petition is dismissed, and the above captioned proceedings are merged in accordance with 37 CFR 1.989 for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,210,016 (the '016 patent) to Ware *et al.*

2. The '016 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is enforcing at least one of claims 1-24 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '016 patent was filed by third party requester NVIDIA Corporation. The request was assigned Control No. 90/009,357 (the '9357 proceeding).

5. On January 16, 2009, the Office issued an order granting the '9357 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9357 *ex parte* reexamination proceeding expired on March 16, 2009.[1]

7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '1160 proceeding).

8. On May 8, 2009, the Office issued a first Office action on the merits in the '9357 *ex parte* reexamination proceeding.

9. On May 26, 2009, the Office issued an order granting the '1160 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order indicated that all the claims of the '016 patent, claims 1-24, would be subject to reexamination.

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[1] There is no provision for filing a patent owner's statement in an inter partes reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

10. On August 10, 2009, Patent Owner filed a response in the '9357 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

11. On October 14, 2009, patent owner filed the present petition in the '9357 proceeding to prevent merger with the '1160 *inter partes* proceeding.

12. This decision addresses Patent Owner's petition to prevent merger.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in 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. 304 states:

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

35 U.S.C. 311(a) states:

> 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.

35 U.S.C. 314(c) states:

> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(a) states:

> (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.

37 CFR 1.33(a) states:

> (1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.
>
> (2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.
>
> (3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.181 (in pertinent part) states

> (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;
>
> (f) The mere filing of a petition will not stay any period for reply that may be

running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 1.182 states:

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

37 CFR 1.560 states:

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

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

37 CFR 1.948 states:

a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

37 CFR 1.955 states:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.989 states:

(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 and publication 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.

MPEP 2240 II states (in part):

In certain situations, after a grant of a second or subsequent request for *ex parte* reexamination, where (A) the patent owner files a petition under 37 CFR 1.182 as part of the statement or as the statement, and (B) it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, if the petition is granted, prosecution on the second or subsequent reexamination would be suspended. Merger of such a second or subsequent request with the already pending reexamination proceeding(s) would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement

that reexamination proceeding be conducted with special dispatch.

MPEP 2246 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2248 states (in part):

> 37 CFR 1.515(c) applies only where reexamination is denied; it does not apply to a grant of reexamination where either the patent owner or the requester is not satisfied with one or more findings made in a decision granting reexamination. Except for the limited exception described in MPEP § 2246, no petition may be filed requesting review of a decision granting a request for reexamination, even if the decision grants the request as to a specific claim for reasons other than those advanced by the requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.550.

MPEP 2640 II states (in part):

> Where reexamination is granted on a second or subsequent request, but the patent owner can clearly show that the second or subsequent request was filed for purposes of harassment, the patent owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended.

MPEP 2646 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2648 states (in part):

> Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for

> reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

MPEP 2686.01 states (in part):

> Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.
>
> . . .
>
> Case (2) - The earlier (pending) reexamination is an *ex parte* reexamination:
>
> (2)(a) The subsequent request is an *inter partes* reexamination request. ***Any party*** other than the patent owner can file the subsequent *inter partes* reexamination request. (Emphasis added)

DECISION

Findings and Analysis

Patent owner asserts the filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a). Patent owner further asserts this reexamination filing pattern combined with a subsequent merger of the two reexamination proceedings will deny Patent Owner of "*ex parte* reexamination rights". Finally Patent owner asserts that merging of the two present proceedings is improper because the later filed *inter partes* reexamination request was granted based upon the same substantial new question of patentability (SNQ) granted in the earlier filed *ex parte* reexamination request. Patent owner requests the remedies of: (1) Suspension of the *inter partes* reexamination proceeding; (2) Non-merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are merged.

In accordance with 35 U.S.C. 302, any member of the public possesses the right to file a request for ex parte reexamination on an issued patent. Specifically the statute states that ANY third party may at ANY time file a request for reexamination based upon ANY prior art. After an *inter partes* reexamination request is ordered, by statute, 35 U.S.C. 317(a), the third party requester in the *inter partes* reexamination is barred from filing another *inter partes* request for reexamination, until an *inter partes* reexamination certificate is issued and published, unless authorized by the USPTO Director. MPEP 2686.01 provides guidance, in accordance with 35 U.S.C. §§ 302 and 317(a) and notes that after the filing of an *inter partes* reexamination request, ANY party may file an *ex parte* reexamination request. The reexamination statutes place not

limitation upon a requester, as to the timing of filing a request for *ex parte* reexamination relative to the filing of parallel *inter partes* reexamination. However, any *ex parte* reexamination filing must contain a substantial, new and non-cumulative question of patentability. In regard to the asserted derogation of Patent Owner's "*ex parte*" reexamination right to an interview, no statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.33(a) and 1.560 provide guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer an absolute right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[2] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[3] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right.

Finally, use of one set of rules, namely the *inter partes* rules and relevant MPEP guidance, is necessary to facilitate the statutory mandate of special dispatch. The arrangement proposed by Patent Owner, permitting a patent owner to conduct an *ex parte* interview on SNQs[4] presented in the *ex parte* reexamination and only letting the requester comment on SNQs presented in the *inter partes* reexamination request, would be untenable to manage, monitor and control and therefore contrary to the mandate of special dispatch. It would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding SNQs, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. In each instance of a patent owner point, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

As reexamination must, by statute, be conducted with special dispatch. Merger of the present concurrent reexamination proceedings is in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings furthers special dispatch by permitting all issues raised in both proceedings, and any overlap of issues, to be resolved at the same time, i.e., a resolution of all SNQs raised in both requests with special dispatch, rather than delaying resolution in one of the proceedings. Patent Owner's "suggestions" to modify the Office's procedure for merging a proceeding that include an *inter partes* reexamination MUST be in accord with, and not contrary to, special dispatch. In the present case, Patent Owner has not established on the record a basis to justify the relief requested. Accordingly, the requested relief will not be granted.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '1160 *inter partes* reexamination proceeding with the '9357 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an

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[2] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.

[3] See MPEP §§ 713 *et seq.*, 2281 and 2685

[4] Substantial New Question of Patentability

ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination requests until after an *inter partes* reexamination certificate has issued and published, unless authorized by the USPTO Director.

Patent Owner's rationale for this violation of the statute is that merger of an *ex parte* reexamination with an *inter partes* reexamination, under 37 CFR 1.989(b), converts the *ex parte* reexamination proceeding into a "*de facto" inter partes* reexamination proceeding. Patent owner then extrapolates this logic to multiple *ex parte* filings by the same requester upon the same patent to conclude that such a strategy would result in multiple "*de facto" inter partes* reexamination proceedings. As the Office as a matter of routine practice always merges in such instance, Patent Owner asserts that the statutory mandate of special dispatch will be challenged. Patent Owner goes on to note that the requester in the present proceeding has employed a multiple filing strategy on eight other different but related patents in Patent Owner's portfolio. Patent Owner cites the Office decisions not to merge *ex parte* reexamination proceedings 90/007,844 (the '7844 proceeding) and 90/007843 (the '7843 proceeding) with *inter partes* reexamination proceedings 95/000,093 (the '093 proceeding) and 95/000,094 (the '094 proceeding) (collectively the "Sony cases") as persuasive for denying merger between the present proceedings. The logic of the Sony cases asserted is that the subsequent filing of an *ex parte* reexamination proceeding merged with a previously filed *inter partes* reexamination by the same requester converts the *ex parte* proceeding into a "*de facto*" *inter partes* reexamination proceeding, and hence a violation of the statute. Patent Owner concedes that the present proceedings are not under suspension, as was the case in the '093 and '094 proceedings. Patent Owner requests thus that the proceedings not be merged, or if merged that 37 CFR 1.989(b) be waived so that Patent Owner may retain "*ex parte* rights" to those issues raised in the *ex parte* reexamination proceeding.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request prior to the filing of an *inter partes* reexamination request. The plain language of the statute states, in part:

> . . . [O]nce 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.

The requester filed an *ex parte* reexamination request prior to filing an *inter partes* reexamination request. The statute does not prohibit the filing of *inter partes* reexamination requests by a requester, that previously filed an *ex parte* reexamination request on the same patent. The non-merge decisions rendered in the "Sony cases" are not binding on the Office. As a general rule, the merger and suspension of proceedings for the same patent before the Office

are determined on a fact specific, case-by-case basis. Hence, a decision in one proceeding before the Office is not *per se* binding upon the Office in other proceedings.

Furthermore, the decision to not merge in the "Sony Cases" was based upon the pre-existence of a suspension of the previously filed '093 and '094 *inter partes* reexamination proceedings. (See the Decision Denying Petitions to Merge in the '093 and the '094 proceedings, the text that bridges from the bottom of page 8 to the top of page 9). The statement of denial of the request to merge in the "Sony Cases" appears at an approximate mid-point on page 9 of the decision. After this legal statement of denial, based upon the existence of a suspension of the '093 and '094 *inter partes* proceedings, the decision then goes on to discuss this "*de facto*" *inter partes* filing logic. Therefore, the "*de facto*" *inter partes* filing logic was not part of the decision's rationale that precluded merger. The decision then concludes with a return to the fact that the court affirmed suspension of the '093 and the '094 *inter partes* proceedings was the determinative factor in denying the petition to merge the later filed *ex parte* proceedings with the previously filed *inter partes* proceedings.

Finally, Patent Owner's "parade of horribles" argument that the confluence of an *inter partes* reexamination with multiple *ex parte* reexamination filings and the Office's routine practice of granting merger will result in a frustration of special dispatch is misplaced. Patent Owner's "parade of horribles" will not come about due the statutory, regulatory and policy protections put in place to prevent such a strategy from being employed against a Patent Owner in a reexamination proceeding. By statute any reexamination requests must contain a substantial, new and non-cumulative question of patentability. By regulation the Office permits a third party requester to file prior art during an *inter partes* reexamination proceeding in very specific circumstances, in a manner that precludes harassment of the Patent Owner. Finally, MPEP §§ 2240 II and 2640 II both set forth an appropriate procedure for petitioning the suspension of any second or subsequently ordered request for reexamination if the Patent Owner can clearly show an intent to harass the Patent Owner. Therefore, Patent Owner's "parade of horribles" filing strategy will not occur, due to these statutory, regulatory and policy mechanisms, which deters and prevents harassment of a patent owner.

In view of the above, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Prevention of Merger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1160 *inter partes* reexamination proceeding and the '9357 *ex parte* reexamination proceeding, merger should not be granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings even if merger occurs, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination rights. Patent Owner states that merger of the proceedings without waiver of 37 CFR 1.989(b) both expands the requester's rights while curtailing the patent owner's rights. Finally, Patent Owner states that rout merger of proceedings filed in this manner

only encourages this pattern of filing reexamination requests, which encourages piecemeal reexamination, resulting in a waste of Office resources, a frustration of the statutory mandate of special dispatch and a removal of the distinction between *inter partes* and *ex partes* reexamination proceedings.[5]

Merger of an *inter partes* reexamination and an *ex parte* reexamination, and hence 37 CFR 1.989, does not constitute a statutory, violation as it is grounded in the statutory mandate of special dispatch. 35 U.S.C. 314(c). Title 35 of the United States Code does not contain a statutory right to conduct an interview before the Office in any proceeding, to include *ex parte* reexamination proceedings. Merger of an *inter partes* reexamination proceeding and an *ex parte* reexamination proceeding does not occur until after the time passes for submission of a Patent Owner's statement. Therefore merger does not deny Patent Owner any statutory "*ex parte* rights". Merger, as based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either not merging or merging, but permitting Patent Owner *ex parte* interviews in a merged proceeding, will burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(a) and 1.560 provide the guidelines for conducting and making a record of interviews, but 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview. The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview. Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right. Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Asserted Improvident SNQ Analysis. Patent Owner alleges the Office improvidently granted the '1160 *inter partes* reexamination request. Patent Owner alleges that the same substantial new question (SNQ), based upon the Coteus reference, was previously raised in the '9357 *ex parte* reexamination request. Patent owner alleges that the examiner did not comply with the procedures outlined in MPEP 2640 II, by ordering the '1160 reexamination request. Patent owner argues that to now merge the '1160 *inter partes* reexamination with the '9357 *ex parte* reexamination would "endorse" the improvident granting of the '1160 reexamination request and "eviscerate" the Patent Owner's ability to challenge the subsequently field and granted *inter*

[5] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

partes reexamination under its "*ex parte* reexamination rights".

The issue is moot as any Patent Owner *ultra vires* petition regarding the propriety of granting the '1160 request would be untimely in accordance with 37 CFR 1.181(f). Furthermore, even if timely, Patent owner's argument is in error. As noted above, outside of the right to submit a statement in accordance with 35 U.S.C. 304, *ex parte* reexamination does not confer any other statutory *ex parte* reexamination rights upon a patent owner that is not conferred by *inter partes* reexamination. Merger does not occur in an *ex parte* reexamination proceeding until the time for submission of a Patent Owner statement has passed. Therefore merger does not derogate any *ex parte* unique right. Any challenge to the grant of a reexamination request would have needed to have been made in the proceeding that was granted second. In this instance that would be the '1160 *inter partes* proceeding, which would be devoid of any "*ex parte* rights". The procedure for challenging the granting of a request for reexamination is the same for both *ex parte* reexamination and *inter partes* reexamination, an *ultra vires* petition under 37 CFR 1.181. See MPEP §§ 2246 II, 2646 II; See also MPEP §§ 2248, 2648. Therefore, as 37 CFR 1.989 places any merged proceeding that contains at least one *inter partes* proceeding under the *inter partes* rules, Patent Owner rights regarding challenge to the grant of the *inter partes* proceeding could not be altered by merger. However, as noted previously, the filing of an *ultra vires* petition under 37 CFR 1.181 would be untimely.

Accordingly, the petition to stay the *inter partes* proceeding, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

III. Merger of the 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 95/001,160 and 90/009,357 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

A. 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.

B. CONDUCT OF MERGED PROCEEDING

1. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

2. 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 EFS:

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

By U.S. Postal Service Mail:

> 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 (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

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

3. 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.

4. 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.

5. 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. The October 14, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,160 and *ex parte* Reexamination Control No. 90/009,357 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

3. 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.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,358	12/08/2008	7177998	2805.001REX5	1953

26111 7590 06/17/2009

EXAMINER	

Fabio E. Marino
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1000 Marsh Road
Menlo Park, CA 94025

ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2009

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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Robert Greene Sterne.
STERNE, KESSLER, GOLDSTEIN
& FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

MAILED

JUN 17 2009

CENTRAL REEXAMINATION UNIT

Fabio Marino
ORRICK, HERRINGTON
& SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
37 CFR § 1.550(c) and § 1.181

In re: Barth *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,358
Deposited: 08 December 2008
For: US Patent No. 7,177,998

This is a decision on the 12 June 2009, "Petition For Extension of Time to File Response to First Office Action Pursuant to 37 CFR § 1.550(c)" requesting that the time for responding to the non-final Office action mailed 08 May 2009, be extended by two (2) months. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g). The petition includes the required 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.

SUMMARY OF RELEVANT FACTS

1. On 13 February 2007 US Patent No. 7,177,998 was granted to Ware *et alia*.

2. On 08 December 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,358.

3. On 16 January 2008 the Order was granted for *ex parte* reexamination in control number 90/009,358.

4. On 08 May 2009 a non-final Office action was mailed

5. On 12 June 2009 the instant petition was submitted.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 08 May 2009. The Office action is a non-final Office action. The petition for extension of time was timely filed on 12 June 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.17 (g). The petition includes the required certificate of service.

The extension of time is granted-in-part

37 CFR § 1.550 (c) states:

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

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

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

ANALYSIS AND FINDINGS

The patent owner's representative petition to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final rejection mailed 08 May 2009. The petition was timely filed on 12 June 2009. The petition indicates that service was provided to the third party requester.

The petition dated 12 June 2009 articulates the extensive number of pages of deposition to be reviewed, examining the need for expert declarants and the possibility of swearing behind references. On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time.

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

CONCLUSION

1. The patent owner's petition for extension of one month time in which to file a response to the Office action dated 08 May 2009 is hereby **granted-in-part**.

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

3. The patent owner's response is due on **08 August 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

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ART UNIT	PAPER NUMBER

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MENLO PARK, CA 94025

DATE MAILED: 12/16/2009

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For Patent Owner)
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: Fabio E. Marino
1000 Marsh Road
Menlo Park, CA 94025

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

In re Ware *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,159
Filed: March 24, 2009
For: U.S. Patent No. 7,177,998

In re Ware *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,358
Filed: December 8, 2008
For: U.S. Patent No. 7,177,998

: DECISION
: DISMISSING
: PETITION TO
: PREVENT MERGER
: AND
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 14, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 REGARDING MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS" filed in *ex parte* reexamination proceeding 90/009,358.

The Patent Owner petition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400 was charged to Patent Owner's credit card on October 15, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

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

Patent Owner's petition is dismissed, and the above captioned proceedings are merged in accordance with 37 CFR 1.989 for the reasons set forth below.

REVIEW OF FACTS

1. On February 13, 2007, the Office issued U.S. Patent No. 7,177,998 (the '998 patent) to Ware *et al.*

2. The '998 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is enforcing at least one of claims 1-24 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '998 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,358 (the '9358 proceeding).

5. On January 16, 2009, the Office issued an order granting the '9358 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 7, 13, 21 and 22 of the '998 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9358 *ex parte* reexamination proceeding expired on March 16, 2009.[1]

7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '998 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,159 (the '1159 proceeding).

8. On May 8, 2009, the Office issued a first Office action on the merits in the '9358 *ex parte* reexamination proceeding.

9. On May 26, 2009, the Office issued an order granting the '1159 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order indicated that all the claims of the '998 patent, claims 1-24, would be subject to reexamination.

---

[1] There is no provision for filing a patent owner's statement in an inter partes reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

10. On August 10, 2009, Patent Owner filed a response in the '9358 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

11. On October 14, 2009, patent owner filed the present petition in the '9358 proceeding to prevent merger with the '1159 *inter partes* proceeding.

12. This decision addresses Patent Owner's petition to prevent merger.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in 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. 304 states:

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

35 U.S.C. 311(a) states:

> 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.

35 U.S.C. 314(c) states:

> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(a) states:

> (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.

37 CFR 1.33(a) states:

> (1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.
>
> (2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.
>
> (3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.181 (in pertinent part) states

> (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;
>
> (f) The mere filing of a petition will not stay any period for reply that may be

running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 1.182 states:

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

37 CFR 1.560 states:

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

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

37 CFR 1.948 states:

a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

37 CFR 1.955 states:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.989 states:

(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 and publication 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.

MPEP 2240 II states (in part):

In certain situations, after a grant of a second or subsequent request for *ex parte* reexamination, where (A) the patent owner files a petition under 37 CFR 1.182 as part of the statement or as the statement, and (B) it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, if the petition is granted, prosecution on the second or subsequent reexamination would be suspended. Merger of such a second or subsequent request with the already pending reexamination proceeding(s) would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement

that reexamination proceeding be conducted with special dispatch.

MPEP 2246 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2248 states (in part):

> 37 CFR 1.515(c) applies only where reexamination is denied; it does not apply to a grant of reexamination where either the patent owner or the requester is not satisfied with one or more findings made in a decision granting reexamination. Except for the limited exception described in MPEP § 2246, no petition may be filed requesting review of a decision granting a request for reexamination, even if the decision grants the request as to a specific claim for reasons other than those advanced by the requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.550.

MPEP 2640 II states (in part):

> Where reexamination is granted on a second or subsequent request, but the patent owner can clearly show that the second or subsequent request was filed for purposes of harassment, the patent owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended.

MPEP 2646 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2648 states (in part):

> Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for

> reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

MPEP 2686.01 states (in part):

> Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.
>
> . . .
>
> Case (2) - The earlier (pending) reexamination is an *ex parte* reexamination:
>
> (2)(a) The subsequent request is an *inter partes* reexamination request. ***Any party*** other than the patent owner can file the subsequent *inter partes* reexamination request. (Emphasis added)

DECISION

Findings and Analysis

Patent owner asserts the filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a). Patent owner further asserts this reexamination filing pattern combined with a subsequent merger of the two reexamination proceedings will deny Patent Owner of "*ex parte* reexamination rights". Finally Patent owner asserts that merging of the two present proceedings is improper because the later filed *inter partes* reexamination request was granted based upon the same substantial new question of patentability (SNQ) granted in the earlier filed *ex parte* reexamination request. Patent owner requests the remedies of: (1) Suspension of the *inter partes* reexamination proceeding; (2) Non-merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are merged.

In accordance with 35 U.S.C. 302, any member of the public possesses the right to file a request for ex parte reexamination on an issued patent. Specifically the statute states that ANY third party may at ANY time file a request for reexamination based upon ANY prior art. After an *inter partes* reexamination request is ordered, by statute, 35 U.S.C. 317(a), the third party requester in the *inter partes* reexamination is barred from filing another *inter partes* request for reexamination, until an *inter partes* reexamination certificate is issued and published, unless authorized by the USPTO Director. MPEP 2686.01 provides guidance, in accordance with 35 U.S.C. §§ 302 and 317(a) and notes that after the filing of an *inter partes* reexamination request, ANY party may file an *ex parte* reexamination request. The reexamination statutes place not

limitation upon a requester, as to the timing of filing a request for *ex parte* reexamination relative to the filing of parallel *inter partes* reexamination. However, any *ex parte* reexamination filing must contain a substantial, new and non-cumulative question of patentability. In regard to the asserted derogation of Patent Owner's "*ex parte*" reexamination right to an interview, no statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.33(a) and 1.560 provide guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer an absolute right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[2] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[3] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right.

Finally, use of one set of rules, namely the *inter partes* rules and relevant MPEP guidance, is necessary to facilitate the statutory mandate of special dispatch. The arrangement proposed by Patent Owner, permitting a patent owner to conduct an *ex parte* interview on SNQs[4] presented in the *ex parte* reexamination and only letting the requester comment on SNQs presented in the *inter partes* reexamination request, would be untenable to manage, monitor and control and therefore contrary to the mandate of special dispatch. It would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding SNQs, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. In each instance of a patent owner point, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

As reexamination must, by statute, be conducted with special dispatch. Merger of the present concurrent reexamination proceedings is in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings furthers special dispatch by permitting all issues raised in both proceedings, and any overlap of issues, to be resolved at the same time, i.e., a resolution of all SNQs raised in both requests with special dispatch, rather than delaying resolution in one of the proceedings. Patent Owner's "suggestions" to modify the Office's procedure for merging a proceeding that include an *inter partes* reexamination MUST be in accord with, and not contrary to, special dispatch. In the present case, Patent Owner has not established on the record a basis to justify the relief requested. Accordingly, the requested relief will not be granted.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '1159 *inter partes* reexamination proceeding with the '9358 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an

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[2] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.

[3] See MPEP §§ 713 *et seq.*, 2281 and 2685

[4] Substantial New Question of Patentability

ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination requests until after an *inter partes* reexamination certificate has issued and published, unless authorized by the USPTO Director.

Patent Owner's rationale for this violation of the statute is that merger of an *ex parte* reexamination with an *inter partes* reexamination, under 37 CFR 1.989(b), converts the *ex parte* reexamination proceeding into a "*de facto" inter partes* reexamination proceeding. Patent owner then extrapolates this logic to multiple *ex parte* filings by the same requester upon the same patent to conclude that such a strategy would result in multiple "*de facto" inter partes* reexamination proceedings. As the Office as a matter of routine practice always merges in such instance, Patent Owner asserts that the statutory mandate of special dispatch will be challenged. Patent Owner goes on to note that the requester in the present proceeding has employed a multiple filing strategy on eight other different but related patents in Patent Owner's portfolio. Patent Owner cites the Office decisions not to merge *ex parte* reexamination proceedings 90/007,844 (the '7844 proceeding) and 90/007843 (the '7843 proceeding) with *inter partes* reexamination proceedings 95/000,093 (the '093 proceeding) and 95/000,094 (the '094 proceeding) (collectively the "Sony cases") as persuasive for denying merger between the present proceedings. The logic of the Sony cases asserted is that the subsequent filing of an *ex parte* reexamination proceeding merged with a previously filed *inter partes* reexamination by the same requester converts the *ex parte* proceeding into a "*de facto*" *inter partes* reexamination proceeding, and hence a violation of the statute. Patent Owner concedes that the present proceedings are not under suspension, as was the case in the '093 and '094 proceedings. Patent Owner requests thus that the proceedings not be merged, or if merged that 37 CFR 1.989(b) be waived so that Patent Owner may retain "*ex parte* rights" to those issues raised in the *ex parte* reexamination proceeding.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request prior to the filing of an *inter partes* reexamination request. The plain language of the statute states, in part:

> . . . [O]nce 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.

The requester filed an *ex parte* reexamination request prior to filing an *inter partes* reexamination request. The statute does not prohibit the filing of *inter partes* reexamination requests by a requester, that previously filed an *ex parte* reexamination request on the same patent. The non-merge decisions rendered in the "Sony cases" are not binding on the Office. As a general rule, the merger and suspension of proceedings for the same patent before the Office

are determined on a fact specific, case-by-case basis. Hence, a decision in one proceeding before the Office is not *per se* binding upon the Office in other proceedings.

Furthermore, the decision to not merge in the "Sony Cases" was based upon the pre-existence of a suspension of the previously filed '093 and '094 *inter partes* reexamination proceedings. (See the Decision Denying Petitions to Merge in the '093 and the '094 proceedings, the text that bridges from the bottom of page 8 to the top of page 9). The statement of denial of the request to merge in the "Sony Cases" appears at an approximate mid-point on page 9 of the decision. After this legal statement of denial, based upon the existence of a suspension of the '093 and '094 *inter partes* proceedings, the decision then goes on to discuss this "*de facto*" *inter partes* filing logic. Therefore, the "*de facto*" *inter partes* filing logic was not part of the decision's rationale that precluded merger. The decision then concludes with a return to the fact that the court affirmed suspension of the '093 and the '094 *inter partes* proceedings was the determinative factor in denying the petition to merge the later filed *ex parte* proceedings with the previously filed *inter partes* proceedings.

Finally, Patent Owner's "parade of horribles" argument that the confluence of an *inter partes* reexamination with multiple *ex parte* reexamination filings and the Office's routine practice of granting merger will result in a frustration of special dispatch is misplaced. Patent Owner's "parade of horribles" will not come about due the statutory, regulatory and policy protections put in place to prevent such a strategy from being employed against a Patent Owner in a reexamination proceeding. By statute, any reexamination requests must contain a substantial, new and non-cumulative question of patentability. By regulation the Office permits a third party requester to file prior art during an *inter partes* reexamination proceeding in very specific circumstances, in a manner that precludes harassment of the Patent Owner. Finally, MPEP §§ 2240 II and 2640 II both set forth an appropriate procedure for petitioning the suspension of any second or subsequently ordered request for reexamination if the Patent Owner can clearly show an intent to harass the Patent Owner. Therefore, Patent Owner's "parade of horribles" filing strategy will not occur, due to these statutory, regulatory and policy mechanisms, which deters and prevents harassment of a patent owner.

In view of the above, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Prevention of Merger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1159 *inter partes* reexamination proceeding and the '9358 *ex parte* reexamination proceeding, merger should not be granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings even if merger occurs, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination rights. Patent Owner states that merger of the proceedings without waiver of 37 CFR 1.989(b) both expands the requester's rights while curtailing the patent owner's rights. Finally, Patent Owner states that rout merger of proceedings filed in this manner

only encourages this pattern of filing reexamination requests, which encourages piecemeal reexamination, resulting in a waste of Office resources, a frustration of the statutory mandate of special dispatch and a removal of the distinction between *inter partes* and *ex partes* reexamination proceedings.[5]

Merger of an *inter partes* reexamination and an *ex parte* reexamination, and hence 37 CFR 1.989, does not constitute a statutory, violation as it is grounded in the statutory mandate of special dispatch. 35 U.S.C. 314(c). Title 35 of the United States Code does not contain a statutory right to conduct an interview before the Office in any proceeding, to include *ex parte* reexamination proceedings. Merger of an *inter partes* reexamination proceeding and an *ex parte* reexamination proceeding does not occur until after the time passes for submission of a Patent Owner's statement. Therefore merger does not deny Patent Owner any statutory "*ex parte* rights". Merger, as based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either not merging or merging, but permitting Patent Owner *ex parte* interviews in a merged proceeding, will burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(a) and 1.560 provide the guidelines for conducting and making a record of interviews, but 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview. The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview. Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right. Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Asserted Improvident SNQ Analysis. Patent Owner alleges the Office improvidently granted the '1159 *inter partes* reexamination request. Patent Owner alleges that the same substantial new question (SNQ), based upon the Coteus reference, was previously raised in the '9358 *ex parte* reexamination request. Patent owner alleges that the examiner did not comply with the procedures outlined in MPEP 2640 II, by ordering the '1159 reexamination request. Patent owner argues that to now merge the '1159 *inter partes* reexamination with the '9358 *ex parte* reexamination would "endorse" the improvident granting of the '1159 reexamination request and "eviscerate" the Patent Owner's ability to challenge the subsequently field and granted *inter*

[5] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

partes reexamination under its "*ex parte* reexamination rights."

The issue is moot as any Patent Owner *ultra vires* petition regarding the propriety of granting the '1159 request would be untimely in accordance with 37 CFR 1.181(f). Furthermore, even if timely, Patent owner's argument is in error. As noted above, outside of the right to submit a statement in accordance with 35 U.S.C. 304, *ex parte* reexamination does not confer any other statutory *ex parte* reexamination rights upon a patent owner that is not conferred by *inter partes* reexamination. Merger does not occur in an *ex parte* reexamination proceeding until the time for submission of a Patent Owner statement has passed. Therefore merger does not derogate any *ex parte* reexamination unique right. Any challenge to the grant of a reexamination request would have needed to have been made in the proceeding that was granted second. In this instance that would be the '1159 *inter partes* proceeding, which would be devoid of any "*ex parte* rights". The procedure for challenging the granting of a request for reexamination is the same for both *ex parte* reexamination and *inter partes* reexamination, an *ultra vires* petition under 37 CFR 1.181. See MPEP §§ 2246 II, 2646 II; See also MPEP §§ 2248, 2648. Therefore, as 37 CFR 1.989 places any merged proceeding that contains at least one *inter partes* proceeding under the *inter partes* rules, Patent Owner rights regarding challenge to the grant of the *inter partes* proceeding could not be altered by merger. However, as noted previously, the filing of an *ultra vires* petition under 37 CFR 1.181 would be untimely.

Accordingly, the petition to stay the *inter partes* proceeding, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

III. Merger of the 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 95/001,159 and 90/009,358 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

A. 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.

B. CONDUCT OF MERGED PROCEEDING

1. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

2. 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 EFS:

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

By U.S. Postal Service Mail:

> 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 (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

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

3. 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.

4. 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.

5. 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. The October 14, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,159 and *ex parte* Reexamination Control No. 90/009,358 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

3. 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.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

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

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.
90/009,367	12/18/2008	5109181	D 088075US2	4543

24737 7590 12/31/2009

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/31/2009

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

Date MAILED

DEC 3 1 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009367
PATENT NO. : 5109181
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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John M DiMatteo
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR NY 10510

(For Patent Owner)

MAILED

DEC 31 2009

CENTRAL REEXAMINATION UNIT

John B Pegram
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Third Party Requester)

In re: Fischer *et alia*
Ex parte Reexamination Proceeding
Control No. 90/009,367
Deposited on: 18 December 2008
For: US Patent No. 5,109,181

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

This is a decision on the 29 December 2009, "Petition for Extension of Time Pursuant to 37 C.F.R. § 1.550(c)" requesting that the time for responding to the Final rejection mailed 01 October 2009, be extended by one-month. The Petition for extension of time was timely filed.

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 to be extended by one (1) month in which to file a response to the final action mailed 01 October 2009 thereto. The petition for extension of time was timely filed with certificate of service. The petition request provides electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

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

CITATION OF RELEVANT AUTHORITY

37 CFR § 1.4(c) Nature of correspondence and signature requirements.

> (c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR § 1.550 (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 § 2272 After Final Practice (in-part)

...

I. FINAL REJECTION — TIME FOR RESPONSE

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 month (in accordance with the guidelines set forth in MPEP § 2265) if the response is the first response after the final rejection and a notice of appeal has not yet been filed. (emphasis added)

Note further that the patent owner is entitled to know the examiner's ruling on a timely response filed 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 for 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 USPQ2d 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. (emphasis added)

...

ANALYSIS AND FINDINGS

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) months 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 petition dated 29 December 2009 is the first response after the final action was mailed on 01 October 2009. 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 month (in accordance with the guidelines set forth in MPEP § 2265) if the response is the first response after the final rejection and a notice of appeal has not yet been filed. Since there is a first response after final the period is automatically extended.

Further, the patent owner is entitled to know the examiner's ruling on a timely response filed 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 for response to the final rejection should be appropriately extended in the examiner's advisory action.

The petition filed 29 December 2009 is hereby dismissed-as-moot.

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the final action dated 01 October 2009 is hereby **dismissed-as-moot.**

2. The time period is automatically extended by one month pursuant to MPRP § 2272.

3. The patent owner's response is due **01 January 2010** .

4. Communications may be submitted as follows:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft

scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

_____

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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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.
90/009,368	12/22/2008	6297751	14372-0045	7171

25883 7590 06/30/2010

HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2010

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,368	12/22/2008	6297751	14372-0045	7171

25883 7590 06/30/2010

PERKINS COIE LLP
PATENT-SEA
P O BOX 1247
SEATTLE, WA 98111-1247

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2010

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Commissioner for Patents
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P.O. Box 1450
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www.uspto.gov

HOWISON & ARNOTT, L.L.P : (For Patent Owner)
P.O. BOX 741715 :
DALLAS TX 75374-1715 :

PERKINS COIE LLP : (For Third Party Requester)
PATENT-SEA :
P.O. BOX 1247 :
SEATTLE, WA 98111-1247 :

MAILED

JUN 30 2010

CENTRAL REEXAMINATION UNIT

In re: Fadavi-Ardekani *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/009,368 :
Deposited on: 05 November 2009 :
For: US Patent No. 6,297,751 B1 :

DECISION
DISMISSING-AS-MOOT
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 23 June 2010 petition titled, "Petition for Extension of Time [37 CFR § 1.550(c)]" requesting the response period for response be extended by one (1) month for response to the Office action dated 23 April 2010. The petition submitted 23 June 2010 was timely filed without certificate of service.

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

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

DECISION

The Patent Owner's representative requests the period for response be extended by one (1) month for responding to the Office action dated 23 April 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 23 June 2010, together with authorization 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 not provided with the petition. The petitioner submitted a timely filed notice of appeal (also lacking certificate of service) dated 23 June 2010, rendering the instant petition for extension of time as moot.

The request is hereby dismissed-as-moot.

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. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a

response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR § 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

37 CFR § 1.550 (f). Conduct of *ex parte* reexamination proceedings.

(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. (emphasis added)

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 submitted a timely filed notice of appeal which lacks the certificate of service. The timely filing of the notice of appeal renders the petition for extension of time as moot.

The petitioner is reminded that any paper lacking certificate of service **may be refused consideration** by the Office. All papers submitted by the patent owner in ex parte reexamination proceedings **MUST** reflect service pursuant to 37 CFR 1.550(f).

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

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the Office action dated 23 April 2010 is hereby **dismissed-as-moot.**

2. The timely response of the notice of appeal renders the request for extension of time as moot.

3. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

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

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For Patent Owner)
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

MAILED
DEC 17 2009
REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: William H. Wright
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614

In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,201
Filed: June 23, 2009
For: U.S. Patent No. 7,330,953

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,369
Filed: December 23, 2008
For: U.S. Patent No. 7,330,953

: DECISION
: DISMISSING
: PETITION TO
: PREVENT MERGER
: AND
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 16, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 REGARDING MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS" filed in *ex parte* reexamination proceeding 90/009,369.

The Patent Owner petition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400 was charged to Patent Owner's credit card on October 19, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

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

Patent Owner's petition is dismissed, and the above captioned proceedings are merged in accordance with 37 CFR 1.989 for the reasons set forth below.

REVIEW OF FACTS

1. On February 12, 2008, the Office issued U.S. Patent No. 7,330,953 (the '953 patent) to Barth *et al.*

2. The '953 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is enforcing at least one of claims 1-28 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 23, 2008, a request for *ex parte* reexamination of claim 25 of the '953 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,369 (the '9369 proceeding).

5. On March 6, 2009, the Office issued an order granting the '9369 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claim 25 of the '953 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9369 *ex parte* reexamination proceeding expired on May 6, 2009.[1]

7. On May 19, 2009, the Office issued a first Office action on the merits in the '9369 *ex parte* reexamination proceeding.

8. On June 22, 2009, the ITC granted Patent Owner's motion for partial termination with respect to the '953 patent. Therefore, the '953 patent is no longer involved in the ITC investigation.

9. On June 23, 2009, a request for *inter partes* reexamination of all the claims (claims 1-28) of the '953 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,201 (the '1201 proceeding).

10. On August 12, 2009, the Office issued an order granting the '1201 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order indicated that all the claims of the '953 patent, claims 1-28, would be

[1] There is no provision for filing a patent owner's statement in an inter partes reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

subject to reexamination.

11. On August 19, 2009, Patent Owner filed a response in the '9369 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.[2]

12. On October 16, 2009, patent owner filed the present petition in the '9369 proceeding to prevent merger with the '1201 *inter partes* proceeding.

13. This decision addresses Patent Owner's petition to prevent merger.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in 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. 304 states:

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

35 U.S.C. 311(a) states:

> 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.

---

[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the May 19, 2009 Office action.

35 U.S.C. 314(c) states:

> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(a) states:

> (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.

37 CFR 1.33(a) states:

> (1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.
>
> (2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.
>
> (3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.181 (in pertinent part) states

> (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;
>
> (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely,

except as otherwise provided. This two-month period is not extendable.

37 CFR 1.182 states:

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

37 CFR 1.560 states:

> (a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.
>
> (b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

37 CFR 1.948 states:

> a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
>
> (1) which is necessary to rebut a finding of fact by the examiner;
>
> (2) which is necessary to rebut a response of the patent owner; or
>
> (3) which for the first time became known or available to the third party requester

after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

37 CFR 1.955 states:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.989 states:

(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 and publication 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.

MPEP 2240 II states (in part):

In certain situations, after a grant of a second or subsequent request for *ex parte* reexamination, where (A) the patent owner files a petition under 37 CFR 1.182 as part of the statement or as the statement, and (B) it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, if the petition is granted, prosecution on the second or subsequent reexamination would be suspended. Merger of such a second or subsequent request with the already pending reexamination proceeding(s) would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement that reexamination proceeding be conducted with special dispatch.

MPEP 2246 II states (in part):

A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a

request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2248 states (in part):

> 37 CFR 1.515(c) applies only where reexamination is denied; it does not apply to a grant of reexamination where either the patent owner or the requester is not satisfied with one or more findings made in a decision granting reexamination. Except for the limited exception described in MPEP § 2246, no petition may be filed requesting review of a decision granting a request for reexamination, even if the decision grants the request as to a specific claim for reasons other than those advanced by the requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.550.

MPEP 2640 II states (in part):

> Where reexamination is granted on a second or subsequent request, but the patent owner can clearly show that the second or subsequent request was filed for purposes of harassment, the patent owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended.

MPEP 2646 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2648 states (in part):

> Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

MPEP 2686.01 states (in part):

> Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.

. . .

Case (2) - The earlier (pending) reexamination is an *ex parte* reexamination:

(2)(a) The subsequent request is an *inter partes* reexamination request. ***Any party*** other than the patent owner can file the subsequent *inter partes* reexamination request. (Emphasis added)

DECISION

Findings and Analysis

Patent owner asserts the filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a). Patent owner further asserts this reexamination filing pattern combined with a subsequent merger of the two reexamination proceedings will deny Patent Owner of "*ex parte* reexamination rights". Patent owner requests the remedies of: (1) Suspension of the *inter partes* reexamination proceeding; (2) Non-merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are merged.

In accordance with 35 U.S.C. 302, any member of the public possesses the right to file a request for ex parte reexamination on an issued patent. Specifically the statute states that ANY third party may at ANY time file a request for reexamination based upon ANY prior art. After an *inter partes* reexamination request is ordered, by statute, 35 U.S.C. 317(a), the third party requester in the *inter partes* reexamination is barred from filing another *inter partes* request for reexamination, until an *inter partes* reexamination certificate is issued and published, unless authorized by the USPTO Director. MPEP 2686.01 provides guidance, in accordance with 35 U.S.C. §§ 302 and 317(a) and notes that after the filing of an *inter partes* reexamination request, ANY party may file an *ex parte* reexamination request. The reexamination statutes place not limitation upon a requester, as to the timing of filing a request for *ex parte* reexamination relative to the filing of parallel *inter partes* reexamination. However, any *ex parte* reexamination filing must contain a substantial, new and non-cumulative question of patentability. In regard to the asserted derogation of Patent Owner's "*ex parte*" reexamination right to an interview, no statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.33(a) and 1.560 provide guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer an absolute right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[3] The relevant sections of the MPEP

[3] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.

provide guidance on the conduct of interviews to include denial of an interview.[4] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right.

Finally, use of one set of rules, namely the *inter partes* rules and relevant MPEP guidance, is necessary to facilitate the statutory mandate of special dispatch. The arrangement proposed by Patent Owner, permitting a patent owner to conduct an *ex parte* interview on SNQs[5] presented in the *ex parte* reexamination and only letting the requester comment on SNQs presented in the *inter partes* reexamination request, would be untenable to manage, monitor and control and therefore contrary to the mandate of special dispatch. It would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding SNQs, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. In each instance of a patent owner point, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

As reexamination must, by statute, be conducted with special dispatch. Merger of the present concurrent reexamination proceedings is in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings furthers special dispatch by permitting all issues raised in both proceedings, and any overlap of issues, to be resolved at the same time, i.e., a resolution of all SNQs raised in both requests with special dispatch, rather than delaying resolution in one of the proceedings. Patent Owner's "suggestions" to modify the Office's procedure for merging a proceeding that include an *inter partes* reexamination MUST be in accord with, and not contrary to, special dispatch. In the present case, Patent Owner has not established on the record a basis to justify the relief requested. Accordingly, the requested relief will not be granted.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '1201 *inter partes* reexamination proceeding with the '9369 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination requests until after an *inter partes* reexamination certificate has issued and published, unless authorized by the USPTO Director.

Patent Owner's rationale for this violation of the statute is that merger of an *ex parte* reexamination with an *inter partes* reexamination, under 37 CFR 1.989(b), converts the *ex parte* reexamination proceeding into a "*de facto*" *inter partes* reexamination proceeding. Patent owner then extrapolates this logic to multiple *ex parte* filings by the same requester upon the same patent to conclude that such a strategy would result in multiple "*de facto*" *inter partes* reexamination proceedings. As the Office as a matter of routine practice always merges in such

[4] See MPEP §§ 713 *et seq.*, 2281 and 2685
[5] Substantial New Question of Patentability

instance, Patent Owner asserts that the statutory mandate of special dispatch will be challenged. Patent Owner goes on to note that the requester in the present proceeding has employed a multiple filing strategy on eight other different but related patents in Patent Owner's portfolio. Patent Owner cites the Office decisions not to merge *ex parte* reexamination proceedings 90/007,844 (the '7844 proceeding) and 90/007843 (the '7843 proceeding) with *inter partes* reexamination proceedings 95/000,093 (the '093 proceeding) and 95/000,094 (the '094 proceeding) (collectively the "Sony cases") as persuasive for denying merger between the present proceedings. The logic of the Sony cases asserted is that the subsequent filing of an *ex parte* reexamination proceeding merged with a previously filed *inter partes* reexamination by the same requester converts the *ex parte* proceeding into a "*de facto*" *inter partes* reexamination proceeding, and hence a violation of the statute. Patent Owner concedes that the present proceedings are not under suspension, as was the case in the '093 and '094 proceedings. Patent Owner requests thus that the proceedings not be merged, or if merged that 37 CFR 1.989(b) be waived so that Patent Owner may retain "*ex parte* rights" to those issues raised in the *ex parte* reexamination proceeding.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request prior to the filing of an *inter partes* reexamination request. The plain language of the statute states, in part:

> . . . [O]nce 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.

The requester filed an *ex parte* reexamination request prior to filing an *inter partes* reexamination request. The statute does not prohibit the filing of *inter partes* reexamination requests by a requester, that previously filed an *ex parte* reexamination request on the same patent. The non-merge decisions rendered in the "Sony cases" are not binding on the Office. As a general rule, the merger and suspension of proceedings for the same patent before the Office are determined on a fact specific, case-by-case basis. Hence, a decision in one proceeding before the Office is not *per se* binding upon the Office in other proceedings.

Furthermore, the decision to not merge in the "Sony Cases" was based upon the pre-existence of a suspension of the previously filed '093 and '094 *inter partes* reexamination proceedings. (See the Decision Denying Petitions to Merge in the '093 and the '094 proceedings, the text that bridges from the bottom of page 8 to the top of page 9). The statement of denial of the request to merge in the "Sony Cases" appears at an approximate mid-point on page 9 of the decision. After this legal statement of denial, based upon the existence of a suspension of the '093 and '094 *inter partes* proceedings, the decision then goes on to discuss this "*de facto*" *inter partes* filing logic. Therefore, the "*de facto*" *inter partes* filing logic was not part of the decision's rationale that

precluded merger. The decision then concludes with a return to the fact that the court affirmed suspension of the '093 and the '094 *inter partes* proceedings was the determinative factor in denying the petition to merge the later filed *ex parte* proceedings with the previously filed *inter partes* proceedings.

Finally, Patent Owner's "parade of horribles" argument that the confluence of an *inter partes* reexamination with multiple *ex parte* reexamination filings and the Office's routine practice of granting merger will result in a frustration of special dispatch is misplaced. Patent Owner's "parade of horribles" will not come about due the statutory, regulatory and policy protections put in place to prevent such a strategy from being employed against a Patent Owner in a reexamination proceeding. By statute any reexamination requests must contain a substantial, new and non-cumulative question of patentability. By regulation the Office permits a third party requester to file prior art during an *inter partes* reexamination proceeding in very specific circumstances, in a manner that precludes harassment of the Patent Owner. Finally, MPEP §§ 2240 II and 2640 II both set forth an appropriate procedure for petitioning the suspension of any second or subsequently ordered request for reexamination if the Patent Owner can clearly show an intent to harass the Patent Owner. Therefore, Patent Owner's "parade of horribles" filing strategy will not occur, due to these statutory, regulatory and policy mechanisms, which deters and prevents harassment of a patent owner.

In view of the above, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Prevention of Merger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1201 *inter partes* reexamination proceeding and the '9369 *ex parte* reexamination proceeding, merger should not be granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings even if merger occurs, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination rights. Patent Owner states that merger of the proceedings without waiver of 37 CFR 1.989(b) both expands the requester's rights while curtailing the patent owner's rights. Finally, Patent Owner states that rout merger of proceedings filed in this manner only encourages this pattern of filing reexamination requests, which encourages piecemeal reexamination, resulting in a waste of Office resources, a frustration of the statutory mandate of special dispatch and a removal of the distinction between *inter partes* and *ex partes* reexamination proceedings.[6]

Merger of an *inter partes* reexamination and an *ex parte* reexamination, and hence 37 CFR 1.989, does not constitute a statutory, violation as it is grounded in the statutory mandate of special dispatch. 35 U.S.C. 314(c). Title 35 of the United States Code does not contain a statutory right to conduct an interview before the Office in any proceeding, to include *ex parte*

[6] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

reexamination proceedings. Merger of an *inter partes* reexamination proceeding and an *ex parte* reexamination proceeding does not occur until after the time passes for submission of a Patent Owner's statement. Therefore merger does not deny Patent Owner any statutory "*ex parte* rights". Merger, as based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either not merging or merging, but permitting Patent Owner *ex parte* interviews in a merged proceeding, will burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(a) and 1.560 provide the guidelines for conducting and making a record of interviews, but 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview. The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview. Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right. Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Accordingly, the petition to stay the *inter partes* proceeding, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

III. Merger of the 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 95/001,159 and 90/009,358 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

A. 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.

B. CONDUCT OF MERGED PROCEEDING

1. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

2. 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 EFS:

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

By U.S. Postal Service Mail:

> 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 (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

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

3. 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.

4. 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.

5. 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. The October 16, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,201 and *ex parte* Reexamination Control No. 90/009,369 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

3. 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.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 17 2009
CENTRAL REEXAMINATION UNIT

Commissioner for Patents
United States Patent and Trademark Office
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(For *inter partes* Requester)

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IP Prosecution Department
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Irvine, CA 92614

(For *ex parte* Requester)

In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,205
Filed: July 1, 2009
For: U.S. Patent No. 7,360,050

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,370
Filed: December 23, 2008
For: U.S. Patent No. 7,360,050

: DECISION
: DISMISSING
: PETITION TO
: PREVENT MERGER
: AND
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 16, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 REGARDING MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS" filed in *ex parte* reexamination proceeding 90/009,370.

The Patent Owner petition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400 was charged to Patent Owner's credit card on October 19, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

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

Patent Owner's petition is dismissed, and the above captioned proceedings are merged in accordance with 37 CFR 1.989 for the reasons set forth below.

REVIEW OF FACTS

1. On April 15, 2008, the Office issued U.S. Patent No. 7,360,050 (the '050 patent) to Barth *et al.*

2. The '050 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is enforcing at least one of claims 1-31 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 23, 2008, a request for *ex parte* reexamination of claims 29 and 31 of the '050 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,370 (the '9370 proceeding).

5. On March 16, 2009, the Office issued an order granting the '9370 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 29 and 31 of the '050 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9370 *ex parte* reexamination proceeding expired on May 16, 2009.[1]

7. On May 19, 2009, the Office issued a first Office action on the merits in the '9370 *ex parte* reexamination proceeding.

8. On June 22, 2009, the ITC granted Patent Owner's motion for partial termination with respect to the '050 patent. Therefore, the '050 patent is no longer involved in the ITC investigation.

9. On June 23, 2009, a request for *inter partes* reexamination of all the claims (claims 1-31) of the '050 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,205 (the '1205 proceeding).

---

[1] There is no provision for filing a patent owner's statement in an inter partes reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

10. On August 13, 2009, the Office issued an order granting the '1205 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order indicated that all the claims of the '050 patent, claims 1-31, would be subject to reexamination.

11. On August 19, 2009, Patent Owner filed a response in the '9370 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.[2]

12. On October 16, 2009, patent owner filed the present petition in the '9370 proceeding to prevent merger with the '1205 *inter partes* proceeding.

13. This decision addresses Patent Owner's petition to prevent merger.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in 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. 304 states:

> 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.

---

[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the May 19, 2009 Office action.

35 U.S.C. 311(a) states:

> 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.

35 U.S.C. 314(c) states:

> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. 317(a) states:

> (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.

37 CFR 1.33(a) states:

> (1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.
>
> (2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.
>
> (3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.181 (in pertinent part) states

> (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;

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 1.182 states:

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

37 CFR 1.560 states:

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

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

37 CFR 1.948 states:

> a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
>
> (1) which is necessary to rebut a finding of fact by the examiner;
>
> (2) which is necessary to rebut a response of the patent owner; or
>
> (3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

37 CFR 1.955 states:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.989 states:

> (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 and publication 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.

MPEP 2240 II states (in part):

> In certain situations, after a grant of a second or subsequent request for *ex parte* reexamination, where (A) the patent owner files a petition under 37 CFR 1.182 as

part of the statement or as the statement, and (B) it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, if the petition is granted, prosecution on the second or subsequent reexamination would be suspended. Merger of such a second or subsequent request with the already pending reexamination proceeding(s) would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement that reexamination proceeding be conducted with special dispatch.

MPEP 2246 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2248 states (in part):

> 37 CFR 1.515(c) applies only where reexamination is denied; it does not apply to a grant of reexamination where either the patent owner or the requester is not satisfied with one or more findings made in a decision granting reexamination. Except for the limited exception described in MPEP § 2246, no petition may be filed requesting review of a decision granting a request for reexamination, even if the decision grants the request as to a specific claim for reasons other than those advanced by the requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.550.

MPEP 2640 II states (in part):

> Where reexamination is granted on a second or subsequent request, but the patent owner can clearly show that the second or subsequent request was filed for purposes of harassment, the patent owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended.

MPEP 2646 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2648 states (in part):

> Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

MPEP 2686.01 states (in part):

> Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.
> . . .
>
> Case (2) - The earlier (pending) reexamination is an *ex parte* reexamination:
>
> (2)(a) The subsequent request is an *inter partes* reexamination request. ***Any party*** other than the patent owner can file the subsequent *inter partes* reexamination request. (Emphasis added)

DECISION

Findings and Analysis

Patent owner asserts the filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a). Patent owner further asserts this reexamination filing pattern combined with a subsequent merger of the two reexamination proceedings will deny Patent Owner of "*ex parte* reexamination rights". Patent owner requests the remedies of: (1) Suspension of the *inter partes* reexamination proceeding; (2) Non-merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are merged.

In accordance with 35 U.S.C. 302, any member of the public possesses the right to file a request for ex parte reexamination on an issued patent. Specifically the statute states that ANY third party may at ANY time file a request for reexamination based upon ANY prior art. After an *inter partes* reexamination request is ordered, by statute, 35 U.S.C. 317(a), the third party requester in the *inter partes* reexamination is barred from filing another *inter partes* request for reexamination, until an *inter partes* reexamination certificate is issued and published, unless authorized by the USPTO Director. MPEP 2686.01 provides guidance, in accordance with 35

U.S.C. §§ 302 and 317(a) and notes that after the filing of an *inter partes* reexamination request, ANY party may file an *ex parte* reexamination request. The reexamination statutes place not limitation upon a requester, as to the timing of filing a request for *ex parte* reexamination relative to the filing of parallel *inter partes* reexamination. However, any *ex parte* reexamination filing must contain a substantial, new and non-cumulative question of patentability. In regard to the asserted derogation of Patent Owner's "*ex parte*" reexamination right to an interview, no statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.33(a) and 1.560 provide guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer an absolute right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[3] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[4] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right.

Finally, use of one set of rules, namely the *inter partes* rules and relevant MPEP guidance, is necessary to facilitate the statutory mandate of special dispatch. The arrangement proposed by Patent Owner, permitting a patent owner to conduct an *ex parte* interview on SNQs[5] presented in the *ex parte* reexamination and only letting the requester comment on SNQs presented in the *inter partes* reexamination request, would be untenable to manage, monitor and control and therefore contrary to the mandate of special dispatch. It would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding SNQs, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. In each instance of a patent owner point, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

As reexamination must, by statute, be conducted with special dispatch. Merger of the present concurrent reexamination proceedings is in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings furthers special dispatch by permitting all issues raised in both proceedings, and any overlap of issues, to be resolved at the same time, i.e., a resolution of all SNQs raised in both requests with special dispatch, rather than delaying resolution in one of the proceedings. Patent Owner's "suggestions" to modify the Office's procedure for merging a proceeding that include an *inter partes* reexamination MUST be in accord with, and not contrary to, special dispatch. In the present case, Patent Owner has not established on the record a basis to justify the relief requested. Accordingly, the requested relief will not be granted.

---

[3] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.

[4] See MPEP §§ 713 *et seq.*, 2281 and 2685

[5] Substantial New Question of Patentability

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '1205 *inter partes* reexamination proceeding with the '9370 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination requests until after an *inter partes* reexamination certificate has issued and published, unless authorized by the USPTO Director.

Patent Owner's rationale for this violation of the statute is that merger of an *ex parte* reexamination with an *inter partes* reexamination, under 37 CFR 1.989(b), converts the *ex parte* reexamination proceeding into a "*de facto*" *inter partes* reexamination proceeding. Patent owner then extrapolates this logic to multiple *ex parte* filings by the same requester upon the same patent to conclude that such a strategy would result in multiple "*de facto*" *inter partes* reexamination proceedings. As the Office as a matter of routine practice always merges in such instance, Patent Owner asserts that the statutory mandate of special dispatch will be challenged. Patent Owner goes on to note that the requester in the present proceeding has employed a multiple filing strategy on eight other different but related patents in Patent Owner's portfolio. Patent Owner cites the Office decisions not to merge *ex parte* reexamination proceedings 90/007,844 (the '7844 proceeding) and 90/007843 (the '7843 proceeding) with *inter partes* reexamination proceedings 95/000,093 (the '093 proceeding) and 95/000,094 (the '094 proceeding) (collectively the "Sony cases") as persuasive for denying merger between the present proceedings. The logic of the Sony cases asserted is that the subsequent filing of an *ex parte* reexamination proceeding merged with a previously filed *inter partes* reexamination by the same requester converts the *ex parte* proceeding into a "*de facto*" *inter partes* reexamination proceeding, and hence a violation of the statute. Patent Owner concedes that the present proceedings are not under suspension, as was the case in the '093 and '094 proceedings. Patent Owner requests thus that the proceedings not be merged, or if merged that 37 CFR 1.989(b) be waived so that Patent Owner may retain "*ex parte* rights" to those issues raised in the *ex parte* reexamination proceeding.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request prior to the filing of an *inter partes* reexamination request. The plain language of the statute states, in part:

> . . . [O]nce 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.

The requester filed an *ex parte* reexamination request prior to filing an *inter partes* reexamination request. The statute does not prohibit the filing of *inter partes* reexamination

requests by a requester, that previously filed an *ex parte* reexamination request on the same patent. The non-merge decisions rendered in the "Sony cases" are not binding on the Office. As a general rule, the merger and suspension of proceedings for the same patent before the Office are determined on a fact specific, case-by-case basis. Hence, a decision in one proceeding before the Office is not *per se* binding upon the Office in other proceedings.

Furthermore, the decision to not merge in the "Sony Cases" was based upon the pre-existence of a suspension of the previously filed '093 and '094 *inter partes* reexamination proceedings. (See the Decision Denying Petitions to Merge in the '093 and the '094 proceedings, the text that bridges from the bottom of page 8 to the top of page 9). The statement of denial of the request to merge in the "Sony Cases" appears at an approximate mid-point on page 9 of the decision. After this legal statement of denial, based upon the existence of a suspension of the '093 and '094 *inter partes* proceedings, the decision then goes on to discuss this "*de facto*" *inter partes* filing logic. Therefore, the "*de facto*" *inter partes* filing logic was not part of the decision's rationale that precluded merger. The decision then concludes with a return to the fact that the court affirmed suspension of the '093 and the '094 *inter partes* proceedings was the determinative factor in denying the petition to merge the later filed *ex parte* proceedings with the previously filed *inter partes* proceedings.

Finally, Patent Owner's "parade of horribles" argument that the confluence of an *inter partes* reexamination with multiple *ex parte* reexamination filings and the Office's routine practice of granting merger will result in a frustration of special dispatch is misplaced. Patent Owner's "parade of horribles" will not come about due the statutory, regulatory and policy protections put in place to prevent such a strategy from being employed against a Patent Owner in a reexamination proceeding. By statute any reexamination requests must contain a substantial, new and non-cumulative question of patentability. By regulation the Office permits a third party requester to file prior art during an *inter partes* reexamination proceeding in very specific circumstances, in a manner that precludes harassment of the Patent Owner. Finally, MPEP §§ 2240 II and 2640 II both set forth an appropriate procedure for petitioning the suspension of any second or subsequently ordered request for reexamination if the Patent Owner can clearly show the proceeding was filed with an intent to harass the Patent Owner. Therefore, Patent Owner's "parade of horribles" filing strategy will not occur, due to these statutory, regulatory and policy mechanisms, which deters and prevents harassment of a patent owner.

In view of the above, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Prevention of Merger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1205 *inter partes* reexamination proceeding and the '9370 *ex parte* reexamination proceeding, merger should not be granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings even if merger occurs, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of

full *ex parte* reexamination rights. Patent Owner states that merger of the proceedings without waiver of 37 CFR 1.989(b) both expands the requester's rights while curtailing the patent owner's rights. Finally, Patent Owner states that rout merger of proceedings filed in this manner only encourages this pattern of filing reexamination requests, which encourages piecemeal reexamination, resulting in a waste of Office resources, a frustration of the statutory mandate of special dispatch and a removal of the distinction between *inter partes* and *ex partes* reexamination proceedings.[6]

Merger of an *inter partes* reexamination and an *ex parte* reexamination, and hence 37 CFR 1.989, does not constitute a statutory, violation as it is grounded in the statutory mandate of special dispatch. 35 U.S.C. 314(c). Title 35 of the United States Code does not contain a statutory right to conduct an interview before the Office in any proceeding, to include *ex parte* reexamination proceedings. Merger of an *inter partes* reexamination proceeding and an *ex parte* reexamination proceeding does not occur until after the time passes for submission of a Patent Owner's statement. Therefore merger does not deny Patent Owner any statutory "*ex parte* rights". Merger, as based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either not merging or merging, but permitting Patent Owner *ex parte* interviews in a merged proceeding, will burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(a) and 1.560 provide the guidelines for conducting and making a record of interviews, but 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview. The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview. Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right. Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Accordingly, the petition to stay the *inter partes* proceeding, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

[6] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

III. Merger of the 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 95/001,205 and 90/009,370 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

A. 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.

B. CONDUCT OF MERGED PROCEEDING

1. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

2. 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 EFS:

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

By U.S. Postal Service Mail:

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 (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

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

3. 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.

4. 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.

5. 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. The October 16, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,205 and *ex parte* Reexamination Control No. 90/009,370 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

3. 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.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

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

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

Robert Greene Sterne.
STERNE, KESSLER, GOLDSTEIN
& FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

MAILED

JUN 11 2009

CENTRAL REEXAMINATION UNIT

William H Wright
ORRICK, HERRINGTON
& SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

(For Third Party Requester)

DECISION
GRANTING IN-PART
PETITION FOR EXTENSION
OF TIME
37 CFR § 1.550(c) and § 1.181

In re: Barth *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,371
Deposited: 22 December 2008
For: US Patent No. 7,330,952

This is a decision on the 5 June 2009, "Petition For Extension of Time to File Response to First Office Action Pursuant to 37 CFR § 1.550(c)" requesting that the time for responding to the non-final Office action mailed 29 April 2009, be extended by two (2) months. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g). The petition includes the required 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.

SUMMARY OF RELEVANT FACTS

1. On 12 February 2008 US Patent No. 7,330,952 was granted to Barth *et alia.*

2. On 22 December 2008 a request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,371.

3. On 20 February 2008 the Order was granted for *ex parte* reexamination in control number 90/009,371.

4. On 29 April 2009 a non-final Office action was mailed

9. On 05 June 2009 the instant petition was submitted.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 29 April 2009. The Office action is a non-final Office action. The petition for extension of time was timely filed on 05 June 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.17 (g). The petition includes the required certificate of service.

The extension of time is granted in-part

37 CFR § 1.550 (c) states:

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

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

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

ANALYSIS AND FINDINGS

The 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 non-final rejection mailed 29 April 2009. The petition was timely filed. The petition indicates that service was provided to the third party requester.

The petition dated 05 June 2009 articulates the extensive number of pages of deposition to be reviewed, examining the need for expert declarants and the possibility of swearing behind references. On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time.

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

CONCLUSION

1. The patent owner's petition for extension of one month time in which to file a response to the Office action dated 29 April 2009 is hereby **granted in-part**.

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

3. The patent owner's response is due on **29 July 2009** .

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,371	12/22/2008	7,330,952	2805.002REX5	9883

26111 7590 10/16/2009

EXAMINER	

MORGAN LEWIS & BOCKIUS LLP/RAMBUS INC.
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA94306

ART UNIT	PAPER NUMBER

DATE MAILED: 10/16/2009

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
ORRICK,HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA SUITE 1600
IRVINE, CA 92614-2558

Date: MAILED

OCT 16 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009371
PATENT NO. : 7330952
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.
90/009,371	12/22/2008	7,330,952	2805.002REX5	9883

26111 7590 10/16/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/16/2009

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

RAMBUS INC.
Morgan Lewis & Bockius, LLP
2 Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306

(For Patent Owner)

MAILED

OCT 16 2009

CENTRAL REEXAMINATION UNIT

William H. Wright
Orrick, Herrington & Sutcliffe, LLP
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

(For *Ex Parte* Requester)

David M. O'Dell
Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

(For *Inter Partes* Requester)

Jon W. Wright
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(Courtesy Copy)

Ex parte Reexamination Proceeding
Control No. 90/009,371
Filed: December 22, 2008
For: U.S. Patent No. 7,330,952

Inter Partes Reexamination Proceeding
Control No. 95/001,196
Filed: June 4, 2009
For: U.S. Patent No. 7,330,952

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,330,952 (the '952 patent) issued to Barth *et al.* on February 12, 2008.

2. A request for *ex parte* reexamination of claims 21, 22, and 24 of the '952 patent was filed on December 22, 2008, by NVIDIA Corporation, and the request was assigned control number 90/009,371 (the '9371 *ex parte* proceeding).

3. On February 20, 2009, *ex parte* reexamination was ordered for claims 21, 22, and 24 of the '952 patent based on the examiner's determination that the December 22, 2008 request raised a substantial new question of patentability affecting these claims.

4. On April 29, 2009, a non-final Office action was mailed in the '9371 *ex parte* proceeding, rejecting claims 21, 22, and 24 of the '952 patent.

5. On April 30, 2009, patent owner filed a notification of prior or concurrent proceedings under 37 CFR 1.565 in the '9371 *ex parte* proceeding.

6. On May 20, 2009, patent owner filed a first supplemental information disclosure statement in the '9371 *ex parte* proceeding.

7. A request for *inter partes* reexamination of claims 1-28 of the '952 patent was filed on June 4, 2009, in which NVIDIA Corporation was identified as the real party in interest, and the request was assigned control number 95/001,196 (the '1196 *inter partes* proceeding).

8. On June 5, 2009, patent owner filed a petition for extension of time to file a response to the April 29, 2009 Office action in the '9371 *ex parte* proceeding.

9. On June 11, 2009, a decision granting-in-part the petition for extension of time was mailed in the '9371 *ex parte* proceeding. The time for response was extended by one month.

10. On July 29, 2009, patent owner filed a response to the April 29, 2009 Office action in the '9371 *ex parte* proceeding, requesting reconsideration of the rejections of the claims.

11. On August 13, 2009, *inter partes* reexamination was ordered for claims 1-28 of the '952 patent based on the examiner's determination that the June 4, 2009 request raised a substantial new question of patentability affecting these claims.

12. On August 25, 2009, patent owner filed a supplemental reply to the Office action in the '9371 *ex parte* proceeding.

13. On September 29, 2009, patent owner filed a second supplemental information disclosure statement in the '9371 *ex parte* 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 the facts, both the '9371 and the '1196 reexamination proceedings are currently pending. An order granting reexamination of claims 21, 22, and 24 and a non-final Office action have been mailed in the '9371 *ex parte* proceeding, an order granting reexamination of claims 1-28 has been mailed in the '1196 *inter partes* proceeding, and a decision under 37 CFR 1.989 is timely.

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, (1) to provide a comprehensive examination of the patent based on the issues raised in both proceedings, and (3) to expedite prosecution of both proceedings. In the present instance, merger of the '9371 and the '1196 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989, the 90/009,371 and 95/001,196 proceedings are hereby 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

The claims are identical in both proceedings. The 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, however, the '9371 *ex parte* reexamination proceeding was requested by the same third party that requested the *inter partes* reexamination. And, that third party (NVIDIA Corporation) has full *inter partes* reexamination participation rights.

It is noted that reexamination was ordered for claims 21, 22, and 24 of the '952 patent in the '9371 *ex parte* proceeding, while reexamination was ordered for claims 1-28 of the '952 patent in the '1196 *inter partes* proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-28 of the '952 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 proceedings 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 proceedings, for entry into each file.

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

By EFS-Web: Registered users may submit the response via the electronic filing system EFS-Web.

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

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '9371 proceeding and (3) the '1196 proceeding. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of RAMBUS INC., c/o Morgan Lewis &

Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306. Accordingly, all future correspondence will be directed to RAMBUS INC., c/o Morgan Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same address should be made of record in the reexamination proceedings).

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of RAMBUS INC., c/o Morgan Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,196 and *ex parte* Reexamination Control No. 90/009,371 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with **ONE (1) MONTH** from the mailing of this decision to file papers to address the correspondence address considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address in both proceedings, or

   (B) The receipt of such papers.

4. Any questions concerning this communication should be directed to Eugenia A. Jones, Senior Legal Advisor, at 571-272-7727, or in her absence to the undersigned at 571-272-7726.

Pinchus M. Laufer
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.
90/009,371	12/22/2008	7,330,952	2805.002REX5	9883

26111 7590 12/23/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2009

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
ORRICK,HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA SUITE 1600
IRVINE, CA 92614-2558

Date:
MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009371
PATENT NO. : 7330952
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

Robert Greene Stern
STERNE, KESSLER, GOLDSTEIN
& FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

William H Wright
ORRICK, HERRINGTON
& SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

(For Third Party Requester)

MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

In re: Barth et alia
Ex Parte Reexamination Proceeding
Control No. 90/009,371
Deposited on: 22 December 2008
For: US Patent No. 7,330,952

In re: Barth et alia
Ex Parte Reexamination Proceeding
Control No. 95/001,196
Deposited on: 04 June 2009
For: US Patent No. 7,330,952

DECISION
GRANTING
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 16 December 2009, "Petition for Extension of Time to File Response to First Office Action in Merged Proceedings Pursuant to Under 37 CFR § 1.956" requesting the response period be extended by one-month for the non-Final Office action mailed 02 December 2009, be extended by one (1) month. The petition submitted 16 December 2009 was timely filed with certificate of service.

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period for response be extended by one-month for the non-final Office action mailed 02 December 2009, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 16 December 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes 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 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.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be

considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

DECISION

The patent owner's representative petitions to extend the period for response by adding one (1) month to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 02 December 2009. The patent owner submitted a

timely filed the petition on 16 December 2009 with the appropriate fee and certificate of service.

The petition dated 16 December 2009 notes several reasons for extension, among them, length of the Office action and need to obtain declaratory and factual evidence pursuant to 37 CFR §§ 1.131 & 1.132. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

The petition request to extend the response time is hereby granted.

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 02 December 2009 is hereby **granted.**

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

3. The response is extended to **02 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

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.
90/009,372		6,425,401	004859.00064	6420

22907 7590 02/18/2009

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/18/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Rober S. Mallin
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
Chicago, IL 60610

Date:

MAILED

FEB 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009372
PATENT NO. : 6425401
ART UNIT : 3991

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paul M Rivard
Banner & Witcoff
1100 13th Street
Suite 1200
Washington, D.C. 2005-4051

(For Patent Owner)

MAILED

FEB 18 2009

CENTRAL REEXAMINATION UNIT

Robert S. Mallin
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(For Requester)

In re Williams
Reexamination Proceeding
Control No.: 90/009,372
Filed: January 2, 2009
For: U.S. Patent No. 6,425,401

: DECISION GRANTING
: PETITION
: UNDER 37 CFR 1.183

This is a decision on the January 27, 2009 patent owner petition under 37 CFR 1.183, titled "PETITION PURSUANT TO 37 CFR 1.183 TO WITHDRAW THE NOTICE OF FAILURE TO COMPLY WITH EX PARTE REEXAMINATION REQUEST FILING REQUIREMENTS MAILED 01/23/09, AND TO GRANT A FILING DATE OF JANUARY 2, 2009," requesting waiver of some provisions of 37 CFR 1.510.

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

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 6,425,401 (the '401 patent) issued on July 30, 2002.

2. A request for reexamination of the '401 patent was submitted on January 2, 2009. The request was assigned control No. 90/009,372 (the '372 proceeding).

3. A notice of incomplete *ex parte* reexam was mailed January 23, 2009.

4. On the same day, January 23, 2009, requester submitted a replacement Form 1449 listing only the six references believed to raise substantial new questions of patentability and a separate evidence appendix listing the remaining documents.

5. On January 27, 2009, the present petition was received, together with an explanation of the relevance of each reference listed on the original Form 1449.

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 1.510 states (in part):

> (b) Any request for reexamination must include the following parts:
>
> (1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
>
> (2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.

37 CFR 1.510 requires a detailed explanation of the pertinency and manner of applying the cited art to every claim for which reexamination is requested.

Based upon the showing set forth in the petition, and the individual facts and circumstances of this proceeding, and in the interests of justice, a filing date of January 2, 2009 has been accorded to this proceeding. It is observed that the record contains sufficient information to permit prompt treatment of the proceeding, despite the fact that specific provisions of 37 CFR 1.510 have not been complied with.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.510 is granted.

2. A filing date of January 2, 2009 has been accorded to this proceeding.

3. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit, for processing of this proceeding with a filing date of January 2, 2009.

4. 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

2-18-09

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JUL 20 2009

CENTRAL REEXAMINATION UNIT

Banner & Witcoff, Ltd.
1100 13th Street, NW
Suite 1200
Washington, DC 20005-4051

(For Patent Owner)

Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No. 90/009,372
Filed: January 2, 2009
For: U.S. Patent No. 6,425,401

DECISION
DISMISSING
PETITION

This is a decision on the May 11, 2009 patent owner petition paper entitled "PETITION TO SUSPEND REEXAMINATION UNTIL JUNE 30, 2009 UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 AND 1.565(b)."

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

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

REVIEW OF FACTS

1. U.S. Patent No. 6,425,401 issued to Williams on July 30, 2002 (the '401 patent).

2. On January 2, 2009, a request for *ex partes* reexamination of claim 41 of the '401 patent was filed by a third party requester, which proceeding was assigned Control No. 90/009,372 (the '9372 proceeding).

3. Reexamination was ordered in the '9372 proceeding on March 5, 2009.

4. On May 11, 2009, patent owner filed the instant "PETITION TO SUSPEND REEXAMINATION UNTIL JUNE 30, 2009 UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 AND 1.565(b)."

5. To date, there has been no Office action in the '9372 proceeding.

DECISION

In the instant petition, patent owner requested limited suspension of the '9372 proceeding until June 30, 2009. To date, there has been no Office action in the '9372 proceeding and the period for which patent owner sought suspension relief has passed. Accordingly, patent owner's request for limited suspension of the '9372 proceeding until June 30, 2009, is moot. Thus, patent owner's May 11, 2009 petition is dismissed as moot.

CONCLUSION

1. Patent owner's May 11, 2009 "PETITION TO SUSPEND REEXAMINATION UNTIL JUNE 30, 2009 UNDER 37 C.F.R. §§ 1.181, 1.182, 1.183 AND 1.565(b)" is dismissed as moot.

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

3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Office of Patent Legal Administration, at (571) 272-7717.

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

Kenpet7
7-16-09

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OCT 20 2009

CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

: For Patent Owner

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

: For Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,372
Filed: January 2, 2009
For: US Patent No. 6,425,401

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

The paper filed May 26, 2009 by James T. Carmichael of Banner & Witcoff in Washington DC, representing Patent Owner in the reexamination proceeding, entitled "PETITION TO REFUSE IMPROPER PAPER" is before the Director of the Central Reexamination Unit.

The patent owner petition is dismissed as moot.

DISCUSSION

Patent Owner requested that the third party paper filed May 18, 2009 be denied entry.

A request for ex parte reexamination was filed January 2, 2009. An order granting reexamination was mailed March 5, 2009. No patent owner's statement under 37 CFR 1.530 was received. The third party requester filed an improper submission on May 18, 2009. The paper has been (and will remain) marked

"closed" and "not public." The paper will not form part of the record, and will not be available to the public.

In view of the above, there is no relief to be granted to petitioner. Accordingly, the petition is dismissed as moot.

Deborah Jones, SPE Art Unit 3991
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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Docket Clerk
P.O. Drawer 800889
Dallas, TX 75380

(For Patent Owner)

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Paul Morico
Baker Botts L.L.P.
910 Louisiana
Houston, TX 77002

(For 3rd Party Requester)
(90/010,114)

K. Lee Marshall
Bryan Cave LLP
211 N. Broadway, Suite 3600
St. Louis, MO 63102-2750

(For 3rd Party Requester)
(90/009,374)

Reexam Control No.: 90/010,114
Filed : February 29, 2008
For U.S. Patent No. : 6,230,930

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/009,374
Filed : January 14, 2009
For U.S. Patent No. : 6,230,930

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. 90/010,114 was ordered in a decision mailed April 9, 2008 indicating that claims 1-22, 24-26, 28-46, 48-50, 53-56, 58-67, 71, 72, 83-85, 87, 129, 130, 134, 136, 138-141, 143-145, and 159 would be reexamined. A non-final Office action was mailed October 28, 2008, rejecting all of the claims for which reexamination was requested. A timely response was filed by patent owner on January 2, 2009 (certificate of mailing dated December 29, 2008, the 28th being a Sunday). The response included amendments to claims 1, 7,

13, 18, 20, 21, 24 28, 59, 63, 69, 83-85, 87, 107, 129-131, 134, 135, 150, 152, 156, and 159, and the addition of claims 160 and 161. In addition, on April 7, 2009, an Information Disclosure Statement was filed. No Office action has been issued in response to patent owner's reply of January 2, 2009.

Reexamination in application control No. 90/009,374 was ordered in a decision mailed March 4, 2009, indicating that claims 57 and 147 would be reexamined. Patent owner did not file a patent owner statement in this proceeding. An Information Disclosure Statement was filed April 7, 2009. No Office action has been issued in this proceeding. No changes to the specification, claims and/or drawings have been made in this proceeding.

As evidenced by the above facts, reexamination control No. 90/010,114 and reexamination control No. 90/009,374 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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

As noted above, claims have been amended and added in the '114 reexamination proceeding by virtue of the amendment filed January 2, 2009. No amendments have been filed in the '374 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-22, 24-26, 28-46, 48-50, 53-67, 69, 71, 72, 83-85, 87, 107, 129-131, 134-136, 138-141, 143-145, 147, 150, 152, 156, and 159-161, 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. 90/010,114 and 90/009,374 are hereby merged into a single proceeding. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in each of the files.** Upon receipt of the response, an Office action will issue in due course.

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

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,375	12/31/2008	6202649	004859.00063	9970

22907 7590 07/02/2009

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

K. Shannon Mrksich
BRINKS, HOFER, GILSON & LIONE
P.O BOX 10395
Chicago, IL 60610

Date:

MAILED

JUL 02 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009375
PATENT NO. : 6202649
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
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ALEXANDRIA, VA 22313-1450
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Banner & Witcoff, LTD.
1100 13th Street, N.W.
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Washington, DC 20005-4051

(For Patent Owner)

Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, Illinois 60610

(For Third Party Requester)

MAILED

JUL 02 2009

CENTRAL REEXAMINATION UNIT

In re Jonnie R. Williams
Inter Partes Reexamination Proceeding
Control No. 90/009,375
Filed: December 31, 2008
For: U.S. Patent No. 6,202,649

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

This is a decision on the May 4, 2009 patent owner petition, which is titled "PETITION TO SUSPEND REEXAMINATION UNTIL JUNE 30, 2009 UNDER 37 C.F.R. 1.181, 1.182, 1.183, AND 1.565(b)" (the "Petition").

The petition and reexamination control number 90/009,375 are before the Office of Patent Legal Administration.

The patent owner petition is dismissed as moot.

DISCUSSION

Patent owner requested suspension of the reexamination proceeding until June 30, 2009 in order to "permit full consideration of evidence likely to be developed as part of an ongoing infringement action that will be tried during the intervening period" (petition at 1).

As June 30, 2009 has come and gone, no relief remains to be granted to petitioner. Accordingly, the petition accordingly is dismissed as moot.

CONCLUSION

1. The patent owner petition is dismissed as moot.

2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit for further processing and examination.

3. Telephone inquires related to 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 Schor
Senior Legal Advisor
Office of Patent Legal Administration

7-1-09

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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OCT 20 2009

CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD.
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SUITE 1200
WASHINGTON, DC 20005-4051

: For Patent Owner

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P.O. BOX 10395
CHICAGO, IL 60610

: For Requester

Ex Parte Reexamination Proceeding
Control No. 90/009,375
Filed: December 31, 2008
For: US Patent No. 6,202,649

: **DECISION DISMISSING PETITION**

The paper filed May 26, 2009 by James T. Carmichael of Banner & Witcoff in Washington DC, representing Patent Owner in the reexamination proceeding, entitled "PETITION TO REFUSE IMPROPER PAPER" is before the Director of the Central Reexamination Unit.

The patent owner petition is dismissed as moot.

DISCUSSION

Patent Owner requested that the third party paper filed May 18, 2009 be denied entry.

A request for ex parte reexamination was filed December 31, 2008. An order granting reexamination was mailed February 12, 2009. No patent owner's statement under 37 CFR 1.530 was received. The third party requester filed an improper submission on May 18, 2009. The paper has been (and will remain)

marked "closed" and "not public." The paper will not form part of the record, and will not be available to the public.

In view of the above, there is no relief to be granted to petitioner. Accordingly, the petition is dismissed as moot.

Deborah Jones, SPE Art Unit 3991
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUL 14 2009

CENTRAL REEXAMINATION UNIT

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Brian Poissant (For Patent Owner)
JONES DAY
222 EAST 41ST STREET
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Robert A. King (For 95/000,465 & 90/009,377 Requester)
HUNTON & WILLIAMS LLP
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David R. Bailey (Courtesy Copy)
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA PA 19104-2891

Inter Partes Reexamination Proceeding
Control No. 95/000,465
Filed: May 5, 2009
For: U.S. Patent No. 7,128,744

Ex Parte Reexamination Proceeding
Control No. 90/009,377
Filed: January 8, 2009
For: U.S. Patent No. 7,128,744

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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. 7,128,744 (the '744 patent) issued to Weaver *et al.* on October 31, 2006.

2. A request for *ex parte* reexamination of claims 1-55 of the '744 patent was filed on January 8, 2009, by third party requester Smith & Nephew, Inc., and the request was assigned control number 90/009,377 (the '9377 *ex parte* proceeding).

3. On February 13, 2009, *ex parte* reexamination was ordered for the '9377 proceeding based on the examiner's determination that the January 8, 2009 request raised a substantial new question of patentability.

4. A request for *inter partes* reexamination of claims 1-55 of the '744 patent was filed on May 5, 2009, by third party requester Smith & Nephew, Inc., and the request was assigned control number 95/000,465 (the '465 *inter partes* proceeding).

5. On June 19, 2009, *inter partes* reexamination was ordered for the '465 proceeding based on the examiner's determination that the May 5, 2009 request raised a substantial new question of patentability.

6. There has been no Office action in the '465 *inter partes* proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 expired in the '9377*e x parte* proceeding after April 13, 2009. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '465 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 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] 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 (aside from the request).

> §§ 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 95/000,465 & 90/009,377 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 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 proceeding are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '9377 *ex parte* reexamination was requested by the same third party that requested the *inter partes* reexamination. And, that third party (Smith & Nephew, Inc.) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester, will contain the identifying data for both proceedings 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 proceedings, 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 (or delivery service) 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

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.

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the 95/00,465 proceeding and (3) the 90/009,377 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. **The current correspondence address of record in the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c),** and it is that of JONES DAY, 222 EAST 41ST STREET, NEW YORK, NY 10017-6702. Accordingly, all future correspondence will be directed to JONES DAY, 222 EAST 41ST STREET, NEW YORK, NY 10017-6702, unless patent owner changes the correspondence address of record in the patent (the same address should be explicitly made of record in the reexamination proceedings).

It is further noted that different attorneys are of record for the two reexamination proceedings. In order to permit filing of patent owner papers in the now merged proceeding by one attorney alone, the two proceedings must given a single attorney of record, with appointment being made as appropriate. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to do so. If there is a newly designated attorney, patent owner must supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings). If this is not rectified, the attorney of record will be taken as the attorney of record in the patent

As a one-time courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of JONES DAY, 222 EAST 41ST STREET, NEW YORK, NY 10017-6702, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,465 and *ex parte* Reexamination Control No. 90/009,377 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

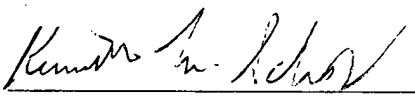
2. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to file papers to address the correspondence address and attorney of record considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address and attorney of record in both proceedings, or

   (B) The receipt of such papers.

4. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



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

7-13-09

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.
90/009,377	01/08/2009	7128744	SYNT-0702	4031

53443 7590 02/02/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2010

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

Robert A. King
HUNTON & WILLIAMS LLP, INTELLECTUAL PROPERTY DEPT.
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109

Date:

MAILED

FEB 02 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000465 & 90/009,377
PATENT NO. : 7128744
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

ROBERT A. KING
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPT.
1900 K STREET, N.W., SUITE 1200
WASHINGTON, DC 20006-1109

(For *Inter Partes & Ex Parte* Requester)

MAILED

FEB 02 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,465
Filed: May 5, 2009
For: U.S. Patent No. 7,128,744

Ex Partes Reexamination Proceeding
Control No. 90/009,377
Filed: January 8, 2009
For: U.S. Patent No. 7,128,744

DECISION DISMISSING PETITION

This is a decision on the patent owner paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)," filed on November 19, 2009.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's Deposit Account No. 233050.

REVIEW OF THE RELEVANT FACTS

1. On October 31, 2006, United States Patent No. 7,128,744 ("the '744 patent") issued to Weaver *et al.*

2. On January 8, 2009, a request for *ex parte* reexamination of the '744 patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/009,377 ("the '9377 proceeding").

3. On February 13, 2009, the Office mailed an order granting *ex parte* reexamination in the '9377 proceeding.

4. On May 5, 2009, a request for *inter partes* reexamination of the '744 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,465 ("the '465 proceeding").

5. On June 19, 2009, the Office mailed an order granting *inter partes* reexamination in the '465 proceeding.

6. On July 14, 2009, the Office mailed a decision *sua sponte* merging the '9377 *ex parte* and the '465 *inter partes* proceedings ("the merged proceeding").

7. On November 5, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On November 19, 2009, patent owner filed the instant petition entitled, "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("petition under 37 CFR 1.183").

9. Concurrently, on November 19, 2009, patent owner filed a request for a two-month extension of time to respond to the November 5, 2009 Office action.

10. On November 25, 2009, patent owner's petition for a two-month extension of time was granted for one month only, extending the period for response to the November 5, 2009 Office action to February 5, 2009.

11. On December 30, 2009, patent owner filed a petition for an additional two-week extension of time to respond to the November 5, 2009 Office action.

12. On January 7, 2010, patent owner's petition for an additional two-week extension of time was granted, extending the period for response to the November 5, 2009 Office action to February 19, 2009.

DECISION

Relevant Statutes, Regulations and Procedures

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.

Patent Owner's Petition under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length. In particular, patent owner requests that "[i]n view of the voluminous nature of the Office Action and the numerous and complex issues raised therein" the page limit for patent owner's response to the November 5, 2009 Office action be increased "to an amount equal to the number of pages used by the Examiner for presenting the rejections set forth in the November 5, 2009 Office Action."[1]

In support of its request for waiver of the rule, patent owner asserts that "[t]he outstanding Office Action presents 58 separate grounds of rejection for alleged obviousness that are said to find basis in 17 documents and publications" and that "[t]he Examiner has adopted in their entirety 17 claim charts submitted by the Third Party Requester and 23 pages from one of the Requester's written requests to support the rejections."[2] Patent owner asserts that "[i]n sum, these adopted claim charts and written request documents cited by the Examiner reflect that the Examiner has used approximately 1,263 pages for presenting the rejections set forth in the November 5, 2009 Office Action."[3] Patent owner further asserts that "[a]s a point of reference on the facial insufficiency of the 50-page limit under these circumstances, Patent Owner notes that the Requests for Reexamination (in both the *ex parte* and *inter partes* requests) that appear to have served as a basis for the Office Action span 116 pages (not including the exhibits) and include in addition the aforementioned numerous and lengthy claim charts."[4]

Further in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b), patent owner asserts that "[t]he increase in pages is further necessitated by the fact that the outstanding grounds for rejection are for alleged obviousness" and that "[g]iven the analytical standards set forth in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), Patent Owner needs adequate briefing space to tell the full and complete story of the significant inventions embodied in the patent claims that currently are subject to reexamination."[5] Additionally, patent owner states that it intends support its response with factual expert declarations, in addition to drawings and images of bone plates and the prior art.[6]

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[1] Petition under 37 CFR 1.183 at page 2.
[2] Petition under 37 CFR 1.183 at page 2.
[3] Petition under 37 CFR 1.183 at page 2.
[4] Petition under 37 CFR 1.183 at page 2.
[5] Petition under 37 CFR 1.183 at page 2.
[6] Petition under 37 CFR 1.183 at page 2. *See* MPEP 2667, which provides, in-part: "Any affidavit or declaration (or a clearly defined portion thereof) that contains opinon(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

Analysis and Findings

The instant 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. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

As indicated above, patent owner seeks waiver of 37 CFR 1.943(b) to increase the page limit for patent owner's response to the outstanding Office action to a length that is equal to the length of the November 5, 2009 Office action, which, patent owner asserts, is effectively 1,263 pages long.[7] It is to be noted, however, that the length of the Examiner's treatment of issues is not a *per se* indication of how many pages patent owner will need. In some instances, a long examiner discussion can be rebutted by simply showing a flaw in one or more points of the discussion, using a few sentences or paragraphs to do so. For example, while patent owner states "that 50 pages are plainly insufficient for its response to an Office Action of such magnitude and depth," it is not clear exactly how many pages patent owner would need to develop a response to each of the rejections, or that a maximum of 1,263 pages would be needed to sufficiently to develop a response to all of the rejections.[8] Thus, in this instance, patent owner has provided arguments in support of why more pages are deemed necessary to complete the response, but patent owner has failed to provide a concrete basis for an accurate determination of how many additional pages are needed to complete the response.

A concrete showing which petitioner could have made in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) would be an attempt to draft a response in compliance with the 50-page limit followed by submission of the resulting drafted response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Such a submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner could have relied on the proposed response for justification that more pages (than are permitted by rule) are needed to complete the response and to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

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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. ... Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count."

[7] On its face, the November 5, 2009 Office action is 23 pages long.

[8] Petition under 37 CFR 1.183 at page 2.

Patent owner may file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), accompanied by a drafted response, as described immediately above. If the Office does not grant such a petition under 37 CFR 1.183 to the full extent of the suggested proposed response, patent owner would be given a period of 15 days within which to submit a compliant response in accordance with the page limit set forth in the decision on that petition. The third party requester would then have 30 days from the date of service of any patent owner's rule-compliant response that is filed, to file a comments paper pursuant to 37 CFR 1.947.[9] If the Office does grant such a petition under 37 CFR 1.183, the third party requester would have 30 days from the mailing date of a decision granting patent owner's petition under 37 CFR 1.183 and accepting the proposed response as page-length compliant, in which to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

For all of the reasons set forth above, patent owner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b), and the November 19, 2009 petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. The patent owner November 19, 2009 petition under 37 CFR 1.183 is **dismissed**.

2. Jurisdiction for the instant merged reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at 571-272-7717.

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

2-2-10
Kenpet7/IP/length

[9] *See* MPEP 2667(I)(A)(2), which provides, in-part: "Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options: (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. ... If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice."

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 04 2010

CENTRAL REEXAMINATION UNIT

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WOODCOCK WASHBURN LLP
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PHILADELPHIA, PA 19104-2891

(For Patent Owner)

ROBERT A. KING
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPT.
1900 K STREET, N.W., SUITE 1200
WASHINGTON, DC 20006-1109

(For *Inter Partes & Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,465
Filed: May 5, 2009
For: U.S. Patent No. 7,128,744

Ex Partes Reexamination Proceeding
Control No. 90/009,377
Filed: January 8, 2009
For: U.S. Patent No. 7,128,744

DECISION GRANTING PATENT OWNER PETITION AND *SUA SPONTE* WAIVING REQUESTER PAGE LIMIT

This is a decision on the patent owner paper entitled "RENEWED PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)," filed on February 19, 2010.

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

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's deposit account on February 22, 2010.

BACKGROUND

1. On October 31, 2006, United States Patent No. 7,128,744 ("the '744 patent") issued to Weaver *et al.*

2. On January 8, 2009, a request for *ex parte* reexamination of the '744 patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/009,377 ("the '9377 proceeding").

3. On February 13, 2009, the Office mailed an order granting *ex parte* reexamination in the '9377 proceeding.

4. On May 5, 2009, a request for *inter partes* reexamination of the '744 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,465 ("the '465 proceeding").

5. On June 19, 2009, the Office mailed an order granting *inter partes* reexamination in the '465 proceeding.

6. On July 14, 2009, the Office mailed a decision *sua sponte* merging the '9377 *ex parte* and the '465 *inter partes* proceedings ("the merged proceeding").

7. On November 5, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On November 19, 2009, patent owner filed the instant petition entitled, "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("the petition under 37 CFR 1.183").

9. Concurrently, on November 19, 2009, patent owner filed a request for a two-month extension of time to respond to the November 5, 2009 Office action.

10. On November 25, 2009, patent owner's petition for a two-month extension of time was granted for one month only, extending the period for response to the November 5, 2009 Office action to February 5, 2009.

11. On December 30, 2009, patent owner filed a petition for an additional two-week extension of time to respond to the November 5, 2009 Office action.

12. On January 7, 2010, patent owner's petition for an additional two-week extension of time was granted, extending the period for response to the November 5, 2009 Office action to February 19, 2009.

13. On February 2, 2010, the Office mailed a decision dismissing patent owner's November 19, 2009 petition under 37 CFR 1.183.

14. On February 19, 2010, patent owner filed the instant petition entitled, "RENEWED PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("the renewed petition under 37 CFR 1.183").

15. Concurrently, on February 19, 2010, patent owner filed a response to the November 5, 2009 Office action.

DECISION

Relevant Statutes, Regulations and Procedures

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.

Patent Owner's Renewed Petition under 37 CFR 1.183

On February 2, 2010, the Office mailed a decision dismissing patent owner's November 19, 2009 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.948(b). In the February 19, 2010 renewed petition under 37 CFR 1.183, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) for patent owner's concurrently-filed response, which includes remarks and supporting declarations.[1] In particular, patent owner requests that the 50-page limit of 37 CFR 1.943(b) "be increased to an amount equal to that used in the response and declarations of Dr. Parsons and Mr. Haag as filed February 19, 2010."[2]

In this instance, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages. Patent owner asserts that it "attempted to meet the 50 page limit, but was not able to do so without prejudice to its arguments" and that "Patent Owner has tried to structure the response to limit any repetition, not repeat information already in the record, and arrange the material in a concise fashion."[3] In addition to the showing, patent owner has also substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts regarding the length of the November 5, 2009 Office action, the number and nature of rejections, and the number of references relied upon therein.[4]

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[1] The renewed petition under 37 CFR 1.183 at pages 1-2.

[2] The renewed petition under 37 CFR 1.183 at page 3. The declarations are subsequently referred to herein as the "Parsons declaration" and the "Haag declaration."

[3] The renewed petition under 37 CFR 1.183 at page 3.

[4] *See* the renewed petition under 37 CFR 1.183 at page 2 (asserting that "The outstanding Office Action presents 58 separate grounds of rejection for alleged obviousness that are said to find basis in 17 documents and publications. The Examiner has adopted in their entirety 17 claim charts submitted by the Third Party Requester and 23 pages from one of the Requester's written requests to support the rejections. In sum, these adopted claim charts and written request documents cited by the Examiner reflect that the Examiner has used approximately 1,263 pages for presenting the rejections set forth in the November 5, 2009 Office Action.")

Based on the specific facts set forth in the renewed petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) 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 the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.[5] Accordingly, the renewed petition under 37 CFR 1.183 is granted to the extent of permitting patent owner's February 19, 2010 response to exceed the page limit by 70 pages as follows. The number of pages of the remarks portion of patent owner's February 19, 2010 response that count toward the page limit is 86 pages and the number of pages of the declarations of patent owner's February 19, 2010 response that count toward the page limit is approximately 34 pages.[6] Thus, the total number of pages of patent owner's response that count toward the page limit is 120 pages, which exceeds the page limit of 37 CFR 1.943(b) by 70 pages. This waiver makes patent owner's February 19, 2010 response page-length compliant.

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 120 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.**[7] 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 February 19, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

CONCLUSION

1. Patent owner's February 19, 2010 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's February 19, 2010 response to the November 5, 2009 Office action to exceed the page limit by 70 pages. This waiver makes patent owner's February 19, 2010 response page-length compliant.

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 February 19, 2010

---

[5] It is noted that, on its face, the substantive portion of the November 5, 2009 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only 5 pages but relies exclusively on incorporation by reference of approximately 1200 pages from the request for *inter partes* reexamination in the '465 proceeding to set forth the rejections.

[6] Of the declarations submitted with patent owner's February 19, 2010 response, only the Parsons declaration is replete with pages of arguments (*e.g.*, pages 23-56) that count toward the 50-page limit of 37 CFR 1.943(b). The Haag declaration does not appear to contain any pages of arguments that count toward the 50-page limit of 37 CFR 1.943(b). *See* MPEP 2667(I)(A)(2) (providing that only those pages of the accompanying affidavits/declarations that contain opinon(s) of the affiant/declarant that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination are counted toward the 50-page limit.)

[7] Patent owner's February 19, 2010 response and the Parsons declaration appear to use one-and-a-half line spacing.

response shall not exceed 120 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 merged proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

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

Kenpet8
5-3-10

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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.
90/009,378	01/08/2009	6623486	SYNT-0703	5757

53443 7590 05/26/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, NW, SUITE 1200
WASHINGTON, DC 20006-1109

Date:

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000468 ₹90\000,378
PATENT NO. : 6623486
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,378	01/08/2009	6623486	SYNT-0703	5757

53443 7590 05/26/2010

EXAMINER	
ART UNIT	PAPER NUMBER

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(For Patent Owner)

ROBERT A. KING
HUNTON & WILLIAMS LLP
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1900 K STREET, N.W., SUITE 1200
WASHINGTON, DC 20006-1109

(For *Inter Partes* & *Ex Parte* Requester)

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,468
Filed: May 8, 2009
For: U.S. Patent No. 6,623,486

Ex Partes Reexamination Proceeding
Control No. 90/009,378
Filed: January 8, 2009
For: U.S. Patent No. 6,623,486

DECISION GRANTING PATENT OWNER AND REQUESTER PETITIONS AND *SUA SPONTE* WAIVING REQUESTER PAGE LIMIT

This is a decision on the patent owner paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)," filed on March 22, 2010. This is also a decision on the requester paper entitled "PETITION TO ADOPT A SCHEDULE FOR THIRD-PARTY COMMENT SUBMISSION," filed under 37 CFR 1.182 on March 23, 2010.

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

The patent owner and requester petitions are granted to the extent set forth herein.

FEES

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the patent owner petition under 37 CFR 1.183 was charged to patent owner's deposit account on March 25, 2010.

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the requester petition under 37 CFR 1.182 is being charged to requester's deposit account pursuant to the authorization on page 5 of the requester March 23, 2010 petition.

BACKGROUND

1. On September 23, 2003, United States Patent No. 6,623,486 ("the '486 patent") issued to Weaver *et al.*

2. On January 8, 2009, a request for *ex parte* reexamination of the '486 patent was filed by third party requester, Smith & Nephew, Inc., which request was assigned Reexamination Control No. 90/009,378 ("the '9378 proceeding").

3. On February 14, 2009, the Office mailed an order granting *ex parte* reexamination in the '9378 proceeding.

4. On May 8, 2009, a request for *inter partes* reexamination of the '486 patent was filed by third party requester, Smith & Nephew, Inc., which request was assigned Reexamination Control No. 95/000,468 ("the '468 proceeding").

5. On June 19, 2009, the Office mailed an order granting *inter partes* reexamination in the '468 proceeding.

6. On July 10, 2009, the Office mailed a decision *sua sponte* merging the '9378 *ex parte* and the '468 *inter partes* proceedings ("the merged proceeding").

7. On November 30, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On December 30, 2009, patent owner filed a request for a six-week extension of time to respond to the November 30, 2009 Office action.

9. On January 6, 2010, patent owner's petition for a six-week extension of time was granted, extending the period for response to the November 30, 2009 Office action to March 15, 2010.

10. On February 23, 2010, patent owner filed a request for an additional one-week extension of time to respond to the November 30, 2009 Office action.

11. On March 3, 2010, patent owner's petition for a one-week extension of time was granted extending the period for response to the November 30, 2009 Office action to March 22, 2010.

12. On March 22, 2010, patent owner filed the instant petition entitled, "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("the petition under 37 CFR 1.183").

13. Concurrently, on March 22, 2010, patent owner filed a response to the November 30, 2009 Office action.

14. On March 23, 2010, requester filed the instant petition entitled, "PETITION TO ADOPT A SCHEDULE FOR THIRD-PARTY COMMENT SUBMISSION" ("the petition under 37 CFR 1.182").

DECISION

Relevant Statutes, Regulations and Procedures

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.

Patent Owner's Petition under 37 CFR 1.183

In the March 22, 2010 petition under 37 CFR 1.183, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) for patent owner's concurrently-filed response, which includes remarks and supporting declarations.[1] In particular, patent owner requests that the 50-page limit of 37 CFR 1.943(b) "be increased to an amount equal to that used in the response and declarations of Dr. Truen, Dr. Parsons and Mr. Haag as filed March 22, 2010."[2]

In this instance, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages. Patent owner asserts that it "attempted to meet the 50 page limit, but was not able to do so without prejudice to its arguments" and that "Patent Owner has tried to structure the response to limit any repetition, not repeat information already in the record, and arrange the material in a concise fashion."[3] In addition to the showing, patent owner has also substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts regarding the length of the November 30, 2009

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[1] The petition under 37 CFR 1.183 at pages 1-2.

[2] The petition under 37 CFR 1.183 at page 3. The declarations are subsequently referred to herein as the "Truen declaration", the "Parsons declaration" and the "Haag declaration."

[3] The petition under 37 CFR 1.183 at page 3.

Office action, the number and nature of rejections, and the number of references relied upon therein.[4]

Based on the specific facts set forth in the renewed petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) 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 the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.[5] Accordingly, the petition under 37 CFR 1.183 is granted to the extent of permitting patent owner's March 22, 2010 response to exceed the page limit by 117 pages as follows. The number of pages of the remarks portion of patent owner's March 22, 2010 response that count toward the page limit is 97 pages and the number of pages of the declarations of patent owner's March 22, 2010 response that count toward the page limit is approximately 70 pages.[6] Thus, the total number of pages of patent owner's response that count toward the page limit is 167 pages, which exceeds the page limit of 37 CFR 1.943(b) by 117 pages. This waiver makes patent owner's March 22, 2010 response page-length compliant.

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 167 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.**[7]

In the March 23, 2010 petition under 37 CFR 1.182, requester requests that a schedule be imposed for submission of requester's comments on patent owner's response to the November 30, 2009 Office action, stating that requester's schedule for submission of it comments is unclear as a result of patent owner's concurrent filing in the merged proceeding on March 22, 2010 of

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[4] *See* the petition under 37 CFR 1.183 at page 3 (asserting that "The outstanding Office Action presents ***ninety-three*** (93) separate grounds of rejection for alleged anticipation and obviousness. There are ***eleven*** (11) primary references upon which the anticipation and obviousness rejections are based. The Examiner has adopted in their entirety ***thirty*** (30) claim charts submitted by the Third Party Requester and numerous pages from the Requester's written requests to support the rejections. In sum, these adopted claim charts and written request documents cited by the Examiner reflect that the Examiner has used over 850 pages for presenting the rejections set forth in the November 30, 2009 Office Action.")

[5] It is noted that, on its face, the substantive portion of the November 30, 2009 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only 10 pages but relies exclusively on incorporation by reference of over 850 pages from the request for *inter partes* reexamination in the '468 proceeding and from the request for *ex parte* reexamination in the '9378 proceeding to set forth the rejections.

[6] Of the declarations submitted with patent owner's March 22, 2010 response, only the Truen and Parsons declarations are replete with pages of arguments (*e.g.*, in the Parsons declaration pages 27-62 and in the Truen declaration pages 13-46) that count toward the 50-page limit of 37 CFR 1.943(b). The Haag declaration does not appear to contain any pages of arguments that count toward the 50-page limit of 37 CFR 1.943(b). *See* MPEP 2667(I)(A)(2) (providing that only those pages of the accompanying affidavits/declarations that contain opinion(s) of the affiant/declarant that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination are counted toward the 50-page limit.)

[7] Patent owner's March 22, 2010 response and the Parsons and Turen declarations appear to use one-and-a-half line spacing.

the petition under 1.183 with its response in excess of 50 pages.[8] Because this decision makes the patent owner's March 22, 2010 response page-length compliant, the date of service of the patent owner's response pursuant to 37 CFR 1.947 is deemed to be the mailing date of the instant decision. Accordingly, requester's petition under 37 CFR 1.182 is granted to the extent that 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 March 22, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

CONCLUSION

1. Patent owner's March 22, 2010 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's March 22, 2010 response to the November 30, 2009 Office action to exceed the § 1.943(b) page limit by 117 pages. This waiver makes patent owner's March 22, 2010 response page-length compliant.

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 March 22, 2010 response shall not exceed 167 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the comments submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.**

3. Requester's March 23, 2010 petition under 37 CFR 1.182 is granted to the extent that 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 merged proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Maria Nuzzolillo at (571) 271-8150 or Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

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

5-25-10
Pet8

[8] *See* the petition under 37 CFR 1.182 at pages 1 and 3. *See also* the petition under 37 CFR 1.182 at page 2, suggesting that a comments submission schedule similar to that which was set forth in the February 2, 2010 petition decision mailed by the Office in the 95/000,465 proceeding be adopted.

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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

EXAMINER	
ART UNIT	PAPER NUMBER

NIRO, SCAVONE, HALTER & NIRO
181 W. MADISON
SUITE 4600
CHICAGO, IL 60602

DATE MAILED: 08/28/2009

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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

Niro,Scavone,Haller & Niro
181 West Madison Street
Suite 4600
Chicago, IL 60602-4515

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 28 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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AUG 28 2009

CENTRAL REEXAMINATION UNIT

Niro,Scavone,Haller & Niro
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(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

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

: 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. 5,253,341 (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.

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

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.
90/009,382	02/11/2009	6,878,717	JJ-0192	8928

7590 12/03/2009

PHILIP S. JOHNSON
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,382	02/11/2009	6,878,717	JJ-0192	8928

7590 12/03/2009

EXAMINER	
ART UNIT	PAPER NUMBER

WOODCOCK WASHBURN LLP
CIRA CENTRE
2929 ARCH STREET, 12th FLOOR
PHILADELPHIA, PA 19104-2891

DATE MAILED: 12/03/2009

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2929 Arch Street
Philadelphia, PA 19104-2891

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DEC 03 2009

CENTRAL REEXAMINATION UNIT

In re Bart De Corte et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,382
Filed: February 11, 2009
For: U.S. Patent No. 6,878,717

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

This is a decision on the November 25, 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 November 25, 2009 patent owner petition to revive").

The appropriate petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the November 25, 2009 patent owner petition to revive has been paid.

The November 25, 2009 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 25, 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 September 24, 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 November 25, 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 September 24, 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 September 24, 2009 Office action set a two-month period for response. A proper response to the September 24, 2009 Office action was not filed until November 25, 2009, which was untimely. However, for the purpose of evaluating whether the November 25, 2009 patent owner petition to revive is a grantable petition, the submission of the November 25, 2009 response to the September 24, 2009 Office action satisfies item (1).[2]

Accordingly, the November 25, 2009 patent owner petition to revive is **granted**.

CONCLUSION

1. The November 25, 2009 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3991, for processing of the November 25, 2009 Reply To Office Action In Ex Parte Reexamination.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Brenda Brumback, of CRU Art Unit 3991, at (571) 272-0961.

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 November 25, 2009 response as to each of the rejections set forth in the September 24, 2009 Office action; such is the examiner's province.

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.
90/009,385	01/16/2009	7039767	383681-105046	6544

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

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.
90/009,385	01/16/2009	7039767	383681-105046	6544

2101 7590 06/22/2009

BROMBERG & SUNSTEIN LLP
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BOSTON, MA 02110-1618

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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. : 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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Cleveland, OH 44114

Date:

MAILED

JUN 22 2009

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CENTRAL REEXAMINATION UNIT

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

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

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

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

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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 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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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. : 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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Date:
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SEP 18 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009385
PATENT NO. : 7039767
ART UNIT : 3992

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(For Patent Owner)

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901 LAKESIDE AVENUE
CLEVELAND, OH 44114

(For Requester)

MAILED

SEP 18 2009

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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United States Patent and Trademark Office
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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEPOLIS, MN 55440-1022

Date: MAILED

SEP 24 2009

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)).

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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
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

RAMAN N. DEWAN
JACKSON WALKER, L.L.P.
100 CONGRESS AVENUE, SUITE 1100
AUSTIN, TX 78701

Date:

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SEP 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009034
PATENT NO. : 5440749
ART UNIT : 3992

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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

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NEW YORK, NY 10036

Date:
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010520
PATENT NO. : 5440749
ART UNIT : 3992

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SEP 24 2009

CENTRAL REEXAMINATION UNIT

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NEW YORK, NY 10036

(For Third Party Requester)

In re Moore *et alia*
Reexamination Proceeding
Control No. 90/009,034
For: U.S. Patent No. 5,440,749

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

: 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. 5,440,749 (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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,390	02/10/2009	6565509	518852802100	4516

90259 7590 04/21/2010

Hughes Hubbard and Reed LLP
One Battery Park Plaza
New York, NY 10004

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2010

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

Date:
MAILED
APR 21 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009390
PATENT NO. : 6565509
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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APR 21 2010

CENTRAL REEXAMINATION UNIT

HUGHES HUBBARD AND REED LLP (For Patent Owner)
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NEW YORK, NY 10004

MORRISON & FOERSTER LLP (For Third Party Requester)
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

In re Say et al.	:	DECISION DISMISSING
Control No. 90/009,390	:	PETITION
Deposited: February 10, 2009	:	TO VACATE PROCEEDING
For: US Patent No. 6,565,509	:	PURSUANT TO
	:	37 CFR 1.182

This is a decision on the July 1, 2009 petition filed by the patent owner titled, "Petition under 37 C.F.R. 1.182 to vacate order granting reexamination, or to suspend reexamination proceedings on grounds of harassment" (hereinafter "the petition"). The petition contains issues pertaining to petitions under 37 CFR 1.181 and 1.182. The petition is treated as a petition under 37 CFR 1.182 (as it is titled), and the issues under 37 CFR 1.181 are not addressed in this decision. On July 15, 2009, the third party requester filed a paper in opposition to the petition.

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.

Because petitions filed under 37 CFR 1.182 are decided by the Office of Patent Legal Administration while petitions filed under 37 CFR 1.181 are decided by the Central Reexamination Unit, the petition must have been filed as two separate petition papers to comply with 37 CFR 1.4(c). Therefore, the issues under 37 CFR 1.181 must be filed in a separate petition in order to be addressed. Patent owner is reminded that, in the future, petitions filed under 37 CFR 1.181 and 1.182 must be filed as separate papers to avoid confusion and delay.

Both patent owner's petition and third party requester's opposition with respect to issues raised under 37 CFR 1.182, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition, treated under 37 CFR 1.182, is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 6,565,509 [hereinafter "the '509 patent"] was granted to *Say et al.* on May 20, 2003.

2. On January 25, 2006, a first request for *ex parte* reexamination for claims 1-19, 24-26 and 35-38 of the '509 patent was submitted by third party requester Dexcom, Inc., and, assigned control No. 90/007,903 [hereinafter, the '903 proceeding].

3. On March 27, 2006, an order granting *ex parte* reexamination for patent claims 1-19, 24-26 and 35-38 of the '509 patent was mailed in the '903 proceeding. This reexamination proceeding is currently pending and is on appeal. During the proceeding, the patent owner proposed amendments to independent patent claims 1, 11, and 26 and added new proposed claims 57-236.

4. On September 17, 2008, a second request for *ex parte* reexamination for original patent claims 1-19, 24-26 and 35-38, proposed amended claims 1, 11, and 26, and proposed new claims 57-139 & 227-236 of the '509 patent was submitted by the same third party requester Dexcom, Inc., and, assigned control No. 90/009,279 [hereinafter, the '279 proceeding].

5. On December 1, 2008, an order denying the second request for reexamination was mailed in the '279 proceeding, because the request did not establish a substantial new question of patentability that was different from the questions already raised in the '903 proceeding in regard to the original patent claims of the '509 patent. This proceeding was concluded on March 3, 2009.

6. On February 10, 2009, a third request for *ex parte* reexamination for original patent claims 20-23 & 27-34, and proposed amended claims 11 and 26 of the '509 patent was submitted by the same third party requester Dexcom, Inc., and, assigned control No. 90/009,390 [hereinafter, the '390 proceeding].

7. On May 1, 2009, an order granting-in-part *ex parte* reexamination was mailed in the '390 proceeding. The order granted reexamination for patent claims 20-23 and 27-34, but denied reexamination as to claims 11 and 26.

8. On July 1, 2009, the present petition was filed, and it requests that the '390 reexamination proceeding be vacated because of harassment of the patent owner.

9. On July 15, 2009, a third party requester opposition to the patent owner petition was filed in the '390 reexamination proceeding.

DISCUSSION

The patent owner requests that the reexamination proceeding be vacated. The petitioner considers the request in the '390 proceeding to be harassment of the patent owner.

The request to vacate the reexamination proceeding is dismissed.

STATEMENT OF RELEVANT AUTHORITY

Selected excerpts of the statutes, regulations and MPEP which are relevant to this decision are reproduced, below with emphasis added (in bold) to highlight relevant portions.

35 U.S.C. 303 Determination of issue by Director.

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

MPEP 2240 provides in relevant part:

> II. SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION
>
> If a second or subsequent request for *ex parte* reexamination is filed (by any party) while a first *ex parte* reexamination is pending, the presence of a substantial new question of patentability depends on the prior art (patents and printed publications) cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different from that raised in the pending reexamination proceeding. If the prior art cited raises the same substantial new question of patentability as that raised in the pending reexamination proceedings, the second or subsequent request should be denied.
>
> Where the request raises a different substantial new question of patentability as to some patent claims, but not as to others, the request would be granted in part; see the order issued in reexamination control number 90/007,843 and 90/007,844.
>
> The second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the first (or prior) pending reexamination proceeding.
>
> ....
>
> In certain situations, after a grant of a second or subsequent request for *ex parte* reexamination, where (A) the patent owner files a petition under 37 CFR 1.182 as part of the statement or as the statement,

and (B) **it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner**, if the petition is granted, prosecution on the second or subsequent reexamination would be suspended. Merger of such a second or subsequent request with the already pending reexamination proceeding(s) would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement that reexamination proceeding be conducted with special dispatch.

MPEP 2242 provides in relevant part:

II.A. Prior Favorable Decisions by the U.S. Patent and Trademark Office (Office) on the Same or Substantially Identical Prior Art in Relation to the Same Patent.

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

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

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

DECISION

The patent owner brings before the Office a petition, treated as a petition under 37 CFR 1.182, to vacate an ordered reexamination proceeding as being harassment of the patent owner. The procedure for such a petition is provided for in MPEP 2240. For this petition to be entertained, however, the patent owner must show facts to support the conclusion that the intent of the requester was for harassment in filing the request for reexamination in the '390 proceeding. See MPEP 2240.

Patent owner contends that the request for reexamination of the '509 patent constitutes harassment and must be vacated. Patent owner states that this request for reexamination is the third request for

reexamination of the '509 patent by Dexcom, Inc.[1] Patent owner contends this third request for reexamination constitutes harassment for the following three reasons. First, Dexcom, Inc. is stated to have "unjustifiably" held back requesting reexamination of some claims of the '509 patent in order to file additional requests for reexamination. See pages 9-10 of the petition. Second, Dexcom, Inc. is stated to have "unjustifiably" held back prior art references for use in subsequent reexamination requests. See pages 10-13 of the petition. Third, Dexcom, Inc. is stated to have misrepresented facts in the third request for reexamination of the '509 patent and to the court. See pages 13-16 of the petition.

Requester opposes the petition on the ground that it had complied with the statutory and regulatory requirements in the request for reexamination, and had proper reasons in requesting reexamination in the '390 proceeding. The requester states that legislative history is clear that the determination of a substantial new question of patentability is the safeguard against harassment of the patent owner, and patent owner's allegations are either incorrect or irrelevant. See pages 19-23 of the opposition. Requester also states that the relief requested, termination of the reexamination proceedings, is not in accordance with the policy set forth in MPEP 2240. See pages 23-24 of the opposition.

Subsequent reexamination of a patent which has previously undergone a reexamination proceeding is permitted where an SNQ is raised in the subsequent reexamination request. See MPEP §§ 2240, 2283, and 2295. Such a determination requires an evaluation of "the context in which the reference was previously considered and the scope of the prior consideration and determin[ation] of whether the reference is now being considered for a substantially different purpose." *In re Swanson*, 540 F.3d 1368, 1380 (Fed. Cir. 2008). The requirement that a subsequent request for reexamination contain a substantial new question of patentability provides the required safeguard against harassment of the patent owner. Reexamination may be used to address a third party's concerns where such concerns could not have been addressed earlier. In a situation where a subsequent reexamination is filed to address an issue that was not present in an earlier reexamination proceeding, such a subsequent reexamination request does not, absent other evidence, constitute harassment of the patent owner. The determination of whether harassment exists is a fact-specific inquiry, and must be supported by evidence that the second or subsequent request was filed for the purpose of harassment of the patent owner. MPEP 2240(II).

In the instant case, in the order for reexamination, the examiner determined that the request for reexamination raised a substantial new question of patentability for original patent claims 20-23 and 27-34. The order specifically addressed the issue of whether the request in the instant proceeding raised substantial new questions of patentability that was different from questions raised in the prior examinations. See pages 4-7 of the May 1, 2009 order. The order found that claims 20-23 and 27-34 were not subject to reexamination in the prior proceedings and that prior art was never applied against these claims in the examination of the application that issued as the '509 patent. See page 7 of the order. The order also analyzed each proposed rejection to determine if the proposed rejections were supported by a substantial new question of patentability that is different from questions raised in the prior examinations. The order found that Shichiri I in combination with Oka raised a substantial new question of patentability for original patent claims 20-22 (see pages 7-8 of the order), and that Shichiri I in combination with Allen raised a substantial new question of patentability for original patent claims 20, 21, 23, and 27-34 (see page 8 of the order).

---

[1] This decision will not address allegations of harassment due to conduct in other reexamination proceedings. See, e.g., pages 1-5 of the petition. The Office will only address such issues if and when petitions are filed in the other reexamination proceedings.

Patent owner's contention that the request for reexamination of the '509 patent constitutes harassment is not supported by the record. As stated above, the record shows that the '390 request for reexamination contains a substantial new question of patentability. Thus, the determination that a SNQ was raised provided the required safeguard against harassment of the patent owner. Specifically, the record shows that reexamination in the '390 proceeding was used to address a third party's concerns about original patent claims 20-23 and 27-34, which were not present in the earlier '903 and '279 proceedings. In a situation where a subsequent reexamination is filed to address an issue that was not present in an earlier reexamination proceeding, such a subsequent reexamination request does not, absent other evidence (as discussed above), constitute harassment of the patent owner. The allegations that the requester, Dexcom, Inc., "unjustifiably" held back requesting reexamination of some claims of the '509 patent and some prior art references for use in subsequent reexamination requests, or had misrepresented facts in the third request for reexamination of the '509 patent are not supported by evidence, and do not clearly show that the intent of the requester was harassment of the patent owner.

For these reasons, patent owner has presented insufficient evidence to support the conclusion that the '390 request was filed for the purpose of harassment of the patent owner. In view of the above, the petition to vacate the reexamination proceeding is dismissed.

CONCLUSION

1. The patent owner's petition under 37 CFR § 1.182 is hereby **dismissed.**

2. Jurisdiction over the present reexamination proceeding is hereby forwarded to the Central Reexamination Unit for preparation of an Office action in due course.

3. Response should be addressed as follows:

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

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

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Eric Keasel, at (571) 272-4928, or Mark Reinhart, at (571) 272-1611, and, in the event that they are unavailable, to Pinchus M. Laufer, Legal Advisor, at 571-272-7726 or to the undersigned at 571-272-7710.

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

kenpet8/
4-21-10

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,391	01/22/2009	D536,881		2977

26389 7590 05/10/2010

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SEATTLE, WA 98101-2347

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/10/2010

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

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3001 SOUTHWEST 3rd. AVENUE
MIAMI, FL 33129

Date:

MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009391
PATENT NO. : D536881
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Miami, FL 33129

MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

In re James V. Mischel, Jr. et al. :
Ex Parte Reexamination Proceeding :
Control No. 90/009,391 :
Filed: January 22, 2009 :
For: U.S. Patent No. D536,881 :

DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)

This is a decision on the March 23, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Patent Owner's Statement of the Substance of the Interview and revive the present terminated reexamination prosecution ("the March 23, 2010 petition to revive").[1]

The March 23, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The March 23, 2010 petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file the written statement of interview required under 37 CFR 1.560(b) for the interview of February 22, 2010.

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
>
> *
>
> (d) *Terminal disclaimer.*
>
> > *
> >
> > *
> >
> > (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

> (d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.
>
> (e) If a response by the patent owner is not timely filed in the Office,
>
> > *
> >
> > *

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

37 CFR 1.560(b) provides:

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

filing of a grantable petition was unintentional. The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Regarding item (1), this merged reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the February 22, 2010 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until March 23, 2010, which was untimely. For the purpose of evaluating whether the March 23, 2010 petition to revive is a grantable petition, the submission of the statement under 37 CFR 1.560(b) on March 23, 2010, satisfies item (1).

The appropriate petition fee of $810.00 set forth in 37 CFR 1.17(m) for the March 23, 2010 petition to revive has been paid, which satisfies item (2).

A proper statement under 37 CFR 1.137(b)(3) with respect to the March 23, 2010 statement under 37 CFR 1.560(b) was submitted as part of the March 23, 2010 petition to revive. Item (3) has thus been satisfied.

Accordingly, the March 23, 2010 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

CONCLUSION

1. The March 23, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to Art Unit 2913 for processing of the March 23, 2010 Patent Owner's Statement of the Substance of the Interview and the March 25, 2010 Supplemental Response To Ex Parte Reexamination Communication.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Mary Ann Calabrese, of Art Unit 2913, at (571) 272-8704.

---

[2] *See*: 37 CFR 1.137(d)(3).

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,399	03/17/2009	6021018	044760-5001US	6663

24341 7590 11/30/2009

MORGAN, LEWIS & BOCKIUS, LLP. (PA)
2 PALO ALTO SQUARE
3000 EL CAMINO REAL, SUITE 700
PALO ALTO, CA 94306

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/30/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Michael J Lyons
MORGAN, LEWIS & BOCKIUS, LLP. (PA)
2 PALO ALTO SQUARE
3000 EL CAMINO REAL, SUITE 700
PALO ALTO CA 94306

(For Patent Owner)

Perry Clark, Kirkland & Ellis, LLP
950 Page Mille Road
P. O. Box 51827
Palo Alto, CA 94303

(For Third Party Requester)

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

In re: Sawai *et alia*
Ex Parte Reexamination Proceeding
Control Number 90/009,399
Deposited on: 17 March 2009
For U.S. Patent No. 6,021,018

This is a decision on the 02 October 2009, Patent Owner requested petition titled "Petition to Expunge Information Under 37 CFR § 1.59(b)." This petition considers under 37 CFR 1.59 (b) a request to expunge materials submitted by the Patent Owner also filed 02 October 2009. The petition was timely filed with the authorization for the appropriate fee from a deposit account pursuant to 37 CFR § 1.17 (g). There was proper certificate of service to the third party requester.

The petition is hereby granted.

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 expunge ment of the information is appropriate in which case a notice granting the petition for expungement will be provided.

....

MPEP § 724.04

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

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

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

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

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

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

(F) Any petition to expunge a portion or all of the submitted information under 37

CFR §1.59(b) will be treated in accordance with MPEP § 724.05.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR § 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

(A) a clear identification of the information to be expunged without disclosure of the details thereof;

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

(E) the fee as set forth in 37 CFR § 1.17(g) for a petition under 37 CFR § 1.59(b).

DECISION

The petitioner seeks to expungement of documents which are subject to a protective order. The examiner has prepared the Notice of Intent to Issue a Re-examination Certificate (NIRC) and determined that the submission is not material to the patentability of the claims before the examiner for *ex parte* reexamination in the proceeding identified by control number 90/009,399, the documents are expunged. Further the petitioner has met the requirements pursuant to 37 CFR § 1.59(b) and MPEP § 724. The petitioner has committed to retain the materials for the period of the patent under reexamination.

Since the petitioner has fully complied with the requirements and the submission is not material to the patentability of the claims before the Office in this proceeding, the petition is hereby **granted**.

The materials submitted as Confidential are hereby returned to the petitioner.

CONCLUSION

1. The petition to expunge documents submitted by the patent owner on 02 October 2009 as confidential is hereby **granted**

2. The confidential submission is hereby **returned** to the petitioner.

3. The patent owner is reminded that for compliance pursuant to MPEP § 724.05 the submission will be retained for the period of the patent.

FUTURE CORRESPONDENCE

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

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

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449 Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/009,400	02/09/2009	RE 35952		4219

7590 09/16/2009

NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON - SUITE 4600
CHICAGO, IL 60602

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,456	05/27/2009	RE35952		7400

7590 09/16/2009

EXAMINER	

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison
Suite 4600
Chicago, IL 60602

ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2009

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
WILDMAN HARROLD ALLEN & DIXON LLP
225 WEST WACKER DRIVE
SUITE 2800
CHICAGO, IL 60606

Date:

MAILED

SEP 16 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009400
PATENT NO. : RE35952
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 Patents and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Frederic M. Meeker
BANNER & WITCOFF, LTD.
1100 13th Street, N.W., Suite 1200
Washington, DC 20005-4051

Date: MAILED
SEP 16 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009456
PATENT NO. : RE35952
ART UNIT : 3992

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NIRO, SCAVONE, HALLER & NIRO
181 W. Madison
Suite 4600
Chicago IL 60602

(For Patent Owner)

MAILED

SEP 16 2009

CENTRAL REEXAMINATION UNIT

SHUMAKER & SIEFFERT, P. A.
WILDMAN HARROLD ALLEN & DIXON LLP
225 WEST WACKER DRIVE, SUITE 2800
CHICAGO, IL 60606

(For Third Party Requester)

BANNER & WITCOFF, LTD.
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

(For Third Party Requester)

In re Beery
Reexamination Proceeding
Control No. 90/009,400
Request Deposited: February 9, 2009
For: Reissued U.S. Patent No. RE 35,952

In re Beery
Reexamination Proceeding
Control No. 90/009,456
Corrected Request Deposited: May 27, 2009
For: Reissued U.S. Patent No. RE 35,952

: 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. 5,045,947, issued to Beery, on September 3, 1991. Reissued U.S. Patent No. RE 35,952 (hereinafter, the '952 patent), issued to Beery, on November 10, 1998.

2. On February 9, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,400 (hereinafter, the '9400 proceeding).

3. The Reexamination Order was granted in the '9400 proceeding on April 22, 2009.

4. There are currently no amendments in the '9400 proceeding.

5. On May 27, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,456 (hereinafter, the '9456 proceeding).

6. The Reexamination Order was granted in the '9456 proceeding on August 20, 2009.

7. Patent owner waived the right to file a patent owner statement on September 8, 2009. There are currently no amendments in the '9313 proceeding.

8. The '9400 and '9456 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 '9400 and the '9456 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. 90/009,400 and 90/009,456 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first 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
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.
90/009,400	02/09/2009	RE 35952		4219

7590 05/04/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON - SUITE 4600
CHICAGO, IL 60602

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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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.
90/009,456	05/27/2009	RE35952		7400

7590 05/04/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison
Suite 4600
Chicago, IL 60602

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,726	10/30/2009	RE35952	454032800900	1039

7590 05/04/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison-Suite 4600
Chicago, IL 60602

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILDMAN HARROLD ALLEN & DIXON LLP
225 WEST WACKER DRIVE
SUITE 2800
CHICAGO, IL 60606

Date: MAILED

MAY 0 4 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009400
PATENT NO. : RE35952
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

Frederic M. Meeker
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1100 13th Street, N.W., Suite 1200
Washington, DC 20005-4051

Date:

MAILED
MAY 04 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009456
PATENT NO. : RE35952
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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Mehran Arjomand
MORRISON & FOERSTER LLP
555 West Fifth Street
Los Angeles, CA 90013

Date: MAILED

MAY 04 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010726
PATENT NO. : RE35952
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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Alexandria, VA 22313-1450
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MAILED

MAY 04 2010

CENTRAL REEXAMINATION UNIT

NIRO, SCAVONE, HALLER & NIRO (For Patent Owner)
181 W. Madison
Suite 4600
Chicago IL 60602

SHUMAKER & SIEFFERT, P. A. (For Third Party Requester)
WILDMAN HARROLD ALLEN & DIXON LLP
225 WEST WACKER DRIVE, SUITE 2800
CHICAGO, IL 60606

BANNER & WITCOFF, LTD. (For Third Party Requester)
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

MORRISON & FOERSTER LLP (For Third Party Requester)
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

In re Beery :
Reexamination Proceeding : DECISION *SUA SPONTE*
Control No. 90/009,400 : MERGING
Request Deposited: February 9, 2009 : REEXAMINATION
For: Reissued U.S. Patent No. RE 35,952 : PROCEEDINGS

In re Beery :
Reexamination Proceeding :
Control No. 90/009,456 :
Corrected Request Deposited: May 27, 2009 :
For: Reissued U.S. Patent No. RE 35,952 :

In re Beery :
Reexamination Proceeding :
Control No. 90/010,726 :
Corrected Request Deposited: October 30, 2009 :
For: Reissued U.S. Patent No. RE 35,952 :

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. 5,045,947, issued to Beery, on September 3, 1991. Reissued U.S. Patent No. RE 35,952 (hereinafter, the '952 patent), issued to Beery, on November 10, 1998.

2. On February 9, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,400 (hereinafter, the '9400 proceeding).

3. The Reexamination Order was granted in the '9400 proceeding on April 22, 2009 finding a substantial new question of patentability (SNQP) as to claims 8, 9, 20, 29, 37, and 38.

4. On May 27, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,456 (hereinafter, the '9456 proceeding).

5. The Reexamination Order was granted in the '9456 proceeding on August 20, 2009 finding a substantial new question of patentability (SNQP) as to claims 1, 2, 5, 12, 13, 23, 24, 41, 48, 52, and 53.

6. Patent owner waived the right to file a patent owner statement on September 8, 2009.

7. On September 16, 2009, the '9400 and '9456 were merged.

8. On September 24, 2009, a non-final office action was mailed on the merged '9400 and '9456 proceedings. Claims 1, 2, 5, 8, 9, 12, 13, 20, 23, 24, 29, 37, 38, 41, 48, 52, and 53 were rejected. All other claims were not subject to reexamination. Patent owner responded on November 23, 2009.

9. On October 30, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/010,726 (hereinafter, the '10726 proceeding).

10. The Reexamination Order was granted in the '10726 proceeding on December 30, 2009 finding a substantial new question of patentability (SNQP) as to claims 1, 2, and 5-53.

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 '9400, '9456, and '10726 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 each proceeding, 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. 90/009,400, 90/009,456, and 90/010,726 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,401	02/06/2009	6,242,830	10695.005.00	1820

38834 7590 12/11/2009

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SONG K. JUNG
McKENNA LONG & ALDRIDGE
1900 K STREET, N.W.
WASHINGTON, DC 20006

Date:

MAILED

DEC 11 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009401
PATENT NO. : 6242830
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.
90/009,293	10/03/2008	6242830	10695.005.00	4935

38834 7590 12/11/2009

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

Date:

MAILED

DEC 1 : 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009293
PATENT NO. : 6242830
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

DEC 1 1 2009

CENTRAL REEXAMINATION UNIT

SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037

(For Patent Owner)

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

(For Third Party Requester)

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON DC 20036

(Courtesy Copy)

In re Katagiri
Reexamination Proceeding
Control No. 90/009,293
For: U.S. Patent No. 6,242,830

In re Katagiri
Reexamination Proceeding
Control No. 90/009,401
For: U.S. Patent No. 6,242,830

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,242,830 (hereinafter, the '830 patent), issued to Katagiri, on June 5, 2001.

2. On October 3, 2008, a request for *ex parte* reexamination of the '830 patent was filed. The reexamination proceeding was assigned Control No. 90/009,293 (hereinafter, the '9293 proceeding).

3. On December 30, 2008, the reexamination order granting the request in the '9293 proceeding was mailed. In response to a non-final rejection, claims 20-79 were added.

4. On February 6, 2009, a third party deposited a request for *ex parte* reexamination of the '830 patent. The reexamination proceeding was assigned Control No. 90/009,401 (hereinafter, the '9401 proceeding).

5. On April 14, 2009, the reexamination order granting the request in the '9401 proceeding was mailed. In response to a non-final rejection, claims 20-61 were added.

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 '9293 and '9401 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, new claims have been added. 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 each proceeding, 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.

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 '830 patent file is that of

SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037

As a courtesy, this decision is being mailed to the address of

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON DC 20036

in view of the February 11, 2009 Power of Attorney and the February 18, 2009 Notice of Acceptance of Power of Attorney present in the file of the '9293 reexamination proceeding.

The address of
SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037

, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '830 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. Reexamination Control Nos. 90/009,293 and 90/009,401 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, Central Reexamination Unit, 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.
90/009,402	02/12/2009	6,225,795 B1	VOLTP002RXUS	6341

22434 7590 07/20/2010

Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/20/2010

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

Date: **MAILED**

JUL 20 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009402
PATENT NO. : 6225795
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.usplo.gov

Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND CA 94612-0250

(For Patent Owner)

MAILED

JUL 20 2010

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

(For Third Party Requester) CENTRAL REEXAMINATION UNIT

In re: Stratakos *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,402
Deposited on: 12 February 2009
For: US Patent No. 6,225,795 B1

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

This is a decision on the 14 July 2010 petition entitled, "Petition For Extension of Time to File a Response to Final Office Action Pursuant to 37 CFR § 1.550(c)" requesting the response period for response be extended by one (1) month. The petition was timely filed with certificate of service and fee.

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's representative requests the period for response be extended by one (1) month for responding to the Final Office action dated 27 May 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 14 July 2010, together with authorization 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 not provided with the petition.

The request is hereby granted.

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. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU

or TC Director for action. A request for an extension of the time period to file a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

ANALYSIS AND FINDINGS

The patent owner 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 requests to have the period for response to be extended by one month. The petition relates the actions taken thus far and notes additional time is needed because the technical expert assisting in the proceeding has scheduling conflicts and patent owner seeks to provide a declaration under 37 CFR § 1.132 which requires additional time to prepare the declaration. On balance, the petition supports the requirement for "sufficient cause" to grant a one (1) month extension of time.

The petition request to extend the response time is hereby granted.

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the Final Office action dated 27 May 2010 is hereby **granted.**

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

3. The response is due **27 August 2010.**

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, 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

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/009,404	02/09/2009	5283726	

CONFIRMATION NO. 1774
POWER OF ATTORNEY NOTICE

67989
HAYWORTH, CHANEY & THOMAS, P.A.
202 N. HARBOR CITY BLVD.
SUITE 300
MELBOURNE, FL 32935

OC000000041962226

Date Mailed: 06/04/2010

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/01/2010.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/jrmatthews/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/009,404	02/09/2009	5283726	

CONFIRMATION NO. 1774

POA ACCEPTANCE LETTER

Paul M. Ulrich
Dinsmore & Shohl LLP
Fifth Third Center
One South Main Street, Suite 1300
Dayton, OH 45402

Date Mailed: 06/04/2010

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/01/2010.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/jrmatthews/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

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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Paper No.

Kelly G. Swartz
202 N. Harbor City Blvd.
Suite 300
Melbourne, FL 32935

MAILED

JUN 04 2010

CENTRAL REEXAMINATION UNIT

In re Application of:
Wilkerson
Application No. 90/009,404
Filed: February 9, 2009
For: AC LINE CURRENT CONTROLLER UTILIZING LINE CONNECTED INDUCTANCE AND DC VOLTAGE COMPONENT

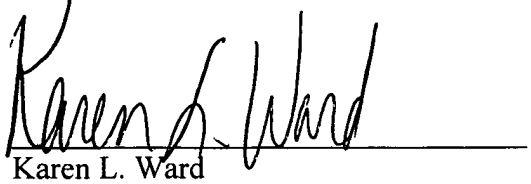
DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed June 1, 2010.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. ∋ 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. ∋ 402.06. 37 C.F.R. ∋ 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request filed June 1, 2010 meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.



Karen L. Ward
Patent Reexamination Specialist
Central Reexamination Unit
(571) 272-7932

cc: Paul M. Ulrich
Dinsmore & Shohl LLP
Fifth Third Center
One South Main Street, Suite 1300
Dayton, OH 45402

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 1 1 2009

CENTRAL REEXAMINATION UNIT

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

For Patent Owner

In re Sheldon et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 90/009,406	:	UNDER 37 CFR 1.181
Filed: February 10, 2009	:	
For: U.S. Patent No.: 6,475,243	:	

This is a decision on a petition filed by the patent owner on November 6, 2009. The petition is entitled "PETITION TO THE WITHDRAW FINALITY OF OFFICIAL ACTION" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to withdraw the finality of the Office action mailed September 21, 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 6, 2009 is denied with respect to withdrawal of the finality of the Office action dated September 21, 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,475,243 (hereinafter, the '243 patent) issued on November 5, 2002.

2. A request for *ex parte* reexamination for claims 20-26, 33, and 34 of the '243 patent, assigned control No. 90/009,406 (hereinafter, the '406 proceeding), was filed by the patent owner on February 10, 2009.

3. *Ex parte* reexamination was ordered for claims 20-26, 33, and 34 of the '243 patent in the '406 proceeding on March 9, 2009.

4. On May 12, 2009, the patent owner filed a statement under 37 CFR 1.530.

5. On May 15, 2009, the patent owner filed an information disclosure statement (IDS).

6. On June 11, 2009, a non-final Office action was mailed in the '406 reexamination proceeding. The initialed copy of the May 15, 2009 IDS citation form (PTO/SB/42) was included as an attachment to the Office action. The examiner crossed out the citation to EP 0091315 and DE 19701536 on the initialed copy of the citation form (PTO/SB/42) because copies of these two foreign references were not included in the May 15, 2009 IDS.

7. On August 14, 2009, the patent owner timely filed a response to the June 11, 2009 Office action, which included another IDS containing a citation form (PTO/SB/42) again listing foreign references EP 0091315 and DE 19701536, and also supplying copies of EP 0091315 (16 pages) and DE 19701536 (6 pages), and a copy of U.S. Patent No. 5,919,236 (5 pages).

8. On September 21, 2009, the Office issued a Final rejection Office action, which addressed the patent owner's response of August 14, 2009. The Office action included new grounds of rejection based on U.S. Patent No. 5,919,236, a copy of which was filed by the patent owner with the August 14, 2009 IDS.

9. On November 4, 2009, a personal interview was held. In the interview, the finality of the September 21, 2009 action was discussed. See the interview summary dated November 10, 2009.

10. On November 6, 2009, Patent Owner filed the petition under 37 CFR 1.181 to withdraw the finality of the September 21, 2009 Office action.

11. On November 23, 2009, the patent owner timely filed a response to the September 21, 2009 Office action.

12. The examiner has not yet acted on the November 23, 2009 response.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding to make final the Office action dated September 21, 2009 because the Office action contained a new ground of rejection based on "the U.S. equivalent of DE 19701536," which was listed on the May 15, 2009 IDS citation form. See page 2 of the petition. The petitioner explains that the finality of the September 21, 2009 Office action should be withdrawn because the IDS citation form cited DE 19701536 and a copy of an English language abstract was provided[1] prior to the first Office action. See pages 2-3 of the petition.

In response to patent owner's arguments, the director finds there are not good and sufficient reasons to withdraw the finality of the September 21, 2009 Office action and delay the proceedings. 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 record clearly shows that U.S. Patent No. 5,919,236 was provided[2] by the patent owner for the first time on August 14, 2009, which is after the mailing date of first Office action on the merits (June 11, 2009). MPEP 2271, subpart III, states that "[w]here art is submitted in a prior art citation under 37 CFR 1.501 and/or 37 CFR 1.555 (an IDS filed in a reexamination is construed as a prior art citation) and the submission is not accompanied by a statement similar to that of 37 CFR 1.97(e), the examiner may use the art submitted and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection is introduced by the examiner based on the new art not cited in the prior art citation." The record does not show that the patent owner made a

---

[1] The record does not show that a copy of the English language abstract of DE 19701536 was received on May 15, 2009.

[2] It is noted that patent owner did not list U.S. Patent No. 5,919,236 on the citation form dated August 14, 2009 but supplied a copy of the reference. The fact that the patent owner did not comply with the regulations (e.g., 37 CFR 1.98(b)) requiring that the reference be listed on a citation form, or its equivalent, does not circumvent the policies that encourage citation of prior art early in the proceedings by allowing Office actions to be made final based on late-filed citations of prior art in certain circumstances. These policies are of particular importance in reexamination proceedings, which are required by statute (35 U.S.C. 305) to be conducted with special dispatch.

statement similar to the statement required in 37 CFR 1.97(e). On the other hand, the record shows[3] that patent owner was aware of U.S. Patent No. 5,919,236 prior to submitting the August 14, 2009 response, and had an opportunity to amend the claims, argue patentability of the claims, provide evidence to overcome the reference, etc. in the response to the first Office action, but chose not to do so. Therefore, in the interest of special dispatch, the examiner appropriately followed reexamination policies and procedures, as set forth in the MPEP and the regulations, and made the September 21, 2009 Office action final.

Patent Owner's argument that the listing of DE 19701536, alleged to be the foreign equivalent of U.S. Patent No. 5,919,236, in the May 15, 2009 IDS means that U.S. Patent No 5,919,236 was not cited for the first time after the first Office action on the merits is not persuasive for the following reasons. First, the Patent Owner has not established that DE 19701536 is, in fact, the foreign language equivalent of U.S. Patent No. 5,919,236 by providing a showing that the two documents are the same disclosure. See MPEP 901.05, subsection III, which states:

> "Duplicate or substantially duplicate versions of a foreign language specification, in English or some other language known to the examiner, can sometimes be found. It is possible to cite a foreign language specification as a reference, while at the same time citing an English language version of the specification with a later date as a convenient translation if the latter is in fact a translation. Questions as to content in such cases must be settled based on the specification which was used as the reference."

The Patent Owner has not provided a translation of DE 19701536 or otherwise shown that the disclosures of the two references are the same.

Second, even assuming that DE 19701536 is the equivalent of U.S. Patent No. 5,919,236, the record shows that a copy of DE 19701536 and the English language abstract was not received in the May 15, 2009 IDS. The examiner lined through the citation to DE 19701536 because a copy was not of record. See the initial PTO/SB/42 form attached to the June 11, 2009 Office action. Therefore, the citation of DE 19701536 was not in compliance with Office regulations, and was not considered by the examiner prior to the first Office action. In the August 14, 2009 response, patent owner made no statements nor provided any evidence (as required by 37 CFR 1.8(b)) that a copy of DE 19701536 was mailed to the Office but the Office misplaced it. Instead, Patent Owner only stated that the enclosed IDS statement is providing copies of the "... two references indicated by the Examiner as not having been received." See page 19 of the remarks dated August 14, 2009. On November 6, 2009, as evidence supporting the petition, Patent Owner filed a filing receipt of the May 15, 2009 IDS. The receipt does not state how many references for which copies were provided or even the total number of pages. Therefore, this receipt provides no evidence that DE 19701536 was received by the Office on May 15, 2009. In conclusion, the record does not support the allegations that DE 19701536 was received by the Office prior to the

[3] This fact is established by the recording showing that Patent Owner provided a copy of U.S. Patent No. 5,919,236.

first Office action, that DE 19701536 is a foreign language equivalent of U.S. Patent No. 5,919,236, and that the citation of DE 19701536 creates an exception to the policies, set forth in MPEP 2271, that permits the finality of Office actions based on late-filed prior art.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the Office action of September 21, 2009 should be final. Therefore, the examiner did not abuse his discretion in deciding to make final the Office action of September 21, 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 in the interest of special dispatch.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the finality of the Office action dated September 21, 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.
90/009,410	05/05/2009	5766782	M-2437	6781

55694 7590 11/24/2009

DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/24/2009

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

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(For Requester) NOV 2 4 2009

CENTRAL REEXAMINATION UNIT

In re Reissue Application of:
Bjorn Ljungberg
Application No. 12/222,440
Filed: August 8, 2008
For: U.S. Patent No. 5,766,782

In re Bjorn Ljungberg
Reexamination Proceeding
Control No. 90/009,410
Filed: May 5, 2009
For: U.S. Patent No. 5,766,782

DECISION
SUA SPONTE
MERGING REISSUE
AND REEXAMINATION
PROCEEDINGS

Reissue application 12/222,440, and reexamination control number 90/009,410 are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565 at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,766,782 (the '782 patent) issued on June 16, 1998, with 13 claims.

2. An application for reissue of the '782 patent, assigned application No. 12/222,440 (the '440 application), was filed by the patent owner on August 8, 2008. The application included a preliminary amendment that amended the text of claims 1, 6, 10, 12, and 13; cancelled claim 4; and added new claims 14-16. The preliminary amendment also added a new paragraph entitled "CROSS REFERENCES TO RELATED APPLICATIONS" before the first line of the specification.

3. The notice of the filing of the '440 application for reissue of the '782 patent published in the *Official Gazette* on September 9, 2008.

4. On January 5, 2009, a non-final Office action rejecting claims 1-3, and 5-16 was mailed in the '440 application.

5. A request for reexamination of claims 1-13 of the '782 patent was initially deposited by a third party requester on February 10, 2009, and was assigned control No. 90/009,410 (the '9410 proceeding). The request received a filing date of May 5, 2009.

6. Reexamination was ordered for the '9410 proceeding on June 12, 2009.

7. On July 2, 2009, patent owner filed an amendment in the '440 application, in response to the January 5, 2009 non-final Office action, that amended the text of claims 1, 10, and 14-16.[1] The July 2, 2009 amendment also amended the paragraph starting at column 4, line 56 of the specification.

8. As of the mailing date of this decision, a patent owner's statement under 37 CFR 1.530 has not been received in the '9410 proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 12/222,440 and reexamination control No. 90/009,410 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

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[1] 37 CFR 1.173(b)(2) requires that for any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Claims 14-16 were changed by the July 2, 2009 amendment, and the status identifier for these claims do not reflect that any changes were made. It is also noted that since claim 4 is already canceled by the August 8, 2008 preliminary amendment, there is no need to indicate that claim 4 is cancelled in the July 2, 2009 amendment. Claims 6, 12 and 13 remain as amended by the August 8, 2008 preliminary amendment. In view of the remarks accompanying the July 2, 2009 amendment, it appears that applicant desired to reinstate claims 6, 12, and 13 and present these claims as original claims. For further guidance on the manner of making amendments to reissue applications, please see MPEP 1453.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

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

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) is discretionary. The present merger is not an assurance that, in a future similar situation, merger would be ordered. In addition, **if a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed**, and the reissue application may then be suspended. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the file for reexamination control No. 90/009,410 shows the presence of the following live claims: original patent claims 1-13.

3. A review of reissue application No. 12/222,440 shows claims 1, 6, 10, 12, and 13 have been amended and that new claims 14-16 have been introduced into the application and were further amended on July 2, 2009. It is noted that in the reissue application, the specification has been amended.

Accordingly, the claims and the specification are not identical in both proceedings.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both proceedings, specifically, Application No. 12/222,440 and Control Number 90/009,410. The response to this requirement must be **strictly limited** to formally placing the same amendment in each **file so that the specification, claims, and drawings are identical in both cases**. The patent owner must **NOT** address any issue of patentability in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper that includes the identifying data for both files (i.e., the reissue application number and the *inter partes* reexamination proceeding control number) and a signature. The housekeeping amendment must be filed in duplicate for entry into the reissue application file and the *inter partes* reexamination file.

It is to be noted that, pursuant to MPEP 2285, amendments in a merged reissue/reexamination proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice. The patent owner is reminded that **any changes must be made relative to the patent pursuant to 37 CFR 1.173(d).** See MPEP 1453 for a complete discussion of amendment practice in reissue applications.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings (or would be construed differently based on a difference in the specifications in the reexamination and reissue proceedings) should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention. The disclosures in both proceedings should be objected to as being inconsistent for the same underlying patent.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding. *Any such responses must be served on the requester*, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application: "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

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

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

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner appeal brief, even though such a brief would relate to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file of the merged proceeding.

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

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 12/222,440 and reexamination control No. 90/009,410 **are merged** into a single proceeding.

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

3. Periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination. In addition, **if a final rejection Office action should be issued in this merged proceeding**, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.

4. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed.** Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d)

5. Jurisdiction over the merged reissue and reexaminations proceeding is being transferred to Technology Center 1700. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '782 patent (e.g., by preparing/signing an action). See: MPEP 2236. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

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

7. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

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(For Patent Owner)

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(For 3rd Party Requester)
(90/009,413)

CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/010,343
Filed : December 23, 2008
For U.S. Patent No. : 6,250,587

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/009,413
Filed : March 19, 2009
For U.S. Patent No. : 6,250,587

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. 90/010,343 was ordered in a decision mailed February 2, 2009, indicating that claims 1-15, all of the patent claims, would be reexamined. No patent owner statement was filed in response to the decision granting reexamination that was mailed February 24, 2009. An Information Disclosure Statements was filed February 4. No Office action has been issued in this proceeding. No changes to the specification, claims and/or drawings have been made in made in this proceeding.

Reexamination in application control No. 90/009,413 was ordered in a decision mailed April 7, 2009, indicating that claims 1-15, all of the patent claims, would be reexamined. No patent owner statement was filed in response to the decision granting reexamination that was mailed February 20, 2009. No Office action has been issued in this proceeding. No changes to the specification, claims and/or drawings have been made in made in this proceeding.

As evidenced by the above facts, reexamination control No. 90/010,343 and reexamination control No. 90/009,413 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.

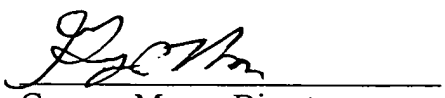
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-15, all of the patent claims, will be reexamined in this merged proceeding. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and each requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), only a single fee need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/010,343 and 90/009,413 are hereby merged into a single proceeding. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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



Gregory Morse, Director
Central Reexamination Unit

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For Patent Owner

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OCT 06 2009

CENTRAL REEXAMINATION UNIT

Malloy & Malloy
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For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,417
Filed: February 25, 2009
For: U.S. Patent No. 6,325,085

Ex Parte Reexamination Proceeding
Control No. 90/010,528
Filed: May 6, 2009
For: U.S. Patent No. 6,325,085

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided 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. 90/009,417 was ordered in a decision mailed March 26, 2009. The decision granted reexamination for only original patent claim 10, the only claim for which reexamination was requested. On May 1, 2009, patent owner filed a letter waiving his rights to file a Patent Owner Statement under 37 CFR 1.530. On May 21, 2009, a non-final Office action was mailed rejecting claim 10. On July 21, 2009,

patent owner filed a response to the Office action. The response amended claim 10. In addition, on July 21, 2009, patent owner also filed an Information Disclosure Statement. No Office action has been rendered since the receipt of patent owner's response.

Reexamination in application Control No. 90/010,528 was ordered in a decision mailed June 25, 2009. The decision indicating that claim 10, the only claim for which reexamination was requested, would be reexamined. On July 22, 2009, patent owner filed a waiver of his rights to file a Patent Owner Statement under 37 CFR 1.530. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/009,417 and reexamination control No. 90/010,528 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings and both proceedings are pending, a decision under 37 CFR 1.565(c) is timely. Accordingly, the petition to merge the above-captioned proceedings is granted and the 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 10, the only claim subject to reexamination, was amended in reexamination Control No. 90/009,417 by virtue of the July 21, 2009 amendment. No amendment has been filed in reexamination control No. 90/010,528.The patent owner is required to maintain identical claims, drawings, and specification in both files. **Accordingly, patent owner is hereby required to provide 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. Claim10, the only claim 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 paper 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 fee, brief fee, etc.) only a single feed 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 art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/009,417 and 90/010,528 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 claim in each of the files**. Upon receipt of the response or expiration of the time period indicated above, whichever comes first, the 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, Supervisory Primary Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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CENTRAL REEXAMINATION UNIT

In re Application of :
TED GOWER :
Control No. 90/009,417 (U.S. 6,325,085) : DECISION ON PETITION
Filed: February 25, 2009 : TO WITHDRAW
Attorney Docket No. 087558.00022 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 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. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Brad Y. Chin on behalf of all attorneys of record. Applicant is reminded that there is no attorney of record at this time. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Manuel Saldana at 571-272-7740.

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: PETER A. MATOS, ESQ. (Third Party Requester)
MALLOY & MALLOY, PA
2800 S.W. THIRD AVENUE
MIAMI, FL 33129

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on October 20, 2009. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,429	04/27/2009	6064538	044760-5003US	8063

24341 7590 11/25/2009

MORGAN, LEWIS & BOCKIUS, LLP. (PA)
2 PALO ALTO SQUARE
3000 EL CAMINO REAL, SUITE 700
PALO ALTO, CA 94306

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/25/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PERRY CLARK
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950 PAGE MILL ROAD, P.O. BOX 51827
PALO ALTO, CA 94303

Date:

MAILED
NOV 25 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009429
PATENT NO. : 6064538
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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MORGAN, LEWIS & BOCKIUS, LLP. (PA)
2 PALO ALTO SQUARE
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(Patent Owner)

MAILED

NOV 25 2009

CENTRAL REEXAMINATION UNIT

KIRKLAND & ELLIS LLP
950 PAGE MILL ROAD
PO BOX 51827
PALO ALTO CA 94303

(Third Party Requester)

In re Stoyell et al.
Reexamination Proceeding
Control No.: 90/009,429
Filed: March 9, 2009
For: U.S. Patent No.: 6,064,538

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

This is a decision on the October 2, 2009 patent owner petition under 37 CFR 1.182, requesting the Office to enter and consider an information disclosure statement (IDS) filed after the termination of the prosecution in the above captioned reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed October 2, 2009, has not been entered for consideration by the examiner.

FEE

A petition fee of $ 400.00 under 37 CFR 1.17(f) for petitions under 37 CFR 1.182 is being charged to petitioner's Deposit Account No. 50-0310 as authorized in the October 2, 2009 petition.

BACKGROUND

1. On May 16, 2000, the Office issued U.S. patent number 6,064,538 (the '538 patent).
2. On March 9, 2009, a request for reexamination of the '538 patent, assigned reexamination control no. 90/009,429 (the '9429 reexamination proceeding), was filed by a third party requester.
3. On June 5, 2009, the Office ordered reexamination of the '538 patent in the '9429 reexamination proceeding.
4. On July 23, 2009, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the '9429 reexamination proceeding.

5. On July 31, 2009, the '9429 reexamination proceeding entered the printing cycle, for printing of a reexamination certificate.

6. On September 9, 2009, patent owner filed an IDS after NIRC without a petition requesting consideration of an IDS after NIRC.

7. On October 2, 2009, patent owner filed the instant petition, accompanied by another IDS filed after NIRC. Patent owner requests the Office consider both the September 9, 2009 and the October 2, 2009 IDS after NIRC submissions.

8. On November 3, 2009, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (7131st), US 6,064,538 C1.

DECISION

The present reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (7131st) US 6,064,538 C1. As a result of the issuance of the reexamination certificate, the Office was divested of jurisdiction over the '538 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 July 23, 2009, and the proceeding has now resulted in issuance of *Ex Parte* Reexamination Certificate (7131st), thereby divesting the Office of jurisdiction over the '538 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 '9429 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 2256 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed**

> **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier.** The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

Even had the petition been addressed prior to issuance of the certificate, the fact situation does not satisfy the above highlighted pre-conditions to address the factual accounting of delay and the relevancy of the submitted prior art, which are grounded on the statutory requirement for special dispatch. The instant petition was filed several months after prosecution on the merits in the '9429 reexamination proceeding closed. The September 9, 2009 and the October 2, 2009 IDS submissions fail to satisfy both the sufficient factual accounting as to the delay requirement and the relevancy requirements when a proceeding is in its publication cycle, in the form of an unequivocal statement of unpatentability of at least one claim combined with providing an amendment to render the claims patentable.

In regards to the timeliness of September 9, 2009 IDS submission, patent owner indicates awareness of the submitted references due to related patent litigation proceedings spanning from 2004 to 2009. Out of the eight pages of litigation documents listed on the PTO-1449 submitted as part of the IDS on September 9, 2009, only one bears a 2009 date - January 21, 2009. All the remaining litigation documents bear a 2008 or earlier date. The '9429 reexamination proceeding was initiated on 2009, therefore almost all of the documents were known to patent owner before initiation of the '9429 reexamination proceeding. Petitioner states it was a very time consuming task to review and compile the IDS, yet provides no dates relevant to when the task was first taken up to when it was completed to when the IDS was submitted on September 9, 2009. This generalized statement without specific dates is not a full and proper factual accounting in accordance with MPEP 2256 guidance. Further, patent owner does not point out what resources (e.g., personnel) were committed to review and compile the IDS and why. As patent owner was aware of the information at the onset of the '9429 reexamination proceeding and that the litigation documents likely were relevant to the '9429 reexamination proceeding, presumably patent owner would have initiated the preparation of the IDS immediately to comply with their duty of disclosure. Instead patent owner provides merely a generalized partial explanation as to why it could not submit the references any earlier, namely because it was "time consuming". However, patent owner presents no specifics as to how it went about insuring that all references that came up in the "related matter" were timely reviewed for relevancy and if found relevant, seasonably presented in the '9429 reexamination proceeding. Obviously the "related" nature of the other matter was established before NIRC in the '9429 reexamination proceeding. Thus the time period from initiation of the '9429 reexamination proceeding until the point the references were submitted to the office, September 9, 2009, is the time period for which patent owner needed to provide benchmark activity dates to establish a proper showing that the references could not have been submitted earlier. However, no such showing was proffered by patent owner.

In regards to the timeliness of the October 2, 2009 IDS submission, patent owner indicates awareness of the submitted references due to the same related patent litigation spanning from 2004 to 2009. Patent owner also notes the references in the October 2, 2009 IDS submission were further delayed as patent owner had to coordinate with other litigants to determine what material would still be covered by a court issued protective order. Presumably the information submitted on October 2, 2009 is not subject to the court issued protective order, as it was not submitted in accordance with 37 CFR 1.59 and MPEP 724. The details this extensive coordination that is alleged to have caused the delay is not fully disclosed. Thus patent owner's

coordination time, without a more detailed explanation, cannot serve as proper justification as to why the references could not have been submitted earlier. Therefore, Patent owner has not provided a full and proper factual accounting to explain why the October 2, 2009 IDS is being submitted so late. Accordingly, without a detailed factual accounting justifying the delay of both IDS submissions, patent owner has failed to satisfy the MPEP 2256 factual accounting requirement for submission of a post NIRC IDS.

In regards to both IDS submissions, patent owner has failed to satisfy the requirements of an unequivocal statement of unpatentability of at least one claim combined with the provision of an amendment to render the claims patentable. Patent owner has expressly stated in the October 2, 2009 petition that the prior art references submitted are not material to patentability to any of the pending claims in reexamination. 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 '9429 reexamination proceeding. The present petition does not satisfy the MPEP 2256 conditions for consideration of an IDS after the proceeding had entered the print cycle, and therefore 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 references 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 submissions filed on September 9, 2009 and October 2, 2009.

2. The IDS papers have not been entered for consideration by the examiner.

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

Kenneth M. Schor

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,435	04/06/2009	6278264	VOLTP003RXUS	8032

22434 7590 12/18/2009

Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/18/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Kenneth L. Cage
McDERMOTT WILL & EMERY, LLP
600 13th Street, N.W.
Washington, DC 20005-3096

Date:

MAILED

DEC 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009435
PATENT NO. : 6278264
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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Joseph M Villenueve
Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND CA 94612-0250

(For Patent Owner)

MAILED
DEC 18 2009
CENTRAL REEXAMINATION UNIT

Kenneth Cage
MCDERMOTT WILL & EMORY LLP
600 13th Street, NW
Washington, DC 20005-3096

(For Third Party Requester)

In re: Burstein *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,435
Deposited: 17 December 2008
For: US Patent No. 6,278,264

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

This is a decision on the 15 December 2009, "Petition for Extension of Time to File Response to Non-Final Office Action Pursuant to 37 CFR § 1.550(c)" requesting that the time for responding to the non-final Office action mailed 30 November 2009, be extended by one (1) month extension of time. The petition was timely filed on 15 December 2009. The petition included the required petition fee pursuant to 37 CFR § 1.17(g) and certificate of service.

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time to be extended one (1) month in which to file a response to the non-final Office action mailed 30 November 2009. The petition for extension of time was timely filed on 15 December 2009 with appropriate fee according to 37 CFR § 1.17(g) and certificate of service.

The extension of time is 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. ...

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'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.

In the petition dated 15 December 2009, the petitioner has demonstrated "sufficient cause" for granting the extension of time. The petitioner articulates several reasons for the extension of time among them the need for additional time to obtain declaratory evidence pursuant to 37 CFR § 1.132. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

The petition request to extend the response time is hereby granted.

CONCLUSION

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

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

3. The Patent Owner's response is due **30 February 2010.**

4. Response and/or submissions to the Office should be addressed as follows:

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

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

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

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

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

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,435	04/06/2009	6278264	VOLTP003RXUS	8032

22434 7590 04/28/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2010

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Washington, DC 20005-3096

Date:

MAILED

APR 28 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009435
PATENT NO. : 6278264
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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MAILED
APR 28 2010
CENTRAL REEXAMINATION UNIT

In re Burstein et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/009,435 : **DISMISSING**
Filed: April 6, 2009 : **PETITION**
For: U.S. Patent No. 6,278,264 :

This is a decision on the patent owner petition, filed March 1, 2010, denominated "Petition For Suspension of Rules Under 37 CFR § 1.183 (per MPEP 715.04 I)" requesting waiver of the signature of a deceased inventor on a declaration under 37 CFR 1.131 and acceptance of the declaration under 37 CFR 1.131 without execution by all of the named inventors.

The proceeding and the petition are before the Office of Patent Legal Administration for decision.

The petition fee required under 37 CFR 1.17(f) has been received.

The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is **dismissed**.

REVIEW OF FACTS

1. On August 21, 2001, U.S. Patent No. 6,278,264 (the '264 patent) issued to Burstein et al. with 43 claims.

2. The patent lists the assignee as Volterra Semiconductor Corporation, which corresponds to the recorded assignment documents.

3. A litigation involving the '264 patent is pending in the U.S. District Court, N. District of California, styled *Volterra Semiconductor Corporation v. Primarion, Inc. et al.*, 3:08cv5129.

4. A third party requester, Infineon Technologies North America, filed a request for *ex parte* reexamination of claims 26-28 and 32-34 of the '264 patent, and the resulting proceeding received a filing date of April 6, 2009. The proceeding was assigned control no. 90/009,435 (the '9435 proceeding).

5. On June 2, 2009, an order granting the reexamination request was mailed.

6. A non-final Office action was mailed November 30, 2009, in which claims 26-28 and 32-34 were rejected.

7. An interview was held on February 4, 2010.

8. After an extension of time was granted, a response to the Office action was filed March 1, 2010, along with several declarations under 37 CFR 1.132 and a declaration under 37 CFR 1.131. The subject petition was filed with the response; the petition requests waiver of the rules to permit entry of the declaration under 37 CFR 1.131.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.131(a) provides, in pertinent part (emphasis added):

> When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, **the owner of the patent under reexamination**, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. [Emphasis added.]

37 CFR 1.183 provides, in pertinent part:

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

MPEP 715.04 I. provides, in pertinent part (emphasis added):

> The following parties may make an affidavit or declaration under 37 CFR 1.131:
>
> (A) All the inventors of the subject matter claimed.
>
> (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
>
> (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
>
> (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s)**. Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. [Emphasis added.]

37 CFR § 1.47 Filing when an inventor refuses to sign or cannot be reached:

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § **1.17(g)**, and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § **1.63**.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § **1.17(g)**, and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § **1.63**.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

37 CFR § 3.73 Establishing right of assignee to take action:

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b) (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § **3.11** in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § **3.11**; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.
(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

ANALYSIS AND FINDINGS

Patent owner requests that the requirement for the signature of one of the inventors, Charles Nickel, be waived for a declaration under 37 CFR 1.131 which has been submitted with the signature of the other inventor, Andrew J. Burstein. Addressing the substance of the petition, it is pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. See, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, an alternative avenue that complies with the rules is available to obtain the requested relief.

37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination*. . . may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). As pointed out in MPEP 715.04 I.(D), an assignee, or other party in interest is permitted to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is asserted in the case here. In accordance with the language of 37 CFR 1.131, the assignee may make the declaration for a patent under reexamination, even if the inventors are available to sign a declaration. It is noted that authority to take action by the assignee Volterra has already been established with the filing of a statement under 37 CFR 3.73(b). However, in this case, the inventor, rather than the patent owner, has attempted to submit a declaration under 37 CFR 1.131. Thus, as an avenue for relief is available by patent owner signing the declaration, waiver of the rule is not required.

In summary, the petitioner has not shown the present situation to be one warranting extraordinary relief, and for that reason, the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

PATENT OWNER'S ADDRESS

The patent owner filed a power of attorney and change of address applicable to several patents including the '264 patent on March 31, 2009. However, it appears that the filing was made in only one of the patent files, although it was made effective in several, but not all, of the other files. The power of attorney and correspondence address was changed in the '264 patent file by way of the filing, but does not appear in the record of the file. To complete the file, it is required that patent owner file a copy of the power of attorney in the '264 patent file. It is recommended that the power of attorney be filed in the other applicable patent files as well.

CONCLUSION

1. For the reasons set forth above, the petition under 37 CFR 1.183 to waive 37 CFR 1.131 as to its requirement for signature of an oath or declaration is **dismissed**.

2. This decision does not address the merits of the patent owner's response or the substance of the declaration, which are determinations within the jurisdiction of the examiner of record.

3. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for further examination as appropriate.

4. Any inquiry concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

/Kenneth M. Schor/

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

April 27, 2010

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.
90/009,436	03/25/2009	6713823	VOLTP005RXUS	9417

22434 7590 06/29/2010

Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/29/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Weaver Austin Villeneuve & Sampson LLP : (For Patent Owner)
P.O. BOX 70250 :
OAKLAND CA 94612-0250 :

MAILED

JUN 29 2010

MCDERMOTT WILL & EMERY LLP : (For Third Party Requester)
600 13TH STREET, N.W. :
WASHINGTON, DC 20005-3096 :

CENTRAL REEXAMINATION UNIT

In re: Charles Nickel :
Ex Parte Reexamination Proceeding :
Control No. 90/009,436 :
Deposited on: 25 March 2009 :
For: US Patent No. 6,713,823 B1 :

DECISION
GRANTING
PETITION FOR EXPUNGEMENT
OF PAPERS
[37 CFR §§ 1.59 & 1.181]

This is a decision on the petition dated 27 April 2010, entitled, "Petition to Expunge Under 37 CFR § 1.59." The petition seeks to have papers expunged from the file of *Ex Parte* Reexamination Proceeding control number 90/009,436.

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests for expungement of material subject to protective order filed under MPEP § 724.02 filed as exhibits in a sealed envelope. The petition meets all of the requirements of MPEP § 724.05 and has provided the appropriate fee.

The request is granted.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

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

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

...

37 CFR § 1.59 Expungement of information or copy of papers in 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 § 724.05 Petition To Expunge Information or Copy of Papers in Application File (in-part)

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).
...

ANALYSIS AND FINDINGS

The Patent Owner's representative requests expungement of material subject to protective order filed under MPEP § 724.02. Since the examiner has determined that the materials presented under seal are not material to the instant *ex parte* reexamination proceeding and the petitioner complies with all of the requirements of MPEP § 724.05 the petition is hereby granted.

CONCLUSION

1. The patent owner's petitions to expunge papers dated 27 April 2010 is hereby **granted.**

2. The documents under seal are to be returned.

3. The proceeding is returned to the examiner for processing of the proceeding control number 90/009,436..

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, 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

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.
90/009,437	04/30/2009	6462522	VOLTP004RXUS	2953

22434 7590 12/23/2009

Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2009

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
MCDERMOTT WILL & EMERY LLP
600 13th STREET NW
WASHINGTON, DC 20005-3096

Date:
MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009437
PATENT NO. : 6462522
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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MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

Joseph M Villenueve
Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND CA 94612-0250

(For Patent Owner)

Kenneth Cage
MCDERMOTT WILL & EMORY LLP
600 13th Street, NW
Washington, DC 20005-3096

(For Third Party Requester)

In re: Burstein *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,437
Deposited: 25 March 2009
For: US Patent No. 6,462,522

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

This is a decision on the 15 December 2009, "Petition for Extension of Time to File Response to Non-Final Office Action Pursuant to 37 CFR § 1.550(c)" requesting that the time for responding to the non-final Office action mailed 25 November 2009, be extended by one (1) month extension of time. The petition was timely filed on 15 December 2009. The petition included the required petition fee pursuant to 37 CFR § 1.17(g) and certificate of service.

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time to be extended one (1) month in which to file a response to the non-final Office action mailed 25 November 2009. The petition for extension of time was timely filed on 15 December 2009 with appropriate fee according to 37 CFR § 1.17(g) and certificate of service.

The extension of time is 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. ...

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'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.

In the petition dated 15 December 2009, the petitioner has demonstrated "sufficient cause" for granting the extension of time. The petitioner articulates several reasons for the extension of time among them the need for additional time to obtain declaratory evidence pursuant to 37 CFR § 1.132. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

The petition request to extend the response time is hereby granted.

CONCLUSION

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

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

3. The Patent Owner's response is due **25 February 2010.**

4. Response and/or submissions to the Office should be addressed as follows:

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

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

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

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

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

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,437	04/30/2009	6462522	VOLTP004RXUS	2953

22434 7590 04/28/2010

Weaver Austin Villeneuve & Sampson LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,437	04/30/2009	6462522	VOLTP004RXUS	2953

22434 7590 04/28/2010

EXAMINER	

Kenneth L. Cage
McDermot Will & Emery LLP
600 13th Street, NW
Washington, DC 20005-3096

ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2010

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

Peter A. Gallagher (For Patent Owner)
Weaver Austin Villeneuve & Sampson LLP
P.O. Box 70250
Oakland, CA 94612-0250

Kenneth L. Cage (For Requester)
McDermott Will & Emery LLP
600 13th Street, N.W.
Washington, D.C. 20005-3096

MAILED

APR 28 2010

CENTRAL REEXAMINATION UNIT

In re Burstein et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/009,437 : **DISMISSING**
Filed: April 30, 2009 : **PETITION**
For: U.S. Patent No. 6,462,522 :

This is a decision on the patent owner petition, filed February 25, 2010, denominated "Petition For Suspension of Rules Under 37 CFR § 1.183 (per MPEP 715.04 I)" requesting waiver of the signature of a deceased inventor on a declaration under 37 CFR 1.131 and acceptance of the declaration under 37 CFR 1.131 without execution by all of the named inventors.

The proceeding and the petition are before the Office of Patent Legal Administration for decision.

The petition fee required under 37 CFR 1.17(f) has been received.

The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is **dismissed**.

REVIEW OF FACTS

1. On October 8, 2002, U.S. Patent No. 6,462,522 (the '522 patent) issued to Burstein et al. with 33 claims.

2. The patent lists the assignee as Volterra Semiconductor Corporation, which corresponds to the recorded assignment documents.

3. A litigation involving the '522 patent is pending in the U.S. District Court, N. District of California, styled *Volterra Semiconductor Corporation v. Primarion, Inc. et al.*, 3:08cv5129.

4. A third party requester, Infineon Technologies North America, filed a request for *ex parte* reexamination of claims 9-11, 13, 15-19, 21-24, and 26-28 of the '522 patent, and the

resulting proceeding received a filing date of April 30, 2009. The proceeding was assigned control no. 90/009,437 (the '9437 proceeding).

5. On June 2, 2009, an order granting the reexamination request was mailed.

6. A non-final Office action was mailed November 25, 2009, in which claims 9-11, 13, 15-19, 21-24, and 26-28 were rejected.

7. An interview was held on February 4, 2010.

8. After an extension of time was granted, a response to the Office action was filed February 25, 2010, along with several declarations under 37 CFR 1.132 and a declaration under 37 CFR 1.131. The subject petition was filed with the response; the petition requests waiver of the rules to permit entry of the declaration under 37 CFR 1.131.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.131(a) provides, in pertinent part (emphasis added):

> When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, **the owner of the patent under reexamination**, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. [Emphasis added.]

37 CFR 1.183 provides, in pertinent part:

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

MPEP 715.04 I. provides, in pertinent part (emphasis added):

> The following parties may make an affidavit or declaration under 37 CFR 1.131:
>
> (A) All the inventors of the subject matter claimed.
>
> (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
>
> (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
>
> (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).
>
> Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or

inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s)**. Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. [Emphasis added.]

37 CFR § 1.47 Filing when an inventor refuses to sign or cannot be reached:

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § **1.17(g)**, and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § **1.63**.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § **1.17(g)**, and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § **1.63**.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

37 CFR § 3.73 Establishing right of assignee to take action:

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.
(b) (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § **3.11** in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § **3.11**; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

ANALYSIS AND FINDINGS

Patent owner requests that the requirement for the signature of one of the inventors, Charles Nickel, be waived for a declaration under 37 CFR 1.131 which has been submitted with the signature of the other inventor, Andrew J. Burstein. Addressing the substance of the petition, it is pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. See, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, an alternative avenue that complies with the rules is available to obtain the requested relief.

37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination*. . . may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). As pointed out in MPEP 715.04 I.(D), an assignee, or other party in interest is permitted to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is asserted in the case here. In accordance with the language of 37 CFR 1.131, the assignee may make the declaration for a patent under reexamination, even if the inventors are available to sign a declaration. It is noted that authority to take action by the assignee Volterra has already been established with the filing of a statement under 37 CFR 3.73(b). However, in this case, the inventor, rather than the patent owner, has attempted to submit a declaration under 37 CFR 1.131. Thus, as an avenue for relief is available by patent owner signing the declaration, waiver of the rule is not required.

In summary, the petitioner has not shown the present situation to be one warranting extraordinary relief, and for that reason, the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

PATENT OWNER'S ADDRESS

The patent owner filed a power of attorney and change of address applicable to several patents including the '522 patent on March 31, 2009. However, it appears that the filing was made in only one of the patent files, although it was made effective in several, but not all, of the other files. The power of attorney and correspondence address was not changed in the '522 patent file by way of the filing. To complete the file and ensure that correspondence in this proceeding continues to be sent to the address in the power of attorney in the reexamination proceeding, it is required that patent owner file a copy of the power of attorney in the '522 patent file. It is recommended that the power of attorney be filed in the other applicable patent files as well.

CONCLUSION

1. For the reasons set forth above, the petition under 37 CFR 1.183 to waive 37 CFR 1.131 as to its requirement for signature of an oath or declaration is **dismissed**.

2. This decision does not address the merits of the patent owner's response or the substance of the declaration, which are determinations within the jurisdiction of the examiner of record.

3. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for further examination as appropriate.

4. Any inquiry concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

/Kenneth M. Schor/

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

April 27, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas W. Humphrey, Esq.
Wood Herron & Evans
2700 Carew Tower
Cincinnati, OH 45202

For Patent Owner

MAILED

JUN 28 2010

CENTRAL REEXAMINATION UNIT

Walter Scott, Esq.
Alston & Bird, LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,455
Filed: April 23, 2009
For: U.S. Patent No. 5,868,710

Ex Parte Reexamination Proceeding
Control No. 90/009,672
Filed: January 22, 2010
For: U.S. Patent No. 5,868,710

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided 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. 90/009,455 was ordered in a decision mailed May 29, 2009. The decision granted reexamination for patent claims 1, and 9-11, the only claims for which reexamination was requested. On September 26, 2009, a non-final Office action was mailed rejecting claims 9-11 and confirming claim 1. On November

25, 2009, patent owner filed a response to the Office action. The response presented arguments in favor of confirmation of claims 9-11. The response also added new dependent claims 13-41. No Office action has been rendered since the receipt of patent owner's response.

Reexamination in application Control No. 90/009,672 was ordered in a decision mailed March 24, 2010. The decision indicating that claims 1-3 and 9-11, the only claims for which reexamination was requested, would be reexamined. No Patent Owner Statement under 37 CFR 1.530 was filed by patent owner. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/009,455 and reexamination control No. 90/009,672 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings and both proceedings are pending, a decision under 37 CFR 1.565(c) is timely. Accordingly, the petition to merge the above-captioned proceedings is granted and the 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, no original patent claims have been amended, but new dependent claims 13-41 have been added by amendment in reexamination control No. 90/009,455. No amendment has been filed in reexamination control No. 90/009,672. As patent owner is required to maintain identical claims, drawings, and specification in both files, and keeping with the statutory requirement of 35 U.S.C. 305 that "All reexamination proceedings under this section ...will be conducted with special dispatch within the Office.", to expedite the proceedings, a copy of pages 2-8 of the response filed November 25, 2009 in reexamination control No. 90/009,455, which pages contain a complete copy of all of the original claims as well as the newly added dependent claims 13-41 (copy attached) will be entered into the file of reexamination control No. 90/009,672, and this version of the claims, which is the most recent, will be treated in the next Office action.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. As indicated above, original patent claims 1 and 9-11 as well as new claims 13-41 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 paper 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 fee, brief fee, etc.) only a single feed 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 art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/009,455 and 90/009,672 are hereby merged into a single proceeding. Upon the mailing of this decision, the files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits that is consistent with this decision.

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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

Attachment: copy of pages 2-8, Listing of Claims, submitted with response received November 25, 2009 in reexamination control No. 90/009,455.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Address: COMMISSIONER FOR PATENTS
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,456	05/27/2009	RE35952		7400

7590 09/16/2009

EXAMINER	

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison
Suite 4600
Chicago, IL 60602

ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2009

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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,400	02/09/2009	RE 35952		4219

7590 09/16/2009

NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON - SUITE 4600
CHICAGO, IL 60602

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2009

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
WILDMAN HARROLD ALLEN & DIXON LLP
225 WEST WACKER DRIVE
SUITE 2800
CHICAGO, IL 60606

Date:

MAILED

SEP 16 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009400
PATENT NO. : RE35952
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 Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Frederic M. Meeker
BANNER & WITCOFF, LTD.
1100 13th Street, N.W., Suite 1200
Washington, DC 20005-4051

Date: MAILED
SEP 16 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009456
PATENT NO. : RE35952
ART UNIT : 3992

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SEP 16 2009

CENTRAL REEXAMINATION UNIT

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison
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Chicago IL 60602

(For Patent Owner)

SHUMAKER & SIEFFERT, P. A.
WILDMAN HARROLD ALLEN & DIXON LLP
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(For Third Party Requester)

BANNER & WITCOFF, LTD.
1100 13TH STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

(For Third Party Requester)

In re Beery
Reexamination Proceeding
Control No. 90/009,400
Request Deposited: February 9, 2009
For: Reissued U.S. Patent No. RE 35,952

In re Beery
Reexamination Proceeding
Control No. 90/009,456
Corrected Request Deposited: May 27, 2009
For: Reissued U.S. Patent No. RE 35,952

: 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. 5,045,947, issued to Beery, on September 3, 1991. Reissued U.S. Patent No. RE 35,952 (hereinafter, the '952 patent), issued to Beery, on November 10, 1998.

2. On February 9, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,400 (hereinafter, the '9400 proceeding).

3. The Reexamination Order was granted in the '9400 proceeding on April 22, 2009.

4. There are currently no amendments in the '9400 proceeding.

5. On May 27, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,456 (hereinafter, the '9456 proceeding).

6. The Reexamination Order was granted in the '9456 proceeding on August 20, 2009.

7. Patent owner waived the right to file a patent owner statement on September 8, 2009. There are currently no amendments in the '9313 proceeding.

8. The '9400 and '9456 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 '9400 and the '9456 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. 90/009,400 and 90/009,456 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first 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
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,456	05/27/2009	RE35952		7400

7590 05/04/2010

NIRO, SCAVONE, HALLER & NIRO
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,400	02/09/2009	RE 35952		4219

7590 05/04/2010

NIRO, SCAVONE, HALLER & NIRO
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CHICAGO, IL 60602

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,726	10/30/2009	RE35952	454032800900	1039

7590 05/04/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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225 WEST WACKER DRIVE
SUITE 2800
CHICAGO, IL 60606

Date: MAILED

MAY 0 4 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009400
PATENT NO. : RE35952
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

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1100 13th Street, N.W., Suite 1200
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Date:

MAILED
MAY 04 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009456
PATENT NO. : RE35952
ART UNIT : 3992

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Date: MAILED

MAY 04 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010726
PATENT NO. : RE35952
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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MAY 04 2010

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Beery
Reexamination Proceeding
Control No. 90/009,400
Request Deposited: February 9, 2009
For: Reissued U.S. Patent No. RE 35,952

In re Beery
Reexamination Proceeding
Control No. 90/009,456
Corrected Request Deposited: May 27, 2009
For: Reissued U.S. Patent No. RE 35,952

In re Beery
Reexamination Proceeding
Control No. 90/010,726
Corrected Request Deposited: October 30, 2009
For: Reissued U.S. Patent No. RE 35,952

: 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. 5,045,947, issued to Beery, on September 3, 1991. Reissued U.S. Patent No. RE 35,952 (hereinafter, the '952 patent), issued to Beery, on November 10, 1998.

2. On February 9, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,400 (hereinafter, the '9400 proceeding).

3. The Reexamination Order was granted in the '9400 proceeding on April 22, 2009 finding a substantial new question of patentability (SNQP) as to claims 8, 9, 20, 29, 37, and 38.

4. On May 27, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/009,456 (hereinafter, the '9456 proceeding).

5. The Reexamination Order was granted in the '9456 proceeding on August 20, 2009 finding a substantial new question of patentability (SNQP) as to claims 1, 2, 5, 12, 13, 23, 24, 41, 48, 52, and 53.

6. Patent owner waived the right to file a patent owner statement on September 8, 2009.

7. On September 16, 2009, the '9400 and '9456 were merged.

8. On September 24, 2009, a non-final office action was mailed on the merged '9400 and '9456 proceedings. Claims 1, 2, 5, 8, 9, 12, 13, 20, 23, 24, 29, 37, 38, 41, 48, 52, and 53 were rejected. All other claims were not subject to reexamination. Patent owner responded on November 23, 2009.

9. On October 30, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '952 reissued patent. The reexamination proceeding was assigned Control No. 90/010,726 (hereinafter, the '10726 proceeding).

10. The Reexamination Order was granted in the '10726 proceeding on December 30, 2009 finding a substantial new question of patentability (SNQP) as to claims 1, 2, and 5-53.

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 '9400, '9456, and '10726 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 each proceeding, 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. 90/009,400, 90/009,456, and 90/010,726 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,474	06/01/2009	4847265	03023.000100.36	5871

5514 7590 06/23/2010

EXAMINER	
ART UNIT	PAPER NUMBER

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

DATE MAILED: 06/23/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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1635 MARKET STREET
PHILADELPHIA, PA 19103-2212

Date:

MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009474
PATENT NO. : 4847265
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
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Alexandria, VA 22313-1450
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Fitzpatrick, Cella, Harper & Scinto
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(Patent Owner)

MAILED

JUN 23 2010

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11th Floor, Seven Penn Center
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Philadelphia, PA 19103-2212

(Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re Alain Badorc *et al.*
Reexamination Proceeding
Control No.: 90/009,474
Filed: June 1, 2009
For: U.S. Patent No.: 4,847,265

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

This is a decision on the May 24, 2010 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, patent owner's fifth 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 fifth IDS filed May 24, 2010, 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. 06-1205 in accordance with petitioner's authorization in the May 24, 2010 petition.

BACKGROUND

1. On July 11, 1989, the Office issued U.S. Patent No. 4,847,265, to Badore *et al.* (the '265 patent).

2. On June 1, 2009, a third party requester filed a request for *ex parte* reexamination of the '265 patent. The request was assigned reexamination proceeding control number 90/009,474 (the '9474 proceeding).

3. On August 17, 2009, the Office issued an order granting reexamination for the '9474 reexamination proceeding.

4. Prosecution progressed to the point where, on March 26, 2010, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '9474 proceeding.

5. On April 2, 2010, the '9474 proceeding entered the print cycle and was designated 452 status.

6. On April 5, 2010, a third party requester deposited a request for a second *ex parte* reexamination of the '265 patent. The request was assigned reexamination proceeding control number 90/009,721 (the '9721 proceeding).

7. On May 24, 2010, patent owner filed a fifth IDS in the '9474 proceeding, submitting references cited in the '9721 proceeding, accompanied by a petition under 37 CFR 1.182 requesting consideration of an IDS submission after issuance of a NIRC.

8. The '9474 reexamination proceeding is in the final phase of the publication process for printing the reexamination certificate (*i.e.* it is in the publication cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 provides (in part):

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

MPEP 2256 provides (in part):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. **Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. (Emphasis added)

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

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

DECISION

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

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

In the present instance, the fact situation fails to satisfy the grounds for the entry of information after issuance of a NIRC, either before or after the proceeding has entered the publication cycle. 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. Furthermore, there is no factual accounting providing a sufficient explanation as to why the information submitted could not have been submitted earlier in the reexamination proceeding. Patent owner states the submitted documents were cited by a third party requester in the '9721 proceeding, another reexamination proceeding on the '265 patent. The request for the '9721 proceeding was filed on April 5, 2010. Patent owner states the submitted documents were cited

by the requester in the '9721 proceeding in papers dated April 26, 2010, and May 6, 2010. The record of the '9721 proceeding reflects that patent owner was served with these same papers on April 26, 2010, and May 6, 2010. Patent owner has made no attempt to provide a factual accounting to explain the three-four week gap between receiving the documents from the requester in the '9721 proceeding and filing the documents in the fifth IDS on May 24, 2010, in the '9474 proceeding. In light of this lack of a factual accounting as to why the information could not have been submitted earlier, in addition to a lack of an explanation as to the relevancy of the documents to the claimed invention, petitioner has not satisfied the requirements for consideration of information submitted after NIRC either before or after the proceeding entered the publication cycle. Therefore, the present petition does not satisfy the requirements for consideration of an IDS after a NIRC has been mailed.

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

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on March 26, 2010, and the proceeding has now entered the final stages of the publication process, *i.e.* the publication cycle, as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure explain why it could not have been submitted earlier, the failure to identify a question of patentability as to 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, as the Office may not permit entry and consideration of these references in the '9721 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 fifth IDS filed on May 24, 2010.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the fifth 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

6-22-2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,474	06/01/2009	4847265	03023.000100.36	5871

5514 7590 06/23/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2010

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

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JUN 23 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009474
PATENT NO. : 4847265
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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CENTRAL REEXAMINATION UNIT

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In re Alain Badorc *et al.*
Reexamination Proceeding
Control No.: 90/009,474
Filed: June 1, 2009
For: U.S. Patent No.: 4,847,265

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the April 30, 2010 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, patent owner's third 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 third IDS filed April 30, 2010, 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. 06-1205 in accordance with petitioner's authorization in the April 30, 2010 petition.

BACKGROUND

1. On July 11, 1989, the Office issued U.S. Patent No. 4,847,265, to Badore *et al.* (the '265 patent).

2. On June 1, 2009, a third party requester filed a request for *ex parte* reexamination of the '265 patent. The request was assigned reexamination proceeding control number 90/009,474 (the '9474 proceeding).

3. On August 17, 2009, the Office issued an order granting reexamination for the '9474 reexamination proceeding.

4. Prosecution progressed to the point where, on March 26, 2010, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '9474 proceeding.

5. On April 1, 2010, patent owner filed a third IDS in the '9474 proceeding, unaccompanied by a petition under 37 CFR 1.182, requesting consideration of an IDS submission after issuance of a NIRC.

6. On April 2, 2010, the '9474 proceeding entered the print cycle and was designated 452 status.

7. On April 23, 2010, the Office issued a communication informing patent owner that the April 1, 2010 third IDS submission was an untimely, improper post-NIRC submission which was being marked "closed" and "non-public" in the '9474 proceeding's IFW, since the submission was not accompanied by a petition under 37 CFR 1.182.

8. On April 30, 2010, patent owner filed the instant petition, accompanied by a second filing of the third IDS, which patent owner requests the Office to consider.

9. The '9474 reexamination proceeding is in the final phase of the publication process for printing the reexamination certificate (*i.e.* it is in the publication cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 provides (in part):

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

MPEP 2256 provides (in part):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. **Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. (Emphasis added)

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could

not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

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

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

In the present instance, the fact situation fails to satisfy the grounds for the entry of information after issuance of a NIRC, either before or after the proceeding has entered the publication cycle. 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. Furthermore, there is no factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier in the reexamination proceeding. Patent owner does indicate, in footnote one, that with regard to one of the sixty-four documents

listed on the PTOL-SB08 of the third IDS submission, patent owner awareness of the reference occurred sometime between March 12, 2010 and the filing of the third IDS.[1] Outside of this one footnote commentary for only one of sixty-four references, patent owner has made no attempt to provide a factual accounting as to why the information submitted in the third IDS was not previously submitted. The petition was not submitted until almost one month after the proceeding was designated 452 status, *i.e.* entered the publication cycle. In light of the lack of a factual accounting as to why the information could not have been submitted earlier nor an explanation as to the relevancy of the teachings to the claimed invention, petitioner has not satisfied the requirements for consideration of information submitted after NIRC either before or after the proceeding entered the publication cycle. Therefore, the present petition does not satisfy the requirements for consideration of an IDS after a NIRC has been mailed.

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

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on March 26, 2010, and the proceeding has now entered the final stages of the publication process, *i.e.* the publication cycle, as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure explain why it could not have been submitted earlier, the failure to identify a question of patentability as to the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will <u>not</u> 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.

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

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 <u>dismissed</u>.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the third IDS filed on April 30, 2010.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the third 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

6-22-2010

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JAN 21 2010

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re: Ahn *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,481
Deposited: 08 June 2009
For: US Patent No. 5,905,274

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

This is a decision on the 15 January 2010, "Petition for Extension of Time Under 37 CFR § 1.550(c)," requesting that the time for responding to the non-final Office action dated 20 October 2009, be further extended by three (3) weeks. The petition was filed with the required certificate of service and petition fee. The petition was timely filed.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time be further extended in which to file a response to non-final Office action dated 20 October 2009 which set a two (2) month period for response thereto. A first petition for extension of time was granted extending the response period by one month in the decision dated 18 December 2009. The subsequent petition was timely filed with the required certificate of service and petition fee pursuant to 37 CFR §§ 1.550(c) and 1.17(g). Second requests for extension of time will only be granted in exceptional circumstances.

The petition for extension of time dated 15 January 2010 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. (emphasis added)

MPEP § 2265 Extension of Time (in-part)

> ...
> *Ex parte* prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement >(by statute (35 U.S.C. § 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR § 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.
> ...

ANALYSIS AND FINDINGS

The patent owner's representative petitions to extend the period for response by adding thirty (30) days to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The patent owner timely submitted a first petition for extension which was granted on 18 December 2009. This first extension of time granted one additional month for which the patent owner to respond to the outstanding Office action. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. The factual accounting presented by the petitioner does not meet the level of extraordinary circumstances.

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

CONCLUSION

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

2. The time to respond continues to run.

3. Response is due on **20 January 2010.**

4. Response and/or submissions to the Office should be addressed as follows:

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

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

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

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

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

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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

Birch Stewart Kolasch & Birch (For Patent Owner)
P.O. Box 747
Falls Church, VA 22040-0747

Babak Redjaian (For *Ex Parte & Inter Partes* Requester)
IRELL & MANELLA LLP
840 Newport Center Drive
Suite 400
Newport Beach, CA 92660

MAILED

NOV 04 2009

CENTRAL REEXAMINATION UNIT

McKenna Long & Aldridge LLP (Courtesy Copy)
1900 K Street, N.W.
Washington, D.C. 20006

Ex parte Reexamination Proceeding :
Control No. 90/009,482 :
Filed: June 8, 2009 :
For: U.S. Patent No. 6,815,321 : **DECISION, *SUA SPONTE,***
: **TO MERGE**
: **REEXAMINATION**
Inter Partes Reexamination Proceeding : **PROCEEDINGS**
Control No. 95/000,483 :
Filed: June 9, 2009 :
For: U.S. Patent No. 6,815,321 :

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,815,321 (the '321 patent) issued to Ahn *et al.* on November 9, 2004.

2. A request for *ex parte* reexamination of claims 7-10, 12, 14, 16-20 and 22 of the '321 patent was filed on June 8, 2009 by Chi Mei Optoelectronics, and the request was assigned control number 90/009,482 (the '9482 *ex parte* proceeding).

3. A request for *inter partes* reexamination of claims 7-10, 12, 14, 16-20 and 22 of the '321 patent was filed on June 9, 2009, in which Chi Mei Optoelectronics Corporation was identified as the real party in interest, and the request was assigned control number 95/000,483 (the '483 *inter partes* proceeding).

4. On August 7, 2009, *ex parte* reexamination was ordered for claims 7-10, 12, 14, 16-20 and 22 of the '321 patent based on the examiner's determination that the June 8, 2009 request raised a substantial new question of patentability affecting these claims.

5. Also on August 7, 2009, *inter partes* reexamination was ordered for claims 7-10, 12, 14, 16-20 and 22 of the '321 patent based on the examiner's determination that the June 9, 2009 request raised a substantial new question of patentability affecting these claims.

6. On September 4, 2009, patent owner filed a "Reexamination – Patent Owner Power of Attorney or Revocation of Power of Attorney With a New Power of Attorney and Change of Correspondence Address" in both the '9482 *ex parte* proceeding and the '483 *inter partes* proceeding.

7. On September 18, 2009, the Office mailed a "Notice of Acceptance of Power of Attorney" in the '483 *inter partes* 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 the facts, both the '9482 and the '483 reexamination proceedings are currently pending. An order granting reexamination of claims 7-10, 12, 14, 16-20 and 22 of the '321 patent has been mailed in each of the reexamination proceedings, and a decision under 37 CFR 1.989 is timely.

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, (1) to provide a comprehensive examination of the patent based on the issues raised in both proceedings, and (3) to expedite prosecution of both proceedings. In the present instance, merger of the '9482 and the '483 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989, the 90/009,482 and 95/000,483 proceedings are hereby 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

The claims are identical in both proceedings. The 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, however, the '9482 *ex parte* reexamination proceeding was requested by the same third party that requested the *inter partes* reexamination, and that third party (Chi Mei Optoelectronics Corporation) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for both proceedings 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 proceedings, for entry into each file.

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

By EFS-Web: Registered users may submit the response via the electronic filing system EFS-Web.

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

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter*

partes reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '9482 proceeding and (3) the '483 proceeding. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747. Accordingly, all future correspondence will be directed to Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same address should be made of record in the reexamination proceedings).

The "Notice of Acceptance of Power of Attorney" mailed on September 18, 2009, in the '483 proceeding was in error to the extent it indicated that correspondence would be mailed to McKenna Long & Aldridge LLP, 1900 K Street, N.W., Washington, D.C. This is because the patent owner did not change the correspondence address of the patent file (U.S. Patent No. 6,815,321, Application No. 10/377,732) to the correspondence address provided in the paper filed September 4, 2009. Patent owner may wish to consider filing form PTO/SB123A, **filed in duplicate** (with identifying data for both proceedings as discussed above in section III.B.), together with form PTO/SB/123 in the patent file.

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,483 and *ex parte* Reexamination Control No. 90/009,482 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with **ONE (1) MONTH** from the mailing of this decision to file papers to address the correspondence address considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address in both proceedings, or

   (B) The receipt of such papers.

4. Any questions concerning this communication should be directed to Eugenia A. Jones, Senior Legal Advisor, at 571-272-7727.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

11-3-09

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.
90/009,483	06/08/2009	7176489	160151-0006	9949

30827 7590 11/03/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2009

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
BABAK REDJAIAN, IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

Date: MAILED

NOV 03 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009483
PATENT NO. : 7176489
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.
95/000,482	06/09/2009	7,176,489	160151-0008	6380

30827 7590 11/03/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2009

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

DO NOT USE IN PALM PRINTER

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BABAK REDJAIAN
840 NEWPORT CENTER DR.
SUITE 400
NEWPORT BEACH, CA 92660

Date: MAILED

NOV 03 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000482
PATENT NO. : 7176489
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

Babak Redjaian
IRELL & MANELLA LLP
840 Newport Center Drive
Suite 400
Newport Beach, CA 92660

(For *Ex Parte & Inter Partes* Requester)

McKenna Long & Aldridge LLP
1900 K Street, N.W.
Washington, D.C. 20006

(Courtesy Copy)

Ex parte Reexamination Proceeding
Control No. 90/009,483
Filed: June 8, 2009
For: U.S. Patent No. 7,176,489

Inter Partes Reexamination Proceeding
Control No. 95/000,482
Filed: June 9, 2009
For: U.S. Patent No. 7,176,489

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,176,489 (the '489 patent) issued to Ahn *et al.* on February 13, 2007.

2. A request for *ex parte* reexamination of claims 1-3 of the '489 patent was filed on June 8, 2009 by Chi Mei Optoelectronics, and the request was assigned control number 90/009,483 (the '9483 *ex parte* proceeding).

3. A request for *inter partes* reexamination of claims 1-3 of the '489 patent was filed on June 9, 2009, in which Chi Mei Optoelectronics Corporation was identified as the real party in interest, and the request was assigned control number 95/000,482 (the '482 *inter partes* proceeding).

4. On August 7, 2009, *ex parte* reexamination was ordered for claims 1-3 of the '489 patent based on the examiner's determination that the June 8, 2009 request raised a substantial new question of patentability affecting these claims.

5. Also on August 7, 2009, *inter partes* reexamination was ordered for claims 1-3 of the '489 patent based on the examiner's determination that the June 9, 2009 request raised a substantial new question of patentability affecting these claims.

6. On September 4, 2009, patent owner filed a "Reexamination – Patent Owner Power of Attorney or Revocation of Power of Attorney With a New Power of Attorney and Change of Correspondence Address" in both the '9483 *ex parte* proceeding and the '482 *inter partes* proceeding.

7. On September 18, 2009, the Office mailed a "Notice of Acceptance of Power of Attorney" in the '9483 *ex parte* 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 the facts, both the '9483 and the '482 reexamination proceedings are currently pending. An order granting reexamination of claims 1-3 of the '489 patent has been mailed in each of the reexamination proceedings, and a decision under 37 CFR 1.989 is timely.

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, (1) to provide a comprehensive examination of the patent based on the issues raised in both proceedings, and (3) to expedite prosecution of both proceedings. In the present instance, merger of the '9483 and the '482 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989, the 90/009,483 and 95/000,482 proceedings are hereby 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

The claims are identical in both proceedings. The 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, however, the '9483 *ex parte* reexamination proceeding was requested by the same third party that requested the *inter partes* reexamination, and that third party (Chi Mei Optoelectronics Corporation) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for both proceedings 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 proceedings, for entry into each file.

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

By EFS-Web: Registered users may submit the response via the electronic filing system EFS-Web.

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

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter*

partes reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '9483 proceeding and (3) the '482 proceeding. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747. Accordingly, all future correspondence will be directed to Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same address should be made of record in the reexamination proceedings).

The "Notice of Acceptance of Power of Attorney" mailed on September 18, 2009, in the '9483 proceeding was in error to the extent it indicated that correspondence would be mailed to McKenna Long & Aldridge LLP, 1900 K Street, N.W., Washington, D.C. This is because the patent owner did not change the correspondence address of the patent file (U.S. Patent No. 7,176,489, Application No. 10/872,527) to the correspondence address provided in the paper filed September 4, 2009. Patent owner may wish to consider filing form PTO/SB123A, **filed in duplicate** (with identifying data for both proceedings as discussed above in section III.B.), together with form PTO/SB/123 in the patent file.

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,482 and *ex parte* Reexamination Control No. 90/009,483 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with **ONE (1) MONTH** from the mailing of this decision to file papers to address the correspondence address considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address in both proceedings, or

   (B) The receipt of such papers.

4. Any questions concerning this communication should be directed to Eugenia A. Jones, Senior Legal Advisor, at 571-272-7727.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

11-3-09

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.
90/009,520	08/28/2009	6875021	ADC021	9714

20210 7590 04/14/2010

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD, NH 03301

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2010

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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,237	09/22/2009	6875021	NINT-001/00US 144575-2016	9171

20210 7590 04/14/2010

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD, NH 03301

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2010

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Michael Bujold
Davis & Bujold, PLLC
112 Pleasant St.
Concord, NH 03301

(For Patent Owner/*Ex Parte* Requester)

MAILED

APR 14 2010

CENTRAL REEXAMINATION UNIT

Matthew Brigham
Cooley Godward Kronish LLP
Attn: Patent Group
Suite 1100
777 – 6th Street, NW
Washington, D.C. 20001

(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,520
Filed: August 28, 2009
For: U.S. Patent No. 6,875,021

Inter Partes Reexamination Proceeding
Control No. 95/001,237
Filed: Sept. 22, 2009
For: U.S. Patent No. 6,875,021

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,875,021 (the '021 patent) issued to Okamoto on April 5, 2005, with 11 claims.

2. A request for *ex parte* reexamination of claims 1, 5, 8, and 11 of the '021 patent was deposited on July 10, 2009, by patent owner, and received a filing date on August 28, 2009. The request was assigned control number 90/009,520 (the '9520 *ex parte* proceeding).

3. On Sept. 29, 2009, *ex parte* reexamination was ordered for claims 1, 5, 8, and 11 of the '021 patent based on the examiner's determination that the Aug. 28, 2009 request raised a substantial new question of patentability affecting these claims.

4. A request for *inter partes* reexamination of claims 1-11 of the '021 patent was filed on Sept. 22, 2009, by a third party requester representing Nintendo of America, Inc., Sony Computer Entertainment America Inc., and Microsoft Corporation as the real parties in interest. The request was assigned control number 95/001,237 (the '1237 *inter partes* proceeding).

5. On Dec. 18, 2009, *inter partes* reexamination was ordered for claims 1-11 of the '021 patent based on the examiner's determination that the Sept. 22, 2009 request raised a substantial new question of patentability affecting these claims.

6. A concurrent litigation styled *ADC Technology Inc. v. Microsoft Corp. et al.*, U.S. District Court of Washington Western, 2:08cv1579 filed Oct. 27, 2008 involving the '021 patent is presently open and stayed pending reexamination.

7. There has been no further Office action in either proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9520 *ex parte* proceeding expired after Nov. 29, 2009. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '1237 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights

[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.

of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

In accordance with 37 CFR 1.989(a), the 90/009,520 and 95/001,237 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. CONDUCT OF MERGED PROCEEDING

A. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Presently, the claims and the specification are the same in each proceeding.

B. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

It is noted that reexamination was ordered for claims 1, 5, 8, and 11 of the '021 patent in the '9520 proceeding and for claims 1-11 of the '021 patent in the '1237 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-11 of the '021 patent.

C. 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.

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, 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.

D. 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.

E. 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.

F. 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.

III. . CORRESPONDENCE ADDRESSES

A. Patent Owner's Representative

The correspondence address for the patent to be reexamined is the address of the patent owner in the patent file. See MPEP 2222 and 37 CFR 1.33(c). The correspondence address of the '021 patent is not the same as the correspondence address listed in the *ex parte* request. The desired correspondence address must be corrected in the patent file to change the correspondence address to that listed in the request. Additionally, a power of attorney and a statement establishing the right of the assignee to take action under 37 CFR 3.73(b) must be filed in accordance with 37 CFR 1.510(f) in the reexamination proceeding.

B. Third Party Requesters' Representatives

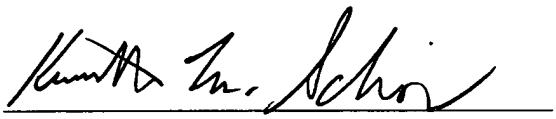
The *inter partes* request was filed by three third party requesters and lists three different customer numbers for the correspondence address. Multiple correspondence addresses are not permitted. See 37 CFR 1.33(a). Therefore, correspondence will only be sent to the first listed requester with Customer Number 58249.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/009,520 and *inter partes* Reexamination Control No. 95/001,237 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.

3. Any questions concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at 571-272-7729.



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

April 12, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,523	08/17/2009	5775995	ADC995	6488

20210 7590 03/12/2010

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD, NH 03301

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD NH 03301

MAILED

MAR 12 2010

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204

In re Okamoto Reexamination Proceeding Control No. 90/009,523 For: U.S. Patent No. 5,775,995	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Okamoto Reexamination Proceeding Control No. 90/010,663 For: U.S. Patent No. 5,775,995	: : : :

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. 5,775,995 (hereinafter, the '995 patent), issued to Okamoto, on July 7, 1998.

2. On August 17, 2009, a corrected request for *ex parte* reexamination of the '995 patent was filed by Patent Owner. The reexamination proceeding was assigned Control Nos. 90/009,523 (hereinafter, the '9523 proceeding).

3. On October 1, 2009, the reexamination order granting the request in the '9523 proceeding was mailed indicating that claims 1 and 2 would be reexamined.

4. On September 2, 2009, a third party deposited a request for *ex parte* reexamination of the '995 patent. The reexamination proceeding was assigned Control No. 90/010,663 (hereinafter, the '10663 proceeding).

5. On November 27, 2009, the reexamination order granting the request in the '10663 proceeding was mailed indicating that claims 1 and 2 would be reexamined.

6. The time period for a patent owner statement has expired in both proceedings.

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 '9523 and '10663 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. 90/009,523 and 90/010,663 are MERGED.

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

Eric Keasel
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,524	08/17/2009	6193520	ADC520	6819

56031 7590 03/12/2010

EXAMINER	

ART UNIT	PAPER NUMBER

John Whitaker
Whitaker Law Group
755 WINSLOW WAY EAST
Suite 100
BAINBRIDGE ISLAND, WA 98110

DATE MAILED: 03/12/2010

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(For Patent Owner)

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD NH 03301

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MAR 12 2010

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204

In re Okamoto Reexamination Proceeding Control No. 90/009,524 For: U.S. Patent No. 6,139,520	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Okamoto Reexamination Proceeding Control No. 90/010,666 For: U.S. Patent No. 6,139,520	: : : :

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,139,520 (hereinafter, the '520 patent), issued to Okamoto, on July 7, 1998.

2. On August 17, 2009, a corrected request for *ex parte* reexamination of the '520 patent was filed by Patent Owner. The reexamination proceeding was assigned Control No. 90/009,524 (hereinafter, the '9524 proceeding).

3. On November 14, 2009, the reexamination order granting the request in the '9524 proceeding was mailed indicating that claims 1, 2, 4, 5, 7-9, 11, 12, 14, 15, 19, and 21 would be reexamined.

4. On September 4, 2009, a third party deposited a request for *ex parte* reexamination of the '520 patent. The reexamination proceeding was assigned Control No. 90/010,666 (hereinafter, the '10666 proceeding).

5. On December 3, 2009, the reexamination order granting the request in the '10666 proceeding was mailed indicating that claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, 19, and 21 would be reexamined.

6. The time period for a patent owner statement has expired in both proceedings.

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 '9524 and '10666 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. 90/009,524 and 90/010,666 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing a first Office 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
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4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

Eric Keasel
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,538	09/25/2009	7302164	081174-0000003A	6237

20995 7590 11/04/2009

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,538	09/25/2009	7302164	081174-0000003A	6237

20995 7590 11/04/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2009

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725 S. Figueroa St.
Suite 2800
Los Angeles, CA 90017

MAILED

NOV 04 2009

CENTRAL REEXAMINATION UNIT

In re Wright *et al.* :
Ex parte Reexamination Proceeding : **DECISION**
Control No.: 90/009,538 : **GRANTING**
Filed: September 25, 2009 : **PETITION**
For: U.S. Patent No. 7,302,164 :

This is a decision on the third party requester's "PETITION UNDER 37 CFR § 1.183 TO SUSPEND THE RULES" filed on August 7, 2009, requesting waiver of the rule to permit submission of compact discs containing computer programs without an accessible computer program listing.

The 90/009,538 proceeding, and the petition, are before the Office of Patent Legal Administration for consideration.

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

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 7,302,164 ("the '164 patent") issued on Nov. 27, 2007 with 27 claims.

2. On August 7, 2009, a third party requester deposited a request for *ex parte* reexamination, which proceeding was assigned Control No. 90/009,538 ("the '9538 proceeding") requesting reexamination of claims 1-27 of the '164 patent.

3. Concurrently with the request for reexamination, the third party requester in the '9538 proceeding filed a petition under 37 C.F.R. 1.183 to suspend the rules to permit entry of a computer program stored on a compact disc, which is the subject of this decision.

4. A Notice of Incomplete Reexamination Request was mailed to the third party requester on August 27, 2009.

5. A response was filed by the third party requester on Sept. 25, 2009, that satisfied the deficiencies of the original request. A filing date of Sept. 25, 2009, was granted in a Notice mailed Oct. 22, 2009.

6. A concurrent proceeding is being conducted in the U.S. District Court, California Central, captioned *Datacard Systems, Inc. v. Codonics, Inc.*, Civil Action No. 8:08cv63.

7. The third party previously filed an *ex parte* reexamination request on Nov. 26, 2008, for claims 9-22 of the '164 patent, which was assigned proceeding no. 90/009,347. The reexamination was ordered on January 30, 2009, and is pending.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

I. Pertinent Regulations

A. Relief Requested

37 CFR 1.183 provides:

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

B. Electronic Documents

A CD is an electronic document. Submission of electronic documents is governed by 37 CFR 1.52(e).

37 CFR 1.52(e) provides in pertinent part:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:
>
> (i) A computer program listing (see § 1.96);
>
> (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
>
> (iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).
>
> (2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only"

medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret (e.g., tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

(i) The name of each inventor (if known);

(ii) Title of the invention;

(iii) The docket number, or application number if known, used by the person filing the application to identify the application; and

(iv) A creation date of the compact disc.

(v) If multiple compact discs are submitted, the label shall indicate their order (e.g. "1 of X").

(vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

II. Findings and Analysis

Third party requestor requests that the requirements of 37 CFR 1.52(e) be suspended or waived to allow submission of a compact disc (CD) containing a computer program without an accessible computer program listing. The CD is submitted as one of the prior art references (the "Vepro Demonstration") which the third party requester contends raises a substantial new question of patentability with respect to the '164 patent.

The petitioner submits that a copy of the program listing for the CD is not available as the CD is an exhibit to a deposition and includes only the executable program code and help files. Petitioner has provided screen shots and help file topics from the program stored on the CD, but asserts that these cannot convey the interactiveness and full functionality of the program. Petitioner argues that to permit actual running of the demonstration CD, it is necessary to waive the requirements of 37 CFR 1.52(e) relating to supplying a program listing. Since petitioner has provided supporting documentation of the contents of the program stored on the CD, but is unable to provide evidence of the functionality without running the actual program, an extraordinary situation has been demonstrated. The remaining requirements of 37 CFR 1.52(e)(3)(ii) have been complied with as to the details of submitting a CD. In view of the extraordinary situation created by the exhibit of the Vepro Demonstration, which may only be evaluated by viewing the program on a CD running on a computer, the requirement that a program listing be submitted along with the CD is waived. The CD exhibit will be entered into the record so that the Examiner may evaluate the full merits of the request.

It is noted that granting of the petition request to waive certain requirements of 37 CFR 1.52(e) is not a decision on the propriety of the CD as to whether it qualifies as a printed publication such that it is available for use in the proceeding or whether it is material to the proceedings. This decision merely permits the Examiner to consider the CD submission, if deemed appropriate. Therefore, the petition requesting such waiver is granted.

Upon inspection of the file, it is additionally noted that five (5) other CDs apparently relating to deposition testimony and exhibits have been submitted. As permission to submit these CDs has not been requested by a proper petition, the five other CDs are being returned to the third party requester with this decision as being improper filings.

CONCLUSION

1. For the reasons set forth above, the instant petition is granted.

2. The CD and transmittal letter will be entered into the record of the '9538 proceeding.

3. Jurisdiction of the '9538 proceeding is being returned to the Central Reexamination Unit for further handling consistent with this decision.

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

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

11/3/09

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For Patent Owner

MAILED

JAN 29 2010

Thomas H. Martin
Martin & Ferraro LLP
1557 Lake O'Pines St., NE
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For 3rd Party Requester
90/009,542

CENTRAL REEXAMINATION UNIT

Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W., Suite 800
Washington, DC 20005

For 3rd Party Requester
90/010,655

Ex Parte Reexamination Proceeding
Control No. 90/009,542
Filed: July 24, 2009
For: U.S. Patent No. 6,936,071

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Ex Parte Reexamination Proceeding
Control No. 90/010,655
Filed: August 24, 2009
For: U.S. Patent No. 6,936,071

Reexamination proceedings control Nos. 90/009,542 and 90/010,655 are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided 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. 90/009,542 was ordered in a decision mailed September 4, 2009, granting reexamination of claims 1-16 and 19-30 of US Patent No. 6,936,071. No Office action has been rendered since the mailing of the decision ordering reexamination, nor have any papers been filed by patent owner, the requester.

Reexamination in application Control No. 90/010,655 was ordered in a decision mailed September 15, 2009, indicating that claims 1-16 and 19-30 of US patent No. 6,936,071 would be reexamined. No Office action has been rendered since the mailing of the decision ordering reexamination, nor have any papers been filed by patent owner, the requester.

As evidenced by the above facts, reexamination Control No. 90/009,542 and reexamination control No. 90/010,655 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely and the 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, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

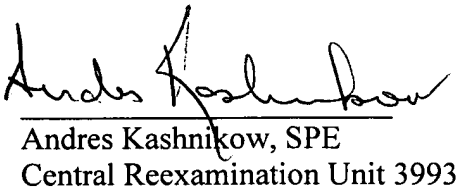
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently claims 1-16 and 19-30 are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexaminations. All papers issued by the Office will contain the identifying data each of the proceedings, and each paper 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 duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on each of the third party requesters and 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 fee, brief fee, etc.) only a single feed 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 art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination control Nos. 90/009,542 and 90/010,655 are hereby merged into a single proceeding. Upon the 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, Supervisory Primary Examiner, at telephone No. (571) 272-4361.



Andres Kashnikow, SPE
Central Reexamination Unit 3993

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CENTRAL REEXAMINATION UNIT

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3d Party Requester
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Ex Parte Reexamination Proceeding
Control No. 90/009,542
Filed: July 24, 2009
For: U.S. Patent No. 6,936,071

DECISION ON PETITION
UNDER 37 CFR 1.59

Ex Parte Reexamination Proceeding
Control No. 90/010,655
Filed: August 24, 2009
For: U.S. Patent No. 6,936,071

This is a decision on the petition under 37 CFR 1.59(b), filed June 4, 2010, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The petition is **DISMISSED**.

Petitioner requests that "the Protective Order Material submitted in a sealed envelop herewith be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability". The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

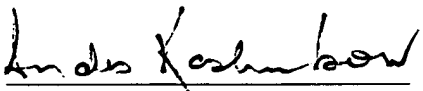
As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the 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 has been 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; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

The information in question has been determined by the examiner in charge of the proceedings to not be material to the examination of the instant merged reexamination proceeding. However, the petition is deficient because it lacks items (A), (C), and (D) listed above. As to item (B), the petition does not indicate that the material in question has not been otherwise made public.

If patent owner still wishes to have the material in question expunged, a renewed petition must be promptly filed in view of the mailing of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate on July 14, 2010, for once the reexamination proceeding enters the reexamination certificate printing process, it may not be possible to address the renewed petition. If a renewed petition is not filed or filed in time to be addressed, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

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.



Andres Kashnikow, SPE
Central Reexamination Unit 3993

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,543	07/27/2009	6259789	MSFT-6586	2476

23869 7590 02/25/2010

HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2010

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

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WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
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2929 ARCH STREET
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Date:

MAILED

FEB 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009543
PATENT NO. : 6259789
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

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SYOSSET NY 11791

(For Patent Owner)

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(For Requester)

In re Paone
Reexamination Proceeding
Control No. 90/009,543
For: U.S. Patent No. 6,259,789

: DECISION DISMISSING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the November 4, 2009 paper entitled "PETITION FROM DENIAL OF REQUEST FOR EX PARTE PURSUANT TO 37 CFR § 1.515 AND MPEP §2248". No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

The petition is **DISMISSED AS MOOT** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,259,789 (hereinafter, the '789 patent) issued on July 10, 2001 to Paone.

2. On July 27 30, 2009, a request for *ex parte* reexamination was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/009,543 (hereinafter, the '9543 proceeding). The request only requested reexamination of claims 2, 23-26, and 32-34.

3. An order granting the request for *ex parte* reexamination was mailed on October 23, 2009. The order determined that the request raised a Substantial New Question (SNQ) of Patentability for claims 33 and 34.

6. On November 4, 2009, the present petition was filed.

7. On December 8, 2009, a reexamination certificate issued for the '789 patent in which claims 23 and 32 were cancelled.

8. On February 23, 2010, an office action was mailed. Said action examined claims 2 and 24-26 as well as claims 33 and 34.

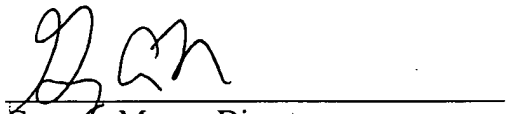
DECISION

In the office action of February 23, 2010, the office exercised their discretion to examine claims 2 and 24-26 as well as claims 33 and 34. Due to the issuance of the first reexamination certificate of the '789 patent that cancelled claims 23 and 32, all claims that were requested in the '9543 proceeding that are still live claims in the '789 patent are examined in the '9543 proceeding.

MPEP 2248 states, in part:
"37 CFR 1.515(c) applies only where reexamination is denied; it does not apply to a grant of reexamination where either the patent owner or the requester is not satisfied with one or more findings made in a decision granting reexamination...No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.550."

Since all claims that were requested in the '9543 proceeding (that are still live claims in the '789 patent) are subject to reexamination in the '9543 proceeding, requester does not have a right to review those claims even if they are not satisfied with one or more findings made in the decision granting reexamination.

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



Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,546	07/29/2009	5591008	G1280US00	4069

24628 7590 12/18/2009

EXAMINER

Husch Blackwell Sanders, LLP
Husch Blackwell Sanders LLP Welsh & Katz
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ART UNIT	PAPER NUMBER

DATE MAILED: 12/18/2009

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Date:

MAILED

DEC 18 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009546
PATENT NO. : 5591008
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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DEC 18 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Wrobel et al.
Control No. 90/009,546
Deposited: July 29, 2009
For: US Patent No. 5,591,008

DECISION DISMISSING
PETITION
TO VACATE PROCEEDING
PURSUANT TO
37 CFR § 1.181(a)(3)

This is a decision on the September 29, 2009 petition filed by the patent owner entitled, "Petition to the Director under 37 C.F.R. § 1.181" [hereinafter "the petition"]. The petition states that the order granting reexamination in the proceeding is *ultra vires* and should be vacated. The patent owner has petitioned under 37 CFR § 1.181(a)(3). The third party requester filed a paper on October 13, 2009 in opposition to the petition. This decision addresses both patent owner's petition and third party requester's opposition.

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. U.S. Patent No. 5,591,008 [hereinafter "the '008 patent"] was granted to *Wrobel et al.* on January 7, 1997.

2. On July 29, 2009, a request for *ex parte* reexamination for claims 1-20 of the '008 patent was submitted by a third party requester and, assigned control No. 90/009,546 [hereinafter, the '546 proceeding].

3. On August 29, 2009, an Order granting *ex parte* reexamination was mailed in the '546 proceeding.

4. On September 29, 2009, the petition under 37 CFR 1.181 requesting that the order for reexamination be vacated as *ultra vires* was filed.

5. On October 13, 2009, an opposition to the petition by the third party requester was filed.

DISCUSSION

The Patent Owner requests that the reexamination proceeding be vacated. The petitioner considers the action taken by the Office by granting the Order to reexamine the patent as an *ultra vires* action by the Office.

The request to vacate the reexamination proceeding is dismissed.

STATEMENT OF RELEVANT AUTHORITY

35 U.S.C. 303 Determination of issue by Director.

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

MPEP 2242 provides in relevant part:

II.A. Prior Favorable Decisions by the U.S. Patent and Trademark Office (Office) on the Same or Substantially Identical Prior Art in Relation to the Same Patent.

A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier

examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

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

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

MPEP § 2246 Decision Ordering Reexamination (in-part):

A petition under 37 CFR § 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR § 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

...

(E) the reexamination order is based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding).

DECISION

The patent owner brings before the Office a petition under 37 CFR § 1.181(a)(3) to vacate an ordered reexamination proceeding as not raising a proper substantial new question of patentability (SNQ). The procedure for such a petition is provided for in MPEP 2246. For this petition to be entertained, however, the patent owner must show that "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" under reexamination. See MPEP 2246.

Patent owner contends that the request for reexamination of the '008 patent does not raise a substantial new question (SNQ) of patentability. Patent owner presents two bases for this contention; first, that Riddiford was previously considered for the very same purpose and therefore does not raise a SNQ; and second, that the Rued and Dean references are merely cumulative to old art and fail to raise a SNQ.

Requester opposes the petition on the grounds that the petition filed by the patent owner is procedurally improper, and even if the petition is procedurally proper, the patent owner has not provided the necessary showing to support the petition. Requester presents four bases for this opposition: first, that Riddiford provides teaching absent from the initial examination and pertinent to the patentability of the claimed invention; second, that Riddiford is not being used for the same purposes and therefore, the reexamination order is not "based wholly on the same question of patentability"; third, that Rued and Dean present Riddiford in a new light and thus raise a SNQ; and fourth, that the petition improperly raises patentability arguments to support patent owner's assertion that neither Rued nor Dean raise a SNQ.

The determination of whether a SNQ exists is a fact-specific inquiry, and is not governed by the mere fact that a reference was previously considered in an earlier examination of the patent. MPEP 2242(II)(A). Such a determination requires an evaluation of "the context in which the reference was previously considered and the scope of the prior consideration and determin[ation] of whether the reference is now being considered for a substantially different purpose." *In re Swanson*, 540 F.3d 1368, 1380 (Fed. Cir. 2008). A SNQ will not be raised solely by an "argument already decided by the Office," or where the issue merely questions the prior judgment of the examiner. *Id.* (*quoting* H.R. Rep. No 96-1307 *and citing* H.R. Rep. No. 107-120).

Analysis of the Prior Proceedings

Determination of the scope of previous examination consideration begins "with an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions." *In re Swanson*, 540 F.3d at 1381. In the Order in the instant proceeding, the references found by the examiner to provide, in whole or in part, the basis for an SNQ were U.S. Patent No. 2,573,875 to Riddiford (Riddiford), U.S. Patent No. 2,842,966 to Rued (Rued), and U.S. Patent No. 2,595,829 to Dean (Dean). Of these references found to form the basis of an SNQ, only Riddiford was of record in prior proceedings, i.e., only Riddiford is "old art." Riddiford was relied upon as a secondary reference for teaching "plural arcuate shaped pockets" in an obvious rejection, in the prior proceedings. See page 2 of the Office action dated August 21, 1995 in application 08/459,796. The Rued and Dean references were not considered by the Office in an earlier examination of the patent.

As discussed above, in the prior proceedings, the examiner rejected claim 1 based upon Japanese Patent Document No. 30,516 in view of Riddiford. See page 2 of the Office action dated August 21, 1995 in application 08/459,796. Riddiford was only applied for teaching the plural arcuate shaped pocket limitation. On February 20, 1996, the patent applicant responded to the August 21, 1995 Office action by cancelling claim 1 and added new claims 2-21. Claim 2 differs from cancelled claim 1 by including the limitation of "one or more arcuate shaped pockets formed in said support member and wherein the arcs of the arcuate shape are angularly disposed in a circular path about the axis of rotation of the hub." No further art rejections were applied, and the application passed in due course to issue.

Patent Owner's First Contention

Patent owner first contends that Riddiford, which was found to raise an SNQ in the Order, does not present a "new" technical teaching because it was fully considered during the prior examination and is being used for the same purposes. Petition at pages 3-6. The Order of August 29, 2009 states that Riddiford raises a SNQ because it teaches the limitation of "one or more arcuate shaped pockets formed in said support member and wherein the arcs of the arcuate shape are angularly disposed in a circular path about the axis of rotation of the hub." See page 3 of the Order of August 29, 2009. Patent owner contends that the examiner in the previous proceeding fully considered Riddiford as it applied to this claim limitation and determined that the claims were allowable over the teaching in Riddiford. Petition at pages 4-5. Patent owner urges that the court in *In re Swanson* stated that the central SNQ inquiry is whether the reference is being considered for a substantially different purpose in the reexamination request than in the prior examination. *In re Swanson*, 540 F.3d at 1380. Patent owner states that Riddiford is being used for the very same purpose, a teaching of "... the arcuate shape and displacement of 'pockets.'" Petition at page 5.

Subsequent to an amendment to 35 U.S.C. § 303 in 2002, the absence of an SNQ cannot be proved by the mere assertion that a prior allowance of a claim necessarily required consideration of all art of record in the prior proceeding, both alone and in all possible combinations. *See Swanson,* 540 F.3d at 1380, (*stating* "Congress, however, has now rejected this presumption of full consideration"). Patent owner's arguments to this effect, on pages 3-6 of the petition, are contrary to the current statutory language and Congressional intent. For this reason, patent owner has presented insufficient support for the contention that no "new" technical teaching was presented in the request.

The court in *Swanson* held that a reference previously considered for one statutory provision, obviousness, had not been considered for a second statutory provision, anticipation, in the absence of any explicit discussion by the examiner of anticipation by that reference in the file history. *Swanson* 540 F.3d at 1381. In the instant case, there was no discussion by the examiner of any consideration of the statutory provision of anticipation with respect to any reference, new or old. There are no facts in the record showing that the examiner in the earlier proceeding considered the Riddiford reference for its teachings on the question of anticipation, or obviousness in combination with the teachings of Rued and Dean.

In the prior prosecution of the patent under reexamination, the examiner did not explicitly consider any rationales for the patentability of claims containing the "one or more arcuate shaped pockets formed in said support member and wherein the arcs of the arcuate shape are angularly disposed in a circular path about the axis of rotation of the hub" limitation. Following the amendment by applicant to include that language in new independent claim 2 in the February 20, 1996 amendment, the examiner withdrew all art rejections. The application passed to allowance without any comment by the examiner upon the reasons for allowability of the claims which issued in the '008 patent. Under these facts, it is neither evident from the file record, nor evident from facts provided by patent owner in the petition, that the Riddiford reference was fully considered by the examiner in the context of a determination of anticipation as well as obviousness. Therefore, the examiner had discretion to grant the request for reexamination and by reasoned analysis determined that Riddiford presented a SNQ.

In conclusion, a detailed analysis of the prior proceedings thus finds that there has been presented no discussion of applying the art relating to the claims in the '008 patent. It may not be presumed that, since the claims were allowed, the examiner considered applying any specific ground for

anticipation or obviousness stemming from the references in front of him. *Swanson,* 540 F.3d at 1380. Therefore, patent owner's contention, that the teachings of anticipation presented in Riddiford found to raise an SNQ are not "new" teachings, is unsupported by the facts in this case.

Patent Owner's Second Contention

Patent owner next contends that Rued and Dean are merely cumulative to Riddiford and fail to raise a SNQ. Petition at pages 6-7. Patent owner states that the Order does not state that Rued and Dean have teachings of the limitation of "one or more arcuate shaped pockets formed in said support member and wherein the arcs of the arcuate shape are angularly disposed in a circular path about the axis of rotation of the hub." The Order does state the relevant teachings of Rued and Dean to the claim limitations and that there is a substantial likelihood that a reasonable examiner would find these teachings important in determining the patentability of the claims. The record is clear that Rued and Dean are newly applied to the claimed impeller device having "one or more arcuate shaped pockets formed in said support member and wherein the arcs of the arcuate shape are angularly disposed in a circular path about the axis of rotation of the hub," for which claim provision no prior art was earlier applied, or stated to have been considered as to that aspect of the claims. Thus, the SNQ found to be raised in the Order is not cumulative to the consideration of the old art in the earlier examination of the patent. Therefore, the examiner had discretion to grant the request for reexamination and by reasoned analysis determined that Rued and Dean presented a SNQ.

Findings

It is found that the Order was not based wholly on the same question of patentability raised by the prior art previously presented, and therefore the Order was not an *ultra vires* action on the part of the Office. For the reasons detailed above, patent owner has failed to show that the Order was based wholly on the same question of patentability raised by the prior art previously presented. Petitioner is referred to *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593. In *Heinl*, 143 F.Supp.2d at 601, the court stated:

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

The court went on to state:

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

After a review of the present record, and based upon the above discussion, it is found that petitioner patent owner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office's determination to order reexamination.

In view of the above, the petition to vacate the reexamination proceeding is dismissed.

CONCLUSION

1. The patent owner's petition vacate the reexamination under 37 CFR §§ 1.181(a)(3) proceeding is hereby **dismissed.**

2. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

3. Response should be addressed as follows:

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

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Andy Kashnikow, at (571) 272-4361, in the event that Andy Kashnikow to the undersigned at (571) 272-3838.

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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

TODD DEVEAU
DEVEAU COLTON & MARQUIS
1360 PEACHTREE STREET NE
SUITE 1400 MIDTOWN PLAZA TWO
ATLANTA, GA 30309

In re Application of	:	
ESLER C. WALKER, JR.	:	
Control No. 90/009,547 (U.S. 5,584,639)	:	DECISION ON PETITION
Filed: May 14, 2010	:	TO WITHDRAW
Attorney Docket No. 822314-1010	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 14, 2010.

The request is **APPROVED**.

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

The request was signed by Todd Deveau on behalf of all attorneys of record. Applicant is reminded that there is no attorney of record at this time. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Manuel Saldana at 571-272-7740.

Manuel Saldana

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

ESLER C. WALKER, JR.
705 CROSS PLAINS ROAD
CARROLTON, GA 30117

cc: SUSAN LORRAINE FIRESTONE (Third Party Requester)
O'MALLEY AND FIRESTONE
919 S. HARRISON STREET, SUITE 210
FORT WAYNE, IN 46802

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on May 14, 2010. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,563	08/19/2009	5241972	LS 003	1351

7590 06/16/2010

EXAMINER	
ART UNIT	PAPER NUMBER

JOHN WILEY HORTON
PENNINGTON, MOORE, WILKINSON, BELL & DUMBAR, P.A.
P.O. DRAWER 10095
TALLAHASSEE, FL 32302-2095

DATE MAILED: 06/16/2010

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
KALOW & SPRINGUT LLP
488 MADISON AVENUE
19TH FLOOR
NEW YORK, NY 10022

Date:

MAILED

JUN 16 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009563
PATENT NO. : 5241972
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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John Wiley Horton
Pennington, Moore, Wilkinson,
Bell & Dumbar, P.A.
P.O. Drawer 10095
Tallahassee, FL 32302-2095

(For patent owner)

MAILED

JUN 16 2010

CENTRAL REEXAMINATION UNIT

Kalow & Springut LLP
488 Madison Avenue
19th Floor
New York, NY 10022

(For third party requester)

In re Alfred O. Bonati
Ex Parte Reexamination Proceeding
Control No. 90/009,563
Filed: August 19, 2009
For: U.S. Patent No. 5,241,972

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

This is a decision on the April 26, 2010 patent owner petition under 37 CFR 1.550(e)(2) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination[1] ("the April 26, 2010 patent owner petition to revive"). The April 26, 2010 patent owner petition to revive is being treated as a petition under 37 CFR 1.137(b).

The April 26, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The April 26, 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 response under 37 CFR 1.550(b) to the February 2, 2010 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.

The present proceeding is a reexamination proceeding; thus, the April 26, 2010 petition does not require a terminal disclaimer.[2]

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the April 26, 2010 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 February 2, 2010 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 February 2, 2010 Office action set a two-month period for response. A proper response to the February 2, 2010 Office action was not filed until April 26, 2010, which was untimely. However, for the purpose of evaluating whether the April 26, 2010 patent owner petition to revive is a grantable petition, the submission of the April 26, 2010 Response To Office Action satisfies item (1).[3]

Accordingly, the April 26, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The April 26, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, for treatment of the April 26, 2010 Response To Office Action.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Beverly Flanagan, of CRU Art Unit 3993, at (571) 272-4766.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

---

[2] *See*: 37 CFR 1.137(d)(3).

[3] This decision is not directed to the persuasiveness and propriety of the arguments presented in the April 26, 2010 Response To Office Action as to each of the rejections set forth in the February 2, 2010 Office action; such is the examiner's province.

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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FEB 16 2010

CENTRAL REEXAMINATION UNIT

GERALD E. LESTER
22107 FIELDER
KATY, TX 77450

(For Patent Owner)

HOGAN & HARTSON LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

(For Third-Party Requester)

In re Hill, Jr. .
Reexamination Proceeding
Control No. 90/009,572
Request Deposited: September 30, 2009
For: U.S. Patent No.5,790,096

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

This is a decision on the February 12, 2010 "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R §1.550(c)" requesting that the time to submit a Patent Owner statement be extended one month.

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

The petition is **granted –in-part** and a two- week extension of time is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No 5,790,096 issued to Hill, Jr. on August 4, 1998.

2. On September 30, 2009 a third party requester requested ex parte reexamination of US Patent No 5,790,096 which is identified under control no. 90/009,572.

3. The Order was granted for reexamination on December 14, 2009.

4. Patent owner requests an addition month to respond to the Order.

DECISION

The Patent Owner requests an extension of time in which to prepare and file patent owner's statement. The request for extension is the **first** request for an extension of time during the proceeding. The present petition for extension of time was timely filed together with the fee in the amount of $200.

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 what steps Owner has taken to date in preparation of a response to the Office action. Further, the request outlines why, in spite of the actions taken thus far, the requested additional time is believed necessary. Reference is made to the petition pages 1-3 for details of these issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time, although one month appears to be excessive. It is felt that an extension of two weeks is sufficient for patent owner to prepare and submit any owner's statement to the record.

CONCLUSION

1. Petitioner's request is **granted-in-part**. A two-week extension is hereby granted. The time for filing a response to the outstanding Office action is extended two weeks and is due on or before February 28, 2010. Note due to the due date being a Sunday, responses received on or before Monday March 1, 2010 will be considered timely.

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, Jessica Harrison at (571) 272-4449 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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,572	09/30/2009	5,790,096	19688-0042RX3	6754

26171 7590 06/17/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2010

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOGAN & HARTSON L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

Date:
MAILED

JUN 17 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009572
PATENT NO. : 5790096
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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Karl W Renner
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

(For Patent Owner)

MAILED

JUN 17 2010

HOGAN LOVELLS US LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re: Jacques R Hill, Jr.
Ex Parte Reexamination Proceeding
Control No. 90/009,572
Deposited on: 30 September 2009
For: US Patent No. 5,790,096

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 08 June 2010, "Petition for Extension of Time Under 37 CFR 1.550" requesting the response period be extended by one (1) month for responding to the non-final Office action mailed 29 April 2010. The petition submitted 08 June 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 (1) month for responding to the non-final Office action mailed on 29 April 2010, which sets two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 08 June 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 period for response is extended by fourteen (14) days time. 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.

Ex parte prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement (by statute (35 U.S.C. 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.

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 that key personnel from the patent owner are unavailable from 08 June to 18 June 2010. The ten days in which the personnel are unavailable supports a request of fourteen days extension of time. 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 fourteen (14) days.

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action mailed on 29 April 2010 is hereby **granted-in-part.**

2. The period for response is extended by fourteen (14) days.

3. The response is extended to **13 July 2010.**

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft

scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, 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

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.
90/009,577	10/30/2009	5459522	25022.0012	9113

7590 02/23/2010

ROLAND W. NORRIS, ESQ
ZENITH ELECTRONICS CORPORATION
1000 MILWAUKEE AVENUE
GLENVIEW, IL 60025

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2010

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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,577	10/30/2009	5459522	25022.0012	9113

7590 02/23/2010

EXAMINER

HOGAN & HARTSON, LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2010

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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,577	10/30/2009	5459522	25022.0012	9113

7590 02/23/2010

EXAMINER

HOGAN & HARTSON, LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

ART UNIT	PAPER NUMBER

DATE MAILED:

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

ROLAND W. NORRIS, ESQ
ZENITH ELECTRONICS CORPORATION
1000 MILWAUKEE AVENUE
GLENVIEW IL 60025

(For Patent Owner)

MAILED

FEB 23 2010

CENTRAL REEXAMINATION UNIT

HOGAN & HARTSON L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

(For Third Party Requester)

In re: Pint
Ex Parte Reexamination Proceeding
Control No. 90/009,577
Deposited on: 11 June 2009
For: US Patent No. 5,459,522

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 12 February 2010, "Petition for Extension of Time Under 37 CFR § 1.550(c) and Suspension of Rules" requesting the response period be extended by one-month for the Order granting reexamination mailed 11 December 2009, be extended by one (1) month. The petition submitted 12 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 for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period for response be extended by one-month for the Order granting reexamination mailed 11 December 2009, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 12 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. While the two months date ended on 11 February 2010, because the Federal government was closed in the Washington DC metropolitan area on 11 February 2010, the submission on 12 February 2010 was timely.

The request is granted-in-part.

37 CFR § 1.550 (c) states:

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

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

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

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 the need for considering prior art from pending litigation. The petition notes that the patent owner waited for a determination of whether the request was granted before considering the references. The MPEP 2265 is clear in that the petition to meet the requirement of sufficient cause requires that the "reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period." The patent owner could not have anticipated the severe weather but would have known the time period were the Order to grant reexamination had a two-month period for patent owner's statement. It is unclear exactly how the various litigation are specific to the claims under reexamination, further what efforts were undertaken by the patent owner to meet the two month period for response and in spite of the actions taken that the requested time is needed. 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 Order granting reexamination mailed 11 December 2010 is hereby **granted-in-part.**

2. The period for response is extended by fourteen (14) days.

3. The response is extended to **25 February 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

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.
90/009,577	10/30/2009	5459522	19688-0042RX1	9113

26171 7590 06/11/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2010

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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,577	10/30/2009	5459522	19688-0042RX1	9113

26171 7590 06/11/2010

EXAMINER	

HOGAN & HARTSON, LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FISH & RICHARDSON P.C. : (For Patent Owner)
P.O. BOX 1022 :
MINNEAPOLIS MN 55440-1022 :

MAILED

JUN 11 2010

CENTRAL REEXAMINATION UNIT

HOGAN LOVELLS US LLP : (For Third Party Requester)
1999 AVENUE OF THE STARS :
SUITE 1400 :
LOS ANGELES, CA 90067 :

In re: Charles T. Pint :
Ex Parte Reexamination Proceeding :
Control No. 90/009,577 :
Deposited on: 30 October 2009 :
For: US Patent No. 5,459,522 :

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 08 June 2010, "Petition for Extension of Time Under 37 CFR 1.550" requesting the response period be extended by one (1) month for responding to the non-final Office action mailed 16 April 2010. The petition submitted 08 June 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 (1) month for responding to the non-final Office action mailed on 16 April 2010, which sets two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 08 June 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 period for response is extended by fourteen (14) days time. 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.
>
> *Ex parte* prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement (by statute (35 U.S.C. 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or TC Director, and the requests will be favorably

considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding two (2) months 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 that key personnel from the patent owner are unavailable from 08 June to 18 June 2010. The ten days in which the personnel are unavailable supports a request of fourteen days extension of time. 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 fourteen (14) days.

CONCLUSION

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action mailed on 16 April 2010 is hereby **granted-in-part.**

2. The period for response is extended by fourteen (14) days.

3. The response is extended to **30 June 2010.**

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, 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

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

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MAR 08 2010

CENTRAL REEXAMINATION UNIT

Song K. Jung
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

Babak Redjaian
IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,586
Filed: September 23, 2009
For: U.S. Patent No. 7,218,374

Inter Partes Reexamination Proceeding
Control No. 95/000,506
Filing Date: September 22, 2009
For: U.S. Patent No. 7,218,374

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 7,218,374 (the '374 patent) issued on May 15, 2007, with claims 1-22.

2. The '374 patent is the subject of a concurrent proceeding styled *LG Display v. AU Optronics; Chi Mei Optoelectronics, and Chi Mei Optoelectronics USA,* Consolidated Case Nos. 06-726-JJF, 07-357-JJF, and 08-355-JJF (D.Del.). The complaints were filed on December 1, 2006, June 6, 2007, and June 12, 2008.

3. On September 22, 2009, a third party, Chi Mei Optoelectronics Corporation, filed a request for *inter partes* reexamination of claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 that was assigned control no. 95/000,506 (the '506 proceeding).

4. On September 23, 2009, a third party, Chi Mei Optoelectronics Corporation, filed a request for *ex parte* reexamination of claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 that was assigned control no. 90/009,586 (the '9586 proceeding).

5. On November 3, 2009, reexamination was ordered for claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 of the '556 patent in both the *inter partes* '506 proceeding and the *ex parte* '9586 proceeding. No claim amendments have been made in either proceeding. No Office action has been issued in either proceeding.

6. On January 3, 2009, the time for filing a patent owner statement under § 1.530 expired without the filing of a patent owner statement.

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 *inter partes* '506 proceeding and the *ex parte* '9586 reexamination proceedings are currently pending. An order granting reexamination of claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 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 '9586 *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 *inter partes* '506 proceeding and the *ex parte* '9586 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,506 and 90/009,586 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, Chi Mei Optoelectronics Corporation has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 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. 95/000,506 and *ex parte* Reexamination Control No. 90/009,586 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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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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JUN 16 2010

CENTRAL REEXAMINATION UNIT

MCKENNA LONG & ALDRIDGE LLP (For Patent Owner)
1900 K STREET, NW
WASHINGTON DC 20006

IRELL & MANELLA LLP (For Third party Requester)
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

In re: Park *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,506
Deposited on: 22 September 2009
For: US Patent No. 7,218,374 B2

In re: Park *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,586
Deposited on: 23 September 2009
For: US Patent No. 7,218,374 B2

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956]

This is a decision on the 08 June 2010, patent owner's "Petition for Extension of Time Under 37 CFR § 1.956," requesting that the time for responding to the non-final Office action mailed 16 April 2010 to be extended by six (6) weeks.

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 requests an extension of time in which to file a response to the non-final Office action dated was mailed 16 April 2010. The non-final Office action provides a two (2) month period for response. The petition requesting a six (6) weeks extension of time was timely filed on 08 June 2010. The $200 petition fee pursuant to 37 CFR §1.17 (g) is provided.

The request is granted-in-part. A one (1) month extension of time is granted.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes 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 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.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), 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.
> Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time

period. Second or subsequent requests for extensions of time, **or requests for more than one month, will be granted only in extraordinary situations.** ... (emphasis added)

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

Decision

The patent owner petitions to extend the period for response by adding six (6) weeks 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 articulates the length of the Office action and applied references. On balance, the petitioner has demonstrated "sufficient cause" for granting-in-part the extension of time. Requests for extensions of time for more than one month will be granted only in extraordinary situations.

The concurrent proceedings are noted but since they are outside the scope of the instant proceeding are not germane to the issue of "sufficient cause."

The petition request to extend the response time is hereby granted-in-part. One (1)month time is hereby granted

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated 16 April 2010 is hereby **granted-in-part**.

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

3. The period to respond will end on **16 July 2010**.

4. All correspondence involving this proceeding may be addressed to the following:

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

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

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

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, 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

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.
90/009,588	09/28/2009	6803984	7773.103.60	1875

30827 7590 03/05/2010

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

IRELL & MANELLA LLP

1800 Avenue of the Stars, Suite 900

Los Angeles, CA 90067-4276

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MAR 05 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,588*.

PATENT NO. *6803984*.

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

Song K. Jung
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

MAILED

MAR 05 2010

CENTRAL REEXAMINATION UNIT

Babak Redjaian
IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,588
Filed: September 28, 2009
For: U.S. Patent No. 6,803,984

Inter Partes Reexamination Proceeding
Control No. 95/000,507
Filing Date: September 28, 2009
For: U.S. Patent No. 6,803,984

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 6,803,984 (the '984 patent) issued on October 12, 2004, with claims 1-21.

2. On September 28, 2009, a third party, Chi Mei Optoelectronics Corporation, filed a request for *inter partes* reexamination of claims 1, 2, 4-6, 9, and 10, that was assigned control no. 95/000,507 (the '507 proceeding).

3. On September 28, 2009, a third party, Chi Mei Optoelectronics Corporation, filed a request for *ex parte* reexamination of claims 1, 2, 4-6, 9, and 10, that was assigned control no. 90/009,588 (the '9588 proceeding).

4. On November 6, 2009, reexamination was ordered for claims 1, 2, 4-6, 9, and 10 of the '984 patent in both the *inter partes* '507 proceeding and the *ex parte* '9588 proceeding. No claim amendments have been made in either proceeding.

5. On December 24, 2009, patent owner filed a notice of concurrent proceedings stating that the '984 patent is the subject of a concurrent proceeding styled *LG Display v. AU Optronics; Chi Mei Optoelectronics, and Chi Mei Optoelectronics USA,* Consolidated Case Nos. 06-726-JJF, 07-357-JJF, and 08-355-JJF (D.Del.). The complaints were filed on December 1, 2006, June 6, 2007, and June 12, 2008. No Office action has been issued in either proceeding.

6. On January 6, 2009, the time for filing a patent owner statement under § 1.530 expired without the filing of a patent owner statement.

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 *inter partes* '507 proceeding and the *ex parte* '9588 reexamination proceedings are currently pending. An order granting reexamination of claims 1, 2, 4-6, 9, and 10 of the '984 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent owner's statement has expired in the '9588 *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 *inter partes* '507 proceeding and the *ex parte* '9588 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,507 and 90/009,588 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, Chi Mei Optoelectronics Corporation has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1, 2, 4-6, 9, and 10 of the '984 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. 95/000,507 and *ex parte* Reexamination Control No. 90/009,588 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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Senniger Powers LLP
100 North Broadway
17th Floor
St. Louis, MO 63102

For Patent Owner

MAILED

JAN 29 2010

CENTRAL REEXAMINATION UNIT

Townsend & Townsend & Crew, LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,583
Filed: June 24, 2009
For: U.S. Patent No. 5,910,088

Ex Parte Reexamination Proceeding
Control No. 90/009,596
Filed: September 24, 2009
For: U.S. Patent No. 5,910,088

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided 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. 90/010,583 was ordered in a decision mailed September 4, 2009 granting reexamination of claims 1-9, all of the claims then pending in US Patent No. 5,910,088[1]. Patent owner filed an Information Disclosure Statement on December 30, 2009. No Office action has been rendered since the mailing of the decision ordering reexamination.

[1] At the time of filing of this request, proceedings in prior reexamination proceeding Control No. 90/010,156 had not concluded, thus the request and order were based on original patent claims 1-9, the claims then in effect.

Reexamination in application control No. 90/009,596 was ordered in a decision mailed November 20, 2009 granting reexamination of claims 2-7 and 10-16, all of the claims pending in US Patent No. 5,910,088 following the publication of reexamination certificate No. 7,038 on September 1, 2009. Patent owner filed an Information Disclosure Statement on December 30, 2009. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/010,583 and reexamination control No. 90/009,596 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 petition to merge the above-captioned proceedings is granted and the 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, drawings, and specification in both files. As noted above, when reexamination Control 90/010,583 was filed, only claims 1-9 were in effect at that time and the submitted copy of the patent for which reexamination was requested only contained original patent claims 1-9. However, when the second reexamination request was filed, i.e., reexamination Control No. 90/009,596, by virtue of the publication of first reexamination certificate No. 7,038, original patent claims 1, 8 and 9 had been cancelled; original patent claims 2, 6 and 7 had been amended, and new claims 10-16 added. Thus, the proceedings do not include identical claims. **Accordingly, patent owner is hereby required to provide 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

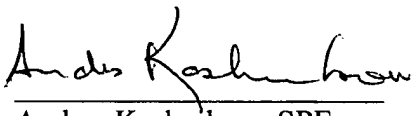
The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently all of the pending claims, namely claims 2-7 and 10-16, are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each paper 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(s) and requester(s) 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 fee, brief fee, etc.) only a single feed 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 art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/010,583 and 90/009,596 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 claim in each of the files**. Upon receipt of the response or expiration of the time period indicated above, whichever comes first, the 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, Supervisory Primary Examiner, at telephone No. (571) 272-4361.



Andres Kashnikow, SPE
Central Reexamination Unit 3993

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.
90/009,610	10/22/2009	5543047	22401-0001RX3	1663

7590 06/15/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/15/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
3M INNOVATIVE PROPERTIES COMPANY
P.O. BOX 33427
ST. PAUL, MN 55133-3427

Date:
MAILED

JUN 15 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009610
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)).

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.
90009610	10/22/09	5543047	

EXAMINER

Dorothy P. Whelan
FISH & RICHARDSON P.C.
60 SOUTH SIXTH STREET, SUITE 3200
MINNEAPOLIS, MN 55402

ART UNIT	PAPER
3999	20100615

MAILED

DATE MAILED: JUN 15 2010

CENTRAL REEXAMINATION UNIT

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

Commissioner for Patents

This is a courtesy copy of the decision granting petition for extension of time.

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

John M. Belz
Leydig,Voit & Mayer
700 Thirteenth Street N.W.
Suite 300
Washington, DC 20005

(For Patent Owner)

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JUN 15 2010

CENTRAL REEXAMINATION UNIT

Dorothy P. Whelan
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402

(For Requester)

Ex Parte Reexamination Proceeding
Control No. 90/009,610
Filed: October 22, 2009
For: US Patent No. 5,543,047

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

This is a decision on the petition filed June 3, 2010 to request a one-month extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated April 22, 2010.

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 April 22, 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 and counsel have been diligently working to prepare a response. Patent Owner's representatives, attorney, technical experts and inventors have met and discussed the claimed invention and the cited prior art and are preparing the declarations and arguments necessary to thoroughly respond to the Office action. A graphics firm has been contacted to develop demonstratives that will help the USPTO better understand the claimed invention. Despite the actions taken thus far, additional time is needed to prepare and complete the response to the outstanding Office action. One month is requested.

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 a response tot eh outstanding Office action. Accordingly, the period of time is extended to July 22, 2010. 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 22, 2010.

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/
SPE, Art Unit 3991
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,610	10/22/2009	5543047	22401-0001RX3	1663

7590 07/15/2010

EXAMINER	

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

ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

3M INNOVATIVE PROPERTIES COMPANY

P.O. BOX 33427

ST. PAUL, MN 55133-3427

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,610*.

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)).

Ex Parte Reexamination Interview Summary	Control No.	Patent Under Reexamination	
	90/009,610	5543047	
	Examiner	Art Unit	
	Krisanne Jastrzab	3991	

All participants (USPTO personnel, patent owner, patent owner's representative):

(1) *Krisanne Jastrzab*

(2) *Deborah Jones*

(3) *Alan Diamond*

(4) *John Belz, Stephen Geibel*

Date of Interview: *15 July 2010*

Type: a)☐ Telephonic b)☐ Video Conference
c)☐ Personal (copy given to: 1)☐ patent owner 2)☒ patent owner's representative)

Exhibit shown or demonstration conducted: d)☒ Yes e)☐ No.
If Yes, brief description: *computer animation depicting "intimate contact" and filter construction*

Agreement with respect to the claims f)☐ was reached. g)☒ was not reached. h)☐ N/A.
Any other agreement(s) are set forth below under "Description of the general nature of what was agreed to..."

Claim(s) discussed: *21,22 and 35*.

Identification of prior art discussed: *JP'220, SU'201, Miller '207 &'743 and Taga*.

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:
See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims patentable, if available, must be attached. Also, where no copy of the amendments that would render the claims patentable is available, a summary thereof must be attached.)

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION MUST INCLUDE PATENT OWNER'S STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. (See MPEP § 2281). IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN **ONE MONTH** FROM THIS INTERVIEW DATE TO PROVIDE THE MANDATORY STATEMENT OF THE SUBSTANCE OF THE INTERVIEW (37 CFR 1.560(b)). THE REQUIREMENT FOR PATENT OWNER'S STATEMENT CAN NOT BE WAIVED. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

/Krisanne Jastrzab/ Primary Examiner, Art Unit 3991		

cc: Requester (if third party requester)

Continuation of Description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. Belz asserted that the hmax formula of the patent is not inherent to all spiral filters because spacing between pleats is conventional and such spacing lengthens the pleats beyond hmax of the patent. Mr. Geibel further asserted that "intimate contact" as used in the claims was not a desired feature of filters at the time of the invention because it was felt it would compromise the filtration efficiency. Mr. Belz asserted that the Hamlin declaration is erroneous because a goal of putting as much filter material in the donut as possible is not the sole driving factor in filter optimization and design. Mr. Belz pointed out that JP '220 does not provide pleats in intimate contact because they are constructed with a wire (4) adjacent the inner core which creates spacing between pleat legs. Mr. Belz further noted that they would be filing a 131 declaration to swear behind the SU '201 reference. Examiner Jastrzab noted that the description of the invention appeared to require the particular layered filter construction in order for the intimate contact and pleat height to be effective. Mr. Belz indicated that while Miller '207 and '743 teach the layered filter construction, neither teach nor suggest the intimate contact spiral configuration. Finally, Mr. Belz indicated that Taga did not teach or suggest either the hmax formula or intimate contact because it clearly used fins 9 to separate and maintain the pleats and the statement in column 3 regarding maximizing pleat heights did not clearly suggest intimate contact. The Examiner indicated that she would fully consider all points upon filing of the response to the outstanding office action.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,610	10/22/2009	5543047	22401-0001RX3	1663

7590 07/19/2010

EXAMINER	

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

ART UNIT	PAPER NUMBER

DATE MAILED: 07/19/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

3M INNOVATIVE PROPERTIES COMPANY
P.O. BOX 33427
ST. PAUL, MN 55133-3427

Date:
MAILED

JUL 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009610
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)).

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

John M. Belz
Leydig,Voit & Mayer
700 Thirteenth Street N.W.
Suite 300
Washington, DC 20005

(For Patent Owner)

MAILED

JUL 19 2010

CENTRAL REEXAMINATION UNIT

Dorothy P. Whelan
3M Innovative Properties Company
P.O. Box 33427
Minneapolis, MN 55133-3427

(For Requester)

Ex Parte Reexamination Proceeding
Control No. 90/009,610
Filed: October 22, 2009
For: US Patent No. 5,543,047

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

This is a decision on the petition filed July 19, 2010 to request a one-week extension of time pursuant to 37 CFR 1.550 for filing a response to the Office action dated April 22, 2010.

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

The petition is granted for one week for the reasons set forth below.

Decision

The Patent Owner requests an additional one-week extension of time in which to file a response to the Office action April 22, 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, in light of the interview held July 15, 2010 concerning possible amendments to the claims and the preparation of a 131declaration, an additional one-week extension of time is necessary for Patent owner and counsel to complete a thorough response to the outstanding Office action. One week is requested.

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-

week extension of time in which to file a response to the outstanding Office action. Accordingly, the period of time is extended to July 29, 2010. 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-week extension of time in which to file a response to the Office action is **granted**.

2. The Patent Owner's response is due July 29, 2010.

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 /
SPE, Art Unit 3991
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.
90/009,611	11/02/2009	6,371,637	5377-014	5280

6980 7590 03/18/2010

TROUTMAN SANDERS LLP
5200 BANK OF AMERICA PLAZA
600 PEACHTREE STREET, N.E.
SUITE 5200
ATLANTA, GA 30308-2216

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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
COATS & BENNETT, P.L.L.C.
1400 CRESCENT GREEN
RALEIGH, NC 27602

Date: MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009611
PATENT NO. : 6371637
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.
90/009,343	11/26/2008	6371637	5377-014	2594

6980 7590 03/18/2010

TROUTMAN SANDERS LLP
5200 BANK OF AMERICA PLAZA
600 PEACHTREE STREET, N.E.
SUITE 5200
ATLANTA, GA 30308-2216

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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
DANIEL P. HOLMILLER
1400 CRESCENT GREEN
SUITE 300
CARY, NC 27518

Date:

MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009343
PATENT NO. : 6371637
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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MAR 18 2010

CENTRAL REEXAMINATION UNIT

James E Schutz
TROUTMAN SANDERS LLP
5200 BANK OF AMERICA PLAZA
600 PEACHTREE STREET, N.E.
SUITE 5200
ATLANTA GA 30308-2216

(For Patent Owner)

Daniel P Holmiller
1400 Crescent Green
Suite 300
Cary, NC 27518

(For Third Party Requester)

In re: Atchinson *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,343
Deposited : 26 November 2008
For: US Patent No. 6,371,637

In re: Atchinson *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,611
Deposited : 02 November 2009
For: US Patent No. 6,371,637

DECISION
SUA SPONTE
MERGING
PROCEEDINGS
[37 CFR § 1.565(c)]

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

BACKGROUND

1. On 16 April 2002 US Patent No. 6,371,637 was granted to Atchinson *et alia*.

2. On 26 November 2008 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,343.

3. On 08 January 2009 the Order was granted for *ex parte* reexamination in control number 90/009,343.

4. On 11 September 2009 a non-final Office action was mailed in 90/009,343.

5. On 11 December 2009 an amendment and remarks were received in 90/009,343.

6. On 26 October 2009 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,611.

7. On 22 December 2009 the Order was granted for ex parte reexamination in control number 90/009,611.

8. There are no amendments to the claims in control number 90/009,611.

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. 90/009,343 & 90/009,611 *ex parte* 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 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.

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. 90/009,343 & 90/009,611 *ex parte* reexamination proceedings 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/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

STROOCK & STROOCK & LAVAN LLP
180 MAIDEN LANE
NEW YORK NY 10038

(For Third Party Requester)

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

(For Third Party Requester)

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

In re Turock	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/010,716	: MERGING
Corrected Request Deposited: December 7, 2009	: REEXAMINATION
For: U.S. Patent No. 6,243,373	: PROCEEDINGS
In re Turock	:
Reexamination Proceeding	:
Control No. 90/009,637	:
Corrected Request Deposited: December 29, 2009	:
For: U.S. Patent No. 6,243,373	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,243,373 (hereinafter, the '373 patent), issued to Turock, on June 5, 2001.

2. On December 7, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '373 patent. The reexamination proceeding was assigned Control No. 90/010,716 (hereinafter, the '10716 proceeding).

3. The Reexamination Order was granted in the '10716 proceeding on January 29, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-6 and 13-18.

4. On December 29, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '373 patent. The reexamination proceeding was assigned Control No. 90/009,637 (hereinafter, the '9637 proceeding).

5. The Reexamination Order was granted in the '9637 proceeding on January 29, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-24.

6. The period for a Patent Owner statement has expired.

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 '10716, and '9637 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 each proceeding, 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. 90/010,716 and 90/009,637 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas W. Humphrey, Esq.
Wood Herron & Evans
2700 Carew Tower
Cincinnati, OH 45202

For Patent Owner

MAILED

JUN 28 2010

CENTRAL REEXAMINATION UNIT

Walter Scott, Esq.
Alston & Bird, LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,455
Filed: April 23, 2009
For: U.S. Patent No. 5,868,710

Ex Parte Reexamination Proceeding
Control No. 90/009,672
Filed: January 22, 2010
For: U.S. Patent No. 5,868,710

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided 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. 90/009,455 was ordered in a decision mailed May 29, 2009. The decision granted reexamination for patent claims 1, and 9-11, the only claims for which reexamination was requested. On September 26, 2009, a non-final Office action was mailed rejecting claims 9-11 and confirming claim 1. On November

25, 2009, patent owner filed a response to the Office action. The response presented arguments in favor of confirmation of claims 9-11. The response also added new dependent claims 13-41. No Office action has been rendered since the receipt of patent owner's response.

Reexamination in application Control No. 90/009,672 was ordered in a decision mailed March 24, 2010. The decision indicating that claims 1-3 and 9-11, the only claims for which reexamination was requested, would be reexamined. No Patent Owner Statement under 37 CFR 1.530 was filed by patent owner. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/009,455 and reexamination control No. 90/009,672 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings and both proceedings are pending, a decision under 37 CFR 1.565(c) is timely. Accordingly, the petition to merge the above-captioned proceedings is granted and the 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, no original patent claims have been amended, but new dependent claims 13-41 have been added by amendment in reexamination control No. 90/009,455. No amendment has been filed in reexamination control No. 90/009,672. As patent owner is required to maintain identical claims, drawings, and specification in both files, and keeping with the statutory requirement of 35 U.S.C. 305 that "All reexamination proceedings under this section ...will be conducted with special dispatch within the Office.", to expedite the proceedings, a copy of pages 2-8 of the response filed November 25, 2009 in reexamination control No. 90/009,455, which pages contain a complete copy of all of the original claims as well as the newly added dependent claims 13-41 (copy attached) will be entered into the file of reexamination control No. 90/009,672, and this version of the claims, which is the most recent, will be treated in the next Office action.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. As indicated above, original patent claims 1 and 9-11 as well as new claims 13-41 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 paper 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 fee, brief fee, etc.) only a single feed 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 art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/009,455 and 90/009,672 are hereby merged into a single proceeding. Upon the mailing of this decision, the files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits that is consistent with this decision.

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

Andres Kashnikow, SPE
Central Reexamination Unit 3993

Attachment: copy of pages 2-8, Listing of Claims, submitted with response received November 25, 2009 in reexamination control No. 90/009,455.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,693	02/22/2010	5903309	353990US91RX	4226

93143 7590 07/07/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, LLC
1940 DUKE STREET
ALEXANDRIA, VA 22314

Date:
MAILED
JUL 07 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009693
PATENT NO. : 5903309
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.
90/010,683	09/15/2009	5903309	R132590	1042

93143 7590 07/07/2010

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

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Date: **MAILED**

JUL 0 7 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010683
PATENT NO. : 5903309
ART UNIT : 3992

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JUL 07 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Herskovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Third Party Requester)

MORRISON & FOERSTER LLP
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(For Third Party Requester)

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

In re Anderson Reexamination Proceeding Control No. 90/010,683 Request Deposited: September 15, 2009 For: U.S. Patent No. 5,903,309	: DECISION *SUA SPONTE* : MERGING : REEXAMINATION : PROCEEDINGS
In re Anderson Reexamination Proceeding Control No. 90/009,693 Request Deposited: February 22, 2010 For: U.S. Patent No. 5,903,309	:

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,903,309 (hereinafter, the '309 patent), issued to Anderson, on May 11, 1999.

2. On September 15, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '309 patent. The reexamination proceeding was assigned Control No. 90/010,683 (hereinafter, the '10683 proceeding).

3. The Reexamination Order was granted in the '10683 proceeding on October 30, 2009 finding a substantial new question of patentability (SNQP) as to claims 1-13.

4. A non-final office action was mailed in the '10683 proceeding on February 19, 2010.

5. On April 19, 2010, Patent Owner responded to the office action in the '10683 proceeding and added new claims 14-36.

6. On February 22, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '309 patent. The reexamination proceeding was assigned Control No. 90/009,693 (hereinafter, the '9693 proceeding).

7. The Reexamination Order was granted in the '9693 proceeding on April 8, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-13.

8. Patent Owner did not waive their right to a file a Patent Owner statement. The period for a Patent Owner statement has expired.

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 '10683, and '9693 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 14-36 have been added in the '10683 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in each proceeding, 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. 90/010,683 and 90/009,693 are MERGED.

2. 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
SPE, AU 3992

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JACKSONVILLE, FL 32207

(For Patent Owner)

MAILED

DEC 17 2007

CENTRAL REEXAMINATION UNIT

Cooley Godward Kronish LLP
ATTN: Patent Group
One Freedom Square
777 6th Street, NW, Suite 1100
Washington DC 20001

(For Requester)

In re *Shaw et al.*
Reexamination Proceeding
Control No. 90/010,005
Filed: August 6, 2007
For: U.S. Patent No. 5,429,437

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on November 26, 2007, styled as "Petition For Review Under 37 CFR § 1.181," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated October 24, 2007. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,429,437 (hereinafter, the '437 patent) issued on July 4, 1995.

2. On September 23, 2005, a third party requester deposited a request for *ex parte* reexamination for claims 1-8 of the '437 patent, and the resulting reexamination proceeding was assigned Control No. 90/007,736 (hereinafter, the '736 proceeding). The reexamination proceeding was granted on November 2, 2005.

3. On October 25, 2007, the patent owner of the '437 patent filed an appeal brief. Currently, claims 1-8 stand rejected and new proposed claims 9-20 are indicated allowable.

4. On August 6, 2007, the third party requester deposited a new request for *ex parte* reexamination for claims 1-20 currently pending in the '736 reexamination proceeding, and the resulting reexamination proceeding was assigned Control No. 90/010,005 (hereinafter, the '005 proceeding).

5. A Notice of Reexamination Request Filing Date was issued on September 11, 2007.

6. An order denying the request for reexamination for claims 1-8 was issued on October 24, 2007.

6. On November 26, 2007, 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 two grounds for which petitioner feels the examiner erred in not finding that substantial new question of patentability exists. The first ground is that French Patent No. 1,371,288 to Yves (hereinafter "Yves") establishes a substantial new question of patentability. The second ground is that the examiner failed to addressed claims 9-20 in the order denying the reexamination proceeding.

In support of their showing under the above-mentioned first ground, the petitioner advances the following two arguments:

1. Yves provides a new teaching because it teaches the invention of claim 1 in a single reference, and accordingly, a reasonable examiner would consider Yves important in deciding whether or not to allow the claims.
2. The reexamination examiner erred in considering Yves cumulative to the teachings U.S. Patent No. 2,719,982 to Hasselquist because Yves discloses a new teaching of a stainless steel resilient frame member.

Petitioner arguments hinge on establishing that Yves establishes a substantial new question of patentability, either alone or in combination with other secondary references.[1]

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-8 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-8 of the '437 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 1-8. The review will not consider evidence not of record at the time of the request for reexamination (e.g., evidence made of record for the first time in the petition).

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous

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[1] In footnote 3 on page 5 of the instant petition, petitioner also argues that Yves in combination with a secondary reference also raises a substantial new question of patentability. This argument is being addressed as part of the overall question of whether Yves raises a substantial new question alone or in combination with other references.

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.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 states that:

> No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.

---

[2] Public Law 96-517, enacted on December 12, 1980.

The decision denying the request will then indicate, for each patent and printed publication cited in the request, why the citation is:

(A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;

(B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);

(C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or

(D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

The examiner should also, in the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

A. In regard to petitioner's first ground, the request fails to raise a substantial new question of patentability regarding Yves (either alone or in combination with other references) that is different from patentability issues raised in the prosecution of application number 08/287,761, which issued as the 5,429,437 patent, and in the pending reexamination proceeding '736.

The request for reexamination, dated August 6, 2007, stated that the following substantial new question of patentability (SNQ) existed:

1. Claims 1, 4, 7-9, 12-15, 18 and 20 of the Shaw patent are anticipated by the Yves patent under 35 U.S.C. § 102.
2. Claims 2, 3, 10, 11, 16, and 17 of the Shaw patent are obvious under 35 U.S.C. § 103 in view of the Yves patent in view of the Hasselquist patent.
3. Claims 1, 4-9, 12-15, and 18-20 of the Shaw patent are obvious under 35 U.S.C. §103 in view of the Yves patent in view of the McAtarian patent.
4. Claims 2, 3, 10, 11, 16, and 17 of the Shaw patent are obvious under 35 U.S.C. §103 in view of the Yves patent in view of the McAtarian patent and further in view of the Hasselquist patent.

As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated August 6, 2007. As will be discussed in further detail in section B. below, consideration is limited as to whether the cited patents raise a substantial new question of patentability (SNQ) to patent claims 1-8.

The U.S. Patent Nos. 2,529,872 and 2.719,982 to Hasselquist, U.S. Patent No. 5,116,273 to Chan, and U.S. Patent No. 6,112,930 to McAtarian were the basis for an order granting reexamination of the 5,429,437 patent in the '736 proceeding. Moreover, the McAtarian patent was twice applied in a rejection of claims 1-8 of the '437 patent. Therefore, Yves is the only reference not previously considered in the previous examination of the '437 patent. Accordingly, Yves must present a new technical teaching (e.g, new information) not previously considered in the previous examination in order for a second request for reexamination to be granted. Yves must also present the teachings of Hasselquist and McAtarian "in a new light" in order to raise a substantial new question of patentability in regards to these secondary references that were already considered in previous examinations.

As previously stated, Yves was not considered in the prosecution of the application, which issued as the 5,429,437 patent, or in the '736 reexamination proceeding. It is also agreed that Yves has a prior art date under 35 U.S.C. 102(b). Yves, however, fails to provide any new teachings as presented in the request for reexamination dated August 6, 2007. In the request, the Yves is described as showing each limitation of patent claim 1. In particular, the requester states that Yves teaches the "resilient" frame member connected to the perimeter of the bottom member wherein the frame member is collapsible from an open stable configuration into a smaller stable configuration by utilizing stored energy to self-open from the smaller stable configuration to the open stable configuration (see pages 12-13 of the request and pages 4-5 of the instant petition). Petitioner states that the stainless steel cable 5 are inherently "resilient," and that because Yves teaches the same structural elements as claim 1 of the '437 patent, Yves meets all the functional limitations pertaining to the open and smaller configurations. The request further states that the evidence that Yves' cable 5 is inherently "resilient" is the statement in Yves that the cable is "practically non-deformable" stated in the left-hand column of page 1. No other evidence was provided regarding inherent resiliency of the Yves' cables in the request dated August 6, 2007.

The evidence and explanation, as set forth in the request dated August 6, 2007, simply does not support ordering a request for reexamination. Yves does not present sufficient evidence to present the Hasselquist or McAtarian references in a new light, or provides any new teaching that was not already considered in a previous examination. Regardless of whether or not Yves' cable 5 is resilient, the teaching of a "resilient" frame member in a collapsible liquid container device was present and considered in the previous examinations. For example, in the '736 reexamination proceeding, the examiner consider and applied McAtarian's teachings a resilient frame member 28. In addition, in the examination of the application that became the '437 patent, U.S. Patent No. 2,754,869 to Bartels also teaches a steel cable surrounding the perimeter of the bottom member of a collapsible liquid container. There is little doubt that the teachings McAtarian were extensively considered in a previous examination. As to the other claim limitations allegedly taught by Yves, the record is clear that the Hasselquist's patents and McAtarian patent also provide such teachings, and that the examiner considered them in the '736 reexamination proceedings. For example, Hasselquist's patent '982 teaches a collapsible liquid container device (Fig. 1 container) having a bottom member (flat bottom 10), a wall member (marginal wall 11) with an open top, a floating member (inner tube 20), and a frame member (restraining cord 15). Accordingly, Yves does not present any new technical teaching that was

not present and considered in a previous examination. Petitioner's argument that Yves raises an SNQ because Yves teaches of all the elements of claim 1 in a single reference (as opposed to multiple references already considered) is unpersuasive. Reexamination proceedings can be granted if there is a SNQ established based upon a single reference (e.g., under 35 U.S.C. 102) or multiple references (e.g., 35 U.S.C. 103). The fact that Yves allegedly teaches all the elements of patent claim 1 in a single reference does not, by itself, present a new technical teaching if, as the case is here, the references of record teach the same elements. Accordingly, Yves' teachings are deemed cumulative to the teachings already consider and as such, a reasonable examiner would not consider these teachings important in light of the entire record of the previous examination.

Furthermore, Yves in combination with the secondary references also fails to raise an SNQ as to claims 1-8 of the '437 patent. In accordance with the legislative history of legislation concerning reexamination, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. Accordingly, as Yves presented in the August 6, 2007 request, does not provide a new light or new information to the teachings of McAtarian or Hasselquist, a request for reexamination cannot be granted.

This policy is consistent with the legislative history as discussed above. Petitioner can still avail themselves of the *ex parte* reexamination proceeding, if petitioner can formulate a request that brings forth some new technological information that was not consider in a previous examination.

As explained in the order denying reexamination, in accordance with MPEP 2242, "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.

B. Requester correctly notes that a previous reexamination of the '437 patent is still pending. Reexam control number 90/007,736 is currently in the appeal process. Therefore, at the time of filing the instant reexamination request, the reexamination certificate had not published. Since it has not yet published, proposed new claims 9-20 are not part of the patent. See 37 CFR 1.530(d) and (k). Although the petitioner is correct that MPEP 2240 does allow for the presentation of SNQs for proposed new of amended claims, this practice is only to expedite processing should the request for reexamination be granted on SNQs based on the patent's claims. The Office is only authorized by statute to grant a reexamination proceeding based on any substantial new question "affecting any claim of the patent." See 35 U.S.C. 303. Accordingly, there must be at least one SNQ established for claims 1-8 of the '437 patent in order to grant reexamination. Any amendments to the claims or new claims added during the prosecution of Reexam Control No.

90/007,736 cannot be considered in the determination to grant the reexamination proceeding. In fact, a request for consideration of the proposed new claims would constitute improper *inter partes* participation in an *ex parte* reexam. Thus, requester's comments and arguments regarding the proposed new claims 9-20 in a previous reexamination cannot be considered. Therefore, only requester's arguments and comments regarding original patent claims 1-8 have been considered in deciding this reexamination request. Similarly, the presented prior art has been considered only as it relates and applies to original patent claims 1-8.

REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '437 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination (which new request includes the missing information identified above). The third party requester should file all evidence, with a new and complete request for reexamination, which supports the third party requester's position that Yves provides a new teaching or presents a new light to the teachings of Atarian and Hasselquist. This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. Also, the requester is not barred from filing a new request for reexamination for proposed new claims 9-20 if and when a reexamination certificate issues with claims 9-20. 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. Given the facts involved in this proceeding, the request for *ex parte* reexamination of claims 1-8 of the '437 patent was properly denied by the examiner, and consideration SNQs for proposed new claims 9-20 is not appropriate at this time.

2. Accordingly, the PETITION is DENIED.

3. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,007	08/07/2007	5501404	1007.46REX01	1999

26308 7590 03/30/2009

RYAN KROMHOLZ & MANION, S.C.
POST OFFICE BOX 26618
MILWAUKEE, WI 53226

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/30/2009

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
Bradley J. Thorson
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4800 IDS Center; 80 S. 8th Street
Minnaepolis MN 55402

Date:
MAILED

MAR 3 0 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010007
PATENT NO. : 5501404
ART UNIT : 3900

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

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

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80 South 8th Street
Minneapolis, MN 55402

MAILED

MAR 3 0 2009

CENTRAL REEXAMINATION UNIT

In re Meyer et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/010,007 : **GRANTING**
Filed: August 7, 2007 : **PETITION**
For: U.S. Patent No. 5,501,404 :

This is a decision on the February 26, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.137(b) FOR REVIVAL OF A REEXAMINATION PROSECUTION TERMINATED UNDER 37 CFR 1.550(d)."

The present petition and the 90/010,007 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The petition is granted for the reasons set forth below.

DECISION

37 CFR 1.137(b) states:

> (b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);

> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
> (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

A review of the present petition reveals that it includes, *inter alia*, an appeal brief filed on January 21, 2009. As such, petitioner has provided the response required by 37 CFR 1.137(b) (item 1). It is to be observed that this decision does not make any representation as to the propriety of the appeal brief; such will be reviewed upon return of jurisdiction to the examiner.

Payment of the requisite unintentional delay fee for a small entity was made (item 2). The petition contains the proper statement for unintentional delay in filing the required response (item 3). The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer (item 4). 37 CFR 1.137(d)(3)

Since the present petition under 37 CFR 1.137(b) includes the requisite response (item 1),[1] the $810.00 petition fee under 37 CFR 1.17(m) (item 2), and the requisite statement (item 3), the present petition to revive **is granted**.

CONCLUSION

1. The present petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction of the reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further examination and consideration of the appeal brief filed on January 21, 2009, including a review of the propriety of the appeal brief.

3. Any inquiry concerning this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

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CENTRAL REEXAMINATION UNIT

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Ex parte Reexamination Proceeding
Control No. 90/010,016
Filed: August 29, 2007
For: U.S. Patent No. 7,090,906

Inter Partes Reexamination Proceeding
Control No. 95/001,010
Filed: October 23, 2007
For: U.S. Patent No. 7,090,906

Inter Partes Reexamination Proceeding
Control No. 95/001,020
Filed: January 7, 2008
For: U.S. Patent No. 7,090,906

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF SALIENT FACTS

1. U.S. patent No. 7,090,906 ("the '906 patent") issued to William O'Keeffe on August 15, 2006, and was assigned to O'Keeffe's, Inc.

2. A request for *ex parte* reexamination of claims 1-6 of the '906 patent was filed on August 29, 2007, by Anemostat Products, as the third party requester, and the request was assigned control number 90/010,016 (the '016 *ex parte* reexamination proceeding).

3. On November 2, 2007, *ex parte* reexamination was ordered based upon the examiner's determination that the August 29, 2007 request for *ex parte* reexamination raised a substantial new question of patentability for claims 1-6 of the '906 patent.

4. Patent owner filed a statement and amended claim 5 of the '906 patent on January 2, 2008. No Office action has been mailed for the'016 *ex parte* reexamination proceeding.

5. A request for *inter partes* reexamination of claims 1-6 the '906 patent was filed on October 23, 2007, by third party requester Anemostat Products. The request was assigned control number 95/001,010 (the '1010 *inter partes* reexamination proceeding).

6. A second request for *inter partes* reexamination of claims 1-6 the '906 patent was filed on January 7, 2008, by another third party requester, Technical Glass Products. The request was assigned control number 95/001,020 (the '1020 *inter partes* reexamination proceeding).

7. On January 17, 2008, *inter partes* reexamination was ordered for the '1010 reexamination proceeding based on the examiner's determination that the October 23, 2007 request raised a substantial new question of patentability for claims 1-6 of the '906 patent.

8. On March 28, 2008, *inter partes* reexamination was ordered for the '1020 reexamination proceeding based on the examiner's determination that the January 7, 2008 request raised a substantial new question of patentability for claims 1-6 of the '906 patent.

9. No Office action has been mailed, and no amendments to the claims have been made, in the '1010 and '1020 *inter partes* reexamination proceedings.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in all three proceedings for the same claims of the same patent. Two of the proceedings (the '1010 proceeding and the '0102 proceeding) are *inter partes* reexamination proceedings and one proceeding (the '016 proceeding) is an *ex parte* reexamination 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 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.

The general policy of the Office is that multiple 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 multiple proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in all of the proceedings, and (3) to expedite the prosecution of all of the proceedings. In the present instance, merger of the '016, the '1010 and the '1020 proceedings would address these considerations. In accordance with 37 CFR 1.989(a), the 90/010,016, 95/001,010, and 95/001,020 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 ALL PROCEEDINGS

1. Patent owner is required to maintain the same claims (and specification) in all files *throughout the merged proceeding*. Since claim 5 has been amended in the '016 proceeding, so that the claims are not currently the same in both files, a "housekeeping amendment" is needed to place the same amendments in all of the proceedings.

Patent owner is required to submit an appropriate "housekeeping amendment" within one month of this decision placing the same amendments in all files. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceeding would be improper and would result in non-entry of the paper into the record, as it would result in the paper being an improper submission under 37 CFR 1.939.

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

partes third party requesters at the next opportunity that requesters have to file a paper directed to the merits having an entry right. [1]

3. In the event that the required housekeeping amendment (to place identical amendments in all files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in one of the two *inter partes* reexaminations. Therefore, the third party requester has the full *inter partes* reexamination participation rights in the merged proceeding that are set forth in 37 CFR 1.902 through 1.997.

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 three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all three of the proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, filed in **triplicate**, each bearing a signature and identifying data for all three of the proceedings, 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

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

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

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

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

C. Amendments:

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

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

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of each *inter partes* requester) which may be filed, even though the brief relates to merged multiple proceedings and a copy 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. Reexamination Control Nos. 95/001,010, 95/001,020 and 90/010,016 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

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

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner.

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

5. Any questions concerning this communication should be directed to the Caroline D. Dennison, Legal Advisor, at 571-272-7729.

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Byron Cooper

Goodwin Procter LLP

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53 State Street

Boston, MA 02109

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MAY 22 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/010,017*.

PATENT NO. *6954453*.

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.
90/010,017	08/30/2007	6954453	8096.048.RXUS00	3139

28694 7590 05/22/2009

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WASHINGTON, DC 20005

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

BYRON COOPER
GOODWIN PROCTER LLP
EXCHANGE PLACE; 53 STATE STREET
BOSTON, MA 02109

(For Requester)

In re Schindler et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,017
Filed: August 30, 2007
For: U.S. Patent No. 6,954,453

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the May 15, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 FOR RELIEF NOT CURRENTLY PROVIDED BY THE RULES THAT WOULD BE AVAILABLE WHEN A NEW REQUEST FOR CONTINUED REEXAMINATION PRACTICE IS IN EFFECT."

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

The petition is **dismissed**.

BACKGROUND

- On August 30, 2007, a request for *ex parte* reexamination was filed by the third party requester for claims 34-36 and 38, and the resulting reexamination proceeding was assigned control number 90/010,017 ("the '017 proceeding").

- Prosecution progressed until, on December 8, 2008, patent owner filed a timely appeal brief responsive to a final Office action that was issued by the Office on August 6, 2008. Patent owner, *sua sponte*, filed a corrected appeal brief on December 31, 2008.

- On March 13, 2009, an examiner's answer was mailed by the Office.

- On May 13, 2009, patent owner filed a "Reply Brief" and a "Request For Oral Hearing."

- On May 14, 2009, patent owner filed a "Corrected Reply Brief."

- On May 15, 2009, patent owner filed the instant "PETITION UNDER 37 CFR § 1.182 FOR RELIEF NOT CURRENTLY PROVIDED BY THE RULES THAT WOULD BE AVAILABLE WHEN A NEW REQUEST FOR CONTINUED REEXAMINATION PRACTICE IS IN EFFECT," concurrently with an "AMENDMENT ACCOMPANYING PETITION." The proposed amendment maintains the rejected claims in their original form, and adds new independent and dependent claims 39-45.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

DECISION

The May 15, 2009 patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of the new claims submitted with the petition. In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding **to seek entry of an amendment and/or evidence that was denied entry** after an action closing prosecution in an *inter partes* reexamination proceeding.

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]. The present proceeding has reached a point where the appeal has been briefed and answered, and granting continued reexamination at this stage would require drawing the case back from an advanced state of the appeal process. In view of the advanced stage of the proceedings, the instant petition does not facilitate handling of the proceeding with special dispatch, and is dismissed.

It is to be noted that 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 stated that "patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted

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

after final rejection in an *ex parte* reexamination proceeding or after an action closing prosecution in an *inter partes* reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule" [emphasis added]. The § 1.182 petition was created to address a need for an amendment or evidence submission that patent, the need for which was not apparent until the issuance of the final rejection or action closing prosecution, because of an issue raised for the first time at final rejection or action closing prosecution. It was not created for the purpose of permitting the patent owner to file an appeal brief, after which the examiner has already begun considering the issues of the existing situation, and would be doing unjustified re-work to consider the newly proffered amendment or evidence submission. This clearly runs contrary to special dispatch. If such a § 1.182 petition is to be filed, it is to be filed as the Notice states - after final rejection in an *ex parte* reexamination proceeding or after an action closing prosecution in an *inter partes* reexamination proceeding - such that delay is minimized. The filing of a Notice of appeal may be used in rare instances to keep a proceedings pending; however, once the appeal brief has been filed, the window for such a § 1.182 petition has closed.

Even if the present petition had been filed prior to filing the appeal brief, it would not have been grantable. A petition under 37 CFR 1.182 for continued reexamination must show how granting the petition would further the prosecution of the reexamination proceeding. Prosecution may be furthered by reducing issues, by better defining the issues for appeal, or by placing the claims in condition for the issuance of a reexamination certificate. The petition is to set forth reasons why it was not apparent until the issuance of the final rejection (based on an issue raised for the first time at final rejection) that the specifics of the submission would do so.

The timely filed instant petition adds new claims, *but does not amend the claims under appeal.* The new claims are alleged to address certain comments by the examiner, but have not been approved in the submitted form by the examiner. The addition of new claims, even where added for the purpose of adopting suggestions by the examiner, does not further prosecution where all of the appealed claims are not amended to adopt the suggestions by the examiner, and accordingly remain under rejection. The issues surrounding the claims under appeal remain, and additional issues are raised by the new claims, which have not previously been considered. The amendment does not better define the issues for appeal, since the appealed claims have not been amended. Finally, the presence of unamended, appealed claims does not appear to put the claims in condition for the issuance for the issuance of a reexamination certificate. Patent owner's description of the new claims as incorporating suggestions from the examiner to reformulate the appealed claims indicates that even should the new claims be allowable, the presently appealed claims would remain rejected. Furthermore, patent owner expresses intent to request an interview to present arguments and evidence against the examiner's rejections *of the appealed claims*; however, at this stage of the proceedings, those arguments and evidence presumably have been presented earlier or could have been presented earlier.

In view of the above, the petition is **dismissed**.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- The Central Reexamination Unit will attend to the patent owner's submissions of May 13 and May 14 in due course.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, the undersigned at (571) 272-7710.

/Kenneth M. Schor/

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

May 20, 2009
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.
90/010,018	09/26/2007	6990660	12554.0038USZA	4671

45522 7590 01/22/2008

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EXAMINER	
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,513	02/28/2007	6,990,660	46628-00100	9200

45522 7590 01/22/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

John B. Phillips
Merchant & Gould P.C.
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(For Third Party Requester)

In re Moshir *et alia*
Reexamination Proceeding
Control No. 90/008,513
Request Deposited: February 28, 2007
For: U.S. Patent No. 6,990,660

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Moshir *et alia*
Reexamination Proceeding
Control No. 90/010,018
Corrected Request Deposited: September 26, 2007
For: U.S. Patent No. 6,990,660

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,990,660 (hereinafter, the '660 patent), issued to Moshir *et alia*, on January 24, 2006.

2. On February 28, 2007, patent owner deposited a Request for *Ex Parte* Reexamination of claims 1, 23, and 55 of the '660 patent. The reexamination proceeding was assigned Control No. 90/008,513 (hereinafter, the '8513 proceeding).

3. The Reexamination Order was granted in the '8513 proceeding on April 12, 2007.

4. There are currently no amendments in the '8513 proceeding.

5. On September 26, 2007, a third party deposited a Request for *Ex Parte* Reexamination of claims 1-61 of the '660 patent. The reexamination proceeding was assigned Control No. 90/010,018 (hereinafter, the '10018 proceeding).

6. The Reexamination Order was granted in the '10018 proceeding on November 5, 2007.

7. There are currently no amendments in the '10018 proceeding.

8. The '8513 and '10018 proceedings await the first action on the merits from the assigned examiner.

DECISION

Under 37 C.F.R. § 1.565(c):

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '8513 and the '10018 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/008,513 and 90/010,018 are MERGED.

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

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

By Mail:
Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

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

Eric Keasel For

Lissi Mojica Marquis
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,020	10/09/2007	6054270	100788.0029	5022

513 7590 04/29/2008

EXAMINER	

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,428	01/16/2007	6054270		7156

513 7590 04/29/2008

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2008

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

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.
90/008,830	09/04/2007	6054270	3006US0	3702

513 7590 04/29/2008

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2008

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 :

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APR 29 2008

CENTRAL REEXAMINATION UNIT

Warren M. Cheek, Jr.
Wenderoth Lind & Ponack, LLP
2033 K Street, NW, Suite 800
Washington, DC 20006

(for Patent Owner)

Anthony G. Craig
Fliesler Meyer LLP
650 California street, 14th Floor
San Francisco, CA 94108

(for Third Party Requester)

In re Southern et al
Reexamination Proceeding
Control No.: 90/008,428
Filed: January 16, 2007
For: U.S. Patent 6,054,270

Anthony G. Craig
Fliesler Meyer LLP
650 California street, 14th Floor
San Francisco, CA 94108

(for Third Party Requester)

In re Southern et al
Reexamination Proceeding
Control No.: 90/008,830
Filed: September 4, 2007
For: U.S. Patent 6,054,270

Robert D. Fish
Fish & Associates, PC
2603 Main Street, suite 1050
Irvine, CA 92614-6232

(for Third Party Requester)

In re Southern et al
Reexamination Proceeding
Control No.: 90/010,020
Filed: October 9, 2007
For: U.S. Patent 6,054,270

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. United States Patent 6,054,270 which issued April 25, 2000, is the subject of Reexamination Control Nos. 90/008,428, 90/008,830 and 90/010,020.

2. A first request for reexamination, assigned Reexamination Control No. 90/008,428, was filed January 16, 2007 by Anthony Craig of Fliesler Meyer LLP in San Francisco. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed method or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/008,428 on February 21, 2007.

4. A first non-final Office action was issued on August 24, 2007.

5. Patent Owner filed a response on October 24, 2007.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,830, was filed September 4, 2007 by Anthony Craig of Fliesler Meyer LLP in San Francisco. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed method or are so close as to establish a case of obviousness.

7. Reexamination was ordered for 90/008,830 on October 18, 2007.

8. A subsequent request for re-examination, assigned Reexamination Control No. 90/010,020, was filed on October 9, 2007 by Robert D. Fish of Fish & Associates in Irvine CA. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed method or are so close as to establish a case of obviousness.

9. Reexamination was ordered for 90,010,020 on December 10, 2007.

8. No Office action has been issued in either of the later re-examination proceedings.

DISCUSSION

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/008,428, 90/008,830, and 90/010,020 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

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

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/008,428, 90/008,830 and 90/010,020 as:

Warren M. Cheek
Wenderoth Lind & Ponack LLP
2033 K Street, NW, Suite 800
Washington, DC 20006

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/008,428 and 90/008,830 as:

Anthony G. Craig
Fliesler Meyer LLP
650 California Street, 14th Floor
San Francisco, CA 94108

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/010,020 as:

Robert D. fish
Fish & Associates, PC
2603 Main Street, Suite 1050
Irvine, CA 92614-6232

CONCLUSION

Reexamination Control Nos. 90/008,428, 90/008,830 and 90/010,020 are merged. **Since there has been no amendment in any of the files, the requirement to file a "housekeeping amendment" is waived.** An office action will issue in due course.

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

for Lissi M. Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,021	09/06/2007	H. 5329369	4671-4672-001-02	8993

20872 7590 09/04/2008

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/04/2008

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JENNIFER C. BAILEY,HOVEY WILLIAMS LLP
2405 GRAND BOULEVARD, SUITE 400
KANSAS CITY, MO 64108

MAILED

SEP 04 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/010021

PATENT NO. 5,329,369

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

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SEP 04 2008

CENTRAL REEXAMINATION UNIT

Morrison & Foerster LLP (For Patent Owner)
425 Market Street
San Francisco, CA 94105-2482

Hovey Williams LLP (For Third Party Requester)
10801 Mastin Blvd., Suite 1000
Overland Park, KS 66210

Gates & Cooper LLP (For Third Party Requester)
Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045

In re Willis *et alia*
Reexamination Proceeding
Control No. 90/010,021
Request Deposited: September 6, 2007
For: U.S. Patent No. 5,329,369

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

In re Willis *et alia*
Reexamination Proceeding
Control No. 90/010,074
Request Deposited: December 7, 2007
For: U.S. Patent No. 5,329,369

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. 5,329,369 (hereinafter, the '369 patent), issued to Willis *et alia*, on July 12, 1994.

2. On September 6, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '369 patent. The reexamination proceeding was assigned Control No. 90/010,021 (hereinafter, the '10021 proceeding).

3. The Reexamination Order was granted in the '10021 proceeding on November 1, 2007.

4. There are currently no amendments in the '10021 proceeding.

5. On December 7, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '369 patent. The reexamination proceeding was assigned Control No. 90/010,074 (hereinafter, the '10074 proceeding).

6. The Reexamination Order was granted in the '10074 proceeding on March 4, 2008.

7. There are currently no amendments in the '10074 proceeding.

8. The '10021 and '10074 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 '10021 and the '10074 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. 90/010,021 and 90/010,074 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

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

Morrison & Foerster LLP (Patent Owner)
425 Market Street
San Francisco, CA 94105

MAILED

MAY 04 2009

Jennifer C. Bailey (First *Ex Parte* Requester)
Hovey Williams, LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108

CENTRAL REEXAMINATION UNIT

Jason S. Feldmar (Second *Ex Parte* Requester)
Gates & Cooper, LLP
6701 Center Drive West, Suite 1500
Los Angeles, CA 90045

In re Willis *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/010,021
Request Deposited: September 6, 2007
For: U.S. Patent No. 5,329,369

In re Willis *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/010,074
Request Deposited: December 7, 2007
For: U.S. Patent No. 5,329,369

DECISION
ON
PETITIONS

This is a decision addressing the patent owner papers, "PETITION UNDER 37 C.F.R. § 1.183 REQUESTING WAIVER OF THE SERVICE REQUIREMENT OF 37 C.F.R. §§ 1.550(f)," and "PETITION TO EXPUNGE INFORMATION UNDER MPEP 724.06 AND 37 C.F.R. §§ 1.59(b)," both submitted on February 23, 2009.

The petitions are before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

SUMMARY

The petition to waive the service requirement of 37 CFR 1.550(f) is **provisionally granted**. The petition to expunge information under 37 CFR 1.59 is granted to the extent that the submitted information is **provisionally sealed**, but is otherwise **dismissed**.

BACKGROUND

1. On July 12, 1994, the Office issued U.S. Patent No. 5,329,369 to Willis *et al.* (the '369 patent).

2. On September 6, 2007, a third party requester filed a request for *ex parte* reexamination of the '369 patent. The request was assigned reexamination control number 90/010,021 (the '10021 proceeding).

3. On November 1, 2007, the Office issued an order granting the '10021 reexamination request.

4. On December 7, 2007, a second third party requester filed a request for *ex parte* reexamination of the '369 patent. This second request was assigned reexamination control number 90/010,074 (the '10074 proceeding).

5. On March 4, 2008 the Office issued an order granting the '10074 reexamination request.

6. On September 4, 2008, the Office *sua sponte* merged the '10021 and the '10074 reexamination proceedings into a single "merged" proceeding (the merged proceeding).

7. On January 29, 2009, the Office issued a final Office action in the merged proceeding.

8. On February 23, 2009, the patent owner filed an Information Disclosure Statement (IDS) in the merged reexamination proceeding. The IDS was filed under seal, and was filed concurrently with a patent owner filed petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.550(f) and a petition under 37 CFR 1.59 for expungement upon issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC).

DECISION

37 CFR 1.550(f) provides (in part):

> (f) ... After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in reexamination proceeding in the manner provided by § 1.248.

37 CFR 1.183 provides:

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

37 CFR 1.59 provides:

> (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
> (2) Information forming part of the original disclosure (*i.e.*, written specification including

the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175 will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

Waiver of Service under 37 CFR 1.550(f)

Information submitted for entry into the reexamination file is, by rule,[1] made available to the public. In this instance, confidential litigation/proprietary materials (protected materials) have been submitted under MPEP 724 *et seq*. These materials have not been served on the reexamination requesters. Petitioner requests that the service of copy requirement of 37 CFR 1.550(f) be waived pursuant to 37 CFR 1.183 for these protected materials.

Under MPEP 724 *et seq.* confidential protected information may be submitted for consideration by the examiner during the examination on the merits. Pursuant to MPEP 724 *et seq.*, only such information found to be important to a reasonable examiner, in deciding whether or not a claim is patentable, is opened to the public in the reexamination file.[2] Requiring service of a copy of confidential protected information submitted under MPEP 724 *et seq.* would defeat the intent and purpose of submitting such confidential protected information. Furthermore, service of copy would thwart the intent and purpose of any protective order issued by the federal court, in the related patent litigation, as well as undermine protective order procedure/mechanisms in general. It is only when information is found to be important to a reasonable examiner in deciding whether or not a claim is patentable that the public interest in apprising the public as to the basis for patentability determination requires that the information be opened to the public. Such has not been determined to be the case at this point.

The information being submitted would be disclosed to the public if found to be "important to a reasonable examiner in deciding whether or not a claim is patentable,"[3] despite the fact that the information is not patent owner's nor requester's protected information and it is covered by a federal court's protective order. In this instance, the protective order appears to be designed to protect the rights of parties who are not part of the instant reexamination proceeding. Based on the present individual facts and circumstances, the Office is addressing the protective order issued by the court and is currently deferring to the court's judgment regarding the rights of parties not participating in the present proceeding. Therefore, patent owner is being (in this decision) called upon to apprise the federal court issuing the protective order and any other party covered by the protective order (a) that petitioner has submitted the February 23, 2009 information covered by the protective order to the Office, and (b) that disclosure to the public of the protected information would occur as to any information covered by the protective order that is found to be "important to a reasonable examiner in deciding whether or not a claim is

[1] See 37 CFR 1.11(d).
[2] For reexamination proceeding, see MPEP 724.04(c), part (C).
[3] Id.

patentable."[4] It is to be noted that information supporting patentability could, in some instances, be deemed to be "important to a reasonable examiner," even if the evidence is not persuasive on the ultimate issue of patentability.

In view of the above discussion, while an extraordinary situation is present where justice requires that the provisions of 37 CFR 1 .550(f) be waived to the extent that service on the third party requester of the materials previously submitted and identified as "confidential" is not required, the petition can only be **provisionally granted** at this time. Further action will be taken, as needed, in view of what follows. Until the below is resolved, it cannot be determined whether the waiver will be made permanent, such that the submission can be accepted and considered.

Petitioner Instructions

Petitioner must notify the court which issued the protective order, and all parties covered by the protective order that the February 23, 2009 information has been submitted to the Office, and that under the procedures of the Office for handling documents submitted under seal, if any part of the information is deemed to be "important to a reasonable examiner" in deciding patentability of at least one claim, then that part of the information would be disclosed to the public. Petitioner must then inform the Office that the court and the other parties covered by the protective order have been so informed and set forth the authorization and/or consent to the submission in light of the fact that the information might subsequently be disclosed to the public.

Petitioner is given one month or thirty (30) days (whichever is later) from the issue date of this decision to notify the court and all affected parties, and inform the Office of their authorization/non-authorization and/or consent/non-consent. Concurrent with this submission patent ***must*** provide the Office with a copy of the protective order.

If petitioner timely informs the Office that the court that issued the protective order and/or all the other parties covered by the protective order authorize or consent (respectively) to the submission, then a further decision granting the waiver of the service requirement would be issued and jurisdiction would be transferred to the Central Reexamination Unit (CRU). The information would then be considered by the examiner of record in accordance with current policies and practices relevant to the handling of protected information.

If petitioner does not timely respond, or authorization/consent to the submission of protected information to the Office is not given, then this decision would be revisited, the petition would be dismissed, and the February 23, 2009 information would be expunged from the record without any consideration. Jurisdiction would then be transferred to the CRU and the proceeding would continue.

Petition to Expunge under 37 CFR 1.59

The information submitted with the petition under 37 CFR 1.59, appears to be appropriately submitted under the guidelines of MPEP 724 *et seq*. Accordingly, the information is **provisionally sealed**.

---

[4] Id.

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public under 37 CFR 1.11(d)." If the February 23, 2009 information is not expunged from the record at the point that the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." The requisite determination has not been made, since it has not yet been determined whether the information will be entered for consideration. Therefore, a decision on the petition to expunge at this time is premature, because it is not certain that the February 23, 2009 information will remain in the record, and if the information does remain, then it must be determined whether any of the information submitted will be found to be "important to a reasonable examiner in deciding whether or not a claim is patentable." Accordingly, it is not appropriate at this time to make a determination on whether to expunge. In due course, the proceeding will be forwarded to the examiner for examination, and contingent upon entry into the record, a determination will be made as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." Pursuant to MPEP 724.04(c), the examiner may issue a determination on the issue of importance of the provisionally sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but, in no event, later than the close of prosecution.

If a determination on the issue of importance of the provisionally sealed information is ultimately made of record (as discussed above), the issue of expungment would then be ripe for a decision under the jurisdiction of the Central Reexamination Unit, at which point the petition to expunge may be renewed. **Patent owner is cautioned that, if the information remains of record, a timely renewal of the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate is necessary, to prevent the "not-found-important" provisionally sealed information being unsealed and made of record in the reexamination file and thus becoming open to the public.**

CONCLUSION

1. The petition under 37 CFR 1.183 to waive the service requirement of 37 CFR 1.550(f) is **provisionally granted**.

2. Petitioner is provided with **one month from the issue date of this decision** to submit a copy of the protective order along with a response indicating that either the court that issued the protective order and/or all the other parties covered by the protective order approve or consent (respectively) to the submission of the protective order information in the present Office proceeding per the guidelines set forth above.

3. Jurisdiction over the present proceeding will be retained by the Office of Patent Legal Administration until petitioner submits either: (1) a response to the instant decision; or (2) the one month time period has elapsed, and a decision is rendered as to whether February 23, 2009 information will remain in the record. Thereafter, jurisdiction will be transferred to the Central Reexamination Unit (CRU).

4. **The petition will be dismissed if a timely and appropriate response, as outlined above, is not received. Jurisdiction would then be transferred to the CRU but without the information covered by the protective order.**

5. If a timely and persuasive response is received, the provisional grant for waiver of service will be converted to a **grant** (by the issuance of a decision granting waiver of the service requirement). The proceeding would then be forwarded to the examiner of record for examination, and (in due course) a determination as to whether or not any portion or all of the information submitted as protected is "important to a reasonable examiner in deciding whether or not a claim is patentable."

6. The petition to expunge information submitted under 37 CFR 1.59 is granted to the extent that the submitted information is **provisionally sealed**, but is otherwise **dismissed**. The petition is subject to renewal at a later point in the proceeding, pursuant to the guidelines set forth above.

7. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

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

4-29-09
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MAY 18 2010

CENTRAL REEXAMINATION UNIT

Brian Roffe, Esq.
540-B Willow Avenue
Cedarhurst, NY 11516-2211

(For Patent Owner)

Rickard K. DeMille
Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(Third Party Requester)

In re David S. Breed et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,025
Filed: October 22, 2007
For: U.S. Patent No. 5,901,978

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

This is a decision on the April 12, 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 April 12, 2010 patent owner petition to revive").

The April 12, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The April 12, 2010 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of September 26, 2009.

shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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

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

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*

*

(d) *Terminal disclaimer.*

*

*

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

37 CFR 1.550 provides, in pertinent part:

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

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

*

*

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

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

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

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

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

*

*

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

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), the instant reexamination proceeding was terminated due to the failure to timely submit a response to the September 26, 2009 final Office action pursuant to 37 CFR 1.550(b). Although patent owner filed an Amendment on November 27, 2009, the time period set in the September 26, 2009 final Office action continued to run.[2] In addition, although the period for response to the September 26, 2009 final Office action was extended in the March 29, 2010 Advisory Action, the period for response could not be extended to run past the statutory six months from the date of the final rejection.[3]

Patent owner submitted a Notice of Appeal and paid the corresponding fee of $270.00 on April 12, 2010, thereby satisfying item (1).[4]

A petition fee of $810.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the April 12, 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.[5]

Accordingly, the April 12, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The April 12, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

---

[2] *See*: MPEP 2272(I).
[3] *See*: *Theodore Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988); MPEP 2272(I).
[4] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[5] *See*: 37 CFR 1.137(d)(3).

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3993, for processing of the April 12, 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).

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Catherine Williams, of CRU Art Unit 3993, at (571) 272-4970.

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

UNITED STATES DEPARTMENT OF COMMERCE
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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

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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.

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.

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.
90/009,052	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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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.

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.

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

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

(For Patent Owner)

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JAN 28 2008

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

(For 3rd Party Requester)
CENTRAL REEXAMINATION UNIT

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

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

Consideration of Merger

Under 37 CFR 1.565(c):

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

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

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

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

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

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

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

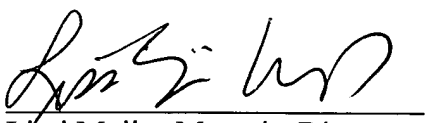
Conduct of Proceedings

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

Conclusion

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

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



Lissi Mojica Marquis, Director
Central Reexamination Unit